

Table of contents

Editorial	118	European Qualifying Examination	
Letter by the epi President		Examination Results	147
What is the <i>epi</i> ?, by W. Holzer	119	Letters to the Editor	
Council Meeting		Grace Period Discussion, by J.E.M. Galama.	148
Bericht über die 47. Ratssitzung, Berlin, 11.-12. Oktober 1999	121	The continuing discussion on the Grace Period, Comments on Heinz Bardehle's submission, by A.V. Huygens.	148
Entwurf der Beschlußliste	122	Comments on Mr. Bardehle's submission, by S. Scott	149
Report of the 47th Council meeting, Berlin, 11-12 October 1999	123	Grace Period, by J.M. Pollaro	149
Draft List of Decisions.	125	epi Membership / epi Subscription	151
Compte-rendu de la 47ème réunion du Conseil, Berlin, 11-12 octobre 1999	125	Information from the Secretariat	
Projet de Liste des Décisions.	127	<i>epi</i> Membership chart as of 1 November 1999	160
President's report	128	<i>epi</i> Art Exhibition	161
Treasurer's report	129	Training programme Queen Mary College	161
Committee Reports		Deadline 1/2000.	162
Report of the Disciplinary Committee, by S.U. Ottevangers.	130	Important warning to <i>epi</i> members	163
Report of the EASY Committee, by D. Speiser.	130	Preparations for the Year 2000 at the EPO	163
Report of the EPO Finances Committee, by J. Boff	131	<i>epi</i> Disciplinary bodies and Committees	164
Report of the EPPC Committee, by A. Casalonga	132	<i>epi</i> Board	165
Report of the epi Finances Committee, by B. Feldmann	135		
Report of the Harmonisation Committee on the Standing Committee on the Law of Patents, by F.A. Jenny	136		
Report of the Professional Qualifications Committee, by T. Onn	138		
Articles			
Priority for the same invention: what does the Paris Convention say about it (and is it relevant what the Paris Convention says about it)?, by L.J. Steenbeek	140		
Patentability Certificate Single Search and Single Patentability Opinion – Can they have a universal value?, by G. Modiano	143		

Editorial

The development of the *epi* web-site has now reached an important milestone. The web structure is finalised and has already become familiar to many *epi* members. The very basic information relevant to the European patent profession is already available in the three official languages, at the time of publication of this particular issue of *epi* information.

Now that we can appreciate the progress made over the past 2 or 3 years, we have to look to the future and how the web site must grow and develop in order to meet the expectations of the Council, the Board, and the *epi* members.

Efforts must still be made to enhance the information which is published, and to update it continuously. Special attention will be brought to emphasize the „more official“ information coming from the Board and give the latter the opportunity to express the Institute's views officially. Consideration is also being made to an appropriate *discussion forum* allowing direct communication between *epi* members. As observed by the President of the *epi*, the web site is an essential communication medium because this tool can guarantee the direct presence of the organization in all the member countries and constitutes the Institute's voice beyond the European horizon.

Obviously, in light of this, the Editorial Board will make their best efforts, in accordance with the principles laid down in its terms of references, to facilitate the publication of all information being submitted, and to ensure that this tool suits the wishes and expectations of the members.

However, it must be kept in mind that the Editorial Board is not the direct source of the majority of the information being published. This responsibility remains with each level of the organisation. It is up to the Board and the President to formulate the official views which are to be presented beyond the European horizon. Each Committee chairman will have to decide which valuable and updated information in his particular area of interest he will make available to all. The Council members will have to think about the information they wish to provide to support the views and opinions expressed at the Council meetings. Finally, it is up to each *epi* member to make a valuable contribution in order to ensure that the web site rapidly reaches maturity and definitively becomes the Institute's voice.

The web site is a communication tool – a pipe – to which the Editorial Board will bring great care and attention. However, what will flow inside that pipe is the responsibility of everybody within the Institute.

Edith Vinazzer · Jon Gowshall · Thierry Schuffenecker

What is the epi? (An attempt)

Walter Holzer, epi President

The question inevitably crosses the mind of someone new in the chair. The provocative immediate answer: *epi* is a registered, hopefully famous trade and service mark. It is also the acronym of the „European Patent Institute“, the adopted short title of the *Institute of Professional Representatives before the European Patent Office*. (In the years of its existence the *European Patent Institute* should have acquired sufficient secondary meaning to defend this denomination against passing off, if necessary.)

A brief return to the roots. The Institute was founded in 1977 when the Administrative Council of the European Patent Organisation pursuant to Article 134 EPC adopted a Regulation *governing the establishment ... of an institute constituted by the persons entitled to act as professional representatives ...* According to the Oxford Dictionary an *institute* is a „society or organisation for the promotion of scientific or other objects“. An appropriate definition. In our context the *European Patent Institute* is an organisation composed of individual members, the *European Patent Attorneys*, who in the frame of their mandatory membership enjoy voting rights and are bound by disciplinary obligations. It must be stressed that the members of the *Institute* neither are firms of attorneys nor industrial patent departments and, what should not be forgotten, the members can leave the *Institute* only by giving up their activity before the European Patent Office or by being expelled for some reason or other.

Since the organisation which calls itself „European Patent Institute or *epi* derives from a European Convention it is an *organisation of European public law*. As such it has *observer status* with other international organisations, notably the Administrative Council of the European Patent Organisation and WIPO, but recently also with the French Intergovernmental Conference and its Working Parties on Litigation and Cost Reduction. Embedded in the field of tension between non-governmental and governmental institutions the *epi* is a unique *transnational organisation*, apparently the only one of its kind.

The *Institute* also is a *legal person*. Pursuant to Art 2 of the Founding Regulation, the *Institute*

(1) *in each of the States party to the European Patent Convention shall enjoy the most extensive legal capacity accorded to legal persons under the national law of that State; it may in particular acquire or dispose of movable or immovable property and may be party to legal proceedings; furthermore the Institute*

(2) *shall be non-profit making.*

As a (European) legal person the *epi* exists alongside of national associations in all of the member states of the EPC. It is privileged because in some of the countries it may enjoy a higher legal status than the national association. It will be interesting, by the way, to examine the extent of the „most extensive legal capacity“ in the different member states. The question has been raised whether the *epi* being a *centralised* European organisation should set up branch secretariats in all or some of the member states. Since this would involve additional expenses and since the *epi* is represented by its Board members as „ambassadors“, it will probably be sufficient for the time being to maintain virtual branches of *epi* via the Internet.

Article 4 of the Founding Regulation lists the *objects* of the *Institute*. The Institute shall

collaborate with the European Patent Organisation in matters relating to the profession, in particular in disciplinary matters and in matters concerning the European Qualifying Examination;

aid in the dissemination of knowledge appertaining to the work of its members; promote compliance by its members with the Rules of Professional Conduct, inter alia through the formulation of recommendations;

liaise as appropriate with the European Patent Organisation and other bodies on all matters relating to industrial property.

While the first two paragraphs relate to the necessary basic obligations of *epi*, the third paragraph gives the Institute the freedom to liaise with *all* other bodies, such as the European Commission, WIPO, international and national associations in *all* matters relating to *industrial property*. This seems a natural objective because industrial property matters in practice are interrelated. A company might contemplate to keep its inventions secret instead of patenting them, to make more use of copyright and trade marks, to rely on design protection or utility model rights, and so on. IP-rights can be put in many different drawers!

Quite evidently, the first and foremost task of the *Institute* is to look after the interests of its members vis-a-vis the European Patent Organisation („collaboration“ does not exclude confrontation, if necessary) and nowadays also vis-a-vis the European Commission which becomes increasingly active in industrial property matters and enjoys the advantage of being able to swiftly adopt legislative measures. The *epi* for example has addressed the European Commission recently regarding representation rights of European patent attorneys in future (pan-)European judicial systems to be set up in the

wake of the upcoming Community Patent Regulation and regarding legal privileges of patent attorneys in Europe. I should also mention that the *epi* has appealed the decision of the European Commission pertaining to the Code of Conduct of *epi*, and it goes without saying that any decision of the European Court of Justice will have an effect in all member states also as concerns national codes of conduct.

A predominant field of activity for *epi* is *training and examination* of future *European patent attorneys*. Also with respect to the aforementioned centralised European judicial system, the curriculum of the European Qualifying Examination will in the future undoubtedly have to be revised to include a much broader spectrum of knowledgeable matter if European patent attorneys are to represent their clients before courts. As any Community Patent Regulation will most probably be administered by the European Patent Office, the members of *epi* acting in their general capacity as „professional representatives before the European Patent Office“ will then be able to also represent their clients/companies in Community Patent matters. Thus, the scope of activities of *epi* members will increase. It is therefore most important that European patent attorneys be accorded the right to represent their clients before pan-European courts (even if together with attorneys at law), at least with the right to speak and to be heard. It is of even importance that the European Qualifying Examination should be accepted in the member states as a „module“ in national examinations, which by the way should be provided for in all countries and at a high level!

As concerns *epi* activities in the field of so-called *continued professional education* of European patent attorneys, it goes without saying that the *Institute* up to now neither can compete with private organisations, some of which evidence an admirable ability to organise educational forums, nor with any of the hyperactive commercial tutorial conference organisations, which tend to flood our daily mail with all sorts of continued educational programs. (In fact one could totally refrain from working, concentrate on further education and

become a wise person with a high degree of professional knowledge for no apparent use.) A balance must obviously be struck between the extremes. The idea is appealing: why does not a large body like *epi* run a continued education scheme of its own? What would be needed is to cover costs only, in conformity with the requirement that the *Institute* is a non-profit organisation. The *Institute* could certainly avail itself of a sufficient number of experts among its members. Occasional seminars organised by *epi* alone or together with international or national associations are fine, however a continued collaboration with other associations would be difficult to maintain because these organisations normally pursue different interests. The *Institute* if it wishes to be successful should be able to rely on its own resources and run a competent tutorial scheme under the *epi* flag, perhaps together with an experienced neutral academic partner. The idea is not new, the market is there, it is worthwhile to examine implementing means.

Is the *Institute* also active for the general public? Basically this is not one of its tasks. However, activities of *epi* in the shaping of relevant IP- laws in collaboration with the respective authorities (EPO, WIPO, EC), raising awareness for the patent system by publications, disseminating relevant information over the Internet as well as conscientiously enforcing disciplinary rules are all activities of interest to the public. Given the present centralised structure of *epi* the future communication medium of the *Institute* in my view must be the Internet. This medium guarantees the direct presence of the organisation in all of the member states and constitutes the *Institute's* voice beyond the European horizon. The Internet at the same time not only provides the necessary *links* to authorities, national associations, publications and so forth, but also guarantees the communication highway between the members of *epi*, the central *Secretariat* and the vital *epi Committees*.

I am well aware of the fact that many thoughts could be added to these notes. Therefore, any albeit contradictory comments are welcome.

Bericht über die 47. Ratssitzung in Berlin 11.-12. Oktober 1999

Die 47. Ratssitzung fand in der beeindruckenden und schönen Stadt Berlin statt. Wie vom Präsidenten, Walter Holzer, zu Beginn der Sitzung bereits angekündigt, enthielt die anscheinend harmlose Tagesordnung wichtige Diskussionsthemen.

Am Montag, 11. Oktober 1999, um 9.00 Uhr eröffnete der Präsident offiziell die Sitzung. Nachdem die Stimmenzähler gewählt und die Tagesordnung angenommen war, wurde das Protokoll der 46. Ratssitzung in Florenz genehmigt.

Der Präsident verkündete die vom Vorstand seit der letzten Ratssitzung getroffenen Entscheidungen und Massnahmen. Dabei wies er besonders auf die Anliegen des *epi* hin, dass das Europäische Patentamt eine Entscheidung bezüglich der Zuerkennung oder Nichtanerkennung eines Anmeldetages geben möge und eine Warnung erlassen solle, dass auch ohne eine Stellungnahme einer der Parteien zu einem übersandten Schriftstück eine Entscheidung ergehen könne; beiden Anliegen wurde seitens des EPA nicht entsprochen.

Dem Rat wurde ein Bericht zur Grösse von Ausschüssen vorgelegt, die auf der einen Seite in vernünftigen Grenzen gehalten werden sollen, wobei jedoch andererseits engagierte Mitglieder, die bereit sind, konstruktive Beiträge zu leisten, nicht an der Teilnahme gehindert werden sollen. Der Bericht wurde dem Geschäftsordnungsausschuss zur weiteren Prüfung zugeleitet.

Der Präsident gab den Tätigkeitsbericht über seine Aktivitäten seit der letzten Ratssitzung, der in dieser *epi*-Information veröffentlicht ist.

Daran schloss sich der Bericht des Generalsekretärs an, der sich im wesentlichen mit dem Umzug des *epi*-Sekretariats befasste. Er dankte dem Personal des Sekretariats für die Geduld und das Durchhaltevermögen während dieser turbulenten Zeit.

Danach berichtete der Präsident über das Beschwerdeverfahren in Sachen der Standesregeln vor dem Europäischen Gerichtshof. Die Kommission hat eine Stellungnahme abgegeben. Derzeit wird vom *epi*-Anwalt eine Erwiderung ausgearbeitet. Dies brachte eine ausführliche Diskussion über den Sinn und die Erfolgsaussichten der Beschwerde in Gang, auch hinsichtlich der Kosten. Am Ende bestand weitgehende Einigkeit, die Beschwerde fortzuführen.

Die Sitzung wurde für einen Vortrag von Herrn von Moers von der Berliner Dienststelle des EPA unterbrochen. Herr von Moers begann mit einer kurzen Vorstellung der Dienststelle, in der 183 Mitarbeiter, darunter 113 Prüfer und 33 Mitarbeiter des BEST Programms, arbeiten. Sie befasst sich mit fast allen Aufgabengebieten des EPA's, einschliesslich der Bearbeitung von Anmeldungen, Recherchen und Prüfungen. Mündliche Verhandlungen können auch in Berlin abgehalten werden, wenn dies zweckmässig erscheint. Lediglich in

München, nicht jedoch in Berlin, werden Einsprüche bearbeitet.

Bezüglich des Prüfungsrückstands auf einigen technischen Gebieten, wurde mitgeteilt, dass eine Anmeldung in Berlin nicht zu einer schnelleren Bearbeitung führt.

Weiterhin demonstrierte Herr von Moers an Beispielen die Vorteile, die *esp@cenet* für Recherchen bietet. Dieses Programm kann durch die EPA homepage oder durch die homepage nationaler Patentämter genutzt werden. Letzteres bietet den Vorteil, in der jeweiligen nationalen Sprache zu recherchieren, die auch nicht eine Amtssprache des EPA sein kann. Es wurde eine typische Recherche im *esp@cenet* vorgeführt, wobei die Möglichkeiten bestehen, einen gesamten Text ausgedruckt zu bekommen und Familienrecherchen nach der Prioritätsnummer durchzuführen. Nach der Beantwortung einiger Fragen erhielt Herr von Moers viel Applaus und wurde zum gemeinsamen Mittagessen eingeladen.

Nach dem Mittagessen begann die Sitzung mit dem Bericht des *epi* Finanzausschusses sowie des Schatzmeisters. Die anschliessende Diskussion konzentrierte sich in erster Linie auf die Kosten des Umzugs des *epi*-Sekretariats und die daraus folgenden laufenden Kosten für die neuen Räume. Am Ende wurde der Schatzmeister entlastet und das revidierte Budget 1999 sowie der Voranschlag 2000 vom Rat genehmigt bzw. verabschiedet.

Im Anschluss daran folgten ausführliche Berichte über die Regierungskonferenz in Paris und über die Arbeit der eingesetzten Arbeitsgruppen, von denen sich die eine mit Europäischen Patentrechtsstreitigkeiten und die andere mit Kostensenkungsproblemen befasst, insbesondere hinsichtlich nationaler Übersetzungen.

Die Arbeitsgruppe „Patentrechtsstreitigkeiten“ beschäftigt sich mit Möglichkeiten der Harmonisierung von Patentrechtsprozessen in ganz Europa. Bis zu ihrem nächsten Treffen im Januar werden Stellungnahmen der Teilnehmer, einschliesslich des *epi* erwartet. Es wurde ausführlich diskutiert ob überhaupt und wenn ja welche Vorschläge das *epi* machen sollte. Einigkeit bestand darin, dass es wichtig sei, Vorschläge zu unterbreiten. Jedoch wurde nichts offiziell festgelegt. Axel Casalunga, Vorsitzender des EPPC, wurde gebeten, für den folgenden Tag einen Diskussionsvorschlag vorzubereiten.

Anschliessend wurde über die Fortschritte der zweiten Arbeitsgruppe informiert, besonders über die verschiedenen vorgeschlagenen Möglichkeiten, die Kosten für Übersetzungen zu senken. Wegen der Interessenslage im *epi* sollen Stellungnahmen nur zu Lösungen abgegeben werden, die das Erteilungsverfahren vor dem EPA betreffen. Das EPPC soll diese Lösungen analysieren und ggf. Stellungnahmen zu allen Problemen erarbeiten, wo dies im Interesse des *epi* ist.

Nach Beendigung des Sitzungstages trafen sich die Ratsmitglieder zu einem gemeinsamen Abendessen.

Am zweiten Tag begann die Sitzung mit dem Bericht des Vorsitzenden des Ausschusses für Berufliche Qualifikation, Thorsten Onn. Er gab eine kurze Übersicht über die Ergebnisse der letzten Europäischen Eignungsprüfungen, die 1999 besser ausgefallen waren als in den vergangenen Jahren, wobei dennoch ein hoher Anteil verblieb, der die Prüfungen nicht bestanden hat. Interessant war, dass es erstmals einen Rückgang in der Anzahl der Kandidaten gab, die erstmals zur Prüfung antraten und dass zweitens die Anzahl derer, die in Chemie die Prüfungen A und B bestanden haben, entgegen dem allgemeinen Erfolgstrend, zurückgegangen ist.

Anschließend wurde über eine vom PQC vorgeschlagene Änderung des Artikels 10 der Prüfungsregeln diskutiert, die sich auf eine Anrechnung von Tätigkeiten auf dem Gebiet des gewerblichen Rechtsschutzes hinsichtlich der Zulassung zur Prüfung bezieht. Nach längerer Debatte wurde die Änderung mehrheitlich angenommen.

Weiterhin wurde ein Vorschlag des EPA's diskutiert, der vorsah, dass eine Wiederholung der Prüfung direkt im darauffolgenden Jahr nicht zulässig sein sollte. Dieser Vorschlag wurde einstimmig abgelehnt.

Schliesslich wurde noch das Thema der beruflichen Weiterbildung innerhalb des *epi* kurz angesprochen, wobei seitens des PQC über eine in Vorbereitung befindliche Bestandsaufnahme derartiger Aktivitäten auf nationaler Ebene berichtet wurde.

Der Präsident eröffnete dann die Diskussion über die seitens des EPA vorgeschlagene Änderung von Regel 102, nämlich dass die Aufnahme in die Liste der zugelassenen Vertreter von der Zahlung einer Gebühr an das EPA abhängig gemacht werden solle. Die Debatte ging nun darum, ob dies überhaupt akzeptabel sei und, wenn ja, ob es der Art nach eine Bearbeitungsgebühr für das

EPA sein solle oder, mindestens teilweise, eine Art Inkasso für den ersten an das *epi* zu zahlenden Beitrag. Mit überwältigender Mehrheit wurde eine derartige Gebühr aus grundsätzlichen Gründen abgelehnt.

Der Vorsitzende des EPPC präsentierte seinen Bericht, wobei die Diskussion vom Vortage über die Stellungnahme des *epi* zum Thema „Patentrechtsstreitigkeiten“ aufgenommen und bezüglich des vom Vorsitzenden, Herrn Casalonga, vorgelegten Entwurfs ergänzt wurde. Schliesslich bestand Einigkeit, den Vorschlag mit geringfügigen Änderungen als *epi* Papier der Arbeitsgruppe „Patentrechtsstreitigkeiten“ zu unterbreiten.

Anschließend wurden Berichte der Ausschüsse für Biotechnologische Erfindungen, der Geschäftsordnung, Disziplinarangelegenheiten, Schriftleitung und Harmonisierungsfragen sowie der Arbeitsgruppe EASY kurz und knapp vorgetragen. Einige sind in diesem Heft der *epi* Information veröffentlicht.

Gegen Ende wurde angekündigt, dass es für 2000 wieder eine Kunstaussstellung von Künstlern aus den Reihen der *epi* Mitglieder geben soll, wozu alle Mitglieder aufgerufen sind, sich mit künstlerischen Arbeiten zu beteiligen (ausführliche Informationen enthält diese Ausgabe der *epi* Information).

Schliesslich wurden die Daten für die kommenden Vorstands- und Ratssitzungen genehmigt, wobei der Präsident vorschlug, die Ratssitzung im Oktober 2000 erst am Ende des Monats stattfinden zu lassen, da die Zeit zwischen Vorstands- und Ratssitzung meist zu knapp bemessen sei, was akzeptiert wurde.

Der Präsident schloss die Sitzung und dankte allen Gästen sowie allen anwesenden, ordentlichen und stellvertretenden Ratsmitgliedern für ihr Kommen und die intensiv geleistete Arbeit. Sein Dank richtete sich auch an die Berliner Organisatoren. Eine Liste mit den vom Rat gefassten Beschlüssen ist anschliessend veröffentlicht.

Entwurf der Ratsbeschlüsse, 47. Ratssitzung in Berlin 11.-12. Oktober 1999

1. Die vom *epi* beim Europäischen Gerichtshof eingereichte Beschwerde soll weitergeführt werden (50 Stimmen dafür, 1 dagegen, 15 Enthaltungen).
2. Der Mitgliedsbeitrag bleibt für 2000 bei DM 300.–.
3. *epi* wird eine Stellungnahme für die von der Regierungskonferenz in Paris eingesetzten Arbeitsgruppe „Patentrechtsstreitigkeiten“ erarbeiten.
4. Bezüglich der von der ebenfalls eingesetzten Arbeitsgruppe „Kostensenkung“ wird vom EPPC bei seiner nächsten Sitzung am 23. November 1999 eine Stellungnahme zur Kostenstruktur ausgearbeitet.
5. Die Regel 102 EPÜ soll im Grundsatz nicht geändert werden. Regel 102 (2) sollte lediglich klarer formuliert werden. Der Präsident des EPA soll entsprechend informiert werden.
6. Dem Verwaltungsrat werden die vom PQC vorgeschlagenen und vom Rat mehrheitlich verabschiedeten Änderungen der Vorschriften über die europäische Eignungsprüfung vorgelegt.
7. Die seitens des *epi* vorgeschlagene Änderung des Artikels 18 der Vorschriften über die europäische Eignungsprüfung wurde vom Rat abgelehnt. Diese besagt, dass wenn ein Kandidat bei der Wiederholung der Eignungsprüfung weniger als 40% der Höchstpunktzahl erreicht, er die Prüfung erst beim übernächsten Mal wiederholen darf.
8. Der Rat erklärte sein Einverständnis zum Vorschlag des EPA's zur Änderung von Artikeln 27 und 28 der Vorschriften über die europäische Eignungsprüfung, um die Beschwerdeverfahren zu verkürzen. Ein ent-

- sprechender Brief soll dem Präsidenten des EPA zugesandt werden.
9. Der Rat nahm den vom EPPC gemachten Vorschlag Artikel 54(4) EPÜ abzuschaffen, an.
 10. Die vom EPPC erarbeitete Stellungnahme zum EU Grünbuch bezüglich der Produktpiraterie wird mit einer allgemeinen Einleitung vom *epi* Präsidenten an die EU Kommission weitergeleitet.
 11. Bezüglich der neuen vom EPA vorgeschlagenen Regel 38(4) EPÜ – Prioritätserklärung und Prioritätsunter-

- lagen – wird dem EPA vorgeschlagen, den Anmelder schriftlich darüber zu informieren, wenn die Abschrift der Prioritätsunterlagen zur Akte gelangt ist.
12. Die Herren NORIN (SE) und EINSELE (DE) wurden zusätzlich als ordentliche Mitglieder und die Herren DESOLNEUX (FR) und BOTELLA REYNA (ES) als stellvertretende Mitglieder in den Harmonisierungsausschuss gewählt.

Report of the 47th Council Meeting in Berlin 11-12 October 1999

The 47th Council Meeting was held in the imposing and beautiful city of Berlin. As was made clear by the President, at the start of the meeting, the apparently innocuous agenda held several important topics for discussion.

The President, Walter Holtzer, formally opened proceedings at 9.00 a.m. on Monday 11th October, 1999. Following the appointment of the scrutineers and the adoption of the agenda, the Minutes of the 46th Council Meeting in Florence on 10th and 11th May, 1999 were approved.

The President then ran through the Decisions and measures taken by the Board since the last Council Meeting. In particular, he noted that the requests of the *epi*, that the EPO give a formal Decision on the filing date of each Application, as well as the provision of a warning of a forthcoming written Decision, were both rejected by the European Patent Office.

A paper was presented to the Council, regarding the need to maintain reasonable sized Committees, whilst, at the same time, ensuring that enthusiastic contributors are not barred from taking part. This was passed to the By Laws Committee.

The President then presented his report of his activities since the last Council Meeting which report is published elsewhere in *epi* Information.

The Report of the Secretary General followed which, understandably, concentrated on the recent move of the *epi* Secretariat to premises outside the EPO building. The staff of the Secretariat were thanked for their patience and good humour during the difficult move.

Progress of the appeal to the European Commission, regarding their proposed review of the Code of Conduct, was then outlined by the President. To date, an appeal against the Decision of the Commission, to allow the *epi* Code of Conduct to stand for only a short time, has been filed by *epi* and the submissions of *epi* have been countered by the Commission. The submissions of the Commission were currently being studied by the *epi*'s attorney.

There followed considerable discussion as to the merits of the appeal, particularly in terms of the cost

of the appeal and the potential benefit or otherwise of both success and failure. At the end of the discussion it was agreed that the appeal procedure would continue for the time being.

The meeting was then adjourned whilst the Council was addressed by a Mr. Von Moers from the Berlin sub-office of the European Patent Office. Mr Von Moers began with a brief explanation of the Berlin sub-office. The office is located in part of an attractive building in Berlin and has 183 employees of whom 113 are Examiners, 33 being on the BEST scheme. The office is responsible for most aspects of EPO work, including the formalities of filing, as well as search and examination. Oral Proceedings are possible and can be held in the Berlin sub-office if appropriate. The one area of day-to-day European Patent Office work that is not carried out in the Berlin Office is Opposition, which is confined to the Munich Office.

In response to a question with regard to backlogs in certain technical fields, the Council were informed that filing an Application at the Berlin sub-office would not assist in the expedition of the prosecution of the Application!

Having explained the Berlin sub-office, Mr. Von Moers carried on to extol the virtues of the *esp@cenet* searching facility. This may be accessed either from the European Patent Office homepage or via the homepage of the National Patent Offices. The advantage of accessing the database from the National Patent offices is the use, in the relevant National Patent Offices, of National languages which are not necessarily an official language of the European Patent office. Council was taken through typical searches using *esp@cenet*, with an indication of the advantages. These included the possibility of obtaining a full text for printing and family searches that could be carried out using a search of the priority number. After fielding some questions relating to *esp@cenet*, Mr. Von Moers finished to warm applause and was formally invited to lunch with the Council.

After lunch the Council Meeting re-convened with the report of the *epi*'s Finance Committee and, sub-

sequently, the Treasurer's report. Discussion of the Treasurer's report focused primarily on the costs of the move of the *epi* secretariat offices and subsequent running costs. Finally, the *epi* accounts and budgets were approved by Council.

Detailed reports were then provided of the recent Inter-Governmental Conference and, in particular, the progress made by the two working groups set up by the Inter-Governmental Conference, one looking at European Patents litigation and the other looking at the issue of reducing costs, notably with regard to national translations upon grant.

The litigation working group were looking at ways of harmonising European Patent litigation across the whole European territory. Comments were awaited by the working group, from the various members, including *epi*, before the next meeting in January. There was considerable discussion in Council, of submissions that might be made by *epi* and, indeed, whether *epi* should make any submissions at all. It was agreed that it was important that *epi* make a submission to the working group. No formal proposal had been made for such a submission, however, and it was agreed that Axel Casalonga, Chairman of EPPC, would draft a general submission for discussion during the next day's meeting.

Council were then advised as to the progress being made in the second working group, relating to the reduction of costs, and, in particular to the various options that had been suggested with respect to the reduction of costs of translations upon grant. It was agreed that *epi* might be able to make submissions on the various solutions already proposed in the working group if these solutions affected the grant procedure at the EPO. It was agreed that EPPC would look at the solutions and prepare observations on any that they felt required *epi* input.

The President then closed the meeting for the day.

The next morning the Council Meeting re-commenced with the Professional Qualifications Committee report. The Chairman of the Professional Qualifications Committee, Thorsten Onn, started by giving a brief review of the results of the European Qualifying Examination. The results were better for 1999 than they had been in recent years. There was still, however, a core of those, re-sitting the examination in full, who had failed the examination. Two statistics were of interest. The first was that, for the first time in many years, there had been a decrease in the numbers sitting the examination for the first time. The other interesting statistic was that, although the pass rates had generally risen, the pass rate for Papers A and B in the chemistry discipline had decreased.

The Council then debated, for some time, a proposed amendment to Article 10 of the Examination Rules relating to the reduction in the training period required for candidates who were forced, as part of their national training, to spend some time in the German Patent Office and the German law courts.

Subsequent to that, there was a further debate on the proposal, from the European Patent Office, to bar failed re-sitters from taking the exam the year following their failure. This EPO proposal was rejected unanimously.

Finally, there was a brief discussion of continuing professional development in the *epi*, with a report from the Professional Qualification Committee as to progress made on this topic.

The President then introduced a discussion of a proposed amendment to Rule 102 EPC. The European Patent Office had proposed that entry onto the list should be subject to the payment of a fee to the European Patent Office. The debate revolved around whether the payment of a fee for admission to a list was acceptable and, if so, whether it should be an administration fee to the European Patent Office or whether it should be the first subscription fee to the *epi*.

The EPPC Report was then presented, the centrepiece of which was a further discussion on the position paper, presented newly by the Chairman of the EPPC, relating to the litigation issue discussed the day before. After discussion and minor amendment of the submission, it was agreed that the submission should be put forward to the working group on litigation.

Reports were then taken from the various Committees, some of which appear elsewhere in *epi* Information. Those Committees which reported including Biotechnology, By-Laws, Disciplinary, EASY, Editorial Board and Harmonisation.

Following a brief disclosure of the information that another *epi* art exhibition would be held in due course (details of which appear elsewhere in *epi* Information) the dates for the next Board and Council Meetings were agreed. The President indicated that the five months' gap between the May and October Council Meetings, which gap included the summer break, appeared to be too short. He therefore proposed that the Council Meeting in October 2000 be held late in October rather than early. This was agreed.

The President then declared the Meeting closed and thanked all for their attendance and hard work, as well as the organisers of the Council in Berlin.

A list of all Decisions taken at this Council Meeting is published hereafter.

Draft List of Decisions, 47th Council Meeting Berlin, 11-12 October 1999

1. The appeal filed by *epi* with the European Court of Justice should be further pursued (50 votes for, 1 against, 15 abstentions).
2. Council approved that the membership subscription fee should be maintained at DM 300.–
3. Intergovernmental Conference : Council approved that an *epi* paper should be sent to the Working Party on Litigation.
4. Intergovernmental Conference: An *epi* position paper will be put forward to the Working group on Costs Reduction, after finalisation by the EPPC at its next meeting on 23 November 1999.
5. Amendment of Rule 102 EPC : Council approved by a large majority the position taken by the Board and PQC that the present situation should not be changed, only Rule 102 (2) should be reworded. The President of the EPO will be informed accordingly.
6. Proposed amendment to Article 10 of the Regulation on the European Qualifying Examination (REE) relating to reductions in periods of professional activity: Council voted in favour of proposing, to the Administrative Council, amendments to Article 10 and Article 28, and deletion of Article 11.
7. Council rejected unanimously the proposed amendment to Article 18 (REE) stating that „if a candidate who resits the examination obtains less than 40% of the maximum possible marks in the paper or one of the papers, he may only resit the examination the next time but one“.
8. Council approved the proposal to amend Articles 27 and 28 (REE) in order to speed up the appeal procedure. A letter will be sent to the President of the EPO.
9. Council approved the proposal, made by the EPPC, to cancel Article 54(4) EPC.
10. Council approved the draft *epi* position paper on the EU Green Paper relating to counterfeiting and piracy, and the sending to the EU Commission together with a general introduction prepared by the President of the *epi*.
11. Council approved the sending to the EPO of a letter with regard to the new proposed Rule 38(4) EPC – Declaration of priority and priority documents, proposing to the EPO to issue a notice informing the applicant when the copy of the priority document has been effectively introduced into the file.
12. Messrs. NORIN (SE) and EINSELE (DE), were elected as new members to the Harmonisation Committee and Messrs. DESOLNEUX (FR) and BOTELLA REYNA (ES) as substitute members.

Compte-rendu de la 47ème réunion du Conseil à Berlin 11-12 octobre 1999

La 47ème réunion du Conseil s'est tenue à Berlin. Comme le Président le précisait au début de la réunion, l'ordre du jour comportait d'importants sujets de discussion.

Le Président, Walter Holzer, ouvre officiellement la séance le lundi 11 octobre 1999, à 9 heures. Après la nomination des scrutateurs et l'adoption de l'ordre du jour, les minutes de la 46ème réunion du Conseil à Florence ainsi que la liste des décisions et actions sont approuvées.

Le Président annonce ensuite les décisions et mesures qui ont été prises par le Bureau depuis la dernière réunion du Conseil. Il souligne que les requêtes de l'*epi* visant, d'une part, à établir un principe de décision de l'OEB pour l'attribution d'une date de dépôt des demandes et, d'autre part, le recours à une notification de l'OEB pour informer une partie appelante de l'imminence

d'une décision écrite, ont toutes deux été rejetées par l'Office européen des brevets.

Un document est présenté au Conseil afin d'attirer l'attention de celui-ci sur l'importance de réduire l'effectif des Commissions à un nombre raisonnable, sans toutefois faire obstacle aux initiatives de membres désireux d'apporter leur contribution. Cette question sera étudiée par la Commission de Règlement Intérieur.

Le Président présente ensuite le rapport de ses activités depuis la dernière réunion du Conseil. Ce rapport est publié dans cette édition.

Dans son rapport, le Secrétaire Général évoque le récent déménagement du Secrétariat de l'*epi*, lequel est installé à présent dans ses propres bureaux hors de l'Office européen des brevets. Le Secrétaire rend hommage aux membres du Secrétariat qui ont fait la preuve de leur patience et de leur bonne humeur pendant cette période.

Le Président informe ensuite le Conseil sur les derniers développements concernant le Recours formé à l'encontre de la décision de la Commission des Communautés Européennes relative à l'amendement du Code de Conduite, dont une de ses dispositions a été mise en cause par la Commission.

L'opportunité du recours a fait l'objet d'une vive discussion, et notamment au regard des frais engagés et des perspectives de succès. Mais le Conseil décide de poursuivre dans la voie du recours.

La réunion du Conseil est ensuite interrompue pour permettre à M. Von Moers de l'Office européen des brevets de Berlin de faire une brève présentation de l'agence de Berlin. L'agence, située dans un bâtiment agréable, compte cent quatre vingt trois employés. Cent treize sont examinateurs et parmi eux trente-trois travaillent sur le projet BEST. L'agence participe aux différents volets de travail de l'OEB, aussi bien en ce qui concerne les dépôts que l'examen. En cas de besoin, des procédures orales peuvent être envisagées dans l'agence de Berlin. Les seules activités qui échappent à l'agence de Berlin concernent l'opposition.

Le dépôt de demandes de brevets à l'agence de Berlin ne pourrait toutefois pas apporter de solution au retard constaté dans certains domaines techniques.

M. Von Moers fait ensuite une présentation des possibilités de recherche du programme esp@cenet. On peut y accéder soit par la page d'accueil de l'Office européen des brevets soit par celle des Offices des brevets nationaux. Cette dernière solution présente l'avantage d'un accès à la base de données dans la langue nationale des différents offices, celle-ci n'étant pas forcément une des langues officielles de l'Office européen des brevets. Une démonstration de l'utilisation du programme esp@cenet et de ses nombreux avantages est réalisée au moyen d'exemples type de recherche montrant que l'on peut obtenir l'impression d'un texte complet, voire conduire des recherches de famille à partir du seul numéro de priorité. Après avoir répondu aux questions des membres du Conseil, M. Von Moers est applaudi chaleureusement et est invité à se joindre aux participants pour le déjeuner.

Dans l'après-midi, la réunion reprend avec les rapports de la Commission des Finances et du Trésorier. Le rapport du Trésorier est principalement concentré sur les coûts occasionnés par le déménagement du Secrétariat de l'*epi* et sur les frais qui en résultent. Les comptes et budgets de l'*epi* sont approuvés par le Conseil.

Des rapports détaillés sont ensuite présentés sur la Conférence intergouvernementale et en particulier sur les deux groupes de travail qui ont été mis en place par la Conférence intergouvernementale. Le premier examine les questions de litige des brevets européens, et le second se préoccupe tout particulièrement de la question de réduction des coûts, notamment en ce qui concerne les traductions nationales à la délivrance du brevet.

Le groupe de travail sur les litiges étudie les moyens qui permettraient d'élaborer une réglementation pour la réalisation d'un système judiciaire européen intégré en matière de brevets. Les membres du groupe de travail y

compris l'*epi* ont été invités à soumettre leurs commentaires avant la prochaine réunion en janvier 2000. Cette question fait l'objet d'une discussion animée au sein du Conseil, sur l'opportunité et le sens d'une prise de position par l'*epi*. Le Conseil reconnaît l'importance de soumettre des commentaires au groupe de travail. Aucune proposition officielle n'a été faite à l'heure actuelle mais il est convenu que M. Axel Casalonga, Président de l'EPPC, prépare une proposition d'ordre général qui sera soumise au Conseil pour discussion le lendemain.

Le Conseil est ensuite tenu informé des activités du deuxième groupe de travail qui se préoccupe de la question de la réduction des coûts, et notamment ceux relatifs à la traduction lors de la délivrance du brevet. Dans la mesure où la procédure de délivrance est concernée, le Conseil approuve le principe de soumettre des observations au groupe de travail et invite la Commission EPPC à examiner cette question.

Le Président clôt la session et la réunion reprend le lendemain matin avec le rapport de la Commission de Qualification Professionnelle. Le Président de la Commission, Thorsten Onn, évoque les résultats de l'examen européen de qualification qui montrent une légère amélioration par rapport aux précédents. Il existe toutefois encore un noyau de candidats, qui ont tenté les épreuves dans leur totalité et qui ont échoué. Pour la première fois on observe cependant une légère baisse du nombre de candidats qui se sont présentés à l'examen pour la première fois. Une autre statistique intéressante indique que, malgré un accroissement du taux de succès en général, le taux de succès pour les épreuves A et B en chimie a baissé.

Le Conseil discute ensuite une proposition d'amendement à l'Article 10 du Règlement relatif à l'examen européen de qualification. Celle-ci concerne la réduction de la période de formation exigée pour les candidats dont une partie de la formation, au niveau national, comporte obligatoirement une période de stage à l'Office national allemand de même que dans les tribunaux allemands.

Puis la discussion porte sur la proposition de l'OEB de sanctionner les candidats qui ont de nouveau échoué à l'examen en les empêchant de s'inscrire à la session de l'année suivante. Cette proposition est rejetée à l'unanimité.

Une brève discussion porte sur le développement de la formation continue au sein de l'*epi*, basée sur le rapport de la Commission de Qualification Professionnelle.

Le Président aborde ensuite la proposition d'amendement de la Règle 102 EPC. L'Office européen des brevets a proposé que l'inscription sur la liste soit assujettie au paiement d'une taxe à l'OEB. Le débat porte sur le statut de cette taxe, à savoir si celle-ci serait considérée comme une taxe administrative à verser à l'OEB, ou bien le règlement de la première cotisation à l'*epi*.

Le rapport de l'EPPC est ensuite présenté. Celui-ci porte principalement sur la proposition soumise par le Président de l'EPPC, relatif à la position de l'*epi* sur la question des litiges discutée la veille. Après avoir discuté

quelques amendements mineurs, le Conseil approuve l'envoi de la proposition au groupe de travail.

Les travaux de la Commission de Biotechnologie, de la Commission du Règlement Intérieur, de la Commission de Discipline, de la Commission EASY, de la Commission d'Harmonisation ainsi que du Comité de Rédaction sont évoqués. Certains rapports sont publiés dans cette édition d'*epi* Information.

La prochaine exposition des artistes de l'*epi* est annoncée (information dans ce numéro) ainsi que les dates des prochaines réunions du Bureau et du Conseil. Le Prési-

dent indique qu'il souhaite que la période comprenant les vacances d'été entre les deux réunions de Conseil soit plus longue. Il propose pour cette raison que la réunion du Conseil en Grèce ait lieu plus tard dans le mois d'octobre, ce qui est approuvé.

Le Président déclare la session close et remercie les participants pour leur travail. Il adresse également ses remerciements aux organisateurs berlinois.

Une liste des décisions prises à cette réunion du Conseil est publiée ci-après.

Projet de liste des Décisions, 47ème réunion du Conseil à Berlin 11-12 octobre 1999

1. Le Conseil décide de poursuivre dans la voie du recours formé à l'encontre de la décision de la Commission des Communautés Européennes relative à l'amendement du Code de conduite (50 votes for, 1 contre, 15 abstentions).
2. Le Conseil approuve de maintenir la cotisation à DM 300,-.
3. Conférence Intergouvernementale: Le Conseil approuve l'envoi d'une proposition de l'*epi* au Groupe de travail sur les litiges.
4. Conférence Intergouvernementale: Une prise de position de l'*epi* sera présentée à la prochaine réunion du Groupe de travail sur la Réduction des Coûts, après finalisation par l'EPPC lors de la prochaine réunion de la commission le 23 novembre 1999.
5. Amendement de la Règle 102 CBE : Le Conseil approuve à une forte majorité la position prise par le Bureau et PQC, à savoir que la situation actuelle ne devrait pas être modifiée et que seule la Règle 102(2) devrait être reformulée. Le Président de l'OEB en sera informé.
6. Proposition de modification de l'Article 10 du Règlement relatif à l'examen européen de qualification (REE), relative aux éventuelles réductions pour les périodes d'activité professionnelle: Le Conseil approuve de proposer au Conseil d'Administration des amendements aux Articles 10 et 28, et de supprimer l'Article 11.
7. Le Conseil rejette à l'unanimité la proposition de modification de l'article 18 (REE) qui stipule que „si un candidat se représentant à l'examen obtient moins de 40% du maximum des notes, il devra attendre une session pour pouvoir se représenter à l'examen.”
8. Le Conseil approuve la proposition de modification des articles 27 et 28 (REE) visant à accélérer la procédure de recours. Le Président de l'OEB en sera informé par courrier.
9. Le Conseil approuve la proposition faite par l'EPPC d'annuler l'article 54(4) CBE.
10. Le Conseil approuve que le projet de position de l'*epi* sur le Livre vert, relatif à la contrefaçon et au piratage, soit communiqué à la Commission Européenne avec une introduction générale préparée par le Président de l'*epi*.
11. Le Conseil approuve l'envoi à l'OEB d'une lettre relative à la nouvelle proposition faite pour la Règle 38(4) CBE – Déclaration de priorité et de documents prioritaires, dans laquelle l'*epi* propose à l'OEB d'informer le déposant lorsque la copie du document prioritaire a été ajoutée au dossier.
12. MM. NORIN (SE) et EINSELE (DE), sont élus nouveaux membres titulaires de la Commission d'Harmonisation, MM. DESOLNEUX (FR) et BOTELLA REYNA (ES) membres suppléants.

President's Report (covering May to October 1999)

W. Holzer (AT)

(1) Subsequent to the Council Meeting in Florence I met with Mr. Nootboom, Head of Unit DG XV of the European Commission in Brussels on May 13. This was the first official visit of *epi* with DG XV. The role of *epi* was explained and a variety of topics were discussed, most of them informally. Mr. Nootboom took a particular interest as to which extent the European patent profession is integrated in *epi*. I explained to Mr. Nootboom that the profession had the feeling that the Commission in preparing for actions in the intellectual property field availed itself of outside experts rather than consulting the profession, and often came up with surprise actions. I offered the expertise of *epi*, saying that we could provide experts in every field. After the meeting information material about *epi* was sent to DG XV.

(2) On May 17 a meeting took place in the Secretariat with Mr. Swift, the secretary of the Professional Standard Board for patent and trademark attorneys of the Australian association, and Mr. Mortley, who had visited the European Patent Office to inform themselves about disciplinary rules concerning the profession, because they are in charge of drafting a Code of Conduct for the Australian profession. The *epi* was represented by Mr. Ottevangens, Mr. Zellentin and myself. The situation of the Code of Conduct and the Rules of Discipline were explained and information material was handed over.

(3) On May 20 I attended the Board Meeting of CEIPI, in which *epi* has a seat. The meeting took place in Paris and was chaired by Mr. van Benthem. The president of the EPO, Mr. Kober also participated in the meeting. The main topic was the future structure of CEIPI, in particular the installment of a General (Manager) Secretary alongside Mr. Reboul, the current director of CEIPI.

(4) The CEIPI meeting on the May 20 offered the chance of a conference with Maître Collin on May 21, to discuss the *epi* appeal against the Commission's decision on the Code of Conduct. The fact has been published in *epi*-Info 2 that an appeal has been lodged. In the meantime the Commission has filed an extensive reply to which a brief with counter arguments has been submitted on behalf of *epi*.

(5) On May 28 a meeting of the labelled officers of *epi* took place in the Secretariat, preceded by a meeting with Mr. Kober and other members of the presidency of the EPO. The courtesy visit introducing the labelled members of the *epi* – Board to the Office was followed by a meeting in which various topics were discussed, in particular the amendment of Rule 102, for which a draft had been prepared by the Office.

(6) On June 15, 16 Vice President Macchetta and I attended the Administrative Council meeting in Munich

as *epi* observers, ahead of the SACEPO meeting which followed immediately thereafter on June 17,18.

(7) On June 24, 25 the Intergovernmental Conference took place in Paris and was attended on behalf of *epi* by Vice President Le Vaguerèse and myself. The other observers were the European Commission, the EPO and UNICE. The petition of FICPI to be granted observer status was turned down. An *epi* position paper was prepared for the Conference by the EPPC. In my oral statement I referred to the problems of the judicial systems in Europe as concerns litigation and to the necessity that European patent attorneys be granted representation rights in litigation proceedings because of their expertise in patent matters.

(8) Due to last minute time constraints I was unable to attend the centennial meeting of the Japanese Patent Attorneys Association in Tokyo. However, I had asked M. Martin to deliver my greetings and best wishes, and moreover I had sent the requested short paper on the *epi* which was included in the Congress papers.

(9) On July 16 I attended the EPOLINE-hearing in the EPO on behalf of *epi* (I am stressing this because the participants list shows little attendance of other organisations). Particular attention should be given to a paper delivered by Mr. Speiser on behalf of the EASY-Committee. This paper was published in *epi*-Info No.3.

(10) On July 19, 20 I participated in the AIPLA/FICPI meeting in The Hague on behalf of *epi*. The meeting was attended by Mr. Kober, the nominated new Commissioner of the USPTO, Mr. Todd Dickinson and the Japanese Commissioner Mr. Isayama as well as Mr. Coble, US House of Representatives. The discussion was more interesting than the year before, mainly because a variety of topics other than money were addressed. I had inherited the task to deliver a speech on how to shorten a patent description European style.

(11) I received an invitation to deliver a paper on behalf of *epi* at the forthcoming PATINNOVA conference organised by the European Commission and the EPO in Thessaloniki on October 19. The topic was „Patent Litigation Insurance – a way ahead“. An interesting if up to now somewhat frustrating topic.

(12) On September 7 I hosted a dinner for the EQE Examiners group III (paper D) in the restaurant of the European Patent Office. This invitation had long been due and was meant as a gratification for the examiner's work.

(13) On September 14, 15 Vice President Macchetta and I took part as *epi* observers in the Working Party on Litigation installed pursuant to the Intergovernmental Conference in Luzern. The main topic of the meeting was the possible future court system in Europe.

(14) On October 14, 15 Vice President Le Vaguerèse and I participated as *epi* observers in the other Working Party on Cost Reduction in Stockholm. The main topic are measures to achieve a 50% reduction of the costs of

European patents. The work of both Working Parties is to be continued. The *epi* will also contribute written submissions.

Measures and Decisions taken by the Board (covering May to September 1999)

(1) The first decision taken by the Board – by a large majority – upon a distribution of the draft for an appeal against the decision of the European Commission on the *epi* Code of Conduct was to instruct *epi*'s attorneys at law to file the appeal with the European Court of Justice.

(2) As a follow up to the initial contact with DG XV, *epi* in the meantime addressed the Commission on two topics, one pertaining to the representation rights of European patent attorneys in any future Community patent regulation, and the other concerning the attorney/client privilege in Europe vis a vis the USA in the light of a recent US court decision.

(3) WIPO has been addressed to grant *epi* observer status in the Standing Committee on Information Technologies. WIPO in the meantime has granted the observer status. The matter will be of relevance for the EASY Committee.

(4) The Board consented to a small working group discussing with *epi*'s attorneys at law the intended

counter-reply of *epi* to the Commission's reply to *epi*'s appeal. A draft concerning the practical side of comparative advertising was presented and discussed.

(5) In connection with the Working party on Cost Reduction the Board confirmed the previous position of *epi* that a unanimous view of *epi* on this topic cannot be presented at the Working Party.

(6) As concerns any amendment of Rule 102 (1) EPC the Board with a first input from PQC did not take a formal decision but felt that the situation should not be changed and that on the other hand Rule 102 (2) should be reworded.

(7) The amendment of Art 134 (8) EPC envisaged for some time by *epi* has been put aside for the time being by the Board in view of the pending appeal concerning the Code of Conduct and in view of some other implications. The matter will require some further discussion.

Treasurer's Report

P. Kelly (IE)

Budget 1999

An analysis of actual income and expenditure for the six (6) month period to June 30, 1999 shows income marginally lower than budget while expenditure is higher than budget. A higher than expected contribution to rent for the year 1999 is the primary reason for a projected operational deficit of DM13,400. We move into a significant deficit when extraordinary items are taken into account.

The 1999 Budget has been revised to take cognisances of following matters:-

Actual expenditure for the six months to June 30, 1999.

The decision of Council in Florence to accept the recommendation of the Finance Committee, to write off in their entirety in 1999 all unpaid subscriptions for all previous years (DM 43,602).

The leasing of new offices for the *epi* Secretariat and the consequent additional expenses to meet the over-budget increase in rent in 1999 (DM 32,000), and the moving expenses including expenses in fully fitting out the new offices (DM130,000 and DM97,000).

The revision to the Budget 1999 shows a projected deficit of DM 284,002

Budget 2000

The first draft of the Budget 2000 has been prepared and on the income side it has been decided to project subscription income on an increased membership (5,800 x 300DM)

On the expenditure side the budget figures have been largely based on actual expenditure in 1998 + for the six months to June 30, 1999. The inclusion of extra expenditure items such as 4.17 (electricity costs) and 4.18 (office cleaning) and increases in other items such as 4.1 (rent) are consequent upon the relocation of the offices. The Budget 2000 projects a deficit (DM 84,300). Taking cognisance of the overall net asset position no increase in membership subscription (DM 300) is deemed necessary for 2000.

Investments currently total DM 3,610,760.00 (included „Festgelder“ and „DWS“) and a cash at Bank total DM 208,816.00 as of June 30, 1999.

Report of the Disciplinary Committee

S. U. Ottevangers (NL)

In the Council Meeting in Florence on May 11 and 12, 1999 the members of the Disciplinary Committee have been appointed. Through consultations in writing the Committee has elected its chairman and secretary and their deputies. The results of these elections were:

Mr. S.U. Ottevangers, chairman
Mr. G.M.L.M. Leherte, deputy chairman
Mr. G. Keller, secretary
Mr. J. Waxweiler, deputy secretary.

In the past period of time four pending cases have been dealt with. In one case the complaint was dismissed, in one it was decided to refer the case to the Disciplinary Board, and in the two other cases the complaint was withdrawn. Currently two cases are pending. In the meantime in the case referred to the Disciplinary Board the complaint has been withdrawn.

In the Council Meeting in Florence Mr. Barendregt and Mr. Lindgaard have been appointed as member of the Disciplinary Committee „until conclusion of the disciplinary case in which they are sitting in a Chamber“.

The Chamber of which Mr. Barendregt was a member has rendered its final decision. In the case handled by Mr. Lindgaard's Chamber the complaint was withdrawn. The term of office of Mr. Barendregt and Mr. Lindgaard therefore has ended.

In the past period of time the Chairman of the Disciplinary Committee has received some letters with questions concerning disciplinary matters. One question was whether non payment by an epi-member of debit notes sent by another epi-member for translation services of European Patents constituted a breach of the Regulation of Discipline. This question was answered in the affirmative. Reference could be made to the decisions in CD 1/98 (epi Information 4/1998) and in CD 2/96 (epi Information 2/1997).

Report of the EASY Committee

D. Speiser (DE)

Today I want to report briefly and for the forthcoming Board meeting that the EASY Committee had its third meeting in Munich in the late afternoon and evening of Thursday, 15 July 1999 and that the members of the Committee attended the EPOLINE-hearing on the following day.

The Committee members elected myself as the new Chairman and Mr. Roger Burt (GB) as the Secretary. The committee meeting was mainly concerned with an introduction of the problems to the new committee members and a discussion of our position vis-à-vis the EPOLINE project and its details.

Having been one of the speakers in the EPOLINE hearing and following an invitation by President Kober I had dinner with the top people of the EPOLINE project, in particular Vice-President Michel in the evening preceding the hearing. I used the possibility to point out strongly to Mr. Michel and others sitting on our table that from our point of view the EPOLINE project to the extent known to us had taken into account only the various interests of the EPO so that it would now be compulsory

that the needs of the representatives are taken care of. Everybody including Mr. Michel agreed and during the second part of the hearing there were many voices strengthening my position.

During the hearing I suggested that the EPO sends out personnel from both DG4 and DG5 to a number of patent attorneys offices and patent departments so that the people dealing with the data processing system as well as the people dealing with necessary changes of the rules can acquaint themselves personally with the needs of the customers. I am pleased to report that in the meantime I had a call from the Office and learned that my proposal has been accepted and that after the vacation period the EPO will visit a number of customers in preparation of software adaptations and changes of the rules.

From the point of view of the EPO these forthcoming visits and the related work subsequently will probably slow down the process of the EPOLINE project and it is likely that the plan for setting up a group of pilot users of the system will be deferred slightly.

Report of the EPO Finances Committee

J. Boff (GB)

Financial Overview

In the year 1998 an operating surplus of DEM235m was achieved, compared with DEM 191m in 1997. As a proportion of total income this is growing (19% 1998 compared with 16.3% 1997). This looks healthy, but as a result of the several fee reductions the EPO are projecting a reduction in the operating surplus over the next few years. Such projections should be viewed with great caution. The 1998 budget surplus was DEM 32m, which shows the actual surplus a spectacular 630% higher than budget.

The EPO is undertaking a major building program but this appears on the budgeted figures, without any borrowing, not to be anything approaching a strain on their finances. New Examiners require accommodation and so building expenditure appears appropriate. However it should be noted that the number in A staffing posts only now exceeds the previous maximum in 1992. The new building work is only appropriate in the context of future increased staffing at the EPO.

The biggest growth areas for income in the 1998 accounts are Examination, Opposition and appeal (up 12%), and Patent Renewal Fees (up 9%). The biggest growth area for expenditure in the 1998 accounts is Staff (up 7.9%) which far exceeds all other expenditure items. Staff costs were 70% of expenditure in 1997 and nearly 74% in 1998.

As would be expected there has been a big drop in filing and search fees following the 1997 amendments to the Rules and Fees Rules.

Workload

This is increasing and is a problem in that increasing delays can be expected over the next few years.

Looking to the 1998 Annual Report the number of applications awaiting search at the end of 1998 was 78,000 as compared with 64,800 in the previous year and 51,700 at the end of 1996. One third of directly filed European patent applications are now published without a search report. Since workload in the search area increased in 1998 by about 13% and search production increased at about 9% an increased backlog is to be expected.

In examination the workload increased 15% in 1998 whereas production increased only 3.5%.

The EPO presently seem to be compounding a rise in demand with a drop in fees. This appears very likely to result in increased demand and hence increased backlogs. Even if the state of the world economy weakens, the recent reduction in fees may well keep up demand. More likely is continued increase in demand with con-

tinued increase in backlogs at least for the short term until the planned increase in staff becomes fully effective.

Staffing

The number of staff at the EPO in A grades (search examination and appeal) has only now returned to the level of 1992. At present the EPO have extremely ambitious targets for recruiting large numbers of searchers and examiners over the next four years. It will be interesting to see if these are met, particularly in some of the most problematic technical areas (e.g. telecommunications) where demand from other employers is high.

Technical Co-operation

There is continuing concern in the committee at the sums being spent on technical co-operation with national offices. While these sums are small in comparison with the scale of the EPOs budget (less than 1.8% in 1998) the increasing amount being spent on technical co-operation requires careful examination to see who benefits. Expenditure benefiting European applicants as a whole might be welcomed, but expenditure for the benefit of applicants in a particular Member State should, in principle, be borne by that state.

An example of expenditure that might be welcomed is the extension of esp@cenet to future EPO Member States and extension states (CA/9/99). Any applicant wishing to see what might impede his activities is likely in the future to consider a wider stage than the present EPC Member States. The advantages of having a free on-line searching tool for the future EPO Member States and Extension States are apparent and not just of interest to the nationals of those countries.

In contrast, and by way of example, some of the expenditure proposed in the co-operation programme between the EPO and the Austrian Patent Office (CA/17/99) does not appear to be of broader benefit. In particular it is not readily apparent what benefit there is outside Austria in capturing AT-T documents (translations of EP Patents) and yet the EPO is proposing to contribute DEM 360,000 for this. In contrast the expenditure on capturing the backfile of AT-B documents (DEM 605,000) may be of wider use.

Validation of European Patents in non-European States

There is a proposal to extend the current extension scheme to certain non-European states that have expressed an interest (CA/54/99). This seems to be good

news for the EPO as it looks like money for nothing. There was some concern in the committee that this might lead to some additional filings from the USA, since Mexico is interested in the scheme and is a NAFTA state. Some businesses that currently file only in the USA,

Canada and Mexico might start filing European applications also. However it is apparent that 90% of Mexican applications are via PCT and there are only about 3,000 – 4,000 national applications a year. There is unlikely to be a significantly increased workload for the EPO.

Report of the EPPC meeting of 9th June, 1999

A. Casalonga (FR)

A. Administrative Matters

I. Constitution of the EPPC

1. The following members of the EPPC were elected as follows:

- *President*: Axel Casalonga (FR)
- *Vice-Presidents*: Wim Hoogstraten (NL) and Peter Shortt (IE)
- *Secretary Rapporteur*: Paul Denerley (GB)
- *Deputy Secretary Rapporteur*: Ian Muir (GB)

2. Election of sub-committees

The following members were elected to work in the EPPC sub-committees as follows:

- *sub-committee for documentation*: it was decided to merge in this new sub-committee the two previous sub-committees for technical documentation and for legal documentation. The following members were elected:
 - Wim Hoogstraten (NL)
 - Peter Indahl (DK)
 - Paul Maué (CH)
- *sub-committee for CPC and EPAC matters*: it was decided to merge in this new sub-committee the previous two sub-committees for CPC matters and for EPAC. The following members were elected:
 - Jacques Bauvir (FR)
 - Axel Casalonga (FR)
 - Luis-Alfonso Duran Moya (ES)
 - Peter Indahl (DK)
 - Gerhard Schmitt-Nilson (DE)
 - Zaid Schöld (SE)
 - Peter Shortt (IE)
 - Leonard Steenbeek (NL)
- *sub-committee for PCT matters*: the following members were elected:
 - Jacques Bauvir (FR)
 - Eugène Dufrasne (BE)
 - Paul Maué (CH)
 - Leonard Steenbeek (NL)

– *delegation to the SACEPO Working Party on Examination Guidelines*: the following members were elected:

- Axel Casalonga (FR)
- Franz Fischer (CH)
- Paul Maué (CH)
- Ian Muir (GB)
- Fritz Teufel (DE)

– *Liaison Committee*: it was decided to maintain as members of the Liaison Committee the president, both vice-presidents and the secretary rapporteur of the EPPC.

– *delegation to the MSBA meeting*: the following members were elected:

- Axel Casalonga (FR)
- Wim Hoogstraten (NL)
- Ian Muir (GB)
- Peter Shortt (IE)
- Gerhard Schmitt-Nilson (DE)

3. Associate member

Upon request, the EPPC decided to appoint Ernest Freylinger (LU) as associate member to the EPPC.

B. Information

I. Short report on the SACEPO 3rd Working Party Meeting on EPO Guidelines (23 February 1999 in Munich)

The proposal of the EPO for amendment of the Examination Guidelines concerning treatment of so-called complex applications was discussed.

A vote was taken on a proposal suggesting introduction of page fees with the aim of deterring applicants to file applications with particularly high number of pages. The vote gave the following result: 8 for, 11 against, 1 abstention.

During the discussion, it was made clear that a part of the problem came from the difficulty of the examiner to define non unity. It was also felt that certain applications were only complex because the invention was itself complex.

A letter was drafted and sent to the EPO within the deadline of 7 June, 1999.

II. Short report on the SACEPO PDI Meeting (18 March 1999 in Vienna)

A hearing on the *Epoline* project organized by the EPO on July 16, 1999 was attended by Paul Maué (CH) as EPPC representative.

III. Short report on the 9th Committee on Patent Law Meeting (16-17 March 1999 in Munich)

The question of protecting medical methods and pharmaceutical products was again discussed by the EPPC.

Some EPPC members felt that product-type claims should be acceptable not only for the first medical use, but also in case of a second medical use.

Some other members were in favour of the possibility to grant European patents on medical methods, even if this would mean protecting pharmaceutical products only by way of their methods of use if the chemical product as such is known.

IV. Short report on the 5th Meeting of the *ad hoc* Advisory Group on PCT Legal Matters (22-26 March 1999 in Geneva)

It was noted by some EPPC members that the PCT unity requirements are only applied by the USPTO in case of national phase of PCT applications, but not to divisional applications or continuation applications further filed at the USPTO. It was also noted that a reservation was made in the same sense by the US delegation for the negotiation of the PLT.

V. Short report on the 8th EUROTAB Meeting (20-21 May 1999 in Munich)

On Article 57 (industrial application), the EPPC felt that this article should be maintained in the EPC even if the question of patentability of EST could thus be slightly more complicated.

Concerning the practice of divisional applications, the EPPC noted that the possibility of filing divisional applications after grant during the opposition procedure seems to be accepted in some Member States. The EPPC members felt however generally that this should not be introduced in the EPC because of its complexity.

VI. Short report on the 10th Committee on Patent Law Meeting (8 July 1999 in Munich)

CA/PL 16/99 – Amendment of Rule 104b EPC et al.

Amendments have been proposed for the new rules 106, 109 and 110. The proposals made by the EPO should permit an applicant of a European application to review his application and particularly to reduce the number of claims before beginning examination at the EPO.

The EPPC members, consulted by writing, have generally expressed their approval.

CA/PL 21/99 – Amendment of Rule 38 EPC – filing the copy of the previous application

According to the new practice of the EPO, priority documents are automatically received at the EPO from the JPO and, in the future, from the USPTO. The amendment proposed for Rule 38(4) is generally acceptable according to the EPPC members. However, with this proposal, the applicant can easily check whether the priority document has effectively and completely been introduced into the file.

The EPPC therefore suggests that the EPO issues a notice informing the applicant when the copy of the priority document has been effectively introduced into the file. A draft letter to be sent to the EPO has been prepared.

C. Substantive Matters

I. Preparation of the 30th SACEPO Meeting (17-18 June 1999 in Munich)

SACEPO 9/99 – Follow-up to the European Commission's Green Paper on the Community Patent.

It appears clear from the opinion of the Commission that a Community patent system should be created by way of a Community Regulation based on Article 235 EC. However, this leads to a rather complex litigation system involving national courts as well as the European court of justice including the Court of first instance. Some EPPC members were of the opinion that the future litigation system for the Community patent should be simplified. If a Common appeal court could be created by an international Convention for the European patent, this could be a starting point for a common litigation system for the European patent as well as for the Community patent.

The EPPC CPC sub-committee will study the subject-matter and make proposals to the EPPC in view of the preparation of an *epi* position paper on the Community Patent System.

SACEPO 10/99 – Revision of the EPC – Articles 52-4 and 54-5 (Treatment of medical methods).

The possible deletion of Article 52-4 was again discussed however, without a definitive conclusion. The EPPC members were asked to study this question in their own constituency and to come back with proposals for the next meeting.

SACEPO 24/99 – Revision of the EPC – Article 54-4 (Prior art effect of prior filed published European patent applications).

In view of the present possibility of paying designation fees only at a later stage and also obtaining a valid designation by paying only 7 designation fees, it appears advisable for the sake of legal certainty that published European patent applications become effective prior art as soon as they are filed independently of the designations subsequently made. After discussion, a vote on the subject-matter was taken on

the question whether Article 54-4 should be cancelled. The vote gave the following results: in favour 14, against 4, abstentions 2.

SACEPO 11/99 – Revision of the EPC – Articles 121 and 122

The EPPC considered the proposals of the EPO for amended Articles 121 and 122. It appears that the possibilities of further processing, according to Article 121, are enlarged to any kind of loss of right and any kind of deadline. However, the time limit for requesting further processing begins when the applicant is informed by the Office that he has failed to meet a time limit or that he has suffered a loss of right. If the notification fails to reach the correct person, further processing may not be possible.

On the other hand, the *restitutio in integrum* according to Article 122 still requires all due care from the applicant or proprietor. Some EPPC members were in favour of enlarging the possibilities of filing *restitutio in integrum* also to other parties to the procedure, i.e. to opponents. Some members of the EPPC were also in favour of opening the possibility of further processing, according to Article 121, to annual fee payments. Some EPPC members also felt that protection of third parties should be maintained. In fact, it could be advisable that third parties be clearly informed when an application or a patent has definitively expired.

In any case, the EPPC felt that a definitive opinion on the proposals of the EPO could not be given until the further proposal of the EPO concerning the rules to be applied was known.

It could be advisable that, according to the previous wishes of the EPPC, Article 121 (further processing) completely replaces Article 122 (*restitutio in integrum*) as long as the deadline for filing a request for further processing is beginning from the removal of the cause of non compliance with the time limit as it is the case presently for *restitutio in integrum*. A rather high fee should be provided to avoid abuses. A maximum time period of one year following the expiry of the unobserved time limit should also be provided as it is the case presently in Article 122 and intervening rights should be provided.

SACEPO 19/99 – Proposal to amend the decision of the President dated 16 September 1985 concerning parts of the file excluded from inspection.

The purpose of the proposal is to enlarge the possibilities for the President of the EPO to exclude certain information from public inspection, for example, confidential documents filed by the applicant or submissions containing personal or financial information about natural or legal persons.

The EPPC felt that only documents having nothing to do with the validity of the patent should be excluded from file inspections. Some EPPC members however indicated that information, for example on animal testing such as addresses of laboratories, should not be available to the public for security reasons.

It was finally suggested that if documents were excluded from public inspection, the file should contain at least a note indicating that some information were excluded.

SACEPO 20/99 – Proposal to modify the EPO practice so that requests for file inspections and for the issuance of priority documents are kept in the public part of the file.

A strong majority of the EPPC was against this proposal. It was in any case noted that an access of the file through Easynet or Epoline will remain anonymous.

It is to be noted that this same unanimous opinion was expressed during the SACEPO meeting. The EPO will reconsider the proposal.

SACEPO 21/99 – Amendments to the EPC Implementing Regulations – Rule 104b et al. (the EPO as designated or elected Office)

The proposal of the EPO for amending Rule 104b provides that the applicant should specify the documents on which the European grant procedure is to be based. This has the purpose of permitting applicants to review the PCT application and propose amendments, for example, reduction of the number of claims before examination begins and claims fees are due. This appears generally acceptable.

The proposed new Rule 109 (amendment of the application) permits to the applicant an amendment of the application within a non extendable period of one month as from notification of the communication informing the applicant accordingly. As long as this possibility of amendment does not affect the provisions of Rule 86, § 2 to 4, the EPPC is in agreement. In fact, this only provides a further possibility of amendment of a Euro-PCT application.

II. Question 156 – Green Paper on Infringement (preparation of a position paper of the *epi*)

The Green Paper on Counterfeiting and Piracy presented by the Commission was studied by the EPPC. A certain number of questions, which may relate to patent protection, have been dealt within a draft position paper which is to be sent out by the president of the *epi*.

III. Question 142 – EU Commission Communication on the Patent System in Europe – Action planned by the Commission in relation to the Community Patent and the use of agents and recognition of professional qualifications

In the follow-up paper to the Green Paper on the Community Patent and the Patent System in Europe (§ 3.5.1 page 16), the Commission indicates that consideration should be given to the possibility of granting patent agents in the Community the rights and obligations linked to confidentiality of opinions (legal privilege) in the same way as acting members of the Bar and, in certain Member States, company lawyers.

Certain members of the EPPC were in favour of studying this question and preparing a position paper tending to grant legal privilege to opinions made by European patent attorneys. Some other members of the EPPC felt on the contrary that the *epi*, not representing all patent agents in Europe, should not take position on this question. The question has now been forwarded for study to the By-laws Committee.

IV. BEST project – reference assignment of cases for interviews

An EPPC member suggested that, in connexion with the BEST project, a geographical reference assignment of the cases to Munich, the Hague or Berlin should be provided so as to facilitate the handling of the case by the applicant or the representative closer to their own location.

After discussion, the EPPC considered however that this would lead to a risk of different practices depending on the assignment location of the case so that the proposal should not be suggested to the EPO.

V. Question 155 – European patents from Taiwan in Portugal

In a circular letter No. 2/99 dated February 24, 1999, the Portuguese Patent Office indicated that since Taiwan is not a member of the Paris Union Convention nor of the World Trade Organization, and since Portugal does not recognize Taiwan as an independent State, the principle of reciprocity does not apply. The Portuguese Patent Office therefore decided not to accept anymore applications from applicants of

Taiwanese nationality or Taiwan residents nor anymore annuity payments regarding files of that kind. No validation of granted European patents was anymore possible.

The EPPC considered that this position of the Portuguese Patent Office appears contrary to Articles 64 and 65 EPC. It was suggested to contact the European Commission if the situation could not be changed. A letter was sent to the EPO by the President of EPPC.

Since then, it appears that the Portuguese Patent Office reversed its strange decision and issued a new circular No. 3/99 dated 3 May 1999.

The situation appears to have come back to normal, at least for the time being, some discussions remaining apparently under way on this matter within the Ministry of Foreign Affairs of Portugal.

VI. Year 2000

In view of the risks of computer breakdown on 1st January 2000, the EPPC felt that *epi* members should be warned and advised to use the automatic debit order provided by the EPO so as to avoid the risks of losing any right. On the other hand, warning each *epi* member could possibly be detrimental in that restitutio in integrum would be more difficult to obtain in case of a loss of right.

The EPPC therefore suggested that a general warning, together with a recommendation to use the automatic debit order, be published in *epi* Information before the end of 1999.

Report of the Finances Committee

B. Feldmann (DE)

1. General

At its last meeting (14/15 Septemebr 1999) the Committee elected the writer as Chairman and Mr. J.U. Neukom as Secretary, therefore leaving these posts unchanged.

2. Gross pay scales

For taking account of inflation, it has been concluded that an upward adjustment by about 4% should be made in the gross pay scales for *epi* personnel with effect from 1.1.2000, this figure having regard to relevant pay indices in Germany.

3. Subscriptions

Continuance of membership subscription of DEM 300 for next year, 2000, is supported. Whether to adopt a round Euro has been considered, eg 155 =

DEM 303. For a variety of reasons, this is not favoured and the conclusion reached is that the DEM figure of 300 should be accompanied by the closest possible Euro equivalent, ie 153.38.

4. EEC Letter

In reviewing with the Treasurer the current status for 1999 and his first thoughts for the 2000 budget, the financial position on the EEC Letter (budget item 5.4) became a cause for concern. Council decided at its last meeting in Florence that an appeal should be filed on that part of the Commission decision which grants a time-limited exemption on two clauses of the *epi* Code of Conduct. As a result of this appeal, there will be included in the Treasurer's revision of the 1999 budget a large increase of the figure against item 5.4, from 10,000 to probably as much as 60,000.

5. If the appeal continues, a hearing next year is going to be expected. It is also understood that the Commission, in its response to the appeal, is seeking an award of costs. How much to budget for these things in 2000 is uncertain, probably at least as much again as in 1999. Highly desirable would be that some

attempt is made to carry out a cost/benefit analysis, ie an analysis which weighs against one another the value of the clauses in question, the removal of time-limitation, the chances of success and the likely costs.

Report of the Harmonisation Committee

F. A. Jenny (CH)

Report on the 3rd Session of the Standing Committee on the Law of Patents
6th to 14th September 1999 in Geneva

The third session of the Standing Committee on the Law of Patents („SCP“) took place at the WIPO building in Geneva from 6th to 14th September 1999.

77 States, members of WIPO and/or the Paris Union, were represented at the meeting and representatives of four intergovernmental organisations (EAPO, EC, EPO and OAPI) were present in an observer capacity.

19 non-governmental organisations (NGOs), including ABA, AIPLA, APAA, AIPPI, BDI, CIPA, CNIPA, *epi*, FICPI, IFIA, JIPA, JPAA and WASME, participated as observers. The *epi* was represented by Mr. J. D. Brown, Secretary of the Harmonisation Committee of the *epi*.

The goal of this meeting (like of the earlier ones) was the further discussion and adoption of a text of a Draft Patent Law Treaty and the Regulations thereunder, which shall constitute the basis of the discussions (= „basic proposal“) at the Diplomatic Conference which will be held from 11th May to 2nd June, 2000, in Geneva. Where this basic proposal contains words in square brackets, only the text which is not in square brackets shall be regarded as part of the basic proposal, whereas the words within square brackets shall be treated as proposal for amendment.

The discussions were particularly based on the following papers prepared by WIPO:

- „Draft Patent Law Treaty and Draft Regulations“ (SCP/3/7 and SCP/3/8);
- „Notes“ (SCP/3/3);
- „Availability of Priority Documents“ (SCP/3/5).
- *Detailed Discussions*

Besides the discussions on the Basic Proposal the following items were also discussed by the SCP:

- A proposal of Colombia to consider the procedural or formal aspects of the protection of biological and genetic resources (in view of the Convention on Biological Diversity). This question should be discussed by the WIPO Working Group on Biotechnological Inventions.
- A proposal of Sudan for a 50% fee reduction for applicants and patent owners who are natural per-

sons. It was agreed to refer the issue for informal consultations.

- *Official Report*

The International Bureau of WIPO have provided a report of the third session of the SCP (document SCP/3/11).

Starting Situation for the Diplomatic Conference

A. Content of the Draft Patent Law Treaty („Basic Proposal“) to be submitted to the Diplomatic Conference:

The Draft Patent Law Treaty contains provisions which the Contracting Parties (= Member States and intergovernmental Patent Offices) must or may not provide in their legislation and / or office practice (i.e. maximum or minimum provisions). After an extensive discussion in the Committee of Experts and in three sessions of the Standing Committee on the Law of Patents, the „Basic Proposal“ which will be submitted to the Diplomatic Conference includes the following main features:

- The *treaty applies* to national and regional applications for patents of invention including divisional applications and patents granted on such applications. It applies to PCT applications only in the national (regional) phase.
- The treaty is clearly *restricted to formal matters*. Nothing in the PLT shall be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe requirements of substantive national Law relating to patents.
- The basic proposal includes the *general principle* that Contracting Parties are free to provide for requirements which, from the viewpoint of applicants and patent owners are *more favourable* than those of the PLT.
- No Patent Office shall be obliged to accept *communications* other than *on paper*. On the other hand, a Patent Office may exclude the filings on paper and

- accept only electronic filings only after the expiration of 10 years from the entry into force of the PLT. It will, however, always be possible to file communications on paper for the purpose of complying with a time limit.
- As to the *form or contents of the application*, the basic proposal contains the general principle that, except where otherwise provided for by the PLT, no Contracting Party shall ask for requirements other than those corresponding to the requirements of the PCT. Unfortunately, however, there will be a possibility (designed for the US !) to make a *reservation* to the application of the PCT Rules *on unity of invention* to this treaty.
 - The Regulations provide for the establishment of *Model International Forms* (e.g. for the Request, Power of Attorney, Certificate of Transfer, etc.) which have to be accepted by all Contracting Parties, if they are in an official language of that Contracting Party.
 - A patent *application can be filed in any language*, but a translation in a language accepted by the Office has to be filed within a time limit of not less than 2 months from the filing date.
 - For an application to be *accorded a filing date* claims and the payment of a filing fee may not be required.
 - It shall be possible to file a patent application replacing the description and drawings by a *reference to an application previously filed* in another country, even if the priority of this latter application is not claimed.
 - It shall be possible to *supplement unintentionally omitted drawings* and parts of a description within a time limit of 2 months from the filing date or, where a notification has been made, not less than 2 months from the date of the notification, with a shifting of the filing date to the filing date of the omitted subject matter. If, however, the omitted subject matter was contained in a priority document the correction can be made on this basis and the original filing date preserved.
 - There was no consensus on the issue of *mandatory representation* and for which acts a Contracting Party may not require mandatory representation („exclusions“). The only exclusion which was accepted was the payment of renewal fees. Accordingly, it was decided to retain this exclusion as the only exclusion without square brackets. From the Article on the filing date it follows that a representative is not necessary for filing an application. Other exclusions (such as the payment of fees in general, the filing of translations and the furnishing of a priority document) were only retained within square brackets.
 - The provisions concerning *extensions of time limits* and continued processing are not very user-friendly. Thus, the providing of extensions for time limits fixed by the Office are only optional for the Contracting Parties. There is only one guaranteed extension of not less than 2 months. The request can be made, at the option of the Contracting Party, only prior or up to not less than 2 months after the expiration of the unextended time limit.
 - Continued Processing shall be provided for by Contracting Parties which do not provide for requests for extension of time limits *after* the expiration of the time limit. It is also restricted to time limits fixed by the Office. The request can be filed up to not less than 2 months from the time limit which was not complied with. This provision is not very helpful if the Patent Office sends no notification or only a late notification that the time limit was not complied with. Moreover, there are too many exceptions where extensions and continued processing need not be granted.
 - The provisions on *Restitutio in Integrum* provide that an Office shall re-instate patent applications and patents on request within not less than 2 months from the date of the removal of the cause of the failure to comply with the time limit but not more than 12 months from the expiration of the time limit if the Office finds that the failure to comply with the time limit occurred in spite of all due care required having been taken or, at the option of the Contracting Party, was unintentional. However, a lot of exceptions (such as procedures before Boards of appeal and inter partes proceedings), where a restitutio possibility need not be provided for were retained, but with payment of maintenance fees, filing requests for search and examination and filing a translation of a regional patent in square brackets.
 - It shall be possible to *correct or add a priority claim* within a time limit which shall not be less than the corresponding time limit under the PCT (cf. Rule 26^{bis.1} PCT).
 - *Re-instatement into the priority period* shall be possible if a request is made within a time limit which shall not be less than 2 months after the expiration of the priority period and the Office finds that the failure to furnish the subsequent application within the priority period occurred in spite of all due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.
 - The Rule on *requests for recordal of change* in applicant or owner leaves the choice to the requesting party whether it wishes to present, as a basis for its request, a (possibly certified) copy of the complete contract, a (possibly certified) extract of the contract showing the change or an uncertified certificate of transfer of ownership by contract. In an analogous manner, a party requesting *the recordal of a licensing agreement* has the choice between a (possibly certified) copy of the complete licensing agreement or a (possibly certified) extract consisting of those portions of that agreement which show the rights licensed and their extent.
 - Almost all *Rules can be changed* by the Assembly of the Contracting States by a * majority. Only the change of very few rules needs unanimity.

B. Availability of Priority Documents:

In order that the priority documents are available to the applicant and third parties upon request, it is envisaged

establishing a system by an Agreed Statement of the Diplomatic Conference, according to which each Contracting Party undertakes to make available upon request copies of applications filed with its Office, which serve as a basis for a priority claim. The UK Delegation will submit a Draft Statement through the Electronic Forum in order to receive comments for a final Draft to be submitted to the Diplomatic Conference for adoption.

C. Future Work

- In November 1999, invitations and documents for the Diplomatic Conference will be mailed. WIPO intends to conduct regional consultations regarding the Draft PLT between November 1999 and May 2000. The Diplomatic Conference will convene in Geneva on 11th May 2000 and continue through 2nd June 2000.
- The SCP will not meet again until after the Diplomatic Conference. Its Agenda will be based on the WIPO Program and Budget for the 2000 – 2001 biennium.

Report of the Professional Qualifications Committee

T. Onn (SE)

1. Students of the *epi*

The studentship of *epi* is increasing in popularity. The current number of students is 282, of which 67 students have enrolled during 1999.

2. *epi* Tutorials

The summer session of this years Tutorials comprises 72 candidates from AT, BE, CH, DE, DK, FI, FR, GB and SE. The 420 papers from these candidates will be commented on by 28 tutors from BE, CH, DE, DK, FR, GB and SE.

3. Tutors

There is a need for more *epi* tutors and PQC sends an appeal to the Council members to encourage *epi* members in their home countries to enrol as tutors.

4. Amendment of Rule 102 EPC

The PQC has given its opinion on this question to the Board.

5. Reduction in periods of professional activity

The question of the reduction in the periods of professional activity has been discussed for many years, in particular as several Institutions have asked for it. There are no rules under which conditions these Institutions could receive a reduction. Therefore, at the Council meeting at Florence, it was said in the PQC-report that in the preliminary opinion of the PQC the reduction should be abolished for all candidates.

PQC therefore propose an abolishment of the reduction but for the German candidates having attended to the full training at the German Patent Office.

It is therefore proposed to ask the Administrative Council to amend:

In the *Regulation* on the European qualifying examination for professional representatives:

Article 10 Conditions for enrolment

4. In determining the periods of activity referred to in paragraph 2(a) the Secretariat shall also take into account

- a) candidates' activities in proceedings relating to national patent applications and national patents
- b) six months' of the full and completed eight months' training with the German authorities on presentation of the certificate for admission to the German qualifying examination.

Article 11 is cancelled.

Article 28 Transitional provisions

(3) Candidates who have enrolled in the courses enumerated in the Official Journal EPO No. 6/1999, 384-385, before this amendment is put into force will be admitted according to the existing regulations.

(4) German candidates who began the training before January 1, 1999 will be granted a reduction of 10 months if they have completed the full twelve months' training with the German authorities on presentation of the certificate for admission to the German qualifying examination.

In the *Instructions* concerning the qualifications required for enrolment for the European qualifying examination:

Article 10

Par. (1) and (3) are cancelled.

6. Restrictions in resitting the EQE

EPO has handed over a draft for amendments of Articles 18, 27 and 28 of the Regulation on the European

Qualifying Examination. The draft does not give any background analysis of the situation why the remedies proposed will be given to a patient without a foregoing proper diagnosis.

The PQC realizes the administrative problem with the increasing number of resitters. However, PQC strives to find a solution where the number of passing candidates increases, thereby decreasing the number of resitters. PQC has appointed a working group to gather more statistical material on the EQE to see if there are conclusions to be drawn from that material. Unfortunately much of the statistics are only for confidential use by the EPO, which means that the PQC cannot today get a sufficient background material to do a proper analysis.

It is therefore proposed that Council takes the position that an analysis is made before amending these articles in the REE. This analysis should be done by a joint *epi*/EPO working group, which group than would come with constructive proposals on how to solve the problem. The PQC suggests that Gabriele Leissler-Gerstl, Ejvind Christiansen and Thorsten Onn will be the *epi* representatives in this group.

7. Continuing Professional Education (CPE)

The PQC has been responsible for CPE for some time now (cp. changes to the by-laws).

Given the present circumstances that on the one hand new states wish to – and will join the EPC and on the other hand „Grandfathers“ and „Grandmothers“ tested representatives without much practical background should represent their clients, competent answers to these questions and solutions have to be found.

It is felt that if continuing education became to a certain extent mandatory then the gap between the

contracting states offering good training and continuing education opportunities and those not offering such schemes would become even greater than previously.

It has to be stressed that there is a problem of compiling the existing information on continuing education programmes and making it accessible. Even though this by and large is not valid for professional offers, with which we are often swamped, it nevertheless would be beneficial to have a periodically up-dated list of such offers, which could be made available, for example, via the Internet.

A sort of à la carte-menu has to be prepared to give appropriate recommendations with essentially a non-compulsory and liberal approach.

„Further education“ is regarded as a separate matter: it is an education over and above the demands directly associated with the procedure before the EPO. Licences, infringement dealings, nullity, representation before the courts etcetera. Such further education should be on a voluntary basis and could include a certificate entitling representation before courts.

The PQC proposes a multiple-track approach:

- Continuing education at a national level, supported by suitable institutions; there are ideas about for example – and particularly – a structure along the lines of the organisation of the CEIPI/*epi* Basic Courses. This should cover the needs which are perhaps purely specific to a certain country and could be effected on the spot.
- Joint venture with the EPO, mock-interviews, opposition and appeal procedures.

Priority for the same invention: what does the Paris Convention say about it (and is it relevant what the Paris Convention says about it)?

L.J. Steenbeek (NL)

1. Foundations.

Pursuant to the Preamble¹ to the European Patent Convention (EPC), the EPC constitutes a special agreement within the meaning of Article 19 of the Paris Convention (PC). Article 19 PC allows the Paris Union states to conclude special agreements provided that these special arrangements do not contravene the PC.² So, by the reference in the EPC Preamble to Article 19 PC, the EPC implicitly declares the Paris Convention to be higher-ranking law.³

Priority for Euro-PCT applications is governed by Article 8 PCT⁴ that simply refers to the Paris Convention. In view of Article 150(2) EPC⁵, the PCT takes precedence over any conflicting EPC provisions. According to the 1998 EPO Annual Report, 64793 (=57%) Euro-PCT applications were filed as compared to only 48550 (=43%) direct European applications.

Article 30 of the Vienna Convention on the Law of Treaties (VC)⁶ contains provisions on the application of successive treaties relating to the same subject matter. The reference in the EPC Preamble to Article 19 PC, and thus also to the provision in Article 19 PC that says that special agreements may not contravene the Paris Convention, renders Article 30(2) VC applicable, so that the Paris Convention prevails over the EPC. Moreover, Article 30(4)(b) VC provides that even if Article 30(2) VC would not apply, between the EPC states and each Paris Convention state that is not an EPC state it holds that the Paris Convention governs their mutual rights and obligations: an e.g. US applicant cannot be deprived of his Paris Convention rights. Finally, it obviously holds that the EPC states, all bound by the Paris Convention, are simply unable to establish an international organization

1 EPC Preamble: The Contracting States, ...

DESIRING, for this purpose, to conclude a *Convention* which establishes a European Patent Organisation and *which constitutes a special agreement within the meaning of Article 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised on 14 July 1967, and a regional patent treaty within the meaning of Article 45, paragraph 1, of the Patent Cooperation Treaty of 19 June 1970, HAVE AGREED on the following provisions:*

2 Article 19 PC: Il est entendu que les pays de l'Union se réservent le droit de prendre séparément, entre eux, des arrangements particuliers pour la protection de la propriété industrielle, *en tant que ces arrangements ne contreviendraient pas aux dispositions de la présente Convention.*

3 This is confirmed by M. van Empel in his dissertation „The granting of European patents”, 1974, Section 595: „In thus laying down substantive provisions on the subject itself the present Convention takes a different approach from that adopted under PCT Article 8 which – apart from certain specific point – simply refers to Article 4 of the Paris Convention (Stockholm text). The approach adopted here presents, of course, the practical advantage of making for a more comprehensive and accessible presentation of legal rules which apply to the European patent. Moreover it should dispose of the problem of the various Contracting States being bound by different texts of the Paris Convention. At the same time, gaps in the present Convention here, if any, may be filled by reference to the Paris Convention, all the same. Any divergences between the two Conventions should be dealt with along the following lines. On the one hand, *the present Convention cannot detract from rights conferred upon private parties by Article 4 of the Paris Convention.* Thus, for instance, as long as the priority period for patents in Article 4C (1) of the Paris Convention remains twelve months, the period as indicated in Article 87(1) of the present Convention cannot be shortened autonomously by Contracting States. On the other hand, however, it should be recalled that the Paris Convention provides for a minimum extent of protection. Domestic law and special agreements like the present may grant a more extensive protection, provided this is done at a non-discriminatory basis. In this regard attention should be drawn to the present Convention's liberal attitude towards utility certificates and inventor's certificates (Article 87(1)). The corresponding Article 4I of the Paris Convention applies only to applications filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate whereas no such condition is contained in the present Convention.”

4 Article 8 PCT (Claiming Priority)

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2) (a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

5 Article 150(2) EPC: International applications filed under the Cooperation Treaty may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of that Treaty shall be applied, supplemented by the provisions of this Convention. *In case of conflict, the provisions of the Cooperation Treaty shall prevail. ...*

6 Article 30 VC: ...

(2) When a treaty specifies that it is subject to, or that it is not to be considered as incompatible with, an earlier or later treaty, the provisions of that other treaty prevail.

(3) When all the parties to the earlier treaty are parties also to the later treaty but the earlier treaty is not terminated or suspended in operation under article 59, the earlier treaty applies only to the extent that its provisions are compatible with those of the latter treaty.

(4) When the parties to the later treaty do not include all the parties to the earlier one:

(a) as between States parties to both treaties the same rule applies as in paragraph 3;

(b) as between a State party to both treaties and a State party to only one of the treaties, the treaty to which both States are parties governs their mutual rights and obligations.

(viz. the EPO) that is not bound by the Paris Convention in the same manner as the EPC states themselves are bound by the Paris Convention.

Consequently, when an issue is investigated on which the Paris Convention contains provisions, such as priority, it does not suffice to limit ones studies to what the relevant EPC provisions are; first and above all one has to study the PC.

On the issue of the *same invention* referred to in Article 87 EPC⁷, Articles 4F and 4H PC⁸ contain relevant provisions. Article 4F PC says that a priority or an application cannot be refused for the reason that an application claiming priority contains one or more elements that were not present in the priority application. However, in that case there should be unity of invention under the law of the country in which the application claiming priority is filed. Nevertheless, as set out in Article 4H PC, the invention for which priority is acknowledged, is limited to those elements precisely disclosed in the priority application. So, if there exists unity of invention as it is defined under the EPC (Rule 30⁹) between an invention claimed in a European patent application and an invention disclosed in a priority application, the priority cannot be refused, be it that only those elements present in the claim of the European patent application that are precisely disclosed in the priority application, benefit from this priority.

2. Comparison to existing Enlarged Board of appeal case law.

Enlarged Board of appeal opinion G 3/93 relates to the right to priority. However, it answers a question that is limited to a situation in which the claim to priority is not valid because the European patent application comprises subject matter not disclosed in the priority document. Consequently, its answer is also limited to a situation in which it is already clear that the priority is not validly claimed. In that case, any publication in the priority interval is obviously relevant to the patentability of the European patent application. G 3/93 does not say when a priority is still validly claimed, because that was outside the question of law referred to the Enlarged Board of appeal. Nevertheless, G 3/93 contains some *obiter dicta* as to which the following comments can be made.

7 Article 87(1) EPC: A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent ... , shall enjoy, for the purpose of filing a European patent application for the *same invention*, a right of priority during a period of twelve months from the date of filing of the first application.

8 Article 4F PC: Aucun pays de l'Union ne pourra refuser une priorité ... pour le motif qu'une demande revendiquant une ou plusieurs priorités contient un ou plusieurs éléments qui n'étaient pas compris dans la ou les demandes dont la priorité est revendiquée, à la condition, dans les deux cas, qu'il y ait *unité d'invention*, au sens de la loi du pays.

Article 4H PC: La priorité ne peut être refusée pour le motif que certains éléments de l'invention pour lesquels on revendique la priorité ne figurent pas parmi les revendications formulées dans la demande au pays d'origine, pourvu que l'ensemble des pièces de la demande révèle d'une façon précise lesdits éléments.

9 Rule 30(1) EPC: ... the requirement of unity of invention referred to in Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression „special technical features“ shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

In G 3/93, reason 3 gives an example in which the invention disclosed in a first priority application is not the same as the one disclosed in a second priority application (although there is unity of invention within the meaning of Article 82 EPC). This remark between brackets is not understood: Article 4F PC clearly states that unity of invention is the standard that has to be used for determining whether a priority claim can be acknowledged.¹⁰ Consequently, if there is unity of invention, it is the same invention, while if there is no unity of invention, the inventions are different.

Reason 4 of G 3/93 states that Articles 87 to 89 EPC provide a complete, self-contained code of rules of law on the subject of claiming priority, and that the Paris Convention is not formally binding upon the EPO. As set out above, these statements are not considered to be correct.

3. Elaboration.

Now that the foundations have been set out, it is possible to consider some more detailed questions. As made clear by Article 4H PC, the priority is limited to what has been precisely disclosed in the priority application. An implicit disclosure does not suffice. So, basically, if there is a lesser degree of correspondence, only those features claimed in the European patent application that are precisely disclosed in the priority application, can benefit from the priority.

Article 4F PC refers to the concept of unity of invention. This implies that the features the claim of the European patent application has in common with the disclosure of the priority application, must be „special technical features“, i.e. features that are new and non-obvious over the prior art. Rule 30 EPC further uses the words „same or corresponding“ special technical features, an expression which is broader than just „same“. As to the notion „corresponding“, the EPO Guidelines (C III 7.2) give the example of a first claim in which the special technical feature which provides resilience might be a metal spring, whereas in another claim the special technical feature which provides resilience might be a block of rubber. Obviously, in this example, resilience, which is the only thing these two claims have in common, must be new and non-obvious over the prior art. Turning now to the issue of claiming priority for the same invention, a claim reciting a block of rubber may benefit from an earlier application disclosing a metal spring, provided that resilience is a „special technical feature“, i.e. new and non-obvious over the prior art. In the wording of Article 4H PC, „resilience“ is what has been precisely disclosed in the priority application.

If a claim in a European patent application contains special technical features that it has in common with the priority application, Article 4F PC allows this claim to recite other features in addition to those patentable

10 This is confirmed by G.H.C. Bodenhausen, Guide to the Application for the Paris Convention for the Protection of Industrial Property as revised at Stockholm in 1967, Geneva 1968, at Article 4, Section A(1), sub (i): „Moreover, with regard to patents, special rules concerning the identity of the subject are given in Sections F, G and H of Article 4.“

special technical features, which additional features are not disclosed in the priority application. In this case, priority is recognized for the special technical features the European patent application and the priority application have in common¹¹, but not for the additional features. These additional features only limit the scope of the claim, but are irrelevant to its patentability, as this patentability is already given by the presence of the special technical features. These additional features obviously do not benefit from the priority, see Article 4H PC, but that is not relevant, as the claimed invention is already patentable in view of the special technical features that it has in common with the disclosure of the priority application.

The prior art in view of which the special technical features common to the claim of the European patent application and the disclosure of the priority application, are new and non-obvious, is everything made available to the public before the priority date. If a new prior art document is discovered, published before the priority date, it might take away the novelty or inventive step of the features the claim of the European patent application has in common with the priority application. In that case, priority is lost (as there are no special technical features any more)¹² and the patentability of the claim in the European patent application is determined by comparing the combination of all its features with everything made available to the public before the filing date of the European patent application. It is only now, when the priority is lost by virtue of new prior art taking away the patentability of the former special technical features, that any additional elements in a claim of a European patent application become relevant for the determination of the patentability of that claim. So, it is not unfair to allow a claim containing elements in addition to elements disclosed in the priority application to benefit from the priority of the priority application, as these additional elements only become relevant for the determination of the patentability of the claim after the priority has been lost.

This reasoning can be explained following the case of the „Snack food“ decision (T 73/88). In this case, claim 1 of the European patent application as filed, and of the European patent as granted, requires as a technical feature of the claimed invention that the claimed snack food contains „at least 5% by weight of oil or fat“. This feature provides a fried flavor to the claimed snack food. The priority application merely discloses a „relatively low fat content“ and „20% by weight or less e.g. 8% to 20% by weight fat“. So, the minimum figure of 5% fat is not expressly mentioned in the priority application. In the EPO Board of appeal's view, this additional feature is clearly an essential technical feature in that it has the effect of limiting the extent of the protection conferred by the patent, so that products which do not have at

least 5% fat or oil are not within the protection conferred. The inclusion of a technical feature in a claim which is an essential feature for the purpose of determining the scope of the protection conferred is not necessarily an essential feature for the purpose of determining priority, however, which depends on whether the additional feature changes the character and nature of the claimed invention. In this case it was held that the additional technical feature did not relate to the function and effect of the invention so that priority was not lost.

Obviously, what has been set out above regarding additional features in a claim of a European patent application as compared to the disclosure of the priority application, also holds regarding features that are more specifically or more narrowly defined in the claim of the European patent application as compared to the disclosure of the priority application. Namely, a more specifically or narrowly defined feature can be considered as the combination of the original broad feature plus the more specific or narrow definition as an additional feature. If the claim without this additional more specific or narrow definition is patentable over the prior art before the priority date, there is no problem. In the other case, there is no priority.

Finally, the following is noted. On the one hand, a claim the scope of which is limited by reciting features in addition to the special technical features the claim has in common with the priority application, still benefits from priority.¹³ On the other hand, a claim that as alternatives to special technical features forming unity with what has been specifically disclosed in the priority application, also encompasses elements not forming unity with what has been specifically disclosed in the priority application, thereby broadening the claim's scope, only benefits from priority as far as the special technical features are concerned. In the latter case, an intermediate publication that takes away the patentability of the alternative elements, also takes away the patentability of such a claim that is broader than what forms unity with the priority application.¹⁴

4. Conclusion.

The Paris Convention should be taken into account when deciding on priority, not only for Euro-PCT applications but also for direct European applications. For deciding on whether an invention claimed in a European patent application is the same as that disclosed in the priority application, the relevant criteria are set out in Articles 4F and 4H of the Paris Convention. Consequently, one has to investigate whether unity of invention exists between the elements precisely disclosed in the priority application on the one hand, and elements recited in the claim of the European patent application on the other hand. Additional elements that limit the scope to a preferred embodiment, do not necessarily result in a loss of priority.

11 This is confirmed by G.H.C. Bodenhausen, *op. cit.*, at Article 4, Section F, sub (d): „Under the Convention, such additions in later applications will not prevent priority from being recognized for those other elements which were already present in the first application.“

12 Or, put otherwise, priority does no longer make sense, as the priority invention is no longer patentable.

13 See T 16/87 and T 73/88.

14 This was the case in the decision of the United States Court of appeal for the Federal Circuit, in re Gostelli, GRUR Int. 1990, pp. 994-996.

Patentability Certificate Single Search and Single Patentability Opinion Can they have a universal value?

Principal Differences between Principles of the U.S. Patent Law and the European Patent Convention

Their effects on the Examination Procedures and on The Drafting of Specification and Claims

G. Modiano (IT)

Recent proposals, originating from the WIPO, are circulated, which aim at proposing to organize a *Patentability Certificate* based on a universally valid Search and Patentability Opinion, to assist in one shot applicants having global interests. It is clear that the problem resides in the fact that such Search and Patentability Opinion has to overcome the differences between, *inter alia*, the U.S. Patent Law and the EPC. The following are comments which may open a debate, on the value of such a Patentability Certificate. Is in other words a Universal Search and Patentability Opinion feasible ?

The Patent Law of the United States has been developed in complete isolation from those of the principal European Countries. The European Countries have enacted in the seventies the European Patent Convention (EPC) which has tried to comprise the main features of the laws of the European Countries which were a party to the EPC. In drafting the EPC, no attempt has been made to close the gap which existed in respect to the U.S. Patent Law. In the last 20 years, the interpretation of the EPC by the various Boards of appeal and by the National Courts of the contracting states have formed a precious body of case law, which has given even more credit to the European Patent Law Principles. Again in the U.S. in the last half of the 20th century the case law has developed a number of binding interpretations, which according to some authors – have contributed to the extraordinary development of the most advanced technologies. It is understandable that the Americans, on the basis of this success test, are reluctant to renounce certain of their principles. The main arguments of the Europeans are that some of the European principles are supported by fair reasoning, and that therefore, should the Americans have adopted them, their success in advancing certain technologies would have been even larger.

Differences in some basic principles

There are many differences in basic principles, a fact which renders a *sole* or *common* Search and the ensuing

Patentability Opinion impossible, unless the U.S. or the EPC countries renounce to the specific principles and to the case law which has been built on them.

Novelty Requirement

Beyond the major differences relating to the period of grace and to the first to invent versus the first to file principle, which are well known and which we shall examine in the first place, some other differences of important impact as well – will also be considered.

Grace Period. According to the U.S. Patent Law (35 U.S. Code) and more particularly according to § 102 (b) a *public use* anywhere (except the U.S.) does not prejudice novelty. A public use in the U.S. prejudices novelty only if it occurred more than 12 months before the filing of an application.

Instead according to the EPC (art. 54) prior public use or knowledge anywhere is a bar to novelty.

Non public use. According to the U.S. Patent Law (35 U.S. Code) and more particularly according to Section 102 of this Law, the novelty is prejudiced [102 (a)] as far as prior non public use is concerned – by a prior use if it occurs in the U.S.

Instead, according to the EPC, a non public use never prejudices the novelty. It may trigger „prior user“ rights, once the patent is „nationalized“ in some designated countries, according to the national law of such countries but the specificity of such prior user rights is that the patent remains valid (and not that the patent is void as is the case under the U.S. Patent Law if a prior use occurs in the U.S.).

Accordingly, under the same factual circumstances (public use or non public use) a U.S. Patent may be valid, and a European Patent may be invalid.

The consequence is that the search and also the Opposition (or, the not totally corresponding U.S. Patent Law procedure called „Re-examination“) criteria are different.

Implication of reproducibility in Novelty Assessment. Under the U.S. case law, if a prior sale (more than 12

months before the filing date) of a patent has occurred in the U.S. of a product, any patent on that product would be invalid.

Under the EPC (*Board of appeal*) case law, if the prior sale, whenever it occurred, of the product does not inherently show how the product can be made, the sale *per se* is not depriving the patent of its patentability. In fact under the EPC Board of appeal case law only if the previously sold product is analyzable and *reproducible* before the patent filing date, can the novelty requirement be defeated. It happens sometimes that there is no way to find out how a chemical product can be made, notwithstanding the fact that it has been sold on the market and thus is analyzable.

Thus, a U.S. Patent may be invalid, a European patent may be valid, under the same factual circumstances.

Accordingly, in assessing the impact of a prior art, different criteria apply under the U.S. Patent Law and the EPC case law.

Impact on the novelty of U.S. application filed after the priority date. Differences in the application of the International (Paris) Convention.

Both the U.S. and all European Countries are a party to the International (Paris) Convention and are members of the Union established by said Convention. The European Patent Organization- not being a country could not become a party to the International (Paris) Convention. It has therefore repeated in the Convention (Art. 87, 88 and 89) all the relevant principles enshrined in the Paris Convention and relating to the recognition of the priority of an earlier filed application in a Country belonging to said Union. Thus, practically, the EPC recognizes the priority principles.

Furthermore both the U.S. and the EPC recognize the priority, even if in between the basic foreign application and the entering into a national phase in another country, a PCT application has been filed. The U.S. and all European Countries are parties to the PCT. Again the European Patent Organization, not being a country, could not become a party to the PCT and to overcome the problem, the EPC has repeated all the relevant provisions (Art. 150 to 158) so that practically the EPC recognizes the PCT provisions.

Still, notwithstanding this common recognition of the Paris Convention (and of the PCT) there are differences between the way the U.S. Patent Law interprets according to the binding U.S. case law – the Paris Convention and the way all the other countries throughout the world (i.e. not only the countries bound by the EPC) apply the principles of the Paris Convention in specific cases.

In fact, when joining the PCT, the U.S. made a reservation under the PCT art. 64 (4), in order to retain the effect of a U.S. Court decision „In Re Hilmer et al.“ of the year 1966 (359 F2 859). In such decision, the Court noted that under § 102 (e) of the U.S.C 35 (U.S. Patent Law, only an application filed in the USPTO could trigger the effects of said section § 102 (e). The „in re Hilmer“ decision distinguished between the *priority date* and the *prior art date*. To understand the difference, only a prior art date can defeat the novelty of a successively filed U.S.

Application, while the priority date cannot defeat such a novelty. It can be used, as will seen hereafter, only in defensive actions, for inst. to overcome a reference or to establish the „first-to-invent“ date.

The consequence is that a foreign filed PCT application designating the U.S., that it to say a PCT application previously filed not in the U.S. but in any other Paris Union country, triggers a priority date, but such priority date may not be used as a *sword* to invalidate a U.S. application of a third party filed after the earlier priority date if such earlier foreign application is not filed in the U.S. before the filing of a U.S. application by a third party. In fact, under section 371 of the 35 U.S.C. national stage commences when the PCT papers are received by the USPTO. Only the *prior art date* invalidates such a successive U.S. application of a third party. Any U.S. patent granted as a national phase of a PCT will list a priority date (for ex. May 23, 1994,) a PCT filing date (for ex. May 17, 1995) and a § 371 Date or a § 102 (e) date (for ex. Nov. 20, 1996), which is the date when the basic PCT application entered the U.S. national stage; only this date would be able to trigger the invalidity consequences enshrined in section 102 (e) of the US Patent Law (35 U.S.C.) and thus act as a *sword*. In other words, the priority date can be used only as a *shield*, for example in overcoming a reference or in establishing the first-to-invent date in an interference proceeding.

Instead in all other laws, including the EPC, the priority date can be used both as a *sword* and as a *shield*.

Thus, a patent which would be invalid under the EPC, would, under the same circumstances, be valid under the U.S. Patent Law.

This is a further proof that the Search Criteria in such very frequent cases are different under the U.S. Law and under the EPC and, for that matter, the Japanese, or German, or French or other Patent Laws, throughout the world.

First-to File versus First-to-Invent-Principle

It is well known, and there is no need for any further comment, that the U.S. Patent Law rewards with a patent him who first invented the related invention (provided the filing occurs within a certain time, after the date of conception) while the EPC countries, and the Patent Laws of most other countries around the world stick to the concept of a *prima facie* reward conferred to him who first files an application for an invention (except if the one who first filed the application came to know the invention disclosed in the application in an abusive manner from another person for inst. connected to the real inventor – a fact which has to be cleared in Court- this not being a *prima facie* concern of a Patent Office, who has no duty to find out whether the invention passed in an abusive or non abusive manner to the applicant).

The U.S. Patent law has instead developed a full procedure, called „interference“ to permit the U.S. Patent and Trademark Office to find out who is the first inventor.

Accordingly, a *later filed application (later art)* which may turn out to be related to the patent which will become the real beneficiary of the valid rights, may not even be located with a Search as made under the EPC, because it would be irrelevant for the EPC. In contrast thereto, such later art may kill the *earlier filed application*, under the U.S. Patent Law.

Thus the Search criteria, and the assessment of their result are different if one applies the U.S. Patent Law and the EPC.

Inventive Activity

A major difference is already to be found in the fact that while the contents of previously filed (still secret) U.S. applications deprive a successively filed U.S. application *both of novelty and of inventive activity* (called under the U.S. law – § 103 „non obviousness“), under art. 56 EPC the contents of previously filed (still secret) applications „are not to be considered in deciding whether there has been an inventive step“

Thus under the same circumstances, a U.S. Patent may be invalid and a EPC patent may be valid.

This derives from the fact that the assessment of the prior art found during the search is different under the U.S. Patent Law and the EPC.

The *European case law* has furthermore implemented approaches, like the „easy to try“ approach, which are unknown in the U.S. examination. Under the „easy to try“ EPC case law approach, it is sufficient for defeating the inventive step requirement – that for inst. an alternative solution may have been easy to try (for inst. in a compound, when the inventor would easily try another radical to substitute one which is belonging to the prior art). Under the U.S. patent case law, it should be first shown that there was an incentive to try, and if such an incentive existed, then the easiness of the trial comes into play, for defeating the „non obviousness“ requirement.

Under similar circumstances a U.S. Patent may be said to possess non obviousness, while the EPC patent may be rejected because of lack of inventive activity.

This derives from the fact that the assessment of the prior art located during the Search is different, under the U.S. Patent Law and the EPC.

Unity of Invention

Also in this respect the criteria are different, and this is well known. Suffice it to consider the criteria defined in the EPO Board of appeal Case Law and usually accepted even by the U.S. Examiners, when faced with a U.S. national phase application stemming from a PCT Application first filed abroad. Such criteria are clearly apparent from the Form Paragraph # 8.17 related to U.S. Rules (see page 800-35 of *the Manual of Patent Examining Procedure M.P.E.P.*). In contrast with such criteria, the *M.P.E.P.* in keeping with 37 CFR 1.141 and its subsections, states (under 806.05 (e) of the *M.P.E.P.*) that a

process and an Apparatus for practicing the process are mostly distinct inventions, requiring elections and subsequent divisionals, or – under 806.05 (f) that distinct inventions are found between Process of Making and Product made or under – 806.05 (g)- that distinct inventions are mostly seen in an Apparatus and Product made, etc. Accordingly, while under the EPC and the PCT there is always unity of invention among the above categories, instead, under the U.S. Patent Law, most frequently unity of invention is disputed.

The differences stem *inter alia* from a different approach in organizing the search literature. Under the U.S. classification, the prevailing criteria are the structures (for products) or the steps (for processes). Under the International Patent Classification (IPC), the prevailing criterion is the field of use or the application of the inventive structure or process to a specific art. Obviously expansions beyond the boundaries of these criteria occur, but they do not minimize the different importance given to the said basic criteria under the U.S. classification and the IPC. Thus a process for making a certain product may be usually found in the same class as the product, under the IPC, while under the U.S. Patent Classification, the process is ascribed to a class completely unrelated to the product. The U.S. Examiner has to effect two different searches, frequently performed by different persons, for finding for inst. products and processes to make the product, while the European Examiner may have to work more, but usually in classes of his domain and immediate reach.

The U.S. Examiner may thus ask for divisionals, while the European Examiner may instead recognize the unity of invention.

Thus the search has to be differently organized in respect to areas which possess unity of invention, under the EPC, and do not possess such unity, under the U.S. Patent Law.

The art located by a single search is accordingly different.

Other Differences

There are other important differences which again stem from the specific case laws.

So for inst. it is well known that during a patent nullity lawsuit in the U.S., each claim of a U.S. patent either resists the challenge of validity or it dies. It is not possible to argue in a lawsuit that should the claim comprise a further limitation (even if this limitation is well supported by the specification) this claim would survive.

Not so under the national Laws of Germany, Great Britain, France, Italy, etc.

Under for inst. the German Patent Law, in a nullity suit, the already granted claims may be redrafted and thus restricted and consequently they may survive. In the U.K. it is possible to file after grant – an amendment of the already granted claims (within certain time constraints) and this provision is used in lawsuits. In Italy, while this is also possible before a lawsuit is filed, there are means to assess the validity of more restricted claims during the

progress of the lawsuit since the Judge may consider a more limited scope within the frame of a granted claim having an initially larger scope. The judge may base his decision on the so defined narrower scope, notwithstanding the broader language of the claims. This last approach is valid in France and other countries as well.

The two different situations have the consequences that those who draft U.S. claims have to rely on an enormous number of claims, each with a different set of limitations, in the expectation that at least some will survive the challenge. Or in order to avoid malpractice charges, which can arise if a claim narrower or different in scope could have been drafted and allowed: the attorney who drafted the broader and not the narrower claim (which could have survived in a lawsuit), or a claim for a device and not a claim of a system within which the device is operational (which again may have survived in a lawsuit) may in fact be liable for malpractice.

As contrasted with this U.S. approach, under the EPC a plurality of claims of this kind is seen as a violation of the rules.

These different approaches about the plurality or large number of claims under the U.S. Patent law are enhanced by the fact that the U.S. examination rules and the practice of the U.S. Patent Law permit or even advise to use a plurality of claims in the same category (for inst. the category formed of products or of apparatuses or of processes, etc.) an approach which is anathema for the EPC examiner.

Therefore the examination (patentability) criteria are different in respect of this aspect as well.

In the U.S. a major problem is the interpretation of the „means plus function“ limitation recited in the claim. Such interpretation (see *in re Donaldson*) corresponds to a reverse *doctrine of equivalents* since the language „means for... (here follows the function)“ is interpreted as considering the „means“ limited to the embodiment shown in the specification. Thus a prior art, very similar to the embodiment, may not deprive of novelty or inventive activity such a claim (if conveniently reworded), if some superiority assists the embodiment. Under the EPC, a „means plus function“ recitation, far from being limited to the embodiment recited in the specification, is instead the usual way to broaden the scope of the claim to all equivalents. The existence of a prior art falling within the „means plus function“ language deprives the related claim of novelty even if the practical embodiments are completely different; this occurs according to the concept that the pre-existing species renders non novel the genus comprising such species, if the claim comprises language trying to protect the genus.

Thus a different assessment of the language of the claims is what occurs when viewing the case under the U.S. Patent Law and the EPC.

Last but not least, it is clear from the case law that the level of knowledge of the person skilled in the art, to whom the specification and claims are addressed, is different in the U.S. from what is considered to be the level of the European person skilled in the art, under the national laws of the EPC countries.

The person skilled in the art under the U.S. Law is almost an apprentice or, if an exaggerated view is taken, the person skilled in the art is a casual member of a Jury (mostly a layman from the technical point of view). Since such casual member of a Jury is a person who will decide on the validity of the patent, one suspects that local U.S. attorneys try frequently to pattern the sufficiency of disclosure according to the knowledge of such a casual member of a Jury (although in lawsuits, the parties may bring experts to educate the Jury and/or the Judge). Thus extremely long (sometimes tedious) specifications are usually supporting a U.S. Patent application, in order to teach the apprentice or the members of the Jury the full art, from its commencement.

When filed under the EPC such specifications have a length which is useless (since the man skilled in the art is supposed by the EPC to thoroughly know the art). Not only are such lengthy specifications and claims useless, but they also entail high translation costs, which then are strongly criticized by non European Applicants, forgetting that the first reason for such costs is to be ascribed to their lack of knowledge of the EPC requirements.

As is seen, even economic factors did not achieve to harmonize the laws. Some EPC examiners, during the prosecution, ask for the deletion of certain redundant portions of the specification, while no U.S. Examiner ever requests such deletion. Again the Examination criteria are different.

Conclusions

In this essay, only some of the differences between the U.S. and the European Search and assessment-of-prior-art criteria have been considered.

They already suffice for building a fair case supporting the showing that it is impossible to envisage a single Search and consequent Patentability Opinion, which would meet the Examination criteria under the U.S. Patent Law or under the EPC (and under other Patent Laws around the world).

RESULTS OF THE EUROPEAN QUALIFYING EXAMINATION 1999

I

FIRST SITTING - Examination in full and modular sitting

Total	PASSED			NATIONALLY FAILED		Candidates (in total)
	%	Examination in full	modular sitting (2modules)	%	Examination in full	
3	50,0	2	1	50,0	2	6
4	57,1	3	1	66,9	2	7
2	66,7	2	0	66,7	0	3
57	45,6	50	7	54,4	63	125
0	0,0	0	0	100,0	5	7
1	20,0	0	1	0,0	3	5
0	0,0	0	0	100,0	1	1
15	37,5	9	6	60,0	19	31
40	58,0	30	10	63,0	18	69
0	0,0	0	0	100,0	0	1
2	13,3	0	2	0,0	5	15
4	57,1	1	3	42,9	3	7
2	28,6	2	0	57,1	5	7
0	0,0	0	0	100,0	2	2
130	44,1	99	31	55,9	128	295
				TOTAL		37

RESITTING - Examination in full
 Total number of candidates: 22
 Passed: 190 (33,5%)
 Failed: 37 (66,5%)

Grace Period Discussion

J.E.M. Galama (NL)

The debate with regard to the grace period in Europe got a new impetus after the Intergovernmental Conference (IGC) of the member states of the European Patent Organisation on the reform of the Patent System in Europe (Paris, 24 to 25 June 1999). The IGC has mandated the EPO „to examine under what conditions the effects of disclosure prior to filing could be taken into account in European patent law“.

In the meantime the discussion of the grace period has been taken up again by the IP professionals. (Ref. the article by Mr. H. Bardehle in *epi-Information* 1999(3)). It would be regrettable however when this discussion is going to be based upon misleading or even incorrect statements. It seems important in this stage to repeat in a clear and consistent way that European industry at large is not in favour of the introduction of a grace period in Europe. Stating that this would only apply to the chemical, especially the pharmaceutical industry, is definitely not complete and not correct.

In its position paper (dated July 14, 1998) the Union of Industrial and Employers' Confederations of Europe (UNICE) has very clearly advocated to stay away from the introduction of a grace period in Europe. The many disadvantages, as well on national as on international level, brought forward by industry are in no way counter balanced by the claimed advantages. Claimed advantages, which can be seen only in fairly few – real cases, would not strike a balance against serious losses of legal certainty for wide circles of patent applicants for the disclosing inventor and for the competition as well.

UNICE has voiced its strong opinion that „rather than changing a well balanced system for a minority of inexperienced users, efforts should concentrate on educating those users who are not familiar with the patent system“.

Here, according to my opinion there is a clear task for *epi* and its members!

The continuing discussion on the Grace Period. Comment on Heinz Bardehle's article

Arthur V. Huygens (NL)

I regret to note that the article by Heinz Bardehle entitled „Decisive Phase in the Discussion of the Grace Period“ which appeared in Issue 3/1999 is inaccurate and misleading, in that it gives a false picture of the actual situation.

Many of us know Mr. Bardehle as one of the strongest advocates of the introduction of a grace period in Europe, and I have great respect for the energy and effort that Mr. Bardehle has put in this crusade for so many years.

However, the statement that at the hearing of the EU Commission in Brussels on 5 October 1998 „a vast majority of speakers of the interested groups favoured the introduction of the grace period, and only the representatives of the chemical, especially the pharmaceutical industry opposed the grace period“, is simply not true.

While other organisations, such as UNICE (not only representing the chemical and pharmaceutical industry!) which were opposed to the grace period can speak for themselves, I would like to remind that I represented *epi* at the hearing as the then President of the Institute, and

expressed also the negative view of the Institute on the introduction of a grace period in Europe.

The official position of the *epi* and an abridged version of the speech that I gave in Brussels were published in *epi Information* 4/1998, p.148-149. Special attention is drawn to the penultimate paragraph of the article, indicating that introduction of a global grace period under a global well-harmonised first-to-file patent system would be acceptable as a compromise solution, although the same basic objections against a grace period as such will remain to exist.

At the recent Council meeting of the Asian Patent Attorneys Association in Kyongju (Korea), Mr. Bardehle presented the same paper on the grace period as was published in *epi Information* 3/1999, but on my urgent request with the indication that *epi*, UNICE and also some other organisations are still opposed to a unilateral introduction of a grace period in Europe.

I hope that whatever the position of bodies and individuals on this matter will be, the facts will be respected and be fairly mentioned.

Comment on H. Bardehle's article

Sue Scott (GB)

The introduction to the article by H. Bardehle, „Decisive Phase in the Discussion of the Grace Period“ (epi information 3/1999) contains the following words. „At the hearing on October 5, 1998, the vast majority of speakers of the groups interested favored the introduction of the grace period. Only the representatives of the chemical, especially the pharmaceutical industry opposed the grace period“.

What the official report of the hearing actually says is: „The hearing of 5 October 1998 revealed that it is basically non-industrial researchers and, above all, independent inventors who have specific requirements [for a grace period]“; and „The arguments against introduction of a grace period ... were put forward by the industrial sector and European professional representa-

tives before the EPO.“ It is simply not true that only the chemical industry opposes the introduction of a grace period.

The arguments for and against the introduction of a grace period are complex, and Dr. Bardehle's article does not do them justice. It is noteworthy that this is an issue on which there is a remarkable degree of consistency amongst European industry. They do not want a grace period, because they believe that this will have adverse effects on their operations in some cases, very serious adverse effects. The prosperity of Europe depends in large measure on the well-being of its research-based industry, and those innovators need a strong, cost-effective patent system in their home market place.

Grace Period

J. M. Pollaro (GB)

An article by Heinz Bardehle recently appeared in *epi* information 3/99 under the heading „Decisive Phase in the Discussion of the Grace Period“. The views expressed in this article are contrary to those of the greater part of innovative European industry, on whose research, development and success nearly all of us in Europe depend, directly or indirectly. In particular the substantial companies represented by the Trade Marks Patents and Designs Federation (TMPDF)* oppose the introduction of a grace period.

It should first be emphasised that it was not merely the representatives of the chemical industry who spoke against the introduction of a general grace period at the Commission hearing on October 5, 1998. Many organisations such as TMPDF and UNICE, representing a wide cross section and very large number of industrial companies, large and small, in all fields of activity, spoke against the grace period with the full support of the great majority of their member companies. These companies carry out over 90% of the total research and development in Europe.

It might also be noted that the voting on February 25, 1999 in the Plenary of the European Parliament on the report from the Legal Committee of the Parliament resulted in the voiding of the substance of the report, which was therefore not adopted.

The article misconstrues the uncertainties which would be created by a grace period. Innovative companies are not primarily concerned with how soon it might be poss-

ible to copy innovative work published by others. Regardless of a grace period, the eventual patent protection, if well thought out, will prevent unauthorised copying.

The main problem concerns the effects of a grace period which might be claimed by a competitor, on a company's research and development efforts. It is rare for a company to be alone in working on a particular issue. A competitor is quite likely to publish material which, while not directly anticipating the company's work, is in the same or a closely related field. Until the corresponding patent application is published, the effect of this material on the commercial viability of the company's own development cannot be assessed.

The problem exists already, but the longest wait at present in Europe and many other countries before the scope of any corresponding patent application becomes known is 18 months. A grace period will add an extra 12 months to this period of uncertainty, during which research effort and development decisions will be at risk or on hold. This extra uncertainty will be bad for innovative industry and for the introduction of new products by European companies.

It cannot be assumed that all enterprises will use the grace period only as a safety net, such that a patent application will be filed very quickly after the graced publication. Some will use the period as a tactical delaying measure and it must be assumed that all enterprises might do so.

There are subsidiary problems. Arguments are bound to arise about whether given publications can fairly claim the benefit of the grace period and the independence of rival publications made in the grace period which constitute prior art will regularly be challenged. More seriously, the grace period will be invoked in suitably arguable circumstances in efforts to overrule the priority and prior art effects of rival patent applications made during the grace period, irrespective of whether the graced publications directly anticipate those applications. Arguments about the degree to which rival applications are inspired by graced publications are bound to arise. Industry shudders at the thought of all the extra litigation; small firms in particular should be concerned. The patent system is likely to be distorted by a race to publish something, rather than to file an enabling disclosure in a patent application.

Furthermore, as was accepted by nearly everyone at the Commission hearing on 5 November 1998, there is a need for wide international agreement on the recognition and terms of any grace period before its introduction is contemplated.

Virtually all inventors, whether large companies or individual innovators, are well aware of the dangers of prior publication of their inventions and the problems concerning confidential testing, suggested in the article, are grossly exaggerated. The difficulties of establishing internal priority for a patent application on the basis of a relatively informal specification without claims are also exaggerated. This system works well in the UK and is under active consideration elsewhere.

Finally, the article suggests that the industry argument is weakened by acceptance that a carefully constructed grace period regime (involving *inter alia* prior user rights when material in a graced publication is used before a corresponding patent application is made) might be adopted internationally in return for the abandonment by the United States of the so called „first to invent“ regime. This is not so. Both the grace period and „first to invent“ introduce serious uncertainty into the patent system. However, first to invent is much the worse and it would be worth accepting a lesser evil to be rid of a greater.

It might also be noted that the voting on February 25, 1999 in the Plenary of the European Parliament on the report from the Legal Committee of the Parliament resulted in the voiding of the substance of the report, which was therefore not adopted.

The article misconstrues the uncertainties which would be created by a grace period. Innovative companies are not primarily concerned with how soon it might be possible to copy innovative work published by others. Regardless of a grace period, the eventual patent protection, if well thought out, will prevent unauthorised copying.

The main problem concerns the effects of a grace period which might be claimed by a competitor, on a company's research and development efforts. It is rare for a company to be alone in working on a particular issue. A competitor is quite likely to publish material which, while not directly anticipating the company's work, is in the same or a closely related field. Until the

corresponding patent application is published, the effect of this material on the commercial viability of the company's own development cannot be assessed.

The problem exists already, but the longest wait at present in Europe and many other countries before the scope of any corresponding patent application becomes known is 18 months. A grace period will add an extra 12 months to this period of uncertainty, during which research effort and development decisions will be at risk or on hold. This extra uncertainty will be bad for innovative industry and for the introduction of new products by European companies.

It cannot be assumed that all enterprises will use the grace period only as a safety net, such that a patent application will be filed very quickly after the graced publication. Some will use the period as a tactical delaying measure and it must be assumed that all enterprises might do so.

There are subsidiary problems. Arguments are bound to arise about whether given publications can fairly claim the benefit of the grace period and the independence of rival publications made in the grace period which constitute prior art will regularly be challenged. More seriously, the grace period will be invoked in suitably arguable circumstances in efforts to overrule the priority and prior art effects of rival patent applications made during the grace period, irrespective of whether the graced publications directly anticipate those applications. Arguments about the degree to which rival applications are inspired by graced publications are bound to arise. Industry shudders at the thought of all the extra litigation; small firms in particular should be concerned. The patent system is likely to be distorted by a race to publish something, rather than to file an enabling disclosure in a patent application.

Furthermore, as was accepted by nearly everyone at the Commission hearing on 5 November 1998, there is a need for wide international agreement on the recognition and terms of any grace period before its introduction is contemplated.

Virtually all inventors, whether large companies or individual innovators, are well aware of the dangers of prior publication of their inventions and the problems concerning confidential testing, suggested in the article, are grossly exaggerated. The difficulties of establishing internal priority for a patent application on the basis of a relatively informal specification without claims are also exaggerated. This system works well in the UK and is under active consideration elsewhere.

Finally, the article suggests that the industry argument is weakened by acceptance that a carefully constructed grace period regime (involving *inter alia* prior user rights when material in a graced publication is used before a corresponding patent application is made) might be adopted internationally in return for the abandonment by the United States of the so called „first to invent“ regime. This is not so. Both the grace period and „first to invent“ introduce serious uncertainty into the patent system. However, first to invent is much the worse and it would be worth accepting a lesser evil to be rid of a greater.

haben.

matique.

Bitte nutzen Sie die Einzugsmöglichkeit vom laufenden EPA-Konto, s. Anlage.

Please use the possibility for direct debiting from EPO deposit accounts, see encl.

Nous recommandons le virement sur le compte courant à l'OEB, v. annexe.



Überweisungen (Euroschecks, sowie alle deutschen Schecks werden akzeptiert) sind zu tätigen

Transfers (eurocheques and banker's drafts are accepted) are to be made

Le virement (les eurocheques sont acceptés) doit être effectué.

*Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office*

- in Deutsche Mark (DM)
- Bankgebühren zu Ihren Lasten

- in German Marks (DM)
- all bank charges payable by subscriber

- en Marks allemands (DM)
- frais bancaires à votre charge

epi - Postfach 26 01 12 - 80058 München - Deutschland

Auf dem Überweisungsträger bitte angeben:

Please note on your transfer order:

Indiquez s.v.p. sur votre ordre de virement:

- Ihren Namen
- Ihre Mitgliedsnummer (steht neben Ihrem Namen auf dem Adreßaufkleber).

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

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

Bei Zahlungseingang nach dem 30. April 2000 erhöht sich der Beitrag um DM 50.

Payments received after 30 April 2000 are subject to a surcharge of 50 DM.

Tout paiement reçu après le 30 avril 2000 est majoré de 50 DM.

3 January 2000 .../...

*Secretariat: P. O. Box 26 01 12 - 80058 München - Tal 29 - 80331 München - Deutschland
Tel.: +49 (89) 201 70 80 - Fax: +49 (89) 202 15 48
e-mail: entepi.com*

**RECHNUNG
epi-Beitrag 2000**

**INVOICE
epi Subscription 2000**

**FACTURE
Cotisation epi 2000**

DM 300

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

Sie erhalten diese Rechnung zur Verwendung bei Ihrer Steuererklärung, auch wenn Sie bereits eine Einzugsermächtigung erteilt

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

Cette facture vous est envoyée pour votre déclaration d'impôts, même si vous avez déjà fait une demande de prélèvement auto-

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

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

Si votre compte-cotisation accuse déjà un solde débiteur, vous trouverez une feuille en annexe. Dans ce cas veuillez aussi virer la somme manquante.

Sollten Sie Ihren Jahresbeitrag nicht bezahlen, nehmen Sie bitte zur Kenntnis, dass Ihr Name von der Liste der zugelassenen Vertreter gelöscht wird, gemäß Regel 102(1) der Ausführungs-ordnung zum EPÜ. Ihr Name kann jedoch wieder in die Liste aufgenommen werden, sobald Sie den ausstehenden Beitrag bezahlt haben, gemäß Regel 102(3).

Please note that if you fail to settle your annual subscription **your name will be deleted from the list of professional representatives**, cf. Rule 102(1) of the Implementing Regulations of the EPC. However, you may, upon request, be re-entered on the list of professional representatives when your outstanding subscription has been paid, cf. Rule 102(3).

Nous vous rappelons que, si vous n'avez pas acquitté votre cotisation annuelle, **votre nom sera radié de la liste des mandataires agréés**, voir Règle 102(1) du Règlement d'exécution de la CBE. Toutefois, vous pouvez faire une demande de réinscription sur la liste des mandataires agréés après avoir acquitté votre cotisation impayée, voir Règle 102(3).

Der Schatzmeister
Peter Kelly

The Treasurer
Peter Kelly

Le Trésorier
Peter Kelly

L'autorisation de prelevement s'applique a plusieurs membres de l'epi:
 Dans l'affirmative, priere de joindre au present formulaire une feuille separée portant le nom et le numéro de ces membres.
Bitte einreichen an / Please return to / retournez s.v.p. à:

Name des Kontoinhabers: Account holder's name: Nom du titulaire du compte:	epi-Sekretariat Postfach 26 01 12 D-80058 München
Kontonummer beim EPA: EPO account number: Numéro de compte auprès de l'OEB:	Telefax +49 89 202 15 48

Einzugsermächtigung	Direct debiting mandate	Autorisation de prélèvement
Eingangsfrist im epi-Sekretariat: Datum · Date	Deadline for receipt by the epi Secretariat: Unterschrift des Kontoinhabers · Account holder's signature	Date limite de réception au Secrétariat de l'epi: Signature du titulaire du compte
15. Februar	15 February	15 février

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

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

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

Bitte verwenden Sie **nur dieses Formular**, gegebenenfalls mit einem gesonderten Blatt für die Namen mehrerer epi-Mitglieder. **Verwenden Sie keine Einzugsermächtigungen des EPA.**

Please use only this form, if necessary with a separate sheet for the names of several epi members. **Do not use EPO mandate forms.**

Veuillez n'utiliser que ce formulaire; ajoutez si nécessaire une feuille séparée pour les noms de plusieurs membres de l'epi. **N'utilisez pas les formulaires d'autorisation de prélèvement de l'OEB.**

Name/Vorname des epi-Mitglieds: epi member's surname/first name: Nom/prénom du membre de l'epi
epi-Mitgliedsnummer: epi membership number: Numéro d'affiliation à l'epi:
Die Einzugsermächtigung gilt für mehrere epi-Mitglieder Falls "ja", bitte ein gesondertes Blatt mit den Namen und Mitgliedsnummern beifügen. This direct debiting mandate applies to more than one epi member If "yes", please list names and membership numbers on a separate sheet.
nein ja <input type="checkbox"/> no <input type="checkbox"/> yes non oui

Einzugsermächtigung

Eingangsfrist im epi-Sekretariat: **15. Februar**

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

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des *epi*-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, faßt das *epi* zu einem Gesamtbetrag zusammen. Demgemäß erteilt das *epi* dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben

nach Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des *epi* nicht aus oder trifft die vorliegende Einzugsermächtigung beim *epi* nach dem 15. Februar ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das *epi*-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das *epi* spesenfrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des erhöhten Jahresbeitrags am 25. Juni. Schlägt auch dieser Versuch fehl, muß der erhöhte Beitrag im normalen Bankverkehr beglichen werden.

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

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

Direct debiting mandate

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

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

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

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

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

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

Autorisation de prélèvement

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

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

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

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

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

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

Regeln für die Zahlung der *epi* Mitgliedsbeiträge

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

- 1) Der jährliche *epi* Mitgliedsbeitrag ist innerhalb von zwei Monaten nach Fälligkeit zu zahlen.
- 2) Für Mitglieder, die bereits zu Anfang eines Jahres in die Liste der zugelassenen Vertreter eingeschrieben sind, ist das Fälligkeitsdatum der 1. Januar.
- 3) Für Mitglieder, die erst im Verlauf eines Jahres in die Liste der zugelassenen Vertreter aufgenommen werden, ist das Fälligkeitsdatum der Tag der Eintragung in die Liste.
- 4) Der jährliche Mitgliedsbeitrag wird erlassen, wenn
 - der schriftliche Antrag des Mitgliedes auf Löschung von der Liste der zugelassenen Vertreter vor dem 1. April beim Europäischen Patentamt eingeht;
 - eine Person nach dem 30. September in die Liste der zugelassenen Vertreter aufgenommen wird.
- 5) In allen anderen Fällen muß der volle jährliche Mitgliedsbeitrag bezahlt werden. Ratenzahlungen, Stun-

dungen oder Beitragsreduzierungen können nicht gewährt werden.

- 6) Zahlt ein Mitglied, das bereits zu Anfang des Jahres auf der Liste der zugelassenen Vertreter stand, seinen Beitrag nicht vor dem 1. Mai (Eingang auf dem *epi* Konto), erhöht sich sein Beitrag um DM 50.–. Gleiches gilt für Mitglieder, die erst im Verlauf des Jahres in die Liste der zugelassenen Vertreter aufgenommen worden sind, falls sie ihren Mitgliedsbeitrag nicht innerhalb von vier Monaten nachdem sie durch „*epi*-Information“ oder einen Brief über seine Höhe informiert worden sind, zahlen.

- 7) Zahlungen müssen mittels Banküberweisungen, in Deutsche Mark und frei von Bankspesen für *epi* erfolgen. Dabei sind der Name und die Mitgliedsnummer jedes einzelnen Mitglieds, für das die Zahlung erfolgt, anzugeben.

8) Wegen der beachtlichen Bankgebühren und darüber hinaus wegen des großen zusätzlichen Verwaltungsaufwand werden keine Schecks, Bankschecks, kein Bargeld oder ähnliches angenommen.

9) Der *epi* Rat beschließt Änderungen des Mitgliedsbeitrages vor Anfang des Folgejahres. Er informiert alle Mitglieder durch „epi-Information“ über den neuen Beitragsbetrag und die Zahlungsmodalitäten. Alle Mitglieder, von denen angenommen werden kann, daß sie die entsprechende „epi-Information“ erhalten haben,

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

Rules Governing Payment of the *epi* Annual Membership Fee

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

1) The *epi* annual membership fee has to be paid within two months after its due date.

2) The due date for members being on the list of professional representatives at the beginning of the year is 1 January.

3) The due date for members entering the list of professional representatives in the course of the year is the moment of entry on this list.

4) The annual membership fee is waived if

– a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;

– a person is registered on the list of professional representatives after 30 September.

5) In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.

6) Members on the list of professional representatives on 1 January who fail to pay their membership fee prior to 1 May (reception on *epi* account) will have to pay a surcharge of DM 50.–. The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being

notified of its amount through „epi Information“ or by letter.

7) Payments have to be made by money transfers, in German Marks, and free of bank charges for *epi*. They must indicate the name and registration number of each member for whom the fee is paid.

8) Due to the substantial bank charges and furthermore to the enormous additional administrative requirements no checks, bankers drafts, cash, or the like will be accepted.

9) The *epi* Council decides on modifications of the amount of the annual membership fee before the beginning of a year. It informs all members through „epi Information“ of the new amount of the fee and the conditions for payment. All members deemed to have received the respective „epi Information“ will have to make provisions for payment within the above mentioned time-limit without further request. The Treasurer will, however, also send out fee invoices to all members at the beginning of the year or to new members after their registration. Late payers deemed to have received the before mentioned „epi Information“ may not plead not having received this invoice.

Règles relatives au paiement de la cotisation annuelle *epi*

Décision prise par le Conseil de l'*epi* à la réunion de Copenhague les 11 et 12 mai 1992

1) Le paiement de la cotisation annuelle *epi* est dû dans les deux mois qui suivent la date d'exigibilité.

2) La date d'exigibilité pour les personnes inscrites sur la liste des mandataires agréés au début de l'année est le 1er janvier.

3) La date d'exigibilité pour les personnes admises sur la liste des mandataires agréés en cours d'année est la date d'admission sur cette liste.

4) N'est pas redevable de la cotisation de l'année en cours:

- un membre qui demande par écrit à l'OEB sa radiation de la liste des mandataires agréés avant le 1er avril;
- toute personne inscrite sur la liste des mandataires agréés après le 30 septembre.

5) La cotisation annuelle doit être payée dans son intégralité dans tous les autres cas. Aucun versement partiel, report d'échéance ou réduction du montant ne peut être accepté.

6) Toute personne inscrite sur la liste des mandataires agréés au 1er janvier et dont la cotisation n'est pas payée avant le 1er mai (date de réception sur le compte de l'*epi*) doit payer un supplément de 50,- DM. Ceci s'applique également à toutes les personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans „epi Information“ ou par lettre.

7) Le paiement doit être fait par virement, en Deutsche Marks, sans frais bancaires pour l'*epi*. Le nom et le

numéro d'affiliation de la/les personne(s) pour qui la cotisation est destinée doivent être indiqués clairement sur le virement.

8) Les chèques, les chèques bancaires, les règlements en espèces ou autres ne sont pas acceptés en raison des frais bancaires importants et de l'énorme supplément de travail que leur traitement nécessite.

9) Le Conseil de l'*epi* décide des modifications du montant de la cotisation annuelle avant le début de l'année. Tous les membres sont informés par „epi Information“ du nouveau montant de la cotisation et des conditions de paiement. Toute personne qui, en tant que membre, reçoit „epi Information“ devra s'assurer que sa cotisation est payée dans le délai imparti, ci-dessus mentionné, sans autre notification. Le Trésorier enverra toutefois aussi un appel de cotisation à tous les membres au début de l'année, de même qu'aux nouveaux membres après leur inscription. Toute personne recevant en tant que membre „epi Information“, mentionné plus haut, et n'ayant pas payé sa cotisation à temps ne pourra pas alléguer qu'elle n'a pas reçu l'appel de cotisation.

epi-Mitgliedschaft und Jahresbeitrag

1. Internationale Kammerorganisation

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

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

2. Mitgliedschaft

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

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

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

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

3. Jahresbeitrag

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

Verschiedentlich ist der Wunsch nach Aus- oder Herabsetzung dieses Beitrages von z.Z. DM 300,- geäußert worden. Diese Frage hat mehrfach den *epi*-Rat und Vorstand beschäftigt. U.a. angesichts der vergleichsweise geringen Höhe des Beitrages wurde eine Aus- oder Herabsetzung abgelehnt. Damit gilt, daß der Mitgliedsbeitrag für das laufende Jahr nur entfällt, wenn

a) die Streichung von der Vertreterliste vor dem 1. April erfolgt ist;

b) der Eintrag in die Vertreterliste erst nach dem 30. September vorgenommen wurde.

Der Jahresbeitrag kann nicht gequotelt werden. Er ist in voller Höhe auch bei Eintragung in die Liste während

des Kalenderjahres zu entrichten, es sei denn er entfällt ganz, wenn die oben unter a) und b) genannten Voraussetzungen vorliegen.

Bitte beachten Sie, daß der Vorstand und Rat des *epi* bei allen Entscheidungen zu beachten haben, daß es sich

bei dem *epi* nicht um eine nationale Einrichtung handelt, sondern daß 19 Staaten am Patentübereinkommen beteiligt sind.

epi membership and subscription

1. Professional Association

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

epi is an international public law corporation.

2. Membership

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

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

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

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

3. Membership subscription

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

Occasionally, requests have been made for suspension or reduction of the membership subscription, currently amounting to 300 DM. The *epi* Council and Board have considered this question many times and have decided that the membership subscription may neither be suspended nor reduced. One of the reasons for this decision is the already low amount of the membership subscription. It is waived if

a) a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;

b) a person is registered on the list of professional representatives after 30 September.

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

Please keep in mind that the *epi* Board and Council have to take into consideration that all decisions they take concern an international organization involving 19 Contracting States to the European Patent Convention and not only one single country.

Affiliation à l'*epi* et cotisation annuelle

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

L'*epi* remplit auprès de l'Office européen des brevets les mêmes fonctions que, au niveau national, le Barreau pour les avocats ou l'Ordre pour les médecins, avec cependant la particularité que non seulement les personnes appartenant à la profession libérale mais égale-

ment celles qui exercent dans l'industrie ou dans le secteur public en sont membres.

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

réussi l'examen européen de qualification de l'Office européen des brevets.

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

2. Affiliation

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

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

Les membres de l'*epi* sont tous des membres actifs. Il n'est pas possible de suspendre l'affiliation. Si une personne désire ne pas payer de cotisation annuelle pendant quelque temps, elle doit demander sa radiation de la liste des mandataires de l'OEB avant le 1er avril de l'année en cours et refaire une demande d'inscription plus tard. La

demande de radiation/réinscription doit être adressée à l'OEB, direction 5.1.1.

3. Cotisation annuelle

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

Une suspension du paiement de la cotisation ou une réduction de son montant, actuellement de 300 DM, n'est pas possible. Une éventuelle suspension ou réduction de la cotisation a souvent été considérée par le Conseil et le Bureau de l'*epi*. Cette possibilité a été rejetée en raison, entre autres, du montant relativement peu élevé de la cotisation. Une personne est toutefois dispensée d'acquitter la cotisation annuelle si

a) elle se fait radier de la liste des mandataires avant le 1er avril;

b) elle se fait réinscrire sur la liste des mandataires après le 30 septembre.

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

Nous vous rappelons que le Bureau et le Conseil de l'*epi* doivent, pour chaque décision, tenir compte du fait que l'*epi* est une organisation internationale constituée non pas d'un seul pays mais de 19 Etats Contractants de la Convention sur le brevet européen.

epi Subscriptions

P. Kelly, Treasurer

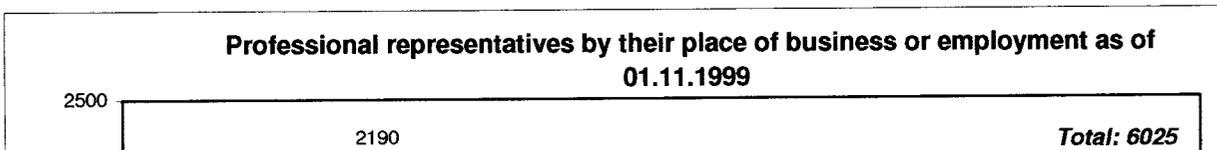
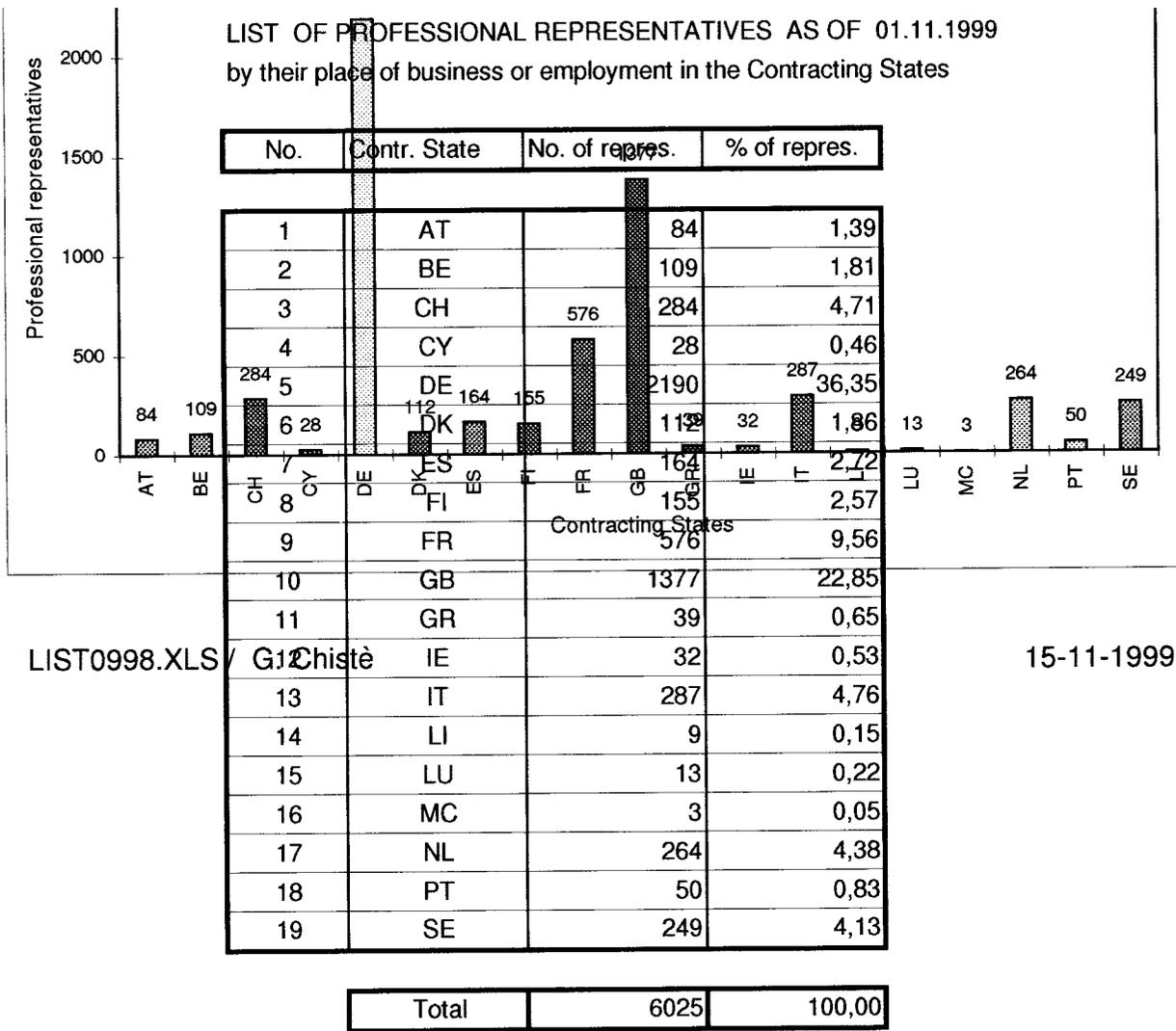
The Secretariat needs your co-operation in relation to the payment of *epi* subscriptions. In order to minimise the heavy workload in processing accurately and efficiently these subscription payments it is very important that each payment can be clearly identified with a specific member. At present we have each year a significant number of payments made to the *epi* in respect of subscriptions where the payment does not identify the member and/or his/her firm or company.

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

request your help and ask that all members personally ensure that their subscription payment – whether by EPO deposit account, bank draft or eurocheque – gives as a basic level of information **your name and membership number.**

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

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



epi Art Exhibition 2000

The Spring Exhibition of *epi* Artists in the EPO main building in Munich is about to become a tradition in EPO's cultural life. Held for the first time in 1991, it was followed by three further ones in 1994, 1996 and 1998. The interesting works on display ranged from paintings to graphical and fine art works such as ceramic works,

sophisticated watches and jewellery, and artistic textile creations. The exhibitions which were opened by the *epi* President and by the EPO President aroused great interest. We hope that the forthcoming exhibition will be just as successful. It is planned to take place from

13 to 31 March 2000,
in the premises of the European Patent Office.

A prerequisite for having the exhibition held again is a large participation of artists coming from various countries. Therefore, all creative spirits among the *epi* membership are invited to register. It is hard to believe that

among 6.000 *epi* members we should not get enough interested persons. Please pass the information round!

If you are interested, please inform the *epi* Secretariat as soon as possible, no later than by end of January 2000.

epi Secretariat
P.O. Box 260112
80058 München
Germany

Tel: +49 89 201 70 80
Fax: +49 89 202 15 48

Training Programme in Preparation for the European Qualifying Examination, 7th-9th February 2000

The Training Programme on the European Patent for students preparing for the European Qualifying Examinations will be held from 7th-9th February 2000.

Cost: £ 650 inclusive of documentation, refreshments and lunches.

As the course is usually over subscribed, applicants are advised to book early to avoid disappointment. Please note that there are only 40 places available. Offers will only be made on return of *completed application forms* on a first come, first served basis.

For further details, please contact Queen Mary Intellectual Property Research Institute, Centre for Commercial Law Studies, Queen Mary and Westfield College, Mile End Road, London E1 4NS.

Tel: (0171) 882 51 26
Fax: (0181) 981 1359
Email: S.C.Ng@qmw.ac.uk

Themed Edition

epi Information 1/2000

Die Schriftleitung, vom Jahrtausend Fieber gepackt, ist zu der Auffassung gekommen, dass die epi Information 1/2000 eine tolle Gelegenheit ist, eine thematisch besondere Ausgabe herauszugeben, die das *epi* selbst zum Thema hat. Dafür suchen wir Beiträge von Mitgliedern des Rates sowie von verschiedenen Ausschüssen zu bekommen, um die Arbeit des *epi* aus möglichst vielseitiger Sicht zu schildern. Beiträge von Mitgliedern, die sich auch kritisch mit dem *epi* und seiner Arbeit beschäftigen, sind sehr erwünscht.

Bitte schicken Sie uns Ihre Beiträge bis spätestens 15. Februar 2000.

Die Schriftleitung

The Editorial Board, swept along by Millenium fever, have come to the conclusion that *epi* Information 1/2000 would be a perfect opportunity to produce a themed edition of *epi* Information 1/2000, dedicated to *epi* itself. As such, we are attempting to get pieces from members of Council and various Committees to build up a picture of how the *epi* works and what it does. Any additional input from members of *epi* relating to any aspects of *epi* on which they care to comment, would be greatly appreciated.

Please let us have all submissions on this subject by 15 February 2000.

The Editorial Board

Saisi par la fièvre du nouveau millénaire, le Comité de Rédaction a pensé que le passage à l'an 2000 était l'occasion idéale de sortir un numéro à thème. Le numéro 1/2000 portera sur le thème de l'*epi* et sur son travail. Les membres du Conseil ainsi que les membres des diverses commissions sont invités à envoyer leurs contributions. Les contributions de membres de l'*epi* qui s'intéressent particulièrement au travail de l'*epi* sont bienvenues.

Merci d'envoyer vos contributions avant le 15 février 2000.

Le Comité de Rédaction

Editorial Board
epi
Postfach 26 01 12
D-80058 München

Tel: +49 89 2017080
Fax: +49 89 202 15 48
e-mail:info@patentepi.com

Redaktionsschluß für epi Information 1/2000

Redaktionsschluß für die nächste Ausgabe der epi Information ist der **15. Februar 2000**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for epi Information 1/2000

Our deadline for the next issue of epi Information is **15 February 2000**. Documents for publication should have reached the Secretariat by this date.

Date limite pour epi Information 1/2000

La date limite de remise des documents pour le prochain numéro de epi Information est le **15 février 2000**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Preparations for the Year 2000 at the EPO

The main part of the Office's Year 2000 activities has been associated with the preparation of the Office computer systems. This includes:

- adaptation of *application systems* for processing of dates and extended priority and application numbers
- Upgrade of the *computing infrastructure* (Mainframe, Server, Workstation and Network services)
- *compliance testing* in an environment which realistically simulated the Year 2000 environment.

All work including the compliance testing was finished by the end of September 1999.

The main conclusions are:

- the major systems are year 2000 compliant
- a higher than expected rate of errors was encountered overall but the compliance testing pro-

gram has enabled these to be detected and eliminated. This does not exclude that some residue of errors will remain to be handled on a fix on failure basis.

As announced in the Official Journal, the Office has decided to close on 03-01-2000 and 04-01-2000 so that all systems can be fully checked in a live status, starting on Saturday morning 01-01-2000, by combined teams of users and Principal Directorate Information Systems for a period of four days.

Further to this *Internal Services* have assessed and where necessary upgraded the systems which are used to support the Office premises.

In addition, firms supplying equipment containing parts which may be affected by the year 2000 problem have certified that their equipment is year 2000 compliant.

Wichtige Mitteilung an alle *epi*-Mitglieder

Trotz aller Vorsichtsmassnahmen können um die Jahrtausendwende Schwierigkeiten mit der fristgerechten Zahlung von Gebühren, insbesondere von Jahresgebühren, an das EPA auftreten.

Die Benutzung des automatischen Abbuchungsverfahrens kann diese Gefahr vorbeugen.

Important warning to *epi* members

In spite of all measures taken by each *epi* member, the millenium bug may create difficulties for issuing in due time payments of all official fees to the EPO and particularly maintenance fees.

Requesting automatic debit order payment could permit to avoid these risks.

Annonce importante pour tous les membres de l'*epi*

Malgré toutes les mesures de précaution prises par chaque membre de l'*epi*, il est possible que le bogue de l'an 2000 entraîne des difficultés pour respecter les délais de paiement des taxes officielles à l'OEB, en particulier pour les taxes de renouvellement.

L'utilisation du système de prélèvement automatique pourrait permettre d'éviter ces risques.

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

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de discipline (epi)
AT – W. Katschinka AT – P. Révy von Belvard BE – G. Leherte CH – J. J. Troesch DE – W. Baum DE – G. Keller** DK – I. Kyed ES – V. Gil Vega	FI – P. C. Sundman FR – P. Gendraud FR – J.-P. Kedinger GB – J. Orchard GB – T. J. Powell GR – T. Kilimiris IE – G. Kinsella IT – G. Mannucci	IT – B. Muraca (Subst.) LI – P. Rosenich LU – J. Waxweiler NL – S. Ottevangers* NL – L. Ferguson PT – A. J. Pissara Dias Machado SE – P. O. Rosenquist
Disziplinausschuß (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
CH – C.-A. Wavre DE – W. Dabringhaus	FR – M. Santarelli	GB – J. Boff
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
CH – C. Bertschinger DE – H. Lichti FR – A. Armengaud Aîné	GB – E. Lyndon-Stanford GR – C. Kalonarou	IT – E. Klausner SE – C. Onn
epi-Finanzen	epi Finances	Finances de l'epi
AT – P. Pawloy BE – A. Colens CH – T. Ritscher	DE – B. Feldmann* DK – K. Vingtoft FR – H. Dupont GB – J. U. Neukom**	IT – R. Dini LU – J. P. Weyland SE – B. Erixon
Geschäftsordnung	By-Laws	Règlement intérieur
CH – C. E. Eder* DE – K. Draeger**	FR – T. Schuffenecker	GB – T. L. Johnson
Standesregeln	Professional Conduct	Conduite professionnelle
AT – E. Kunz AT – E. Piso BE – P. Overath CH – U. Blum DE – W. O. Fröhling DE – H.-H. Wilhelm DK – L. Roerboel ES – C. Polo Flores	FI – L. Nordin FR – J. Bauvir FR – P. Vidon GB – J. D. Brown** GB – J. Gowshall GR – A. Patrinos-Kilimiris IE – P. Hanna IT – A. Pasqualetti	IT – A. Perani LU – J. Bleyer NL – F. Barendregt NL – F. Dietz PT – N. Cruz PT – F. Magno (Subst.) SE – L. Stolt SE – M. Linderoth
Europäische Patentpraxis	European Patent Practice	Pratique du brevet européen
AT – F. Gibler AT – G. Widtmann BE – E. Dufrasne BE – J. van Malderen CH – F. Fischer CH – P. G. Maué CY – C. Theodoulou DE – G. Schmitt-Nilson DE – F. Teufel DK – P. J. Indahl	DK – P. R. Kristensen ES – E. Armijo ES – L. A. Duran FI – E. Grew FI – A. Weckman FR – A. Casalonga* FR – J. Bauvir GB – P. Denerley** GB – I. Muir GR – D. Oekonomidis	GR – M. Zacharatou IE – P. Shortt IT – E. de Carli IT – A. Josif LI – S. Kaminski NL – W. Hoogstraten NL – L. J. Steenbeek PT – J. L. Arnaut PT – N. Cruz SE – S. A. Hansson SE – Z. Schöld

*Chairman/ **Secretary

Berufliche Qualifikation Ordentliche Mitglieder	Professional Qualification Full Members	Qualification professionnelle Membres titulaires
AT – F. Schweinzer BE – M. J. Luys CH – M. Seehof CY – C. Theodoulou DE – G. Leissler-Gerstl DK – E. Christiansen	ES – J. F. Ibanez Gonzalez FI – K. Finnilä FR – L. Nuss GB – J. Gowshall GR – T. Margellos IE – L. Casey	IT – F. Macchetta LI – S. Kaminski** NL – F. Smit PT – G. Moreira Rato SE – T. Onn*
Stellvertreter Substitutes	Suppléants	
AT – P. Kliment BE – G. Voortmans CH – E. Klein DE – L. B. Magin DK – A. Secher	ES – J. A. Morgades FI – K. Roitto FR – M. Le Pennec GB – P. Denerley IE – D. McCarthy	IT – P. Rambelli NL – A. Hulsebos PT – I. Carvalho Franco SE – M. Linderoth
Beobachter Observers (Examination Board Members)	Observateurs	
CH – J. F. Léger DE – P. Weinhold	FR – J. D. Combeau	GB – I. Muir
Biotechnologische Erfindungen	Biotechnological Inventions	Inventions en biotechnologie
AT – A. Schwarz BE – A. De Clercq CH – W. Mezger DE – G. Keller DK – B. Hammer Jensen*	ES – A. Ponti Sales FI – M. Lax FR – F. Chrétien FR – J. Warcoin GB – S. Wright	GB – C. Mercer** IE – C. Gates IT – G. Staub NL – H. Prins PT – J. E. Dinis de Carvalho SE – L. Höglund
EPA-Finzen	EPO Finances	Finances OEB
DE – W. Dabringhaus ES – I. Elozegui de la Pena	FR – H. Dupont	GB – J. Boff*
Harmonisierung	Harmonization	Harmonisation
BE – F. Leyder DE – R. Einsele	CH – F. A. Jenny*	GB – J. D. Brown** SE – K. Norin
Elektronisches Anmeldesystem – Electronic Application System (EASY) Système de demandes électroniques		
BE – M. Van Ostaeyen DE – D. Speiser*	ES – J. A. Morgades y Manonelles FI – J. Virkkala	FR – P. Vidon GB – R. Burt** NL – F. Dietz
Standing Advisory Committee before the EPO (SACEPO) epi-Delegierte epi Delegates Délégués de l'epi		
AT – W. Katschinka BE – D. Wante CH – A. Braun CY – C. Theodoulou DE – R. Keil DK – K. E. Vingtoft ES – M. Curell Suñol	FI – P. Hjelt FR – J. J. Martin GB – C. Mercer GR – H. Papaconstantinou IE – A. Parkes IT – V. Faraggiana	LI – R. Wildi LU – E. Meyers MC – G. Collins NL – A. Huygens PT – J. Arantes e Oliveira SE – S. Berglund

*Chairman/**Secretary