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Editorial

E. Vinazzer · J. Gowshall · T. Schuffenecker

This edition, the first of the year 2000, is a special edition directed primarily to the *epi* itself.

All European Patent Attorneys are members of the *epi*. It seems, however, that many *epi* members are uncertain as to what practical functions the *epi* carries out, particularly with regard to the day-to-day practice of those European Patent Attorneys. The purpose of the present edition of *epi* Information is to attempt to answer some of those questions. The following pages contain a variety of papers relating to different aspects of the *epi*. It is intended that these papers will give an idea as to how some of the *epi* Committees work, often unacknowledged, on behalf of the *epi* members in ensuring that European Patent Attorneys have a representative voice in all areas of interest to the profession. An indication of the

work that the Committees carry out may be gleaned from these pages and an idea of the function of Council, both within the *epi* and within the broader world of intellectual property, is given.

It is acknowledged that the picture presented by the published papers is incomplete. Certain Committees are not represented here and it may well be that the papers throw up more questions than answers. All we can do is encourage our members to question the current workings of the *epi* in order to direct Council appropriately to reflect the concerns of the membership as a whole. It is hoped that this edition will enable all of you to focus a little more on what it is that the *epi* does and, more importantly, what it is that you would like it to do in future.

Internal Auditors

A. Braun (CH)
Internal Auditor

The Institute of Professional Representatives (*epi*) has almost 6000 members who pay a subscription fee of 300 DM each year. These contributions are the main source of income of *epi*. Together with other earnings, nearly 2.000.000 DM are at the *epi*'s disposal, an amount which shows to be appropriate to safeguard the interests of the Institute and its members.

In order to control the expenses of *epi* – and its members in so far as expenses reimbursed by *epi* are involved – external auditors each year check on the bookkeeping of the Institute. Since these outside professionals are not familiar with the activities of *epi*, the *epi* Council elects two ordinary and two substitute internal auditors. To ascertain that these internal auditors

have the necessary knowledge about the activities of the *epi*, both one ordinary and one substitute internal auditor must be ordinary Council members. The other ordinary and substitute internal auditors need to be substitute Council members.

There is an annual meeting of the external and internal auditors at the *epi* Secretariat during which the balance sheet prepared by the outside auditors is discussed and finalized. In the following Council's spring meeting the internal auditors report on the financial results of the *epi* and take motions regarding approval of the accounts, the administration of assets, adherence to the budget as well as release of the Treasurer from liability.

Commission du règlement intérieur – règles et langues

T. Schuffenecker (FR)

Membre de la Commission du règlement intérieur

La Commission du règlement intérieur est sans doute celle dont l'effectif est le plus réduit. Elle regroupe actuellement trois membres, qui maîtrisent respectivement l'anglais, l'allemand et le français, sous la direction de son président, ayant la nationalité suisse. Elle a contribué à l'établissement de nombreux textes et s'assure de leur conformité aux textes fondateurs, ainsi que leur adéquation aux besoins de l'Institut.

Bien évidemment l'objectif premier de cette composition vise l'intégration harmonieuse des différentes langues officielles de l'OEB dans la vie concrète de l'Institut.

Mais il serait peut-être bon de souligner à cette occasion un aspect qui ne doit pas être négligé. D'une manière concrète, lorsqu'elle est chargée de construire, d'élaborer et d'établir une règle, ou de codifier une pratique souhaitée ou souhaitable de manière à l'inscrire durablement dans la vie de l'Institut, la Commission du règlement intérieur ne se borne pas à travailler dans une langue unique – fut-elle l'anglais – avant que de traduire le résultat final dans les deux autres langues officielles. Le texte est simultanément conçu au sein de la Commission dans les trois langues afin de prendre immédiatement en compte les diversités nationales.

Les Règles pour les Elections en constitue un bon exemple. Il a fallu imaginer un système qui pouvait convenir à toutes les sensibilités représentées au sein de l'Institut, et les différences culturelles des membres. A propos de la question de la nullité des bulletins de votes, on s'est interrogé sur le sort à réserver aux bulletins avec ratures, à ceux qui présentent plusieurs marques en regard de certains, voire d'autres noms que ceux qui étaient attendus. Toutes les situations les plus diverses auxquelles pouvait être confrontée la Commission Electorale. Si pour un Français et pour sans doute d'autres membres – l'annulation d'un bulletin de vote quelque peu irrégulier vient assez naturellement à l'esprit, il était clair que cette mesure extrême ne pouvait convenir à d'autres traditions juridiques. Une règle spécifique a donc été conçue (Règle 11 des Règles pour les Elections au Conseil) afin d'éviter que ne soient invalidés trop de bulletins. On a gommé les disparités nationales pour, finalement, forger une règle médiane, un juste milieu européen.

D'une manière générale les idées sont „formées“ par le langage et on ne pense pas partout de la même manière, comme nous le rappellent les linguistes, et notamment le Suisse Ferdinand de Saussure, le plus connu d'entre eux, et de nationalité suisse comme l'est l'actuel Président de la Commission du règlement intérieur. Cette dimension multiculturelle est essentielle et devrait être préservée autant que possible au sein de toutes les Commissions de l'epi, même en cas d'effectif

réduit comme l'est celui de la Commission du règlement intérieur. La rédaction simultanée d'un texte en trois langues qui devra régir la vie de l'Institut, résulte d'un choix entre différentes solutions, différents modes de pensée qui font que, à son niveau, l'epi contribue au développement d'une sensibilité et d'une inspiration européenne commune.

By-laws Committee – rules and languages

The By-laws committee is certainly the one having the lower number of members. It consists of three members, who respectively master the English, the German and the French language, under the direction of its Swiss President. The By-laws Committee was involved in the elaboration of numerous rules and constantly ascertain their adequation to the Institut's needs.

Obviously, the aim of such a composition is the harmonious integration of the different official languages in the Institute's life and rules.

However, it should be noticed that, practically, when the By-laws Committee is elaborating a rule for the purpose of establishing a desired or desirable practice the elaboration is not being performed in only one language, e.g. English, and then followed by a translation into the two other official languages. The text is simultaneously worked in the three official languages.

The rules for the Elections provides with an interesting example of this multilingual process. In this respect, it was desired to elaborate a mechanism which would satisfy the wide range of sensitivity between the different members of the Institute. In particular, concerning the question of the validity of the voting ballots, it was necessary to decide how to consider the ballots with erasures, the ballots with numerous marks against one name, or even the ballot papers having other names than those being expected. All those situations which the Electoral Committee would inevitably have to handle. If a French member may – relatively easily – accept the general idea of disregarding an irregular ballot paper – any irregular ballot paper –, it is clear that such a measure would have appeared excessive for other European traditions. In this example, it was necessary to consider to imagine a mechanism (Rule 11 of the Rules for Election of Council) which avoids a too high number of void ballot papers. It was necessary to elaborate a European medium rule.

Generally speaking the concepts are „formed“ by the language as what is recalled by the linguists, and particularly M. F. de Saussure, from Switzerland as is the current President of the By-laws, and the way of thinking the ideas may change in the different countries. How-

ever the multicultural dimension is vital and should be preserved as much as possible in all the Committees of the Institute, and obviously in the By-laws. In this way the *epi* contributes, at its level, to the development of an European common sensitivity.

Geschäftsordnungsausschuss-Tätigkeit und Sprachen

Der Geschäftsordnungsausschuss ist der kleinste der ständigen Ausschüsse. Nach den für ihn geltenden Bestimmungen gehört ihm je ein Mitglied deutscher, englischer und französischer Muttersprache an. Dazu kommt als weiteres Mitglied ein Angehöriger eines Landes mit mehreren Amtssprachen. Zu den Aufgaben des Ausschusses gehört die Redaktion derjenigen Texte, die der Rat des Instituts als bis auf weiteres dauernde Bestimmungen beschliessen will. Bei dieser Arbeit achtet der Ausschuss nicht nur darauf, dass die erarbeiteten Texte klar und unmissverständlich sind, sondern besonders auch darauf, dass sie einerseits den eingegangenen Anregungen und Wünschen ihrer Urheber entsprechen und andererseits nicht im Widerspruch zu bereits gültigen Beschlüssen oder übergeordnetem Recht stehen.

Die vorstehend genannte Zusammensetzung des Ausschusses soll sicher stellen, dass sich das konkrete Leben des Institutes in allen drei Amtssprachen harmonisch entwickeln kann.

Ein Text, mit welchem etwas neu geordnet oder eine bestehende Ordnung festgehalten werden soll, wird daher im Ausschuss nicht, wie das anderswo üblich ist, in einer Sprache, also zum Beispiel in englischer Sprache, abgefasst und anschliessend möglichst wörtlich in die beiden anderen Sprachen übersetzt. Der Ausschuss hat sich nämlich zur Regel gemacht, seine Texte gleichzeitig in allen drei Amtssprachen zu erarbeiten, wodurch er in der Lage ist, die sprachlichen und, soweit möglich, auch die nationalen Eigenheiten berücksichtigen zu können. Ein instruktives Beispiel für diese Tätigkeit war unter anderem die Redaktion der Regeln für die Wahlen zum Rat.

Auch wenn die Arbeitsorte der einzelnen Institutsmitglieder sehr weit voneinander entfernt sind und

durch diese Tatsache sowie auch durch die historische Entwicklung der verschiedenen Gebiete die Mentalität sowie die politische Tradition und Praxis entsprechend unterschiedlich sind, müssen die Vorschriften so abgefasst sein, dass sie für alle, für die sie gültig und verbindlich zu erklären sind, verständlich, nachvollziehbar und auch durchführbar sind. Diese Aussage ist zwar an sich eine Selbstverständlichkeit oder Banalität. Die Schwierigkeit liegt nun im Detail: Es musste zum Beispiel unter anderem festgelegt werden, welche Angaben oder Eintragungen oder Änderungen ein Wähler auf einem Wahlzettel vornehmen darf ohne ihn ungültig zu machen und welche Änderung ihn ungültig machen, damit einerseits für jeden Wähler, unabhängig von seiner Herkunft und seiner staatsbürgerlichen Vorbildung, leicht erkennbar ist, was er tun und lassen kann. Auch muss für den Wahlausschuss festgelegt sein, welche Wahlzettel er als ungültig zu beurteilen hat, damit nicht ein zu grosser Prozentsatz der Wahlzettel als ungültig deklariert werden muss, wodurch bekanntlich das ermittelte Wahlresultat nicht mehr dem entspricht, was die Wählerschaft wollte. Die Resultate der letzten Wahlen zeigen, dass mit dem vorstehend dargelegten Vorgehen das Ziel erreicht werden konnte.

Um Ideen wiederzugeben, muss man sie bekanntlich in einer Sprache ausformen. Die Linguistiker, so unter anderem der Westschweizer M. Ferdinand Saussure, haben darauf aufmerksam gemacht, dass die Art, wie die Leute denken, bekanntlich nicht überall gleich und unter anderem auch von Kulturkreis zu Kulturkreis verschieden ist. Die Beachtung dieses multikulturellen Aspektes ist in einer länderübergreifenden Organisation wie dem *epi* für ein gutes und erspriessliches Zusammenarbeiten lebenswichtig. Es muss daher nicht nur vom Geschäftsordnungsausschuss, sondern in allen Organen des Instituts so weit wie möglich versucht werden, diesem Problem die nötige Beachtung zu schenken. Das gleichzeitige, also simultane Erarbeiten eines Textes ist eine der Möglichkeiten, um durch die Respektierung der kulturellen Vielfalt in Europa den notwendigen Gemeinschaftssinn zu fördern.

Committee on Biotechnological Inventions

B. Hammer Jensen (DK)
Chairman

This committee is involved in discussions with the EPO organisation on all aspects of the grant and opposition procedures for applications relating to biotechnological inventions, including the formal requirements.

Furthermore, the committee discusses issues related to the protection of biotechnological inventions in general.

The committee meets 1-2 times every year as appropriate in view of whatever issues need addressing by the committee.

The specific issues the committee has dealt with over the years are:

QUESTION 1 – EU Directive on the legal protection of biotechnological inventions, including amendments to Rule 28 concerning deposited biological materials

QUESTION 2 – The „Expert Solution“ under Rule 28(4) EPC (List of Experts in Microbiology Recognised for the Purpose of Rule 28 EPC)

QUESTION 3 – Board of Appeal Decisions (Onco-mouse)

QUESTION 4 – Draft Regulation on Community Plant Breeders' Rights

QUESTION 5 – Sequence Listings/Patent In Software Program

QUESTION 6 – Release of Deposited Microorganisms

QUESTION 7 – „Patents and Ethics“ in the Context of Modern Technology

QUESTION 8 – CBD/COP Convention on Biological Diversity

QUESTION 9 – Language Aspects of Sequence Listings

QUESTION 10 – Scope of Claims in Biotech Patents

QUESTION 11 – Proposed Change of Rule 28 EPC

QUESTION 12 – Decision T356/93 – Plant Genetic System (PGS)

QUESTION 13 – Novartis Case

QUESTION 14 – Grace Period

Among those issues the committee has drafted *Amicus curiae* briefs for EPI to the enlarged board of appeal in relation to both the PGS and Novartis cases.

In more detail the committee was involved in the 10 years of discussion preceding the final acceptance of the EU Parliament of the directive on the legal protection of biotechnological inventions. Regrettably the Administrative Council of the EPO did not feel any inclination to consult the committee prior to the „implementation“ of the directive into the EPC by the new chapter VI of part II (Rules 23b to 23e).

In respect of material deposited under rule 28, and the „Expert solution“ rule 28(4) the committee has made suggestions for experts to be included on the list and discussed the internal procedures of the EPO concerning

release of deposited material both to the public and to experts. The committee was also involved in the amendment from „microorganisms“ to „biological materials“.

The committee provided various input in relation to the practical consequences of the introduction of sequence listings, *i.a.* in order to avoid duplicating sequences already available in public databases. Unfortunately, the USPTO and JPO have not been as wise, and applicants filing in these countries therefore have to make such duplication for those countries.

The plant breeders' rights issue was discussed because the regulation would have an impact on the scope of patents covering plants in general after their validation in the member states.

The discussions on the scope of claims and grace period evolved during the discussion of the EU directive, where some people felt that specifically the broad scope of certain biotech patent claims was abusive. In this discussion the committee has recommended that Article 84 of the EPC should be made a ground for opposition, since it was felt that Examiners sometimes were too lenient in accepting arguments from the applicant concerning the support for broad claims, or did not raise the issue at all. Also, some members of the EU Parliament raised the possibility of introducing a grace period, because the early publication of *e.g.* nucleotide sequences in relation to the Human Genome Project precluded the patenting of these. The committee was not in favour of this.

Finally the debate over the rights to genetic resources and especially the patenting of these has surfaced in relation to the UN Biodiversity Convention, and its implementation in the countries that are members of that convention. This discussion seems to be growing in importance now that the EU directive is in place.

Committee on EPO Finances

J. Boff (GB)
Chairman

Formation and Evolution

1. It was in response to EPO document „Horizon 2000“ that the Council decided in October 1990 to appoint three „wise men“ (as then described) to look at EPO expenditure. At the following meeting in May 1991, this trio of *éminences grises* was expanded to 4 under the name „Working Group on EPO Fees“.

2. In May 1993 there was an elevation to Committee status (under the present name) and terms of reference were agreed, the key item being (as summarised on the *epi* website)

„... to keep under review the information available, from the EPO or otherwise, concerning all aspect of the financial affairs and forward planning of the EPO having relevance for the levels of fees.“

Function

3. A short article published in *epi* Information (1/93 at p. 25) about the activities of the Working Group (as it then was) suggested a function similar to watchdogs. Alarm bells should be sounded if any cause for complaint is seen or suspected.

4. A huge output of documents is generated by the EPO for the Administrative Council and its Committees: Even in our Secretariat the *per annum* listing of these documents is now running at more than 250 items. Our Committee Chairman is selective so that only around 50 or 60 of such papers (in a year) are distributed in full to all the members of the Committee. But the quantity is still large, perhaps around 10 cms. of shelf length for one year with the budget document alone having a thickness of 2 cms (typically 375 pages!).

5. The reading and study of the distributed documents makes heavy demands on time. But not without interest, because one is given insights into the inner workings of the EPO, pictures of what is happening behind the closed doors. The outcome of this reading/study is well illustrated by the Committee's report to the last Council meeting (reproduced in epi Information 4/1999 p. 131); reported in it under a wide range of headings are many issues having ultimately a relevance for levels of fees, and most importantly for the gaining of good value for money.

6. It has been usual, each year since its formation, for the committee to have a meeting with senior EPO officials (led by Dr.Schatz, the Principal Director, International Affairs). The topics discussed arise largely from the EPO documents, notably the very comprehensive annual budget and 5 year forward estimates. Particular attention is paid to extravagances, examples being the expenditure on (a) technical assistance for non-contract-

ing states (DEM 5.2m for 1999) and the proper interpretation of the Resolution concerning developing countries appended to EPC, (b) co-operation with contracting states (DEM 7.6m for 1999), and (c) promotional activity (DEM 2.5m for 1999). An eye is also kept on the demand for EPO services, as of course this affects the personnel requirements of the EPO and hence the level of fees.

7. Following „Horizon 2000“ in 1990, there were other major exercises of a similar nature. „EPO: Charting a Course“ in May 1993, and „Strategies of the European Patent Organisation: Ideas and Topics“ in August 1995. On each of them briefs were prepared by the Committee for the *epi* representatives most closely involved. The Committee has sought in various ways, the role of an indirectly acting pressure group, thus, both in 1995 and 1996, it provided briefs to all *epi*-members of SACEPO on the affordability for the EPO of substantial fee reductions; also both of the letters from *epi* Presidents to the Administrative Council Chairman on the same subject, first in 1994 and then in 1995, arose from Committee recommendations.

Costs

8. The Committee has operated – very appropriately – with great economy and therefore believes that it is setting a good example in giving good value for money.

Editorial Board

J. Gowshall (GB)
Editorial Board Member

The Editorial Board is a team of three Council members, ably augmented by Dominique Monéger of the *epi* Secretariat. Each Council member of the Editorial Board speaks one of the three official languages such that English French and German native speakers are all in the Editorial Board.

The Editorial Board meet four times a year. The Board are invited to each of the two Council meetings in the year. The Board also meet in the spring and the autumn.

The Editorial Board have two main areas of responsibility – *epi* information and the web site.

For each edition of *epi* information, the Editorial Board carry out a number of tasks. The editorial must be written, as must any relevant notices to be placed, by the Editorial Board, in the relevant edition. As pieces for publication are submitted, they are passed to all members of the Editorial Board for consideration. The content of the piece is personal to the author and is not corrected or altered by the Editorial Board. The Editorial

Board are only concerned that the piece relates to subject matter that is suitable for inclusion in *epi* information.

As the publication date approaches, a provisional table of contents is prepared by Dominique Monéger. This is passed to the other members of the Editorial Board to make suggestions for revision in the order of the contents, if they feel it necessary. If it is felt necessary, any official notice is checked by the native speaker of the language in which it is written, to ensure that the notice is linguistically correct.

The first proof of *epi* information is then provided, by the publisher, and each member the Editorial Board proof-reads the edition.

Throughout this process Dominique Monéger coordinates the collection and distribution of papers and liaises with the publisher.

For every second edition of *epi* information, the Editorial Board have the further responsibility of preparing a

report of the recently finished Council meeting and, subsequently, providing translations of that report into the two official languages in which the report was not originally drafted.

The web site is currently being reconstructed. As such, the Editorial Board have not settled regular tasks that are required to ensure that the web site is fully maintained throughout the year. However, the last two years has seen the Editorial Board expend a great deal of effort in constructing the new web site.

The Editorial Board have planned the structure of the web site and, subsequently, worked with the web site designers on the implementation of that structure. The Editorial Board subsequently researched and wrote the information that appears throughout the web site. In the future it is envisaged that the Editorial Board will take responsibility for regular updating of the web site, not only ensuring that the information is up-to-date, but also ensuring that all relevant pieces of new information are added to the web site, not merely in the form of recent editions of *epi* information.

During the Council meetings, the Editorial Board are usually busy, not only ensuring that an accurate report of Council meeting is prepared but also taking the opportunity to meet with Council members who regularly provide ideas for both *epi* information and web site.

During the two meetings that the Editorial Board hold on its own, the Board discuss the above tasks and also set policy for future editions of *epi* information and of the development of the web site. With regard to *epi* information, the overriding concern of the Board is to attempt to make the publication interesting to read whilst retaining suitable gravitas. The other challenge facing the Editorial Board relating to *epi* information is to encourage the *epi* members to submit articles. One way of doing this was the adoption of the idea of themed editions, such as the present edition. With regard to the development of the web site, previous meetings have tended to focus primarily on the structure of the web site. In future meetings it is envisaged that the Editorial Board will discuss, in more detail, the potential use of the web site and how it may be used to interact with the membership, with those outside the profession wishing to know more, and with other areas of the world wide web.

The work involved the Editorial Board is cyclical in nature. Sometimes in the year there is little to do. However, at other times – notably following Editorial Board meetings, following Council meetings, and as a new edition of *epi* information approaches – the work becomes fairly intense. At all times it is fulfilling.

European Patent Practice Committee (EPPC)

Axel Casalonga (FR)
Chairman

The European Patent Practice Committee is considering and studying all questions pertaining to the European Patent Law as well as the PCT. After discussion by the EPPC, steps are proposed to the *epi* Council, for example position papers to be sent to the EPO, to WIPO or to the EC Commission depending on the situation.

For example, the EPPC recently prepared position papers for the *epi* to be presented at both Working Parties of the Intergovernmental Conference for revision of the EPC.

EPPC delegates represent the *epi* in several meetings relating to the European Patent Law. This is the case for the yearly meeting with DG3 where informal discussion takes place on questions relating to the appeal procedure.

Delegates are also sent to the meetings of the SACEPO Working Party on Examination Guidelines each time the EPO decides to prepare amendments of the guidelines.

EPPC officials are representing the *epi* at the Committee on Patent Law where amendments of the European Patent Law are discussed and proposals are made

by the national delegations. The *epi* has an observer status and can therefore present the views of the practitioners before the proposals of the EPO are finally accepted by the Administrative Council under proposal from the Committee on Patent Law.

EPPC delegates also represent the *epi* at the EUROTAB meetings where some future proposed amendments of the European Patent Law are discussed yearly.

The EPPC has formed subcommittees which prepare the work for the discussion at the EPPC.

Subcommittee on Documentation

This subcommittee acts as a liaison between *epi* members seeking access to patent information and providers of such information, particularly those with the European Patent Organization (mainly DG1 and EPIDOS).

The members of this subcommittee attend yearly the SACEPO/PDI meeting entirely devoted to these issues. Members of this subcommittee meet a few times per

year a number of patent information providers including the EPO, WIPO, national patent Offices and private providers in the so-called PDG impact meeting organized by the patent documentation group.

Subcommittee for EPAC and CPC matters

This subcommittee devotes his work to the study of a future Court organization for the European patent and for the Community patent system.

Subcommittee for PCT matters

This subcommittee follows all proposals of amendments of the PCT Rules and Practice submitted by WIPO. The

members of the subcommittee represent *epi* during the meetings of WIPO such as the General PCT Assembly.

Liaison Committee

This subcommittee meets usually once a year with members of the EPO to discuss small practical organization questions with the EPO. Informal discussion takes place and makes it possible to solve technical difficulties between applicants and the EPO.

epi members are welcome to submit questions and difficulties they may have encountered with the practice of the European Patent System. The EPPC will study the questions and, if appropriate, propose some kind of action before the EPO.

EPPC Subcommittee on Documentation (EPPC-SCD)

Wim Hoogstraten (NL)
Chairman

Most *epi* members will be aware of the crucial importance of patent information for their clients especially in industry. Many colleagues offer more or less advanced patent information services to their clients, e.g. copies of patent specifications, patent status information, patent family relationships, copies of search reports or even complete results of file inspections, or perform dedicated novelty searches or searches for patents that might hinder client's operations.

epi's European Patent Practice Committee therefore has established its Subcommittee on Documentation (EPPC-SCD). The task of the EPPC-SCD is not to offer help desk support, but to act as a liaison between EPI and providers of such information, particularly those within the European Patent Organisation (mainly DG1 and EPIDOS). An important event herein is the yearly SACEPO/PDI Meeting that is entirely devoted to these issues and where the *epi* can discuss its views directly with the EPO people involved. Furthermore, an EPPC-

SCD delegate meets, a few times per year and together with industry representatives, a number of core patent information providers including the EPO, WIPO, national patent offices and also private providers like Derwent in the so-called PDG Impact Meeting, organised by the Patent Documentation Group.

Through EPPC-SCD, the EPI and its members are in a position to closely follow the often rasant developments (mostly based on information and communication technologies) and to influence the patent information providers in their decisions that may have great impact on our work as patent attorneys.

The EPPC-SCD consists of only three members and has a very limited budget (in fact it hardly ever meets as such outside of the general EPPC meetings). It forms *epi*'s tool to the quickly evolving world of patent information. In the present time wherein patent information becomes more and more directly available, the importance of this world for *epi* members grows every day.

The *epi* as an observer

W. Holzer (AT)
epi President

It is well known that the *epi* as a European organisation of public law enjoys observer status with official international organisations such as the Administrative Council of the European Patent Organisation, the European Commission and WIPO. Likewise, the *epi* is invited on a regular basis as an observer by private international organisations such as AIPPI, UNICE, FICPI or CNIPA. The status of an observer with official organisations was and is not granted automatically, and sometimes obtained not without difficulty. It has taken years and effort for example before the *epi* was allowed to sit together with WIPO and the European Commission in an entire Administrative Council meeting of the European Patent Organisation, that is not just for the topics directly affecting the profession. Over the years, however, the observer role of *epi* was more appreciated, and the status of observers as such has changed. Today an observer is not supposed to be a silent and passive listener, but an active contributor. Especially the Administrative Council has become interested in the opinion of the profession on *all topics* concerning the patent system, which after all is a system of mutual dependencies. This is quite in line with one of the official objects of the Institute, to liaise as appropriate with the European Patent Organisation and other bodies on *all matters* relating to industrial property. It is evident that a fruitful collaboration with the EPO would not be possible without observing what the Administrative Council has in mind and decides, and in which manner. Since UNICE has also obtained observer status with the Administrative Council, the observer position of the *epi* now is perhaps more accentuated. While the *epi* and UNICE share substantially similar views on general improvements of the system, the political interests tend to be different in some respects, simply because of the different membership structure of the two organisations, which in the case of *epi* also comprises representation of SMEs of all kinds and individual applicants.

The activities of the Working Parties installed in the framework of the French Intergovernmental Conference, which will be terminated by a diplomatic conference in the autumn of 2000, have added to the workload

of the observers, as has the diplomatic conference in the spring of 2000 for concluding a Patent Law Treaty and the increased number of Administrative Council meetings per year. For the *epi* this means preparing at short notice position papers on a range of topics some of which are not without controversy within the *epi*. However, if the *epi* wishes that its voice be heard in the international IP concert, it cannot refrain from submitting position papers on all subject matter in debate. This on the other hand creates problems of a practical nature. Although the *epi* due to its structure can avail itself of a number of specialised committees which are quite able to also tackle problems of a short term nature, it is not possible in some instances to wait for a decision of the *epi* Council. The formal decision making process within the *epi* does not render itself to speedy reaction. In the future it will therefore probably be necessary for the Council to consider and provide general directives and guidelines on the policy to be pursued in a particular case, without laying down the details. The Council will rather have to rely on the expertise of the relevant committee to elaborate the necessary papers when the case arises. These will have to be endorsed by the Board and delivered by the observer representative of the *epi*. In this regard an adequate contribution by Institute members sitting in the committees is indispensable. It is therefore of paramount importance that the members of the committees be dedicated to the committee work and that the structure of the committees be adapted before new countries join the European Patent Organisation. In order to ensure a continued efficient operation of the *epi* committees obviously a balance must be struck between electing an appropriate number of expert members to the committees and safeguarding any national interests of the member countries.

Summing up, today's observers must be alert and responsive, and the *epi* therefore more flexible, which on the other hand puts more responsibility on the *epi* committees. The gratification for the observers is the gaining of direct and first hand information, not to mention the valuable possibility of informal contacts with the members of the respective authorities.

Harmonisation Committee

F. Jenny (CH),
Chairman

The *epi* Harmonisation Committee at present consists of five Full Members and two Substitute Members. Its task is monitoring all activities in connection with the worldwide harmonisation of Patent Laws, i.e. within the framework of the World Intellectual Property Organisation (WIPO) in Geneva.

In the eighties several sessions of the Committee of Experts (CE) on the Harmonisation of Certain Provisions in Laws for the Protection of Inventions took place in Geneva for preparing a Draft Treaty Supplementing the Paris Convention for the Protection of Industrial Property as far as Patents are Concerned (Patent Law Treaty I). The aim of this Draft treaty was to harmonize national and regional Patent Laws. Subject matter to be harmonized included substantive as well as formal matters, e.g. disclosure and description, filing date, conditions of patentability, Grace period for the inventor, rights conferred by the patent, etc.. This Draft treaty was discussed at a Diplomatic Conference in The Hague, which ended on June 21, 1991 with the hope that a second part of this Conference would lead to the conclusion of a treaty. This second part, however, never took place, since the US withdrew several concessions they had agreed to. Thus e.g., they did not wish to change from the first-to-invent to the first-to-file system.

After 1991, the aim of this world-wide harmonisation had to be changed and limited to purely formal matters. At five sessions of a further Committee of Experts and three sessions of WIPO's Standing Committee on the Law of Patents (SCP; created in 1998) a new Draft Patent

Law Treaty (PLT; Patent Law Treaty II), restricted to purely formal matters, was prepared, which will be discussed at the Diplomatic Conference in May/June of this year in Geneva. As to the content of this Draft Treaty please refer to the „basic proposal“ mentioned in item A of the Report of the Harmonisation Committee reprinted in *epi* information 4/1999, pages 136/137. (N.B.: Members of the Committee of Experts and the SCP are all member States of WIPO and/or the Paris Union. In addition, some intergovernmental organisations [such as e.g. the EPO, the EAPO, the EC and WTO] as well as some non-governmental organisations (NGOs) can take part in the sessions in an observer capacity.)

At all of the said CE and SCP sessions *epi* was represented by members of the *epi* Harmonisation Committee. Like the other NGOs it had observer status (which includes the right to speak after the delegations of the States and the Intergovernmental Organisations, but no right to vote or to make proposals [unless at least two States support the proposal]). From time to time, i.e. after WIPO issued new proposals, the *epi* Committee met for discussing these proposals. Alternatively, the preparation of the CE and SCP sessions was made by collecting the comments of the *epi* Committee members in writing. The *epi* Harmonisation Committee will meet again on March 30, 2000 for discussing the said „basic proposal“ (see WIPO Documents PT/DC/3 and PT/DC/4) as a preparation of the Diplomatic Conference at which *epi* will have observer status as well.

Professional Qualifications Committee

T. Onn (SE), Chairman
S. Kaminski (LI), Secretary

As the name implies, the Professional Qualifications Committee of the *epi* is responsible for the development and training of students wishing to qualify as European Patent Attorneys as well as being the *epi* body responsible for other aspects of education and liaison with the European Qualifying Examination Board.

The Professional Qualifications Committee meet two or three times a year. In the majority of the meetings, the Committee meet on their own and discuss topics of particular concern at the time. To give an idea of the wide variety of topics that fall within the concerns of the

Professional Qualification Committee, topics considered include Continuing Professional Education both pre and post-grant, links with various educational bodies, notably CEIPI, an ongoing review of examination statistics and results, an ongoing review of the examination regulations, assistance for the Examination Board, notably concerns they have regarding the eligibility of various candidates and classes of candidates to sit the Qualifying Examination, a review of training, both Nationally and across Europe and suggestions to improve training for the examinations.

The *epi* Tutorials for candidates wishing to prepare for the European qualifying examination are organised by the Professional Qualifications Committee. There are two tutorials annually (summer and autumn). The candidate writes the paper(s) he/she wants to practice and send them to a tutor. The tutor give written comments on the candidate's paper and there is a possibility of further dialogue between the tutor and the candidate.

Every autumn a tutors' meeting is arranged. During this meeting the feedback from candidates regarding the different papers of that years EQE is discussed. In the second part of this meeting the tutors will be joined by the chairman/secretaries of the Examination committees I, II and III. This meeting in the larger group starts with a presentation of the current statistics of the EQE followed by fruitful discussions between the tutors and the members of the Examination committees.

Probably the most important function of the Professional Qualifications Committee is in liaison with the Examination Board for the European Qualifying Examinations. To this end, one meeting a year, held in Spring, is a major meeting comprising three sub-meetings. The first meeting is a meeting of the Professional Qualifications Committee, on their own, to discuss the ongoing concerns such as those given above. The second meeting is the meeting with the *epi* tutors.

During this meeting, the Professional Qualifications Committee is advised of problems that the tutors have encountered. Whilst procedural problems relating to the tutorials themselves fall under this heading, of much more importance are problems that the tutors have encountered with the examination and their tutees approach to the examination, both with an eye to the training of the candidates and to problems experiences that arise from the examination papers themselves. This is very important because it enables the Professional Qualifications Committee to identify problems experienced by candidates for the examination such as, for example, the running time for certain examinations, question structure and, for particular questions the content and phrasing of such questions.

Following the meeting with the tutors, the tutors, the Examination Board and Professional Qualifications Committee have a joint meeting. This enables the Professional Qualifications Committee to put forward concerns to the Examination Board with regard to the examinations themselves, it enables the tutors to discuss, with the Examination Board particular problems that they have experienced in the previous year's exams and enables the Examination Board to advise the Professional Qualifications Committee of problems that they have experienced with candidates and the areas of particular weaknesses that candidates have shown with regard to the different papers. This information is then disseminated to the *epi* tutors and to the candidates. The Professional Qualifications Committee is also then in a position to advise Council and any *epi* member of the practical hints that emerge from such a meeting.

In addition to the task assigned to the PQC (Professional Qualification Committee) to give every support

possible in connection with the European Qualifying Examination, a further matter of ever growing importance to be dealt with lies in maintaining and promoting continuing education of professional representatives. A special Working Group on Continuing Professional Education CPE within the PQC has now been given this latter task in particular, the issue of the Working Group being to find answers and solutions to all the questions arising in this respect, with emphasis at the national level.

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, the question arises as to what is being undertaken to ensure that the European Patent Attorneys really does fulfil the quality requirements laid down by the entrance suitability examination and the professional demands above and beyond it.

Therefore, a multiple track approach is being taken by PQC and the Working Group in particular:

- Continuing education at a national level, supported by suitable institutions; this should cover the needs which are perhaps purely specific to a certain country and could be effected on the spot.
- Joint venture with the EPO, mock interviews, opposition and appeal procedures.

Therefore, the most important primary task is to compile all available information concerning continuing professional education with regard to existing offers and needs as well as the lack of them. For this reason, the Working Group on CPE is running an enquiry aimed at representatives of national organisations and national professional associations in order assess the national situation and the national requirements throughout all Contracting States.

The Working Group will prepare a sort of a la carte menu, giving appropriate recommendations, essentially with a non-compulsory and liberal approach.

Furthermore, *epi* members should also have access to better information about the amount of already existing continuing professional education on offer. It would be beneficial to have a periodically updated list of such offers, which should be made available, for example via the Internet.

For this purpose, the Working Group on CPE plans – for the time being under the direction of the Editorial Board – to set up a Home Page.

Another matter close to our hearts – we refer here also to the report of our President W. Holzer published in the *epi* journal 4/1999 – is that we as European Patent attorneys entitled to act as professional representatives before the European Patent Office definitely wish to reserve the right to be able to represent our clients with respect to Community Patent in the pan-European courts to be created. However we want to prevent such an education becoming mandatory for admitted representatives. Representation of the interest of mandates in patent disputes should always be allowed by the European Patent Attorneys, if need be together with

an attorney at law. We wish to rise to the challenge, even if it involves the necessity of additional education. And we recommend the *epi* to study how such a further education can best be provided.

The Professional Qualifications Committee started a Working Group on statistics, the task of which is to find out if the statistics of the European Qualifying Examination could be of some guidance for future training programmes within the *epi* tutorials. Unfortunately, most of the statistics are only for confidential use by the EPO, which means that PQC cannot today get a sufficient background material to do a proper analysis. However, from the limited statistical material available the following conclusions could be drawn:

- The length of the training period does not seem to matter as there is no statistical difference between candidates having a 3 years or a 4 years training period
- The statistics show that modular sitting does not increase the passing rate
- It does not seem to be a general language problem as such a small number of the candidates chose to answer in their mother tongue

epi has proposed a joint *epi*/EPO working group which group will be able to do a more thorough analysis and

then come with constructive proposals on how to improve training programmes and other related matter. However there has not yet been any reaction from the EPO on this proposal.

Meanwhile this working group of the Professional Qualifications Committee intend to send out questionnaires to the candidates sitting the European Qualifying Examination in order to gather some information on their preparation, views on the examination, etc.

Finally, the Professional Qualifications Committee is continually looking to establish stronger links with other educational bodies in Europe, in order to ensure that the best possible opportunities are available to candidates for the European Qualifying Examination. To further this aim, for example, a meeting was recently held jointly with CEIPI in which mutual problems were discussed and areas for future joint opportunities were explored.

In summary, the Professional Qualifications Committee acts to represent all *epi* members in the areas of education and training. It is emphasised that if any *epi* member has a query or a problem relating to training, education or the European Qualifying Examinations, they are urged to contact their National PQC member who will be able to advise them and, if appropriate, take the matter further.

Standing Advisory Committee (SACEPO)

H. Papaconstantinou (GR)
epi Member of SACEPO

The first Council meeting of the Institute of Professional Representatives before the EPO was held in the Penta Hotel, Munich on 8th and 9th April 1978. It was attended both by full Council members and, for this occasion exclusively, by all substitute Council members.

Mr. Van Benthem, EPO's President, took the chair until the elections were completed, as a result of which Mr. Chavanes was elected the first President of the *epi*.

It was at this first Council meeting of EPO that Mr. Van Benthem announced that he would soon be asking for Institute representatives to sit on a Standing Advisory Committee to the EPO, in order to establish a link between the Office and the Institute. The aim of setting up the Standing Committee was to enable interested circles to be consulted, as promptly and as informally as possible, in all questions concerned with EPO practice and with the progressive development of European Patent Law.

During the 2nd Council meeting of the European Institute, held on 28 June 1978 in Paris, it was decided to supply a list of suggested names from which the President of the EPO might make a selection of the SACEPO members. It was, however, emphasised that the

members of the SACEPO would not represent the European Institute. As a result, SACEPO members may express their personal opinions and not those of the Council, so that the *epi* is not bound by their views and can argue against them if necessary.

SACEPO was set up at the end of 1978 and its inaugural meeting was held in January 1979. It consists of representatives of the patent profession – one member from each EPC contracting State being nominated by *epi* – and from industry – one member per contracting State being nominated by UNICE (the Union of Industrial and Employers' Confederations of Europe) and from specific Research Institutions and industrial groupings, for example IFIA (International Federation of Inventors Associations). In addition a small number of members are appointed „ad personam“ by the President of the EPO.

With regard to the „modus operandi“ of the SACEPO, it was decided to facilitate the practical work of SACEPO. Accordingly, it was suggested that all documents concerning the proceedings should be transmitted directly to the Secretariat which will arrange for their further distribution and for the preparation of translations,

where necessary. The members of the Committee should be prepared to communicate preferably in all three but at least in two of the official languages of the EPO, since the EPO was unable to provide simultaneous translation in all three official languages. The election of a Chairman and Deputy Chairman of the SACEPO should be dispensed with and the meetings be conducted by the President of the EPO or, in the event of his absence, by one of the Vice-Presidents of the EPO and the SACEPO should normally meet in Munich.

SACEPO is a consultative body which enables the President of the EPO to seek advice from the representatives of industry, from the Institute of Professional Representatives before the European Patent Office (*epi*) and from a number of „wise men“ who have contributed to the development of the European Patent Systems.

Whilst EPO can amend the Guidelines by itself, suggestions regarding the amendment of the Rules, must be considered by the Administrative Council.

The SACEPO is consulted on all aspects of EPO policy including, *inter alia*, legislative changes, fee policy and EPO practice in search and examination, though its functions are purely of an advisory nature. If there is general agreement, the EPO can act on recommendations made by SACEPO where it has the power to do so or will make corresponding proposals to the Administrative Council, in the absence of such power. Thus SACEPO represents the „voices“ of the users of the System and has dealt, as from its establishment, with the users proposals, thereby succeeding in becoming a very useful channel for expressing views to the EPO.

Members are nominated for a three-year term of office. One ordinary meeting is held each year and extra-ordinary meetings are convened whenever an issue of particular importance for the EPO arises as, for instance, most recently in autumn 1998 when the opinion of SACEPO was sought on a number of proposals in connection with the ongoing programme for revision of the EPC.

For the period 1999-2002 SACEPO comprises 46 members.

From the date of its establishment up to now SACEPO held thirty ordinary meetings and dealt with numerous important items of an essentially legal, technical or procedural nature, such as:

Patents for medicines and micro-organisms, Permissibility of Omnibus – claims, Amendments to the guidelines for examination in the EPO, Special measures to reduce backlog, Appointment of oral proceedings before the EPO, Delayed decisions to grant a European Patent (so-called „Renewal fees loophole“).

The matters of paramount importance which are being dealt with by SACEPO, over the last years, are in particular:

- Revision of the EPC
- Costs of European Patents (the language issue and the EPO fee policy)
- European Decentralisation
- Restitutio in Integrum

At the last year's ordinary meeting, topics discussed included the Inter-Governmental Conference on reform of the European Patent System held in Paris at the end of June, follow-up work to the European Commission, green paper on the Community Patent, a number of detailed proposals concerning the EPC revision, and proposed amendments to the EPC Implementation Regulations, as well as changes to the Guidelines for examination, stemming particularly from the increasing frequency of so-called complex applications.

A further important activity of SACEPO are the annual meetings of some of its members with the members of the Boards of Appeal to discuss important matters. This activity is complementary to that of the SACEPO members exclusive annual meetings.

The next ordinary meeting of SACEPO is scheduled for 29th-30th June 2000 in Munich.

In December of last year the Administrative Council of the European Patent Organisation decided to convene a diplomatic conference for the revision of the EPC which is scheduled to take place in Munich from 20th-29th November 2000. Outstanding revision points will be dealt with in further meetings of the Committee on Patent Law in February and April of this year and there has been a suggestion to submit a basic proposal for revision of the EPC to the Committee of Patent Law for consideration at a meeting scheduled for the 3rd-7th July 2000.

It is expected that the next ordinary meeting of SACEPO will be devoted exclusively to revision of the EPC and in particular to the basic proposal to be drafted by the EPO.

Spain and Greece became contracting States with effect on the 1st of October 1986. The undersigned's first experience with SACEPO resulted from attending the 14th SACEPO meeting on November 6th-7th of 1986 in Berlin. At that time, the achievement of its initial Officers and Presidents was already evident. SACEPO was a valuable influential forum open to a free exchange of views.

Being a recently re-appointed member of SACEPO, I must emphasise that this body has made remarkable progress and evolution on most of the vital matters it has dealt with. SACEPO has succeeded in becoming a very useful channel for expressing views to the EPO. Fundamental to the future strength and influence thereof is, of course, the competence of its President and members and the generous amount of time which the SACEPO President and members as well as EPO officers continue to devote to SACEPO.

What else could the *epi* be or do?

Leo Ryckeboer (BE)
Past *epi* Vice-President

This is a comment and input following up on the invitation of the President and the Editorial Board in the edition no. 4/1999 and picking in on his Letter therein. Presidents of the *epi* always have their vision, fortunately! The more so since they appear to represent a „unique transnational organisation“. The Institute has of course to look after the professional interests of its members (for another 10, 100 or 1000 years) such as promoting their compliance with the rules of conduct and liaising with the EPO, WIPO, EC and other bodies for IP-protection. Furthermore, the *epi* can not forego the basic interests of the innovators, the clients: effective protection and legal certainty within reasonable time limits and at reasonable costs. In addition, training and examination of future European patent attorneys (= EPA's) is said to be a predominant field of activity for the *epi*. The question is now: is this activity (which is to a certain extent even a task) not so closely entangled with the other objectives that in fact it may contribute to guide and steer them?

EPA's have a somewhat hybrid job: they practise as scientists or engineers with a specific IP-legal training. That is what patent practice requires, in the granting as well as in the enforcement procedures. Legal practitioners normally dominate procedures in the enforcement stage although they mostly lack the required technical education. However, technology becomes more and more sophisticated and specialised so that *the need for a proper input from the technological side in legal disputes on patents increases*. Technical experts without knowledge of patent law do not always satisfy in this respect. In the interest of the innovating industry it could thus be very wise indeed to have engineers and scientists besides lawyers in the bench as judges, and as speakers on the side of plaintiffs and defendants to assure a consistent quality of the judicial decisions and thereby Europe-wide legal certainty. In particular it may be quite difficult for lawyers as judges to properly evaluate peculiar and critical technical issues and their impact on a case. The life of such judges can even be complicated by parties and their experts launching all kinds of contradictory technical statements. It can even drive them to a formalistic approach which does not necessarily or timely bring the equitable justice expected. A technical judge could certainly be helpful to clarify issues, to focus on essentials and to distinguish the right from the wrong from a technical point of view.

As the President points out, the curriculum of the EQE (art. 134.2c and 134.8a EPC) will have to be revised *when EPA's would be invited to represent clients before a centralised European Patent Court system*, but how? Indeed, the EPA's who are not lawyers generally lack the required knowledge of judicial and procedural law. EPA's will all have in the future the necessary technical skills

and some legal skills since Art. 134 (8a) implies that candidates for the EQE should have a university-level scientific or technical qualification or equivalent (Regulation EQE art. 10). Limiting the supplementary curriculum for EPA's to legal principles of judicial and procedural law and to principles of contract law in Europe would very probably suffice for representing clients before courts together with lawyers or for a job as technical judge before a European patent court. An EPA as engineer or scientist does not have to become a lawyer nor vice-versa (although the latter is quite improbable). However, when acting in a legal capacity besides a technical one, the EPA will have to abide also by the rules of conduct for the legal profession. In any event good judicial decisions in the future may more and more depend on a close co-operation between technical and legal competence.

The members of the EPO Technical Boards of Appeal offer of course also a good reservoir of technical and legal competence, e.g. for acting as a European technical judge, provided they would have passed the EQE. However the industrial practice and reality, in particular with regard to the determination of the extent of protection and infringement, is more than desk work. In any event, it would be wise to train such Board members as well in the interest of a proper protection of innovation. The EPO and the *epi* would probably profit both from joining here their training efforts in the interest of the users and to assure a proper impact of technical factors in the drawing up of judicial decisions.

A continued professional education (= CPE) scheme for EPA's, to be run by the *epi* of its own, is another appealing idea, not only to the President. But CPE covers a number of things and it would be worthwhile for the *epi* to make up its mind to define the different curricula. A basic consideration thereby is that the innovating and developing industry, not only in Europe's centre but also in its periphery, will insist in the future on a competent and high quality service for a coherent technology protection through patents. This service is to be rendered throughout Europe, not only by attorneys but also by government officers, including judges. The *epi* could also suggest flexible education systems (networking) and methods (including internet) to organise and manage the courses, e.g. in a modular form, and how to support their continuity and have them funded. The *epi* could invite said officers to join in the courses as teachers or participants. It happens already from time to time in the basic (epi-CEIP)-courses in the Hague and Munich.

Firstly, in CPE there is the market of the „students of the *epi*“, of *the presently running basic tutorials and special training courses and tutorials for the EQE*. Thinking i.a. of the needs to train future EPA's for southern European countries and for the 8 new countries to join

the EPO, the offering of these tutorials per country or region in a more flexible modular form, and adapted to their needs, could be contemplated. The epi-members of this periphery should by all means avoid that their profession disappears in about ten to twenty years from now, or is dominated meanwhile by the law profession. They could deliberately anticipate with a thorough education to close gaps with the centre and with the help of EPA's from the centre.

It could also be envisaged to extend throughout Europe from now on the actual curriculum of the basic courses with a module on basics of the determination of scope of protection and infringement (with case studies) and perhaps of licensing.

Besides the basic (CPE-) programs and EQE, there appears to be a *definite and widespread demand for an advanced training programme or recycling for those who passed the EQE some years ago*. Part of this program could be merged flexibly with certain topics or modules of the steadily updated basic courses. In addition, special subjects could be added such as the practice of oral hearings and pleading, new important case law, licensing, basics of contracts and European competition law, patent and knowledge management etc. The latter aspect gains more attention since patent protection is becoming so abundant that the answer to the question „what is mine and what is not“ becomes more and more complicated. Generally the market does not wait for complex answers and the parties in a conflict prefer to settle disputes with an arrangement that is economically beneficial to both: licensing, co-operation for R&D and/or for the exploitation of rights. This entails knowledge-management and IP-management aspects, including the valuation of IP-assets. There is certainly a market for training on this subject also.

Finally, the President mentions „*raising the awareness of the patent system*“ for the general public, in particular

for the innovating industry and for the (public) institutes for scientific higher education and research. The epi started a couple of years ago with the epi-brochure „An Introduction to Patents in Europe“. It was already proposed to translate this booklet further in the languages of the 8 new countries joining the EPC. Internet is a good vehicle for distribution, however the printed edition may retain its attraction as well. Picking in here by explaining to the public the need for coherent and durable protection in Europe may be a good marketing approach. Good innovators are indeed motivated to spend money for the added value produced thereby because an adequate payback on their investments for innovation underpins competitiveness. Without proper patent protection any European business will fail in the face of low-cost (foreign) competitors. This effort for raising awareness is best organised on a local level, in co-operation with others. However, it is not bad to have the active presence there of the name of epi.

Why could it be to the benefit of *the profession to pursue an active Europe-wide policy on training and education for patent protection*? An answer could be: to avoid that others, e.g. the legal profession, anticipate with such initiatives. We should not forget that there is a definite legal trend in Europe for a liberal approach towards marketing and advertising professional services, to the detriment of conservative rules of conduct. Concentrating on a proactive approach to education and training may be at least as worthwhile and beneficial for marketing the profession as a forced defence on some potentially superseded rules of conduct.

In three years from now, the 25th anniversary of the epi will be there. Could the setting up of a good framework for CPE by that time not be a nice objective, a milestone?

The epi and its Public Relations

Arthur Huygens (NL)
Past epi President

The idea of the Editorial Board to dedicate the first issue of epi Information in the new millennium to the epi itself, is much welcomed. It gives another opportunity to inform our members and others, who are reading epi Information either in paper format or on the epi website, on what epi is and what it does.

Although the awareness of epi certainly has increased in the past few years, I believe the work of epi as a professional organisation is still relatively unknown as compared with the national professional organisations in the member states.

Currently, with a membership of 6,000 people and an envisaged expansion of another 2,000 people in the near

feature, the epi is one of the world's largest supranational organisations in the Industrial Property field. Most of our members are also a member of a national professional organisation. Despite the excellent and streamlined organisation of epi, people use to contact so far their national organisations which they are much more familiar with, because it is more close by. In many countries they get regular information from their „corner shop association“, visit annual meetings, meetings on special topics, sometimes social events, etc.

These ordinary members are somewhat in the dark on how the epi is working. This strikes me, the more so because the bulk of the patent work handled by these

persons is European patent work rather than work on a national level. For these people, the *epi* should be the professional organisation in my opinion. At present, the *epi* has about 150 members who are actively involved in the work of the Institute. This number is much too small for an organisation of 6,000 people. Besides, participation in the *epi* Council and the various Committees is restricted, and subject to election or nomination. The newly created associate membership of some Committees does not constitute a real expansion of the „inner circle“.

What can the *epi* do for its members and how can they be reached? During the previous Council period a working group was set up to generate ideas and make recommendations to the Board on how the organisation of the *epi* could be improved and be made more attractive for its ordinary and in particular young members. Among the many good ideas two themes emerged which in my opinion are key elements for the future of the Institute: provide good education and provide adequate information.

In his article „What is the *epi*?“ in *epi* Information 4/1999, my successor Walter Holzer presents an interesting view in which he touches both subjects, and in the present issue past vice-president Leo Ryckeboer, the chairman of PQC, Thorsten Onn, and the secretary of PQC, Susanne Kaminski, give their views on training and examination, and continued professional education.

Being invited to comment, I would like to add one thought to Mr. Holzers notes. It is certainly true that in disseminating relevant information to our members and to the general public, the Internet will be the future communication medium of the Institute. In my opinion, however, this is not sufficient. If we restrict ourselves to providing information mainly through electronic means,

the Institute would return to the invisible body operating in the dark, as before.

The *epi* should manifest itself more clearly for its members by organizing regular events, conferences, meetings, etc., where the members can be informed about any subjects of interest, discuss professional items, meet their colleagues, and socialize. Such events may be organized both on an international or a regional level, together with or without other (e.g. national) organisations.

Many national institutes organise well-attended annual and other meetings, and also the open forum meetings of FICPI are usually very well attended. I agree that the agenda of events is very crowded, but an organisation of the size and importance of *epi* can not permit itself to stay backstage. Besides, because of the tight links with the European Patent Organisation, *epi* is in a unique position to disseminate information about all aspects of the European patent system and to act together with members of the European Patent Office, if appropriate.

Providing the service which our members may expect from their professional body, and organizing regular and successful events requires manpower and skill. Time has come to set up a PR or a standing organizing Committee to organize or accompany these intended activities. Furthermore, the present size of the Secretariat is rather small for an organisation of 6,000 to 8,000 members, certainly when new tasks will be introduced. Therefore, expansion of the Secretariat in the next few years also needs to be considered.

These ideas are not new, but the discussion should be continued. Decision time will come soon, otherwise you will only be informed through *epi*'s website that it is now the 25th anniversary of the Institute!

The patentability of ‚methods of doing business‘

H. W. Hanneman (NL)

1. Introduction

If the decision by the U.S. Federal Court in the *State Street*¹ case might have been dismissed as a chance event, the forthright formulation of the judgement by the same Court almost a year later in the *AT&T* case² leaves little room for doubt as to the Court's intentions. Both cases were concerned with the extent to which a (computer-based) method of doing business constitutes patentable subject matter. In both cases the Court decided in favour of patentability and – more impor-

tantly – made short shrift of the legal practice that has developed in two areas: the tests used for determining the patentability of (a) software-related inventions and (b) ‚methods of doing business‘. The previous test for patentability of software-related inventions, which had been increasingly refined in numerous cases, was set aside by the Court as being ‚unhelpful‘ and the legal practice of regarding ‚methods of doing business‘ as non-patentable was labelled as ‚ill-conceived‘. The Court did not formulate a new specific test or develop new specific criteria for determining patentability of this type of invention, but returned to the provisions of U.S. patent law itself and its (constitutional) basis. The US Constitution stipulates (Article 1, paragraph 8):

¹ *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368 (Fed. Cir. 1998 also: *USPQ.2d*). Decided July 23, 1998 (cert. denied).

² *AT&T Corp. v. Excel Communications, Inc.*, (Fed. Cir. 1999) 172 F.3d 1352 (also: *50USPQ.2d* 1447). Decided April 14, 1999. Petition for cert. filed.

„The Congress shall have power ... to promote the progress of science and *useful* arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries“. (Author's emphasis)

The U.S. Patents Act enlarges thereon (in Article 101) with the wording:

„Whoever invents or discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful* improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.“ (Author's emphasis)

The U.S. Supreme Court has always interpreted Article 101 extensively (,to include anything under the sun that is made by man³ and has excluded from patent protection only three categories of subject matter: laws of nature, natural phenomena and abstract ideas⁴. On the basis of these fundamental principles, the Federal Court concludes that assessment of patentability should establish whether the subject matter for which protection is requested is ,concrete, tangible and useful⁵.

The significance of these decisions will be discussed in detail below. In author's opinion conferring patent protection to ,methods of doing business' is considered positive in principle. Attention will be given to how, in the author's opinion, the disadvantages thereof – structural and incidental – might be obviated. In that connection it will be argued that the criterion of ,inventive merit' or ,inventive step' should be rehabilitated as one of the material requirements for patentability. Finally, the criteria for determining patentability under the European Patent Convention will be compared with the present US-approach, and conclusions drawn in respect of patentability of this type of inventions under the European Patent Convention.

2. Recent decisions in the United States

Of the two judgments given in the United States, the first one, *State Street Bank & Trust Corporation v. Signature Financial Group Incorporated*⁶, has attracted by far the most attention.

This was due on the one hand to the uncommon even surprising subject matter of patent protection, namely an investment fund strategy, and on the other hand the radical break by the Court with the established method of determining the patentability of subject matter which involves ,mathematical algorithms' or ,methods of doing business'. The second decision, *AT&T v. Excel Communications, Inc.*⁷, related to a method of differentially charging long-distance telephone calls in proportion as the subscribers are connected to the same telephone company or to different companies. A clearly less intriguing subject matter and a decision which was com-

pletely in line (in some cases literally identical) with the decision in *State Street*. The significance of the second case lies primarily in the confirmation that it provided of the course set in *State Street*⁸. For these reasons I shall leave the *AT&T* case and confine myself to *State Street*.

Signature Financial Group had obtained a patent for a system for ,pooling' a number of limited investments of local banks in order to obtain advantages of scale (lower transaction and execution costs) and a more favourable fiscal regime (the partnership company form is fiscally facilitated in the USA). After negotiations with *Signature* for a licence had proved unsuccessful, *State Street Bank* started a nullity action against the patent. The District Court found for *State Street*: the patent was considered invalid because the patent claims related both to a ,mathematical algorithm' and to a ,method of doing business' and, according to the Court, both categories are excluded from patent protection⁹.

Signature appealed to the CACF, the Court of Appeals for the Federal Circuit, and successfully: the Federal Court reversed the judgement of invalidity of the District Court.

2.1 Patentability of mathematical algorithms – brief review

With regard to the approach to determining whether patentable subject matter is present in an invention that involves a mathematical algorithm, the situation in the USA was at that time as follows. Since the development of computers in the 50s, the Courts and the US Patent Office have struggled with the patentability of mathematical algorithms. The US Supreme Court first ruled in 1972 in the *Benson* case¹⁰. The Supreme Court found that a method of converting binary coded decimal numbers into binary numbers was not patentable. The Supreme Court judged the method as being too abstract and stated that ,transformation of matter from one state to another' was a requirement for patentability of a method which does not use a specific device.

In 1978, in the *Flook* case¹¹, the Supreme Court again found against patentability of a mathematical algorithm invention. This case related to a method of updating critical alarm values in the monitoring of a chemical refining process, these critical values being calculated on the basis of specific mathematical equations. The Supreme Court found that in the event that a mathematical algorithm forms part of the subject matter, the mathematical part must be disregarded and it must be established whether the remaining part contains patentable subject matter.

An unfortunate decision, because determining whether patentable subject matter is present in an invention of which one or more essential elements are missing is a

3 *Diamond v. Chakrabarty* (Supreme Court 1980) 447 U.S. 303 at. 309.

4 *Diamond v. Diehr* (Supreme Court 1981) 450 U.S. 175.

5 Note 1, *Supra* at 1372. The Court referred to *Alappat* (note 19 *infra*) in which case the same approach was taken.

6 Note 1, *supra*.

7 Note 2, *supra*.

8 The Supreme Court has meanwhile decided to deny *State Streets* petition for certiorari.

9 *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 927 F. Supp. 502, 38 USPQ 2d. 1530; (D. Mass. 1996).

10 *Gottschalk v. Benson* (Supreme Court 1972) 409 U.S. 63.

11 *Parker v. Flook* (Supreme Court 1978) 437 U.S. 584.

critical matter and is also in conflict with a principle, accepted in the USA and also generally elsewhere, in connection with the analysis of claims: the ‚whole contents approach‘. Fortunately, shortly after this, in 1981, the confusion resulting from the Flook judgement was ended by the well-known and pioneering judgement of the Supreme Court in Diehr¹². The Supreme Court found as patentable a computer-controlled method of curing rubber in a rubber press wherein the curing process was monitored on the basis of the value of a parameter derived from a mathematical equation. The Supreme Court recognised that:

„a claim drawn to subject matter otherwise statutory does not become non statutory simply because it uses a mathematical formula, computer program or digital computer.“¹³

The Court incidentally added that ‚the claim as a whole, including the mathematical formula, must be considered when determining patentable subject matter‘.

The Supreme Court also indicated that practically anything (‚anything under the sun made by man‘) is patentable and that non-patentable subject matter is restricted solely to the following categories:

„Excluded from such patent protection are the laws of nature, natural phenomena and abstract ideas.“¹⁴

The Court of Customs and Patent Appeals (CCPA), the predecessor to the present CAFC, has, for many years and in tens of cases, been engaged in interpreting the patentability of software-related inventions, and it developed a two-stage test in the Flook-Diehr period to establish whether a patentable invention is involved in cases in which the subject matter for which protection is requested involves a mathematical algorithm. This test, the foundation for which was laid in the Freeman case¹⁵ (before Flook) and was further developed in the Walter case¹⁶ and the Abele¹⁷ case (after Diehr), is known as the ‚Freeman-Walter-Abele‘ test (FWA test) and reads as follows:

„First, the claim is analysed to determine whether a mathematical algorithm is directly or indirectly recited. Next, if a mathematical algorithm is found, the claim as a whole is further analysed to determine whether the algorithm is ‚applied in any manner to physical elements or process steps‘ and if it is, it ‚passes muster under § 101‘.“¹⁸

This test has been used very intensively but has not led to unambiguous application nor to predictable results. In 1994, the CAFC, took a remarkable step in the approach used for determining the patentability of software-related inventions.¹⁹ With the smallest possible majority (6 of the 11 judges were in favour), and a minority which predicted ‚untold consequences‘, the Federal Court

decided that Alappat's invention¹⁹ relating to the reproduction of a smooth wave form display on a rasterizer monitor constituted a patentable subject matter. In this case the Court did not apply the FWA test but the Diehr analysis indicated above, with which it should be established whether the invention considered as a whole is more than a law of nature, a natural phenomenon or an abstract idea. Although, according to the Court, all the means mentioned in the (apparatus) claim related to circuits which perform mathematical calculations, together – i.e. regarded as a whole – they form an apparatus (= ‚machine‘ in the meaning of U.S. patent law) for reproducing on a display waveforms which have been smoothed and constitutes a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it produces a useful, concrete, and tangible result‘.

2.2 State Street Bank – FWA-test exit

In State Street Bank, the CAFC continues the line – applied in the case of Alappat – and establishes, in what is probably the most important part of its decision:

‘Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces „a useful, concrete and tangible result“ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.’²⁰

Where Diehr and the FWA-test still explicitly required the mathematical algorithm to be implemented in a manner to define structural relationships between physical elements in order to transform or reduce an article to a different state or thing, the CAFC has decided here that physical transformation should not be regarded as a prerequisite, as a *conditio sine que non*, but that transformations of data can also qualify as patentable subject matter.

The Court also explicitly evaluates the role of the FWA-test in earlier decisions and comes to the positive conclusion that the FWA-test: ‚has little, if any, applicability to determining the presence of statutory subject matter‘. Where the Court ignored the FWA-test in Alappat and proceeded from the very basis of patent law, the FWA-test was explicitly consigned to the wastepaper basket in the case of State Street.

2.3 State Street Bank – method of conducting business

The second ground on the basis of which the District Court declared Signature's patent invalid at that time was the ‚business methods‘ exception to what may normally be considered as patentable subject matter.

12 Note 4, supra.

13 Note 4, supra at p. 187.

14 Note 4, supra at p. 185.

15 In re Freeman (CCPA 1978) 573 F. 2d 1237; 197 USPQ 464.

16 In re Walter (CCPA 1980) 618 F. 2d 758, 205 USPQ 397.

17 In re Abele (CCPA 1982) 684 F. 2d 902, 214 USPQ 682.

18 Note 16, supra at p. 906.

19 In re Alappat (CAFC 1994) 33 F. 3d 1542, 31 USPQ 2d 1556.

20 Note 1, at p. 1372.

The Federal Court gave short shrift to this interpretation, which is applied particularly at the U.S. Patent and Trademark Office, and stated: 'we take this opportunity to lay this ill-conceived exception to rest'. In so doing, the Court took into consideration that this exception had never been applied by the Court itself, or its predecessor, the CCPA. According to the Court it is better, in this case too, directly to apply the exceptions to patentability which are formulated in the Patents Act and by the Supreme Court and, for example, to apply the 'abstract idea' exception in the present case. Therefore, according to the Court: 'whether claims are directed to subject matter within § 101 should not turn on whether the claimed subject matter does 'business' instead of something else', but on the contrary a check must be made whether the claims are directed at achieving a concrete, tangible and useful result.

3. The consequences of the State Street decision

The State Street decision expands patent law to a new category of inventions: inventions which are not situated exclusively or even primarily in the area of technology and (manufacturing) industry, but for example in areas like banking, insurance, marketing and e-commerce. This is a development which of itself must be welcomed: patent law would soon face irrelevance if not extinction, if it were not allowed to follow innovation into the new areas it happens to develop. However, one problem that immediately arises is one that also arose at the time when the scope of patent law was extended to software-related inventions: how can patent applications in new areas be properly subjected to examination by patent offices who have never systematically collected and classified literature in that area. In the case of the software-related inventions we have seen that it took years before patent offices recognised (and acknowledged) the problem and then it took even more years to implement the steps that were taken. The steps that have been applied for the purpose in the United States in recent years are considerable, as will be apparent from the list recently given by the present Commissioner of Patents of the U.S. Patent and Trademark Office, Q. Todd Dickinson²¹:

- access provided to more than 900 commercial databases with information in this area;
- new patent classification set up so that inventions can be classified systematically and are therefore retrievable;
- 290 new examiners appointed in the last two years (with on average 4 years' industrial experience); and
- existing examiners trained in the new areas.

Since patenting has only recently become a real option for software-related inventions, the (early) state of the art is documented primarily in journal, brochure and other (inter alia 'grey') literature. The absence of any

reference to a non-patent document in a software-related application is accordingly generally regarded as an ominous sign. An examination recently carried out by Dickinson's Office showed that 65% of recently filed patent applications in this area did not cite any non-patent literature as prior art. Similar steps will have to be taken for 'business methods' in order to be able to guarantee an adequate examination as to novelty.

What is new, however, is that the area in which inventions are now being granted is not primarily a technical area, and examiners, patent offices and patent attorneys generally are not really familiar with the subject matter. The invention in the case of State Street lies in a fiscal-judicial field and the 'outcome' is also in that. The merits of such an application can accordingly be best set out or evaluated by a patent attorney or examiner with expert knowledge on that subject.

Although technology is still the vehicle that the 'method of doing business' invention makes use of, it is in the form of the obvious ubiquitous vehicle in a standard model: a PC. The patent claims applied by State Street are illustrative. The first claim²² reads (schematically) as follows (with, in parentheses, the 'means' indicated as such in the description):

1. A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:

- a. computer processor means (a personal computer) for processing data;
- b. storage means (a data disk) for storing data on a storage medium;
- c. first means (an arithmetic logic unit (ALU) configured to prepare the data disk to magnetically store selected data) for initialising the storage medium;
- d. second means (an ALU) configured to retrieve information ...) for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds' assets and for allocating the percentage share that each fund holds in the portfolio;
- e. third means (an ALU configured to retrieve information ...) for processing data regarding daily incremental income, expenses, and net realised gain or loss for the portfolio and for allocating such data among each fund;
- f. fourth means (an ALU configured to retrieve information ...) for processing data regarding daily net unrealised gain or loss for the portfolio and for allocating such data among each fund; and
- g. fifth means (an ALU configured to retrieve information...) for processing data regarding aggregate year-end income, expenses and capital gain or loss for the portfolio and each of the funds.

The State Street claim is directed at the optimal financial management (in terms of costs and taxation) of a portfolio consisting of the combination of the funds

21 Q.Todd Dickinson, E-commerce, software patents and the law – the US PTO position, Derwent Information Newsletter, Dec. 1999.

22 The full text of the claims of US octrooi 5,193,056 are found at <http://www.patents.ibm.com>.

held separately by each of the members of a partnership: a universal PC is used for the calculation required for the purpose, and this PC is defined at the most abstract level imaginable (CPU, memory, ALU).

No other further technical steps are described (nor, in my opinion, are they necessary to clarify what is described in the claim).

3.1 The European approach

To be considered for a European patent, an invention must satisfy a number of material requirements. Article 52, paragraph 1, EPC, defines the four basic requirements:

- (a) ‚invention‘ (in the sense of subject matter susceptible of patent protection;
- (b) novel;
- (c) involve an inventive step; and
- (d) susceptible of industrial application.

In addition to these basic requirements, there are two other requirements which are included elsewhere or implicitly in the European Patent Convention and the Implementation Regulations, namely:

- (e) clear and complete description of the invention (Article 83); and
- (f) the invention must relate to a technical field, a technical problem and its solution (Rule 27, paragraph 1) and define the technical features by reference to which the subject matter of the application for which protection is requested should be described (Rule 29, paragraph 1).

In determining whether Signature's invention constitutes an ‚invention‘ within the terms of the Convention, we shall disregard criteria (b), (c) and (e) as being immaterial here.

Although Signature's invention does come within the category of „systems, rules and methods (...) for doing business“, which is excluded from patenting under Article 52 (2) EPC, this exclusion applies only to the extent that it relates to the subject matter ‚as such‘ (Article 52 (3)). Where, in Signature's invention, PC hardware and software means are used to perform the system for doing business, the subject matter must be regarded as an ‚invention‘ within the meaning of Article 52.

With regard to criterion (d) – susceptible of industrial application – Article 57, EPC requires that the subject matter for which protection is requested ‚can be made or used in any kind of industry‘. According to the Guidelines for Examination in the European Patent Office, ‚industry‘ must be understood as ‚an activity which belongs to the useful or practical arts as distinct from the aesthetic arts‘ (author's emphasis). Although Signature's invention is intended for use in the (financial) services sector and ‚services sector‘ is used to indicate something other than manufacturing ‚industry‘, Signature's invention does qualify under the wide interpretation given to Article 57 in the Guidelines.

If Signature's invention is tested against criterion (f) – ‚triple technical character‘ – it can be established that although the subject matter for which Signature

requests protection has technical features (central processor (CPU), memory, arithmetic and logic means) and is described by reference thereto, it is extremely uncertain whether the invention relates to a technical problem situated on a technical field. In my opinion, the invention lies on the economic or econometric field (‚the determination of the current value of an investment fund‘), wherein economic/fiscal problems are solved with technical means. Signature's invention would therefore not qualify for patent protection in Europe.

As already demonstrated, in interpreting Article 52 Europe would be well advised to pay more attention to the technological and economic developments and also to the speed at which they are taking place. The fact that the Board of Appeal recently pronounced in favour of world-wide harmonisation of material patent law (in the spirit of TRIPS²³ is a positive sign and inventions as described above will probably then qualify for patent protection²⁴.

The evaluation of the patentability of Signature's invention would also be different in Europe if Signature were to require protection for the program on a carrier. According to a recent decision²⁵ of the Board of Appeal of the European Patent Office, the requirement of „technical character“ in software-related inventions is satisfied only if a specific or further technical character is also present in addition to the general universal technical character inherent in the performance of the invention by means of a computer. One might term this a requirement for a second technical indication. This specific second technical character can be found, for example, in the circumstances that the computer program controls an industrial process or an apparatus and the computer program causes the computer to operate to obtain the specific further technical effect inherent therein.

As indicated above, Signature's invention makes use of a standard universal PC which is used in a standard manner. Therefore, signature's invention in the form of a program on a support is lacking a further technical effect as specified by the Board of Appeal and would not be considered for patent protection.

It will incidentally shortly be clearer whether the EPO actually considers inventions in this category to be patentable. In 1997 the European Patent Office granted a patent for a system for computer-assisted trading in warrants. No less than twelve parties independently filed opposition against that patent. No decision has yet been given. After the Opposition Division has given a decision, it will still be possible to file an appeal at the Boards of Appeal. It will therefore still take some time before their decision can be expected. The European Courts have never yet given any ruling on the patentability requirements in Europe, and hence it is unlikely that this will happen in the interim.

23 Art. 27 of TRIPS provides that ‚patents shall be available for any inventions whether products or processes in all fields of technology, provided they are new, involve an inventive step and are capable of industrial application.

24 As the methods of doing business are generally carried out using IT-means, the broad TRIPS-criterion ‚in all fields of technology‘ will be met.

25 T 1173/97 is published in OJ EPO 1999.

If we compare the patent procedures in the United States and Europe, one is struck by the momentum with which justice is dispensed in the United States (motto: ‚justice delayed is justice denied‘) and the absence of any ‚sense of urgency‘ in Europe to prevent the legal system from lagging very far behind the rapid developments in technology and business²⁶.

3.2 Direct consequences

The consequences of the two decisions in the United States will incidentally be felt directly throughout the world. Stern²⁷ refers to these consequences as ‚irrational overextensions of US law‘ but rightly also states that adequate care of user interests requires that they must be taken into account or made use of. Europe will have to take into account the following extra-territorial consequences:

1. U.S. patent law prohibits selling on to the U.S. market products which were made outside the United States in accordance with a method patented in the United States.

This could be a very effective weapon for electronic trading systems.

2. If U.S. patent contains claims directed to a program as such and a European company does e-commerce with U.S. customer, then the electronic signal sent by the U.S. customer might be a (direct) infringement of the US patent.

3. A foreign company addressing customers in the United States for e-commerce will also run the risk of being liable for contributory infringement.

Foreign companies will therefore be well advised (a) to be aware of the risk they run if they manifest themselves electronically in the USA and (b) to consider making active use of the new possibilities available there.

Patent attorneys active in the area of ‚e-commerce‘ are faced with the challenge of so partitioning patent claims that the claims thus formed portray the discrete intermediate stages (e.g. in client-server architecture) recognisable in conducting e-commerce business.²⁸

4. Desirability of ‚methods of doing business‘

The most important positive consequence of the extension of protectability to inventions which are concrete, tangible and useful, is that it allows the patent law to do what it is intended for in that new area: to stimulate innovation.

After software and biotechnology, the scope of the patent law is now being increasingly adapted to the less technological and – in the present case – the general economic developments which are oriented more

towards services business than material, industrial production. Innovators, and particularly small entrepreneurs starting up are given the opportunity of protecting their – often – only ‚assets‘, the intellectual assets, and hence gain the time and attract the funds to develop the idea and bring it to the market.

A large number of objections can also be adduced against the protection of innovations in the area of doing business:

(a) The prior art is poorly documented in the patent literature. The example of software-related inventions has taught us that it takes years before a good classification system is developed and there is an adequate number of examiners available and educated and trained for proper examination of the patent claims²⁹.

For the ‚business methods‘ invention as well, initially a large number of inventions will be granted which will later prove to be void, with all the consequences for the third party and the ‚presumption of validity‘ reputation of the (U.S.) granted patent.

(b) The patenting of ‚e-commerce‘ inventions stifles innovation because of the temporary monopoly that is established. Licences, ‚designing around‘ or own development (‚creative destruction‘) is the answer here. Any abuses can be prevented by anti-trust actions or compulsory licences.

(c) Patenting renders standardisation difficult. This is not an argument applicable specifically to patents relating to ‚methods of doing business‘. These considerations also play a part, for example, in the audio, video and telecommunications industry. In my opinion it should not be a problem provided that prior agreement is reached to the effect that a licence is to be granted, preferably under predetermined reasonable conditions, to each interested party where standardisation covers a patented solution³⁰.

(d) The inertia of the patent system is too great: both the time taken for granting and the maintenance of the patent are out of proportion to the speed of developments in this area. If, and to the extent that that is applicable in a specific case, patenting really is not an adequate means. I am also of the opinion that patent procedures, particularly in Europe and Japan, should be drastically shortened.

(e) International jurisdiction is fragmented. True. There is generally much room for improvement.

(f) There is often no inventive merit whatsoever underlying patents relating to methods of doing business. Of the ‚invention‘ in State Street it was said: ‚the invention amounted to no more than reciting the steps of performing the requirements of a regulation of the Internal Revenue Service‘.³¹ Personally, I find the latter the most fundamental and substantial objection to the granting of patents to software-related and methods of doing busi-

26 In an excellent review of the EPO case law on computer-related inventions, Newman submits, that the EPO does not put a sufficiently high priority on clarity and certainty in this difficult but important field. „Speed“ should in my opinion be added to that list. See J. Newman (1997) E.I.P.R. 701 at 707.

27 Richard Poynder, Patents, the World Wide Web and growing controversy, Derwent Information Newsletter, Dec. 1999.

28 More is to be found at: Robert R. Sachs, Patent protection for internet companies, <http://www.fenwick.com>.

29 The U.S. PTO recently created a new Class 705 for inventions in the new areas which is titled: Data processing: financial, business practice, management, or cost/price determination.

30 Standardisation without involving any intellectual property rights can under circumstances, also be viable as the open source software initiative (with *e.g.* the operating system Linux) proves.

31 Note 27, supra nr. 2.

ness. An objection that I share: if in fact the only new contribution of an invention lies in the performance of methods or techniques known per se on means known per se from software and network technology, then patenting should be refused because of lack of 'invention'. I would add the following general remarks in this connection.

4.1 Material requirement for patent protection: 'inventive step'

The criterion 'inventive step' or 'inventive merit' in the sense of 'not obvious to the man skilled in the area concerned' has greatly declined in importance and in actual fact the situation now is that an invention which has not been literally previously published in the literature qualifies as an 'invention' without any difficulty. This applies incidentally not only to inventions in areas under discussion here, but also applies more generally.

Patent Offices have become service-providing market-orientated organisations which grant patents at the request of their 'customers' and give the 'customers' the benefit of the doubt where necessary³². Patent Offices – and this must be said – have in recent years done their utmost, and successfully, to retrieve relevant patent literature, and particularly also non-patent literature, for their search examiners. The quality of the *novelty* examination has indisputably improved as a result. Testing against the other material requirement for patent protection, 'invention' continues to lag

behind. Reasons for this may be: pressure for examiners to achieve ('arguing with applicants costs time'), reliance on assumed self-correcting mechanism in the system ('opposition by third parties') and the prime idea of the reward principle (applicant gets 'his money's worth'). Whatever the reasons may be, the role of the 'inventive step' criterion has in the meantime become marginalised to insignificance.

4.2 Conclusion

Where most of the objections enumerated above can be surmounted or are of a transient nature, I am of the opinion that the actual and vigorous application of the 'inventive step' yardstick is a necessary condition to the patent system playing a stimulating and not a stifling role in the area of software and network technology and 'methods of doing business'. Patentees must be able to accept the fact that 'expert skills' cannot, but 'inventions' can be protected and that they can rely on the fact that a patent granted to them means that it has been granted rightfully and upholdable.

Equally, third parties must not drown in a flood of what subsequently largely prove to be 'trifles'. Legal security as to the validity of the patent is to the advantage of the patentee and 'third parties'. Society at large also benefits from this. Finally, the patent law is a law which attempts to provide a contribution to the economic order and planning and correct metering of the innovation stimulus is a determining factor for success.

The *epi* has published the contributions to the 1st CNIPA FORUM held in 1989 in a special edition of the *epi* Information. The 2nd CNIPA FORUM which took place in Milan in November of 1999 due to its program which centered around a mock trial did not result in contributions to be printed. However, the FORUM gave an excellent opportunity to present different views on the main topic: „The Patent Attorney in Court“. Since this topic and in particular the question of the representation of parties in court proceedings by European patent attorneys is also debated within the *epi* we are pleased to present as a follow up to the special edition of the *epi* Information the report of the Secretary General of CNIPA, Mr. Eugen Popp, on the 2nd CNIPA FORUM for your information.

Walter Holzer, *epi* President

2nd CNIPA Forum

in Milan on November 26, 1999

Pathway to the EUROPEAN PATENT LITIGATOR

E. Popp (DE)

With the poster below in the TRIBUNALE DI MILANO more than 300 participants were shown the way to the

2nd CNIPA-Forum in the Aula Magna of the impressive justice palace in Milan:

³² Patent Offices – and this must be said – have in recent years done their utmost, and successfully, to retrieve relevant patent literature, and particularly also non-patent literature, for their search examiners. The quality of the *novelty* examination has indisputably improved as a result.

CNIPA COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS

invital al Convegno

IL CONSULENTE BREVETTUALE IN AULA

VENERDI, 26 NOVEMBRE 1999

AULA MAGNA – TRIBUNALE DI MILANO

PROGRAMMA

9:00	INDIRIZZO DI SALUTO	Vincenzo Seriani Presidente Corte di Appello di Milano
9.10	DISCORSO DI BENVENUTO	Eugen Popp Segretario Generale CNIPA (Comitato Ordini Nazionali dei Consulenti Brevettuali)
9:20	DISCORSO DI APERTURA DEI LA VORI	Lise Dybdahl Direttore dell'Ufficio Amministrativo Brevetti Europeo
10:00	PRESENTAZIONE CASO DI NULLITÀ E DI CONTRAFFAZIONE BREVETTUALE (ESPOSIZIONE DEI FATTI)	Edward Lyndon-Stanford Vice Presidente CIPA – Ordine Britannico Consulenti brevettuali
10.30	COFFEE BREAK	
11:00	SIMULAZIONE DI CAUSA „CORTE“	Discussione e argomentazioni orali Massimo Scuffi RAPPRESENTATO DA: Giudice della Corte di Appello di Milano Sir Nicholas Pumfrey Giudice della Corte Brevettuale britannica Hans Marschall Giudice della Corte di Appello di Monaco di Baviera Claus Schülke Presidente della Corte Federale Brevettuale tedesca Gerhard Kadner Giudice Tecnico della Corte Federale Brevettuale tedesca Helmut Sonn Consulente brevettuale austriaco P. Robin B. Lawrence Consulente brevettuale britannico Patrice Vidon Consulente brevettuale francese Alexander Witte Consulente brevettuale tedesco Guido Modiano Consulente brevettuale italiano
	„IL TITOLARE DEL BREVETTO“ RAPPRESENTATO DA:	
	„IL CONTRAFFATTORE“ RAPPRESENTATO DA:	
12:45	PRANZO	
14:15	DISCUSSIONE DEL CASO SIMULATO CON IL PUBBLICO COMPRESA VOTAZIONE	
14:45	PRESENTAZIONE DELLA „SENTENZA“	
15:15	OPINIONE DELLA COMMISSIONE EUROPEA	Erik Nooteboom Capo del DG XV della Commissione Europea
15.45:	CHIUSURA DEL CONVEGNO MODERATORE	Adriano Vanzetti Professore di Diritto Industriale – Università Cattolica Milano Presidente S.I.S.P.I.

Obtaining such an eminent and distinguished group for the 2nd CNIPA Forum was the first key to success.

The material presented made the success complete.

Already in the introduction, Mrs. Lise Dybdahl, Director of the Patent Administration Division in the European Patent Office, welcomed the creation of a „*European Patent Litigator*“ along the lines of the British „*Patent Agent Litigator*“, initiated on November 25, 1999. The European Patent Attorney should receive the sole right of representation before the Court in both patent nullity suits as well as patent infringement procedures after a corresponding supplemental training in general law and, in particular, procedural law on a European basis.

The university training in general law, as it is required since January 1, 1999 from all German patent attorneys, certainly represents a good basis. A separate training in general law and procedural law is also required for the admission as a Patent Agent Litigator in England. Consequently, the education conditions in Great Britain are now very similar to those in Germany.

The comments of Lise Dybdahl, mirroring the view of the European Patent Office, were applauded by all of the participants and were supported in the various contributions made by the representatives of European patent attorney organisations, such as

- **Prof. Dr. Uwe Dreiss** (President of the German Patentanwaltsskammer)
- **Jean-Jacques Martin** (President of the Compagnie Nationale des Conseils en Propriété Industrielle)
- **Walter Holzer** (EPI-President and President of the Austrian Patentanwaltsskammer)
- **Edward Lyndon-Stanford** (Vice-President of the Chartered Institute of Patent Agents).

At the same time, it was always stressed by all of the participants that the patent attorneys in Europe would be prepared to accept a separate training in general law and in procedural law for the admission before Court.

Edward Lyndon-Stanford explained that in Great Britain a so-called „master course“ at the University of Nottingham will be established for the admission as „*Patent Agent Litigator*“. The course is primarily a remote university course combined with attendance on

at least six weekend sessions. This study is supposed to be available also to foreign patent attorneys.

Walter Holzer explained that he, as the EPI President, has set as a goal to set up such a European-wide advanced training. It remains to be seen, however, if this will succeed within the framework of the EPI. According to the present state of affairs, the national patent attorney organisations are primarily challenged to venture forth.

After the conduction of the „mock trial“, forming the core of the event in Milan, it was clear to all participants, in particular, the representatives of the European Commission, above all here, Mr. Erik Nooteboom (Director of DG XV of the European Commission), WIPO, as well as the European Patent Organisation, that patent attorneys are clearly capable of advocating without restriction both in patent nullity and patent infringement proceedings, that an Oral Hearing before a European-composed Court does not pose any language problem and that clearly through the inclusion of „Technical Judges“, it is possible to form a qualified judgement without the engagement of experts and consequently, the procedure becomes more time- and cost-efficient. The highly qualified and in particular, lively presentations of the participating patent attorneys as well as the representation of the participating judges for the judgement were most impressive and demonstrated how various legal cultures can be overcome and a new „pan-European“ legal culture can be created within the briefest of time.

CNIPA demonstrated a model for a European Patent Court with both legal and technical judges on the one hand and technically as well as legally trained patent attorneys on the other hand. It is an impressive model which will certainly remain as a topic of discussion. For this CNIPA requests the further support not only through its member organisations, but also through each individual member of these organisations.

At the end of the program CNIPA was asked to organise a 3rd. CNIPA-Forum next year in Paris. The EU-presidency of France should be used to gain more political support for the „*European Patent Litigator*“ within a new „*European Patent Court System*“ (in whatever form that may be).

epi-Tutorien 2000

Das *epi* bietet 2000 wieder Tutorien zur Vorbereitung auf die europäische Eignungsprüfung (EEP) 2001 an.

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

Der Sommertermin (Anmeldung bis spätestens 9. Juni 2000) ist für Kandidaten gedacht, die die EEP im Jahr 2001 zum ersten Mal ablegen wollen (vollständig oder in Modulen). Der Herbsttermin (Anmeldung bis spätestens 13. Oktober 2000) ist dagegen für diejenigen von Interesse, die ein Tutorium für die 2000 nicht bestandenen Prüfungsaufgaben wünschen.

Kandidaten, die sich für den Sommertermin anmelden, wird empfohlen, die Aufgaben von 1999 und 2000 nacheinander zu bearbeiten, um von den Kommentaren zu ihren Antworten auf die Aufgaben von 1999 für die Aufgaben von 2000 zu profitieren.

Die Daten für die Tutorien sind wie folgt:

	Sommertermin	Herbsttermin
Angebote Prüfungsunterlagen:	1999, 2000	nur 2000
Anmeldung bis spätestens:	09.06.2000	13.10.2000
Versand der Prüfungsaufgaben an die Kandidaten bis:	30.06.2000	10.11.2000
Eingang der Antworten auf die Prüfungsaufgaben 1999 bis:	01.09.2000	
Kommentare zu den Prüfungsaufgaben 1999 bis:	08.10.2000	
Eingang der Antworten auf die Prüfungsaufgaben 2000 bis:	10.11.2000	15.12.2000
Kommentare zu den Prüfungsaufgaben 2000 bis:	15.12.2000	19.01.2001
Besprechung:	Februar 2001	

Im Sinne eines reibungslosen Ablaufes der Tutorien werden die Kandidaten gebeten, sich an die angegebenen Fristen zu halten.

Kandidaten für den Sommertermin werden gebeten, sich sobald wie möglich, spätestens jedoch bis zum 9. Juni 2000 durch Rücksendung des nachstehend abgedruckten, ausgefüllten Formulars an das *epi*-Sekretariat (Fax Nr. +49 89 2021548), anzumelden.

Für weitere Auskünfte wenden Sie sich bitte an das *epi*-Sekretariat (Tel. +49 89 201 70 80).

epi Tutorials 2000

In 2000 the *epi* will again offer tutorials for candidates wishing to prepare for the European qualifying examination (EQE) in the year 2001.

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

The summer term (enrolment deadline 9 June 2000) is particularly for those candidates who are going to sit the EQE in the year 2001 for the first time (either in full or in modular form), while the autumn term (enrolment deadline 13 October 2000) is particularly devised for those candidates who wish to have tutorials for those papers which they failed in the 2000 EQE.

Those enrolling in the summer term are encouraged to do the 1999 and the 2000 papers in sequence, to benefit from the comments on their 1999 answers to improve their answers to the 2000 papers.

The tutorials will run according to the following timetable:

	Summer term	Autumn term
Papers offered:	1999, 2000	2000 only
enrolment:	09.06.2000	13.10.2000
Papers sent to the candidates by:	30.06.2000	10.11.2000
1999 papers, scripts in by:	01.09.2000	
1999 papers, comments by:	08.10.2000	
2000 papers, scripts in by:	10.11.2000	15.12.2000
2000 papers, comments by:	15.12.2000	19.01.2001
Meeting:	February 2001	

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

Candidates for the summer term are encouraged to enrol as soon as feasible, and by 9 June 2000 at the latest, by filling in and sending the form printed hereafter to the *epi* Secretariat (Fax No. +49 89 202 15 48). For further information, please contact the *epi* Secretariat (Tel. +49 89 201 70 80).

Tutorat epi 2000

En 2000, l'*epi* propose de nouveau un tutorat destiné aux candidats qui souhaitent se présenter à l'examen européen de qualification (EEQ) en 2001.

Afin de mieux répondre aux besoins des candidats, deux sessions de tutorat sont de nouveau organisées, l'une en été, la seconde en automne.

La session d'été (date limite d'inscription 9 juin 2000) s'adresse particulièrement aux candidats qui se présenteront à l'EEQ pour la première fois en 2001 (soit à l'ensemble des épreuves, soit par modules), tandis que la session d'automne (date limite d'inscription 13 octobre 2000) est spécialement conçue pour les candidats qui souhaitent un tutorat concernant les épreuves auxquelles ils ont échoué à l'EEQ en 2000.

Il est recommandé aux candidats qui s'inscriront à la session d'été de traiter les épreuves de 1999 ainsi que celles de 2000 afin de profiter des commentaires relatifs à leurs réponses aux épreuves de 1999 pour améliorer leurs réponses aux épreuves de 2000.

Le tutorat se déroulera selon le calendrier suivant:

	Session d'été	Session d'automne
Epreuves proposées:	1999, 2000	2000 seulement
Inscription:	09.06.2000	13.10.2000
Envoi des épreuves aux candidats le:	30.06.2000	10.11.2000
Epreuves 1999, envoi des réponses, le:	01.09.1999	
Epreuves 1999, commentaires retournés le:	08.10.1999	
Epreuves 2000, envoi des réponses le:	10.11.1999	15.12.2000
Epreuves 2000, commentaires retournés le:	15.12.1999	19.01.2001
Réunion:	février 2001	

Il est rappelé aux candidats de respecter les dates indiquées afin d'assurer un déroulement fluide du cours.

Les candidats qui souhaitent participer à la session d'été sont invités à s'inscrire le plus rapidement possible, au plus tard le 9 juin 2000. Ils sont priés de retourner le questionnaire imprimé ci-après, dûment rempli, au Secrétariat de l'*epi* (Fax no. +49 89 202 15 48). Pour tous renseignements, prière de s'adresser au Secrétariat de l'*epi* (Tel. +49 89 201 70 80).

epi looks for tutors

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

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

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

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

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

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

epi Secretariat
Tal 29
D-80331 München
Tel: +49 89 201 70 80
Fax: +49 89 202 15 48
e-mail: info@patentepi.com

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

.....
.....

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

- a national examination

- the European Qualifying Examination:.....

Years of professional experience:

Would you be willing to travel to meet your tutors?

.....

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

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

.....

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

Date:

Signature:

Name:

Special notice from the By-laws Committee relating to the reimbursement of Associated members expenses

For the purpose of increasing the involvement of *epi* members in the work of the *epi* Committees, and to construct a „reservoir“ for the future recruitment of full members, the concept of „associated members“ of Committees was recently developed. That concept was adopted by the Council in the Florence meeting of 1999.

Basically, each associated member is appointed by the relevant Committee and receives a copy of all documents which are normally transmitted to the full members. The associated members have the right to file submissions with the Committee on all questions which fall under its terms of reference. Normally the associated members do

not need to attend the Committee meetings and are not reimbursed for attending such meetings. However, it should be noted, that the By-laws do not prohibit, and therefore allow, Chairmen of Committees to invite guests, be they members of the Institute (such as associated members) or experts chosen from outside the Institute, such as, for instance, officials of the EPO, WIPO or national patent offices. *This interpretation has been confirmed as correct by the By-laws Committee.* The Committee Chairmen's invitation may or may not cover the reimbursement of a guest's expenses.

Secretariat office

Wie Ihnen mittlerweile bekannt ist, ist das *epi*-Sekretariat umgezogen und befindet sich nun im Tal 29, nur zehn Minuten Fussweg entfernt vom Europäischen Patentamt als auch vom „Isartor“.

Im Falle, dass *epi*-Mitglieder während ihres Aufenthalts in München die Büroräume für eine Sitzung oder einfach für eine Pause nutzen möchten, bitten wir Sie, dies dem Sekretariat rechtzeitig im Voraus mitzuteilen.

As you all know the *epi* Secretariat has moved into its own offices and is now located in Tal 29, close to the European Patent Office – only 10 minutes walk – as well as to the „Isartor“ station.

epi Members who would like to use the premises at the Secretariat for a meeting or to rest temporarily when passing through Munich should advise the Secretariat in advance.

Comme vous le savez tous, le Secrétariat de l'*epi* est maintenant installé dans ses propres bureaux, à proximité immédiate de Isartor, Tal 29, à seulement dix minutes à pied de l'Office européen des brevets.

Les membres de l'*epi* qui souhaiteraient utiliser les locaux du Secrétariat pour une réunion ou pour y faire une halte lors de leur passage à Munich sont invités à en informer le Secrétariat à l'avance.

epi Art Exhibition

The 5th Exhibition of *epi* Artists takes place from 13 to 31 March 2000 in the EPO main building, 1st floor in Munich.

The following participants from Belgium, Finland, Germany, Great Britain and the Netherlands display their works of art:

Ernst Anders, Jörn Anritter, Klaus Hoffmann, Sheila Kerr, Tero Laako, Gunnel Lönnqvist, Pieter Eveleens Maarse, Dominique Monéger, Johannes Raß, Andrea Schrickler-Laufhütte, Johannes Spies, Laetitia Van De Werve, Roland Veith.

A brief report will be published in the next issue 2/2000.

Erinnerung · Reminder · Rappel

Der *epi*-Jahresbeitrag für 2000 beträgt DM 300,-. Er erhöht sich auf DM 350,-, wenn die Zahlung nach dem 30. April 2000 eingeht.

The *epi* annual subscription for 2000 amounts to 300 DM. It is raised to 350 DM if it is received after 30 April 2000.

La cotisation annuelle *epi* pour 2000 est de 300 DM. Elle est relevée à 350 DM si le versement n'a pas été effectué avant le 30 avril 2000.

Erratum

Report of the Harmonisation Committee (at page 137, second column, of 4/1999).

For correcting a typographical error, the asterisk (in penultimate line of last paragraph

of item A should be replaced by 3/4). It should then read: „ ... by a 3/4 majority“.

Redaktionsschluß für
epi Information
2/2000

Redaktionsschluß für die nächste Ausgabe der *epi* Information ist der **5. Mai 2000**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for
epi Information
2/2000

Our deadline for the next issue of *epi* Information is **5 May 2000**. Documents for publication should have reached the Secretariat by this date.

Date limite pour
epi Information
2/2000

La date limite de remise des documents pour le prochain numéro de *epi* Information est le **5 mai 2000**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

VESPA

Verband der beim Europäischen Patentamt eingetragenen freiberuflichen schweizerischen Patentanwälte

VIPS

Verband der Industriepatentanwälte in der Schweiz

organisieren auch in diesem Jahr wieder ein

PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2001

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

Aufteilung des Kurses

Modul 1

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

Modul 2 (zusammen mit Modul 3)

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

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

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

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Disciplinary bodies and Committees · Organes de discipline et Commissions

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*Chairman/ **Secretary