

Table of contents

Editorial	2	<i>epi</i> Disciplinary bodies and Committees	43
Interview with the President of the European Patent Office, by the Editorial Board	3	<i>epi</i> Board	U3
I – Information concerning epi			
Conference on the Revision of the European Patent Convention, by F. Macchetta, W. Holzer, S. Le Vaguerèse.	12		
European Qualifying Examination			
<i>epi</i> Tutorien . <i>epi</i> Tutorials . Tutorat <i>epi</i> 2001	14		
Extranet	18		
Information from the Secretariat			
Erinnerung · Reminder · Rappel	15		
Corrigendum	15		
Binders for <i>epi</i> Information	20		
Deadline 2/2001	41		
Prüfungstraining für die europäische Eignungsprüfung 2002	42		
II – Contributions from <i>epi</i> Members and other contributions			
Reports and Information			
The European Patent Litigator. A Presentation made at the CIPA Congress 2000, by E. Popp	21		
Pressemitteilung des Deutschen Patent- und Markenamt	25		
Electronic Filing, by J. Bambridge	26		
Articles			
Economical with the Law - Is there a Case for removing Computer Programs from the List of non-Inventions ?, by R. Jehan	26		
Some Observations on the controversy on „Software Patents“, by A. Horns	31		
Implications of recommendations in the Guidelines concerning the use of Rule 45EPC, by D.R. Terrell	36		
Preliminary Review under Rule 40.2(e) – Remuneration only!, by M.A. Störzbach	39		

Editorial

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

This month's edition was intended to be a special edition devoted to the European Patent Office itself. However, because of both a lack of different contributions relating to the European Patent Office combined with a surprisingly large number of contributions on other matters, the usual variety of topics is covered.

The centrepiece of this month's edition, however, is an interview held with the President of the European Patent Office. As the introduction to the interview makes clear, this is not an official interview between the *epi* as an Institute and the President but, rather, a more informal meeting between a member of the *epi* Editorial Board and the President of the European Patent Office.

The message that comes from the interview is clear. The European Patent Office wishes to work with attorneys in an attempt to improve the performance of the European Patent Office in granting Applicants a fair prosecution of their Application and in ensuring the best possible service in granting patents. To that end, communication between the relevant members of the European Patent Office and members of our profession is emphasised.

It seems clear that such regular communication can only assist both parties in understanding the problems facing their counterparts.

At the same time, both sides must understand the constraints imposed upon the other. It is clear, from the interview, that the European Patent Office wish to help Applicants, but only within the legislative framework allowed to them. They also have other considerations, not least the interests of third parties as well as political pressures which inevitably come to bear upon such a large organisation.

We, of course, are aware of the constraints placed upon us by our clients, notably with regard to commercial pressures both in cost and time. It seems that friction most often arises when clients' commercial needs are not met by the European Patent Office due to the legislative framework within which the Office is forced to work. An appreciation that the European Patent Office employee is not necessarily being difficult because they happen to enjoy it, would always assist matters!

Finally, the thanks of the Editorial Board go to the President of the European Patent Office for his kind agreement to hold the interview, for the time he gave to the discussion and the care with which his answers were considered.

Interview with the President of the European Patent Office



The following is an interview with the President of the European Patent Office held on 16 January 2001. The interview was conducted by a member of the *epi* Editorial Board (EB) and was not conducted as an official exchange between the *epi* and the President of the European Patent Office, Mr. Ingo Kober (IK)

but, rather, as an exchange of views between the President and a representative of the profession.

As such, the questions were designed to focus on matters of interest to those in the profession rather than of more formal interest.

Also in attendance at the interview were:

Mr. Bertil Hjelm (BH), Principal Director, Physics/Electricity in Directorate General 2

Mr. Gert Kolle (GK), Director, International Legal Affairs in Directorate General 5

EB There seems to be a sharp increase in cases filed at the EPO. How is the Office coping with the workload? It seems to us that there are increasing delays in issuing the first communication on European patent applications because priority has to be given to PCT applications.

IK I would like to start with some background. As you rightly say, the workload at the European Patent Office has increased throughout the years, especially during the last five years. I have here some key figures produced by the Office. Applications are up from 79,000 in 1995 to just over 142,000 at the end of 2000, which means an increase of almost 80%. At the same time our staff increased from 3,670 to 4,640, which is an increase of 26%. If you put these two things together, this is already part of an answer, but, of course, I am going to elaborate on that a little bit more. It is very important to note that from 1995 to 2000 our overall production rose by 30%, the productivity of our core products, which are searches, examinations, oppositions and appeals, rose by 12% and simultaneously unit costs went down by 12%.

What these figures show clearly is that, to use a very trivial wording, you can't have it all. Certainly not simultaneously. What we find is a remarkable change in something which I like to call the „Philosophy of patenting“. If you consider the situation ten, fifteen or even twenty years ago, people had a different approach vis-à-vis protection of intellectual property in general and protection of inventions, i.e. the grant of patents, in particular. Today we find that there are lots of people who think they

should protect their invention, for a number of reasons which didn't exist fifteen or twenty years ago. For instance, today it seems to be considered advantageous to have a large portfolio of patents, much more than was the case in the past. This is a cultural development and is, of course, not limited to the European Patent Office. This is also something which happens in national offices. I do not need to mention them, but our neighbour here [in Munich] suffers more or less from a similar phenomenon – although of course, I would not like to compare the German, or any national Office, with the European Patent Office.

It is also clear from these figures that if, within five years, we have an increase of some 80% in terms of applications and an increase of 26% in staffing levels, there is an apparent gap. Now we have tried of course to close this gap, and we are still trying very hard to do so. Our productivity increase over the last five years is twelve percent, of which about 8% alone stems from the last two to three years. So productivity is increasing and the 12% over the five years doesn't give the correct picture, in the sense that the curve is becoming steeper.

We have a number of problems where we are obliged to find our way between conflicting interests with regard to our work and also with regard to the users.

First of all, it is clear that we have a determined policy of study and smooth recruitment. We can't recruit as many as we would like to for a number of reasons, first of all because they simply don't exist to the extent that we need them, they don't exist in the structure that we need them and they don't exist in the sense that the European Patent Office is not the only employer in the relevant technical fields. We are in direct competition with the private sector which is in need of exactly the same people we need, especially in the „hot“ fields. The fields where our peak problems are, these are exactly the fields where the users, the applicants, want to file their applications, which leads to a situation which I need not elaborate on further. We have to deal with it and we are dealing with it. We have clear recruitment programmes/schemes over the years.

I have to add that recruitment was stopped for a number of years before I came here. There was practically no recruitment between 1992 and 1996. At the time the workload was decreasing. The problem was that the time when the motor should have been restarted was not properly identified, which led to a disruption in the smooth development of the Office's work schedule. This led to the Office being obliged to recruit hundreds of examiners within a relatively short period of time. If you take figures over two, three, four years, our recruitment targets have been more or less met, i.e.

roughly 90% – 95% of our target has been achieved. Now the problem is not only that we must appoint these people, we must be able to train them properly too. This is the point which has repercussions in terms of recruitment policy and in terms of professional training within the Office. This has an impact on pendency times for two reasons. First of all, our staff complement looks much bigger than it used to be, but the working capacity does not reflect this picture one-to-one, because new examiners need training and in our case they need three years' training. On top of that, who is going to train them? It's the most experienced examiners we have who are obliged to function as tutors to newcomers. This leads to the phenomenon which we call, in our jargon, the „learning curve“. The learning curve means a deduction in production as well as in productivity because of the efforts which we have to take internally in order to train our new people.

So that describes the situation as it is. What are we going to do? I have already mentioned recruitment, which is a policy for the medium term. We will go on recruiting able people but we are also, to a very large extent and very intensively, busy modernising our Office internally.

I would like to give you some examples. I think we can claim to be at least amongst the forerunners, and I think within Europe we are certainly the forerunners, in terms of technical development. I do not think that there is any national patent authority in Europe which equals the European Patent Office with respect to modern machinery, search tools and the like. As an example, I would just like to mention EPOQUE. So the modernisation in terms of working technology is one of our goals all the time and I think we are doing a lot, successfully.

Then we try to call on the expertise and the goodwill of our staff. As an important example, last year, the management invited the staff at the EPO to take part in something called the Broad Consultation Process. That is to say, everybody was invited to put forward ideas. If thousands of people put forward their ideas without organisation, you will end up with chaos, so the process was, of course, structured. It was structured in the sense that the discussion on the proposals was held at three levels. Level 1 was where everybody was welcome and could propose whatever they wanted. These proposals then were discussed, sorted out, evaluated and assessed. This was done by discussion, and this was an exercise which was not dominated by the management. The impetus came from the staff themselves and they were very keen on it. So these ideas, these proposals were condensed into three levels and in the third level what had not been refused in the other two was then prepared for submission to the top management for further consideration and decision. I think this shows a deep willingness on the part of this Office to face

problems. We also use political instruments in order to make progress, not least with respect to our workload. As an example, I would like to mention the relevant parts of the Diplomatic Conference, which was held at the end of last year here and which had a number of very interesting and very promising results. One of the most important concerns BEST. BEST, at that conference, received the „baptism“, if you like, which it needed in order to be implemented Office-wide on an indisputable legal basis. As you know, it has so far been introduced in the form of a provisional project. It is an important point that the Office-wide implementation was largely called for in that broad consultation process, so our staff is fully in favour. If you look round our Office, you will also find that people on an individual basis wish to work with BEST and I think that is also a good sign for the future. Our position vis-à-vis PCT Chapter II work, where one of our big problems lies, is one I would like to reserve for later in the course of our discussion.

EB Firstly, I think the reasons more people are patenting is because they are now more aware of the importance of intellectual property, and obviously the Patent Office has had a major say in bringing that awareness to people. The other comments I would make, with regard to recruitment and the learning curve, is that I believe you will receive sympathy from our profession, because we are facing exactly the same challenge. The increase in demand has affected us, as it has you. We have done the same thing and we are all aware how difficult it is (a) to get decent candidates and (b), once we have got them, to bring them to a stage where they are actually producing more than they are using up in attorney time training them. You say that you would like to talk about the PCT II later. I wonder if we could deal with it now.

IK This is something which is now under discussion. We are discussing it within the Office internally in order to find out what could be done. The problem is that, in the field of PCT Chapter II, the Office is doing more than it is obliged to do. We will stop this, we just don't know to what extent, that's all. Of course we cannot stop it just like that, we will follow the proper route, that is we will submit the ideas to our political bodies. We will certainly submit our ideas to SACEPO in order to have the users on board with us.

I am coming back to what I said at the beginning. One thing is certain and that is that you can't have it all. In the present circumstances, we have to strike a balance between having the European patent cheap, fast and of high quality. However, we have no intention of compromising on the quality of our final product, the European patent, but there are certain intermediary products such as preliminary examination reports and there is also sometimes confusion between quality and perfectionism. The choice which will be made should be prepared and

discussed with those who receive our services, because what they want and what they think is very important. We have always taken it very seriously and we will continue to do so in the future. However, we are unable to do the impossible (which some people think we could or even should do) but that is something which we will explain, because there is a problem there, and that is there is no prospect of a decrease in quality. The solution to the problem that we are looking for should not affect quality, but it has to do with political and legal obligations and our capacity to do our work, and this has to be balanced out in a proper way.

EB My second question is something you touched upon in your last answer and it's to do with the electronic age. How has the European Patent Office approached entry into this age and what future steps does it envisage to further embrace the role of technology?

IK Firstly, I would like to emphasise, as I have already said, that the EPO is amongst the forerunners as far as technical development is concerned in this specific professional sphere. I would like to give you some examples. First of all, years ago the European Patent Office started to develop working tools which are unique, for instance EPOQUE and BNS.

But, of course, we did not rest on our laurels. Work went on and our project to modernise the Office technically continued. Two and a half years ago I started a project which covers large parts of the overall activity not only of the Office but also of the users. The name of the project is *epoline*[®]. *epoline*[®] means that everything from submission of the application until the very last fee invoice can be done electronically to a very large extent, if not up to 100%. We are now at the beginning of this development in practice. As you might know, in December last year the first electronic filing was deposited with the EPO.

We are all very keen on making this system run perfectly, for the benefit of the users, but we are not Samaritans! I mean we are not only working for the benefit of others, we must also look at our own needs, so we must also modernise and facilitate our own work and we are pretty sure that *epoline*[®] will also contribute to that end.

Another point which I would like to mention in that respect – the electronic age – is *esp@cenet*[®], which is a project which was initiated by the European Patent Office, one might say spontaneously, about two and a half years ago. It was developed in six months by the Office together with the member states, which is not an easy exercise in the sense that it is not easy to develop a project of such a complexity together with between ten and twenty partners. This is especially so if you take into account, for example, that all the menus for *esp@cenet*[®] are in national languages and these of course also had to be developed, on top of the basic development of the whole technique.

So this is another example of the EPO's activities and interest in fully sharing the benefits of modern technology and we will follow this path. We are obliged to follow this path because otherwise we will leave others by the way and we will be unable to cope with our work. Even I have now started, in my old age, to learn to use a computer.

EB Certainly, when European patent attorneys meet and they talk about the European Patent Office, perhaps the most regular complaint that they all have is that they have experienced a lack of consistency between practices and approaches of Examining Divisions and of Appeal Boards. It's obvious that in such a large organisation, particularly with so many strong personalities that you cannot get absolute consistency. I wonder if it would be possible to explain what system exists within the Office to attempt to ensure, as far as possible, that there is quality control and consistency of approach.

IK Well, in the first instance, I would like to recommend that patent attorneys talk to the European Patent Office about it instead of amongst themselves. The crucial point is, is it true, is there an inconsistency which one can really demonstrate, which you can really prove? I will use a little joke: you know, a man loses a case and turns to his attorney. The attorney tells him „Now look, justice won“. And the man says „Lodge an appeal“. You know, if it's not what you have been expecting or wishing for, it might look a bit more inconsistent than if it is exactly what you have been expecting, because things we expect look very consistent, especially in legal matters.

Now this is more of a philosophical nature if you like. Let's go into the practice. The practice is first of all that our Examining Divisions and of course the Opposition Divisions are as a practical matter bound to follow the case law of our Boards of Appeal. This is sure, and this guarantees to a large extent consistency.

EB There has been some debate as to whether case law of the Boards of Appeal is in fact binding, or whether it is merely persuasive.

IK Well, that's a good point. In most cases of that sort, the Examining Division and the Opposition Division may understand it in a different way, but then they will be corrected if the Board of Appeal feels, after an appeal has been lodged, that they misunderstood the case law. I have taken the example of the neutral – you know, somebody who thinks he can impose his legal or technical findings instead of what has been decided by case law. These cases need reflection because, as a general rule, you may disagree, but if you look into the individual case you must listen to the examiner's explanations, why he didn't like it, and he may provide something in there which gives reasons for diverging from the case law. To come back to the crucial point, the crucial point is that judicial review is here to control the adminis-

tration, which is the granting of patents and the handling of oppositions. I think that is to a very large extent understood and accepted. As long as I don't see concrete examples where somebody claims specific inconsistency, it is difficult for me to take a general position. On top of that, I can't find any evidence of inconsistency because inconsistency is just another term for lack of quality. If it's not consistent, it can't be good quality. As far as our commodity is concerned, we have a number of control mechanisms. We have the control mechanism of our Harmonisation and Quality Directorate, so we have a directorate which is monitoring quality all the time. Secondly, we have the response of the users in the user satisfaction surveys, the results of which are very satisfactory.

We also have the other parameter of the case law in national courts. If we compare the ratio of patents revoked in full or in part at the European level with national patents revoked fully or in part at a national level, we find ourselves in a very good position. We are at least at the German level, which is acknowledged to be a good level. It could perhaps be better, but that is a reasonable point of reference. I do not claim that things are ideal but what I do claim is that we can defend our level of quality in respect of consistency of our decisions. It is clear that if you have to discuss a matter with an examiner, and an office has thousands of examiners, there might be things that vary slightly, but that is to be expected.

EB A couple of points, firstly with regard to the user survey. Hopefully, if we are doing our job properly, the users will be reasonably happy because any problems are dealt with by their attorney. Secondly, often the inconsistencies are small points, for example when you go into an oral proceedings, having been to five others where they have dealt with a pair in one way and, suddenly, the Opposition Division takes a different approach to that to which you have become used.

You said we should talk to the EPO if we have any problems. The difficulty with that, as an attorney, is that most of the problems that one has will be with the Examining Division. I don't like to complain unless I really feel it is necessary because otherwise you just get a reputation.

EB That way, when you do complain, then people realise that you might be justified. I am not too sure who to complain to. If I do complain, it's to the head of that particular Directorate, but then I am always concerned that it will go back to the examiner and the next case I have with the examiner may be unconsciously prejudiced. How do we complain without upsetting anybody?

IK There is a misunderstanding here! I was not recommending complaints. What I was recommending is to contact the examiner. One should not talk about an examiner, one should talk with the examiner.

As I see it, the examples to which you are referring are concerned with the perception that if one complains about an examiner, to their Principal Director, this will result in a black cross in the box by one's name. This is something which I cannot accept. Furthermore, if an examiner gives you the wrong answer, you lodge an appeal and then it will be corrected. If you take a judge, in a court, and he is judging against you, either his judgement is correct or the court of appeal thinks it is not correct. We have a procedure which is clearly defined in the law. It does not *guarantee* truth, it does not *guarantee* justice, but it guarantees a judgement and that's how life is.

EB I think again the problems that tend to be discussed in that way tend not to be interpretation of substantive law, more procedural. In those cases, the difference between the analogy with the judge is that the judge is sitting there listening to two sides and deciding which one is correct. We are arguing with the examiner and he is a combination of the judge and the opponent other side, which makes it more difficult.

IK Also in opposition.

EB In opposition, people tend not to be so worried because the Opposition Division are primarily just the judges and they are listening to both sides.

IK That is an interesting point. If you are referring to an examiner, you are dealing with Administration. The member of the Administration gives his view, at his own risk. If he is wrong, this will be noted, at least if you react. If you don't react, it passes unnoted. If you react, the matter will be looked into by a superior body or an internal supervisory organ, i.e. the Opposition Division. If you are not pleased with that, lodge an appeal and then you will have a finding by the Board of Appeal. So no examiner ultimately is able to have an impact which is not within his legal competence.

EB A point I have made to examiners in response to this argument is that, from the point of view of the applicant, there is a large appeal fee, there is a large increase in terms of costs and time in prosecution, and if the Appeal Board find in your favour, the case merely reverts to the first instance. So, if you can't persuade the examiner, you *have* to appeal and your costs go up and the time taken in prosecution goes up. This appeal is something that we avoid, if we possibly can, because many applicants can't afford the time and expense,

IK You have just neglected one aspect and that is the risk aspect. You, as a patent attorney, could go to a client and say we lost because that examiner didn't understand a thing about it, but if you lodge an appeal, you will win the case. The point is, are you sure in the given case? When every attorney gives advice to his client he must also assess the risk and the balance between the risk and what is at stake, of course. It is not only that, if the examiner is wrong, the poor applicant is unfortunately unable

to defend his right. He is able to defend his right, but he is also obliged to take a risk, which is always linked to defending one's right.

But one should not blame „stupid examiners“ for not granting, for making errors. They are subject to mistakes like everybody else and at a pretty small rate, at least if I measure it by the number of corrections by further instances. There is a certain rate of mistakes, which is part of the system and mistakes have to be corrected according to the system. The discussion would then have to revolve around the fundamental question of whether the system is fit for dealing with these conflicts if there is no common understanding between the examiner and the applicant and/or his representative.

EB The discussion has focused on this point but I don't want it to sound like we are unhappy with the majority of the examiners. The problem is that at least 90% of the time we have no difficulty with the examiners. One of the problems you have with PCT requests arises because many applicants from around the world come to the European Patent Office because they believe it is the best examination system and expect 100% consistency. As ever with these things, you do 100 cases and 98 of them go smoothly – you are able to negotiate. But you only ever remember the two that don't!

IK I am very grateful you are saying that. I think it's very good saying that the vast majority of things that are going smoothly are passing you by. That's what you expect. Those two or three per cent which do not go as you think they should will inevitably rankle.

EB The point you made that there are errors and there are occasionally inconsistencies is appreciated. The overall purpose was to confirm that you have these mechanisms in place, which is what you have done.

IK I should add that, in cases where I am addressed personally by an applicant or his representative, I pursue the issue personally. That is to say, I insist on a report to me.

EB Are you sure you wish me to put this in here?! (laughter)

IK Yes, I think people know this. It's not many anyway, but the possibility does exist. What I want to say is that I take a personal interest and am really tough on that. I do not accept easily explanations of the sort – you know, we are all only humans and things happen from time to time. That's not enough.

EB Thank you for that. The next topic is on communication between members of the EPO and attorneys. Sometimes EPO staff members will have discussions, off the record, about the way we work. I learn a lot from these about what annoys and frustrates them about the way some attorneys practise. This enables me to do my job in a way that doesn't annoy the examiner as much as it might. Equally, they find out what examiners do that drive me up the wall and that are not necessary. As far as I am concerned, this is one of the most important aspects of my visits to Munich, finding

out about how the individual members of the Office do their job. I wonder if there are any other fora that exist for such an exchange of views and information.

IK This is, in a sense, a „masked“ problem, because we do have such mechanisms but for the time being, and to an increasing extent, it is getting more difficult to make use of them in concrete terms. We have the „Praktika intern“, where we invite young patent attorneys to join the Office for a number of months and to work under the guidance of the well-experienced senior examiners. People tell us it is very useful for them and is borne out by the fact that there are lots of applications to participate in this programme. I think it's not only useful for the young attorneys. I think it is also useful for the examiners because they are in direct contact with young people from the other side of the profession, which is always an important exercise. We have, on the other hand, examiners joining industry, sharing knowledge and being trained in industry. This offers an insight into areas to which normally, as an examiner, you don't have access. Last but not least, we have on a pretty regular basis work visits by our examiners, who are invited to all sorts of enterprises in Europe and overseas. These are visits which take a week or so. The examiners are shown recent developments in very specific fields. Of course, we send examiners who deal with that technology in order to deepen their technical expertise. All these occasions are also used for an exchange of views between examiners in that field and the applicants.

The point is that we continue at the same level with respect to these work visits. Statistically, an examiner has a chance to go on such a work visit every two to three years, in that order of magnitude. But as far as both the Praktika intern and the external training periods are concerned, it's now a bit of a problem, because we need our people to do their jobs. We cannot afford to lose either trainers or trainees. For information, I have recalled more or less all the examiners seconded elsewhere. Of course, you can't recall *all* of them because there are certain projects which cannot work without such examiners, in the area of technical co-operation or international co-operation. These are people who are sent abroad to implement certain techniques using special knowledge, for example in new or developing patent offices. There are other instances where it really hurts to call them back, but we still have to do so. This is the present policy but we hope that in the medium to long-term we will be able to be a little more generous again.

EB How about in a more general sense? One purpose of this interview is to try and demystify the workings of the European Patent Office. For many attorneys, it is just this big building where you go and you sit in front of examiners. You don't understand how it works or how they think. It seems to me that, for

example, a regular exchange of articles and publications would be of help.

IK Yes, I think it would and I would encourage all sorts of meetings or fora. This is less time-consuming than exchanging examiners all the time. We have a lot of reasonably prepared fora for discussions but it's not enough and perhaps not focused in an optimal way.

I would say the one forum is SACEPO, but I wouldn't limit such exchanges of information to formal bodies like SACEPO. We have meetings with lots of people. Tomorrow we will have FEMIP here and we will have FICPI soon. We have people of all groups all the time, but the point is that what is discussed there is mostly of a political nature. It is certainly not examination matters, and it's certainly not what you and your colleagues are dealing with in your practical work with an examiner. It can't be done here because I think that certainly I, but also others here are not experienced in examining. We do not do that sort of work and the purpose of these meetings is of a different nature. What I would like to consider, together with *epi* and others, is how we could perhaps establish a practice of discussion which embraces the work at a more practical level, in a well-balanced way, of course, because we can't spend our day arguing! One must find the right balance. Discussion is useful, especially if it is well-prepared.

EB I absolutely agree with you. I think on both sides it is beneficial because from my client's point of view it enables a great deal of time and money to be saved. It means we don't pursue fruitless paths, things that are not going to work and things that are just going to antagonise the examiner and make it more difficult for them.

IK Can I add one thing? It would be nice to have more contact. I really advise you to try to establish personal contact with the examiner whenever you can, not to discuss big things, but based on the actual facts. Whenever there is anything in a communication of which you are not 100% sure, instead of starting to write long replies, pick up the phone.

BH What happens if you phone an examiner? I think it's very, very important to have this personal contact. What happens if you do normally?

EB Well, it depends on the examiner, of course.

BH They are not interested?

EB Some don't want to talk, but most of them are more than amenable. Often what happens is you discuss the point and then you go on to something more general. The example that springs to mind is when I have a discussion sometimes about any informal interview with an examiner. There are some examiners who do not like informal interviews and I have discovered, from such general discussions, that this is because some attorneys have behaved appallingly. They walk in with four or five people and they have ended up shouting or trying to bully the examiner, which is appalling behaviour. Therefore,

the examiner in future doesn't want to conduct informal interviews. Often, by the time I have made relevant assurances about the conduct of the interview, they will accede. Talking on the phone about a point, to say „Can we just sort this out?“, is much easier. That way has been very beneficial and I agree with you, I recommend that to anybody training with me.

EB There are occasions where there appears, at least to us, to be an internal change in practice or procedure. We only ever see it once we start seeing the official letters coming out. Firstly, is it true that there are certain internal guidelines issued every so often? If so, is there any reason why the users of the system such as the attorneys don't get to see them?

IK I would like to make a distinction first. There are changes due to certain decisions coming from the Boards of Appeal. For these, I say frankly that it is the duty of the patent attorney to be aware of these decisions. He is obliged to know that, at least to the extent to which it is published in the Official Journal.

If it comes to changes of practice, or instructions to the examiners, that's a different thing. In that regard I would like to emphasise that the Office has always pursued a very open and transparent policy. You will never find something implemented by the Office by stealth, you know, something telling my examiners, „Tomorrow morning I will do this or that but please don't talk about it“. What does happen is that somebody may come up with a proposal. This may come from, for example, the executive arm of the Office, DG 2 or DG 1. It may come from DG 5 legislative preparation. The proposal is submitted to the Management Committee of this Office. There is no decision of relevance which is taken and exacted in this Office which has not passed through this Committee, at least not since I have been here. We have a regular meeting each month where everything is discussed. If we agree that the proposal is a good idea, it is prepared for the consultative bodies. We do not decide anything of relevance to the users without having it submitted to everybody relevant for discussion. We do not always decide to do what people like, of course – that is a different thing. We just don't take them by surprise, because that would be unfair. If you can, show me a point where you feel that the public, the applicants or anybody has been prejudiced by the Office taking a course of action which we should not have taken.

EB Oh, I don't think that that is the case. It's just that sometimes you will notice a trend in communications issuing suddenly at points. I think it happened a few years ago when suddenly examiners started citing clarity objections and then it settled down.

IK An office of this size is a huge organisation. In the Principal Directorates, with many examiners, there are always questions coming up. They are constantly under discussion. A particular subject may be discussed and this comes to the attention of the

directors. The principal director meets his directors every month or every two months and then it is discussed and they come to a conclusion. This is not an official instruction, but just a self-regulation of the Office.

It may also be that occasionally some things are applied in practice before they are reflected in the Guidelines. We have a body, the DG 2 Patent Practice and Procedure Committee, where all these things are discussed. It might be that a particular point is agreed and at the same time it is translated into the draft Guidelines, but it may be a while before the Guidelines themselves are published and brought to the attention of the public.

EB Sometimes a point of interpretation or conventional practice is in dispute between the Examining Division and the applicant and there is no Board of Appeal decision on it. The Examining Division would like a Board of Appeal decision on it and so they are minded to refuse the application, so that the applicant appeals. The Examining Division has then found that the applicant hasn't the money or the time to appeal and the application has been refused. Are there any plans to allow a process whereby an Examining Division may refer a case to the Board of Appeal to obtain a decision?

IK Let me answer again with an example. This is true and I knew the colleague concerned. It was a young magistrate who had to come up with a judgement on a given case. One day he wrote a letter to the president of the court, annexing the whole file, which was a pretty thick file, saying that for the problem in that case the law did not provide any solution, so he was unable to deal with it. You know what happened? He was fired.

There is no situation where somebody who is called to judge upon a legal or technical question says, „I can't answer it“. If you meet a situation which has not been decided, so it is unclear in legal or technical terms, you have to ask for a decision. If the one who is responsible for the decision does not feel in a position to decide in your favour, he will decide against you. You have the instrument of appeal if required.

The mechanism of asking for advice is a mechanism which we do not envisage introducing because it would be very much to the detriment of a number of people involved. First of all, we must consider third parties in the same situation. We would have to delay their cases until the recommendation comes. Then, of course, the recommendation is still just a recommendation and it's not binding. So it is still not certain whether the Examining Division will be convinced at all! Thus the process will take longer and it may yet lead to the same result, after advice has been taken. All this time the third party is waiting, you know, for the outcome of the proceedings. That is something which looks good from one side but it looks much less good from the other side! I think we should leave things the way they are.

I think they are correct the way they are. If you ask, you get an answer. If you like the answer, OK. If not, lodge an appeal. I mean, that is the sad truth.

EB In what practical ways will the coming into force of the Community patent affect the operation of the European Patent Office?

IK First of all, the Community patent doesn't exist yet and it will certainly be some time before it exists (if it will, which we don't know). We have always been very positive about the Community patent. To come back to your question, the Office will not be very much affected, at least not as far as the fundamental work of the Office, i.e. search and examination, is concerned. This work will not be affected by the Community patent because the Commission chose to use a mechanism which is fully based on the EPC, as far as search and examination are concerned. The post-grant procedure, of course, is a different issue, because then it will be a truly European patent. National administrations will not have to deal with it. There is no validation procedure in the national offices for this patent and this will have to be done by the Office. We have been prepared for the past nine years. I believe we prepared as early as 1992, when a previous version of the Community patent was proposed. The work we will face and the way that we will deal with it have been prepared. It is in our remit, so we know what to do and we will certainly provide for that. When it becomes clear that the Community patent is to come into force, we will be prepared.

EB The next two questions are very much attorney questions. The first one is becoming more and more important to attorneys and has been a thorn in our side for some time and that is the addition of subject-matter problem. It seems to us that there is an increasing reluctance for Examining Divisions to accept any sort of implicit disclosure. Many European patent attorneys are now recommending to clients that when an application is drafted you do not just recite all the possible elements, embodiments and specific features, but you also recite every single possible combination to ensure a specific basis for potential amendments. Because of this, there is no doubt that the size of specifications will increase even more. This is something that I know the European Patent Office is not happy about. Is there any way you are going to be able to deal with this dichotomy?

IK Well, there again, I think we are facing a conflict of interest. I mean, what you are saying is obvious and I don't contest it. On the other hand, clarity is a very important aspect, as I understand it. As far as I can see, no fully convincing way has been found to solve that conflict of interest so far.

BH Examining and opposition divisions have followed DG 3 case law in this respect and a recent action run by DHQ (Directorate 2.0.1 Harmonisation and Quality) targeted this aspect to ensure that DG 2

examiners were aware of the trend of DG 3 decisions on added subject-matter.

- EB I would tend to agree with you. I have to say that the Boards of Appeal seem to work very fairly on that in the decisions I have seen. Many Examining Divisions now seem unwilling to accept any amendments unless there is an absolute and specific basis for the exact wording in the original text. Unless the words are there, there is no manoeuvring allowed for implicit disclosure. It does seem to me that you are right, that we are stuck with it.
- IK There is another aspect which we should not forget and that is always the other party. I mean it is not necessarily the examiner who comes to the point, it might be your opponent who objects.
- EB The new rules for setting dates for oral proceedings have caused a major stir in the community of attorneys. Now, when we will have oral proceedings, we are not entirely sure how they are going to be set.
- EB Why is the Office being quite so draconian with the minimum two months for settling an oral proceedings' date. Many attorneys say „What are they doing?“ What is the answer, why is the EPO suddenly very draconian, with no consultation or leeway given?
- IK First of all, I would again like to make a distinction between what is happening with the Boards of Appeal and what is happening with the Examining and Opposition Divisions. As far as the Boards of Appeal are concerned, it is none of my business, it's part of their judicial authority and I have no comment to make

Now, turning to the Examining and Opposition Divisions, one has to have a look to the past again. A generous past. To make it very simple, we can't afford that generosity any longer. Maybe you could, but we can't, in the sense that offering two or three different dates for oral proceedings requires a lot of co-ordination between the members of the relevant bodies, not only with the patent attorney or attorneys, but amongst themselves. This puts a strain on our logistic potential, because if you offer three dates, you must have three rooms for the different dates. This exceeds our potential in terms of rooms, interpreting arrangements and so on. This was not welcome, but it didn't come as a surprise. It was discussed with SACEPO at length and it was discussed with others. I appreciate the specific situation of European patent attorneys, being obliged to travel all over the place. It is not easy, but two months is quite a bit of a time. If you have good and valid reasons, the examiner will certainly appreciate that. Normally two months in advance it should be possible to arrange a meeting. In my view, one must get accustomed to it. Two years from now, nobody will talk about it any longer and people will take it as it is, reasonable practice.

EB One of the big problems is with the two months' warning time. I don't know about your diary. I mean, are you free in two months' time?

IK Well, if I show you my diary, my diary is already full for the whole year.

EB Well, there you go! I think a lot of us do have arrangements two months in advance. I think the short lead time does not help. I think more attorneys would be content if the lead time was longer. The lack of consultation particularly with regard to ex parte proceedings also irritates.

IK What do you mean by „lack of consultation“.

EB Well, it used to be that for an oral proceedings with the Examining Division they'd ring up and say „We've got this date, is that convenient for you?“ There would be no issuance of a summons to oral proceedings. I get back to my client with the date and ask for a reply by the end of this week. They come back and say „Yes, that's acceptable“ or „No, it's not“, for whatever reason. Thus, we are able to find a date that is mutually convenient to all of us.

IK That's an interesting wording, „for whatever reason“. We don't accept „for whatever reason“. This is an authority, it's not just a service. We offer you a date and if you don't have a good reason, the proceedings will take place. I understand that this is not very popular because it is much tougher than it used to be. On the other hand, I think it will make life easier once it has been adapted. If you accept it, it makes life easier because you can go to your client and say „Now look, this is the date“ and he cannot argue. He will have to accept it because you tell him that there is no way out. The European Patent Office will not accept any excuse, unless it's really something where everybody can see it's not possible. I think this new measure should be accepted. Once it has been accepted, it will make life easier, particularly for the patent attorneys.

There is another side to it. It is difficult to understand that, on the one hand, people are complaining about the long prosecution times and then if you take one measure they complain about an attempt to speed up the process. Of course, everybody is happy to have something, provided they are not obliged to pay. We pay for both the Office and the applicant's attendance. I have always been very much in favour of burden sharing. I am not willing to put the whole burden on the shoulders of the applicants, but we are doing quite a lot and the applicants must contribute to that. We can't act such that the Office is taking all the obligations and the applicant advises us whether he is „perhaps“ in the position to respond to an invitation. I think one could discuss whether two months is an ideal lead time. What I am definitely not willing to discuss is any continuation of the practice of offering two or three dates, for the applicant to choose.

With regard to the two months, I would like to clarify that the practice which you have seen has not been imposed on the examiners by a management

decision. So nobody told them to set a term of two months. The two months is the minimum period which is foreseen in the rules. Examiners may use that if they have good reason. To date, I see no need to intervene. However, I have taken note and I will consider the principles involved.

EB I understand the principles you have set out. With regard to the cost, the advantage for the European Patent Office is that the date is chosen at the convenience of the members of the European Patent Office. Furthermore, for applicants and attorneys who are based outside Munich there is of course the cost of getting here. Thus, there is a degree of cost on our side.

IK I appreciate that.

EB I can understand that there is a problem on both sides. However, there seems to have been a big change between almost a free-for-all and the present situation where one has exactly two months and one must turn up on a single day, the choice of which is nothing to do with you. This is a shock to the system, to say the least!

The next question is much nicer! To what extent are national court decisions considered and acted upon within the EPO?

IK The answer is very simple. National decisions are not binding on the EPO. They are, however, followed, they are monitored, they are evaluated. If a decision shows a general trend in legal thinking, or a revelation, we take that into account if it is relevant to our work.

GK Of course, such decisions are not binding but the Boards of Appeal take notice of national case law which is important and they refer to such cases more and more, and vice versa. There is clearly a mutual impact on European and national case law. There is a fruitful discussion among courts, because nobody can really claim to have found the truth, or the philosopher's stone. It's a permanent discussion on what is the right way to approach a particular problem. If you take a case like equivalency, etc., we have the situation that, for instance, German courts can develop the law much more easily than UK courts, because the UK courts are bound by the rule of precedent and, therefore, until a higher (court) has reviewed the law, the situation will remain as it is.

We have established a very useful forum for this exchange of views. This is the judges' meeting, which takes place every two years, the last one in Luxembourg. This is appreciated by everyone and the judges say that these meetings have contributed

a lot to mutual understanding. They get to know each other and this makes it much easier for judges to understand what others are doing.

In many cases, there may be no precedent and no case law. Those are situations which are straightforward for the Boards of Appeal. But Boards of Appeal look into national case law. It may be that in some cases they do not argue specifically the merits based on such case law, but they do it.

Your question and our discussion reflect clearly the situation in the absence of a European patent court. As soon as we have such a court, harmonization will start. It doesn't exist at present and I think that is a deficiency. I think this area does need improvement and it does need harmonisation because it is very difficult to calculate for people considering going to court. A European Court, which is the last resort for determining what is the right application and interpretation of the law, seems a good idea .

EB Finally, do you know the current status of the re-writing of the Regulations, and when can we expect a draft?

GK Something which was reported wrongly in the CIPA information is a deadline of 30 June 2001. This is not the deadline for the Implementing Regulations, this is the deadline for the transitional provisions and a revised text of the entire Convention further to the Revision Conference in November 2000.

What we have planned as an internal deadline now is to complete the whole exercise of reviewing the Implementing Regulations, to transform what has been taken out of the Convention into the Regulations. We also have to look at the Implementing Regulations as a whole. Therefore we think we need two years for the whole exercise. So by the end of 2002, the revised Implementing Regulations should be in order for a final decision by the Administrative Council.

We have one year for internal preparation and then we have to consult SACEPO. Then we have to go through the Committee on Patent Law, which examines such proposals. We will need two or three meetings of the Patent Law Committee and then they should be in order for submission to the Administrative Council for a decision.

EB So you will expect the draft to be ready around the end of 2001?

IK Hopefully, yes.

EB Great, I think I have taken more than enough of your time. Thank you very much.

IK You are very welcome.

Conference on the Revision of the European Patent Convention

Remarks by *epi* observers

F. Macchetta, W. Holzer, S. Le Vaguerèse

The Conference began with opening statements from all of the twenty delegations, the observers to the Administrative Council and the interested circles invited. The European Commission had a special status at the conference.

Most Articles of the *Basic Proposal* were adopted without controversy (for final document visit: www.european-patent-office.org/epo/dipl_conf/documents.htm)

The contents of a considerable number of Articles was deleted from the Convention and will be included in the Implementing Regulations, which however were not known at the time of the Conference.

Some Articles of interest will be dealt with below:

Art 4a Conference of ministers of the Contracting States

A conference of ministers of the Contracting States responsible for patent matters shall meet at least every five years to discuss issues pertaining to the Organisation and to the European patent system.

Art 14 Languages ... of European patent applications

European patent applications can be filed in any language. Pursuant to a French proposal translation of the European patent application filed in languages other than the Office's languages must be submitted according to the Implementing Regulations.

Arts 17, 18, 33 BEST procedure

In order to provide room for the BEST procedure in the Convention no geographic location of the Search Division and the Examining Division is given. Moreover, the Administrative Council can by a simple majority of votes decide, *in the light of experience*, that in certain categories of cases Examining Divisions shall consist of one technical examiner. Such decision may be rescinded.

Art 33 Competence of the Administrative Council

The topic discussed was whether the Administrative Council could amend the Convention to conform with international treaties or European Community legislation. After an extensive debate an amended proposal was adopted limiting the Council's competence in this respect to „*international treaties relating to patents*“.

Art 52 Patentable Inventions

Art 52 (1) has been adapted to Art 27 (1) of the TRIPS provisions.

Art 52 (2) (c) of the *Basic Proposal* was not adopted. Although there were unanimous statements and interventions from the side of the interested circles defending

the *Basic Proposal*, the delegations voted in favour of a reintroduction of the non-patentability of computer programs *as such*, because the consultation process of the European Commission on this topic had not been concluded.

The *epi* in a position paper had favoured the cancellation of the exclusion from Art 52 (2) EPC and in the conference substantially argued that the reintroduction of the non-patentability of computer programs into the *Basic Proposal* would have negative effects, such as decreasing legal certainty, depriving European inventors of an incentive and driving them to the USA, and in general diminishing the competitiveness of the European patent system with US patent laws.

Art 54 (5) Novelty

The *epi* actively supported a proposal of the Swiss delegation to introduce a new paragraph to Art 54, permitting to obtain patent protection for any product (pharmaceutical) used for the first time in a new specific therapeutic method (second medical indication). The amendment to this article was finally adopted in spite of strong counteractivity from various sides and an effort by the Greek delegation in the Conference to combine the paragraphs pertaining to the first and second medical indication.

The new paragraph (5) of Art 54 reads as follows:

Paragraphs 2 and 3 shall not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in any method referred to in Art 53 (c), provided that such use is not comprised in the state of the art.

Art 69 Extent of protection – Protocol to Art 69

In the opinion of the *epi* the concept of a definition of equivalence and the mentioning of the file history pursuant of the *Basic Proposal* would have required an extensive and in-depth discussion of the problem, which however did not take place mainly because the proposal had come up at a late stage of the revision process. The *epi* therefore favoured deletion of these stipulations from the *Basic Proposal*.

Also on this topic a prolonged discussion ensued in the Conference, which finally adopted paragraph (1) of the envisaged amendment, however deleted paragraphs (2) and (3) (definition of equivalence and file wrapper estoppel).

New Article 2 of the Protocol reads as follows:*Equivalents*

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

Art. 101 Examining of the opposition

The *epi* did not favour the contents of this article of the Basic Proposal, in particular paragraph (2) demanding that at least one ground for opposition be examined. The *epi* was of the opinion that in its decision the opposition division should deal with all grounds of opposition. However, the article was adopted without amendment.

Art. 105(a),(b),(c) Central limitation procedure

The Basic Proposal put forward that the proprietor can request *limitation* of the claims and *revocation* of the patent by central request to the EPO. The provisions were favoured by the *epi*. In the conference Sweden and Denmark voiced constitutional problems with the proposal which transfers part of the national sovereignty and asked for a reservation under Art 105. However, the removal to the Second Basket was turned down and a reservation not granted.

Art. 112a Petition for review by the Enlarged Board of Appeal

A party to an appeal proceeding that is adversely affected by the decision may file a *review* petition with the Enlarged Board of Appeal. However, there is a strict limitation as to the grounds possible.

Art. 121 Further processing of the European patent application

The time limits lending themselves to further processing have been increased to conform to the PLT.

Art. 122 Re-establishment of rights

The grounds for re-establishment of rights were aligned with the PLT.

Art. 134a Institute of Professional Representatives before the European Patent Office

This new article anchors the Institute of Professional Representatives before the European Patent Office in the Convention. It also provides an enabling clause for the Administrative Council to adopt provisions pertaining to the so-called attorney-client privilege.

Art. 149a (1), (2) Other agreements between the Contracting States

The first paragraph provides a basis for special agreements concluded between Contracting States, such as an agreement establishing a European patent court, an agreement establishing a common entity and the already concluded agreement dispensing with translations under Art. 65.

According to paragraph 2 members of the Board of Appeal or the Enlarged Board of Appeal could serve on a (future) *European patent court* or *common entity* and take part in the proceedings before that court or entity. It remains to be seen whether this provision is a realistic and workable model or will lead to controversy and to formal appeals.

Furthermore, the European Patent Office will provide the common entity with support and bear its expenses.

ARTICLE 7 Transitional Provisions

Upon a British proposal a *Transitional Provision* was adopted which defines that the revised version of the Convention shall apply to all patent applications filed after the entry into force, but not to applications pending at that time, unless otherwise decided by the Administrative Council which must take a decision until 30 June 2001 by a majority of three quarters of the Contracting States present and voting.

ARTICLE 8 Entry into force

The revised version of the Convention will enter into force two years after the fifteenth Contracting State has deposited its instrument of ratification or accession, or on the first day of the third month following the deposit of the instrument of ratification or accession by the Contracting State taking this step as the last of all the Contracting States, if this takes place earlier.

(See also Art 172 (4))

The so-called „Second Basket“

A number of items were referred to the „Second Basket“ of the Revision, namely the implementation of the Biotechnological Directive, the patentability of computer programs, the implementation of the Community Patent, the Grace Period etcet.

It remains to be seen how much time the second step of the revision process will take, which at any rate will be some years.

epi-Tutorien 2001

Das *epi* bietet 2001 wieder Tutorien zur Vorbereitung auf die europäische Eignungsprüfung (EEP) 2002 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 8. Juni 2001) ist für Kandidaten gedacht, die die EEP im Jahr 2002 zum ersten Mal ablegen wollen (vollständig oder in Modulen). Der Herbsttermin (Anmeldung bis spätestens 12. Oktober 2001) ist dagegen für diejenigen von Interesse, die ein Tutorium für die 2001 nicht bestandenen Prüfungsaufgaben wünschen.

Kandidaten, die sich für den Sommertermin anmelden, wird empfohlen, die Aufgaben von 2000 und 2001 nacheinander zu bearbeiten, um von den Kommentaren zu ihren Antworten auf die Aufgaben von 2000 für die Aufgaben von 2001 zu profitieren.

Die Daten für die Tutorien sind wie folgt:

	Sommertermin	Herbsttermin
Angebotene Prüfungsunterlagen:	2000, 2001	nur 2001
Anmeldung bis spätestens:	08.06.2001	12.10.2001
Versand der Prüfungsaufgaben an die Kandidaten bis:	29.06.2001	09.11.2001
Eingang der Antworten auf die Prüfungsaufgaben 2000 bis:	31.08.2001	
Kommentare zu den Prüfungsaufgaben 2000 bis:	05.10.2001	
Eingang der Antworten auf die Prüfungsaufgaben 2001 bis:	09.11.2001	14.12.2001
Kommentare zu den Prüfungsaufgaben 2001 bis:	14.12.2001	18.01.2002
Besprechung:	Februar 2002	

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 8. Juni 2001 durch Rücksendung des auf Seite 16/17 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 2001

In 2001 the *epi* will again offer tutorials for candidates wishing to prepare for the European qualifying examination (EQE) in the year 2002.

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 8 June 2001) is particularly for those candidates who are going to sit the EQE in the year 2002 for the first time (either in full or in modular form), while the autumn term (enrolment deadline 12 October 2001) is particularly devised for those candidates who wish to have tutorials for those papers which they failed in the 2001 EQE.

Those enrolling in the summer term are encouraged to do the 2000 and the 2001 papers in sequence, to benefit from the comments on their 2000 answers to improve their answers to the 2001 papers.

The tutorials will run according to the following timetable:

	Summer term	Autumn term
Papers offered:	2000, 2001	2001 only
enrolment:	08.06.2001	12.10.2001
Papers sent to the candidates by:	29.06.2001	09.11.2001
2000 papers, scripts in by:	31.08.2001	
2000 papers, comments by:	05.10.2001	
2001 papers, scripts in by:	09.11.2001	14.12.2001
2001 papers, comments by:	14.12.2001	18.01.2002
Meeting:	February 2002	

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 8 June 2001 at the latest, by filling in and sending the form printed on page 16/17 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* 2001

En 2001, l'*epi* propose de nouveau un tutorat destiné aux candidats qui souhaitent se présenter à l'examen européen de qualification (EEQ) en l'an 2002.

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 8 juin 2001) s'adresse particulièrement aux candidats qui se présenteront à l'EEQ pour la première fois en l'an 2001 (soit à l'ensemble des épreuves, soit par modules), tandis que la session d'automne (date limite d'inscription 12 octobre 2001) est spécialement conçue pour les candidats qui souhaitent un tutorat concernant les épreuves auxquelles ils ont échoué à l'EEQ de 2001.

Il est recommandé aux candidats qui s'inscriront à la session d'été de traiter en premier les épreuves 2000 et ensuite celles de 2001. Ils profiteront ainsi des commentaires relatifs à leurs réponses aux épreuves 2000 pour améliorer leurs réponses aux épreuves 2001.

Le tutorat se déroulera selon le calendrier suivant:

	Session d'été	Session d'automne
Epreuves proposées:	2000, 2001	2001 seulement
Inscription:	08.06.2001	12.10.2001
Envoi des épreuves aux candidats le:	29.06.2001	09.11.2001
Epreuves 2000, envoi des réponses, le:	31.08.2001	
Epreuves 2000, commentaires retournés le:	05.10.2001	
Epreuves 2001, envoi des réponses le:	09.11.2001	14.12.2001
Epreuves 2001, commentaires retournés le:	14.12.2001	18.01.2002
Réunion:	février 2002	

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 8 juin 2001. Ils sont priés de retourner le questionnaire imprimé page 16/17, 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).

Erinnerung · Reminder · Rappel

Der *epi*-Jahresbeitrag für 2001 beträgt DM 300,-. Er erhöht sich auf DM 350,-, wenn die Zahlung nach dem 30. April 2001 eingeht.

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La cotisation annuelle *epi* pour 2001 est de 300 DM. Elle est relevée à 350 DM si le versement n'a pas été effectué avant le 30 avril 2001.

Corrigendum

Issue 4/2000 of *epi* Information, Review of the Patent Profession in the EPC Contracting States:

Page 141, „BE“, column 4, „2 years of professional activity in industrial property profession“ should be replaced by „3 years ... profession“.

Page 143, „FR“, column 1, should be added „Lawyers admitted at bar“.

epi Tutorials, Summer 2001

8 June 2001

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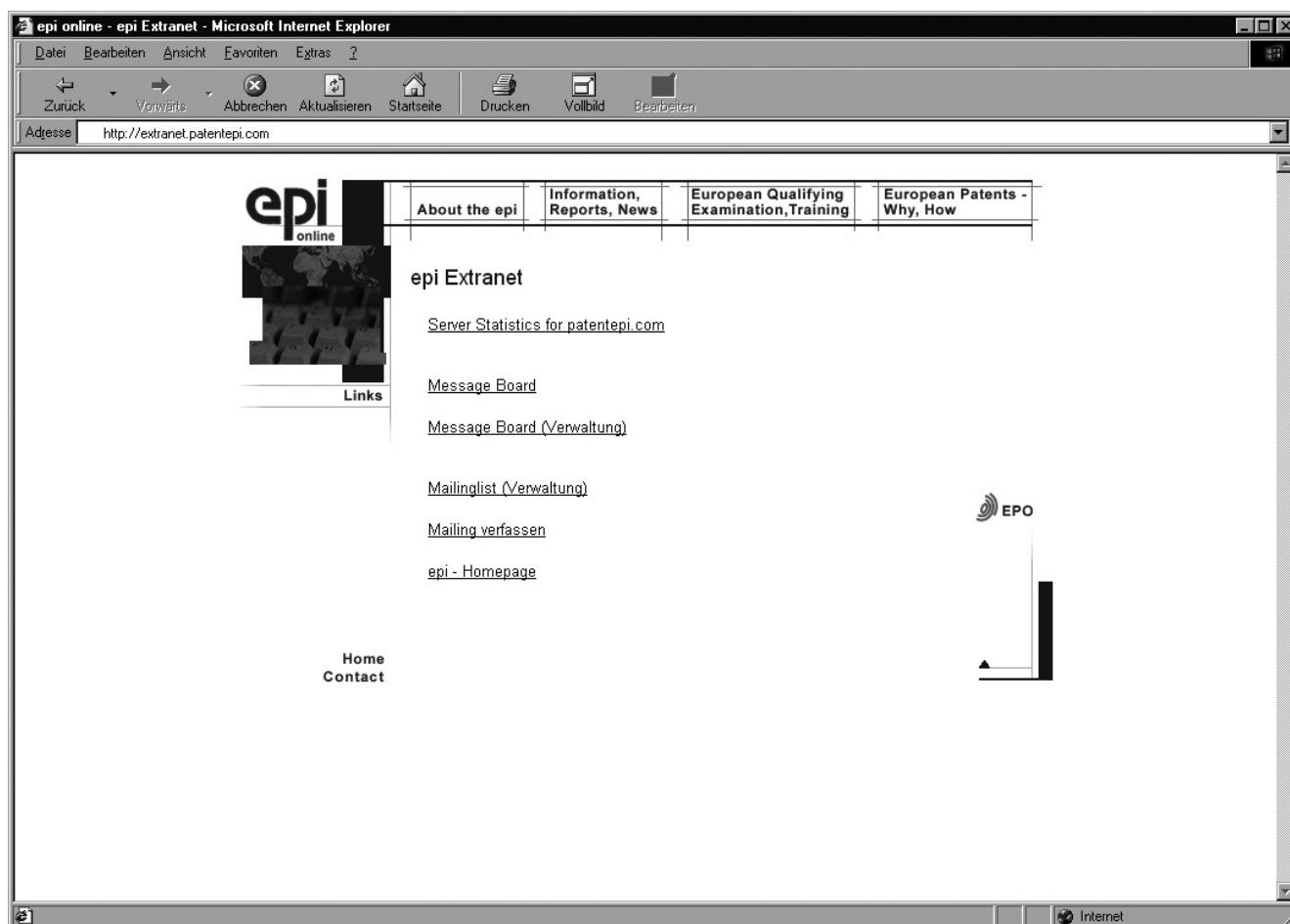
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The European Patent Litigator A presentation made at the CIPA Congress 2000 in London on November 3, 2000

E. Popp¹ (DE)

The European Patent Litigator is a topic linked to the intended creation of a European Patent Court and, at present, the subject of intensive discussions. In their Green Paper on „Promoting Innovation through Patents“, the European Commission made the proposal that common court system be established. Its aim is to overcome the present drawbacks of the European patent system, namely that a European Patent, once granted, must be enforced separately in each country. The fact that there is no centralized court system leads to great legal uncertainty, due, in part, to differences in the application and interpretation of EPC provisions by national courts and, in part, to the risk of contradictory judgements in the different member states.

Regardless of the legal uncertainty just mentioned, the enormous costs of patent litigation in the various countries are a formidable barrier to enforcing or defending a European patent.

For this reason the European Commission proposed that a central body of administering justice be established within the European Union to settle litigation pertaining to the *infringement* and *legal validity of Community patents*. That would necessitate amending the basic Treaty of the European Community, as already requested by the Commission in March of this year in their comments on the Inter-Governmental Conference.

The European Commission favors instituting a „*Community Court for Intellectual Property*“, including *first and second instances*, this court to be given competence to decide also on Community Trademarks and Community Design Patents.

An integrated judicial system for litigation concerning European patents (*EPC patents*), where uniform rules of procedure would apply and which would have at least one common court of appeal is a topic of discussions also within the European Patent Organisation (EPO). A special „Working Party on Litigation,“ was established under a mandate by the Inter-Governmental Conference of the Member States of the European Patent Organisation in Paris on June 24, 1999. This working party is co-chaired by Switzerland, Germany, and Luxemburg. Three meetings of the working party took place in the meantime. In addition, the co-chairmen met informally with patent judges from eight European countries to discuss a draft of a structural paper for a *European Patent Litigation Protocol (EPLP)*. This EPLP structural paper was approved by the Working Party at their last meeting in June of this year. The participants at the Intergovernmental Confer-

ence in LONDON on 16th and 17th October decided that the discussions on the basis of the said structural paper should be continued.

The principal elements of the *Litigation Protocol* to the EPC are the following: In respect of European patent litigation, the signatory states – which either may be member states of the European Union or non-member states – would agree to the formation of an integrated European Patent Judiciary (EPJ) with uniform rules of procedure and at least one *Common Patent Appeals Court (COPAC)*. In the course of preparing for the upcoming revision of the EPC, a new Article 149a on „Special Agreements“ was submitted which will permit a so-called „EPLP court“ to be established.

Regardless of the judicial system which eventually may come to life in respect of Community Patents and European Patents, and whether it will provide for a European or a national entry instance, with or without possibility of appeal on points of law to the Court of 1st Instance of the European Communities or the European Court of Justice, and so forth, it is remarkable that all the proposals presented up to now state that „the respective courts will be responsible exclusively for litigation in matters of

VALIDITY and/or INFRINGEMENT

of European patents or Community Patents“.

As regards Community patents, this concept was included also in the „Proposal for a Council Regulation on the Community Patent“. Article 30, paragraphs 1 and 2 thereof read as follows:

- „(1) The Community patent may be the subject of invalidity or infringement proceedings, of action for a declaration of non-infringement, of proceedings relating to the use of the patent or to the right based on prior use of the patent, or of requests for limitation, counterclaims for invalidity, and so on.
- (3) The actions and claims referred to in paragraph (1) come under the exclusive jurisdiction of the Community intellectual property court.

Primarily, therefore, jurisdiction of both, the Community court and the EPLP court, is to be restricted to issues of

VALIDITY and/or SCOPE OF PROTECTION

of a Community patent or European patent.

These two fields are the domain of the patent attorney – and here I am speaking as a German patent attorney.

¹ Dr. Eugen Popp, Secretary General of CNIPA and Vice President of the Deutsche Patentanwältkammer.

For more than sixty years, German patent attorneys have been executive bodies of the administration of justice. In other words, they are independent representatives in legal matters, just like lawyers, bound by nothing but the law, albeit that their activity, in contrast to that of lawyers, is clearly defined by the German Patent Attorney Act. As a consequence, German patent attorneys, like our colleagues in Austria and by now also the „Patent Agent Litigators“ in the United Kingdom, hold a quite privileged position. A more or less natural consequence of the privilege mentioned is the right of representation, not only in the usual procedures up to grant of a title in Patent and Trademark Offices, but also in the subsequent appellate instances. The German Federal Patent Court is such an instance. It is a special administrative court and has a rank corresponding to that of an Appeal court, which is situated directly below the Federal Court of Justice.

The right of representation applies also in the case of the reversal of the grant of a patent, in other words in opposition proceedings and any subsequent appeal to the Federal Patent Court, as well as nullity and compulsory licence proceedings. These cases are presented before the German Federal Patent Court, as the court of first instance, and then before the Federal Court of Justice, as the second instance. According to the rules of procedure of the European Court of Justice those persons who enjoy the right of representation under their respective national law before the court which refers a case back to European Court of Justice, are entitled to representation also before the European Court of Justice. This is applicable to German and Austrian patent attorneys, and also to our colleagues in the United Kingdom, within corresponding judicatory channels. As regards German patent attorneys, they are thus entitled to represent before the European Court of Justice when a question on a point of law is submitted to the European Court of Justice (a) by the German Federal Court of Justice in nullity or compulsory license lawsuits or (b) by the German Federal Patent Court in any *legal* matter pertaining to patents, trademarks, utility models, design patents, or topographies.

Furthermore, German patent attorneys enjoy the right of pleading, through all the stages, in any infringement case relating to any intellectual property right, in other words including appeal proceedings before the German Federal Court of Justice. What this means is that the German patent attorney has a legally guaranteed right not only to offer professional services of consultation but also to speak in court. And he or she always makes use of this right to plead when it comes to the following:

- describing the subject matter of the particular intellectual property right asserted,
- interpreting the same, and
- bringing the facts of the subject matter under attack under the right asserted and its scope of protection.

The only thing a patent attorney is not allowed to do is to state applications or requests respectively, such as a request to refrain from interference, a request to render

information and accounts, or a request for payment of damages. The German Code of Civil Procedure defines that this must be done by a lawyer admitted to practice before the respective court.

However, as I already said, the technical aspect of infringement of an intellectual property right, especially of a patent, as a rule, is presented in court mainly by a patent attorney. Competence in these matters, increasingly has convinced the respective courts in charge of deciding on patent litigation to appoint patent attorneys as court experts in matters of the technical interpretation of patents and even of the assessment of adequate damages to be paid.

As you will have gathered from my illustration of existing circumstances in Germany, a patent attorney accompanies a patent infringement lawsuit throughout the lawsuit, acting as representative with regard to the validity issue and in a cooperating and pleading capacity when it comes to the scope of protection of the patent at issue. By contrast, at least two or even three different lawyers must become active through the various stages of litigation because, for example, only lawyers admitted to practice before the Federal Court of Justice have the right of representation in that court. This illustrates that, in patent nullity and compulsory license suits before the German Federal Court of Justice, patent attorneys enjoy the same privilege to represent their clients as those lawyers who are specifically admitted to practice before that court.

It should be mentioned also that, within their legally defined range of activity, patent attorneys are entitled to representation before all courts, except where there is a statutory requirement for parties to be represented by a lawyer. The latter applies, among others, to civil courts entrusted with patent infringement matters. Thus patent attorneys are fully entitled to represent their clients before all local courts (Amtsgerichte) – which would correspond in rank to the British (Patents) County Court – furthermore all administrative courts, financial courts, etc. The only limitation of representation, as I said, are civil courts subject to the statutory requirement of representation by a lawyer. However, patent attorneys e.g. also in patent matters are allowed to file a request for an interlocutory injunction. A lawyer has to be appointed only if an opposition is filed so that Oral Proceedings will follow.

The privilege of consultation and representation just explained is derived from the technical and legal background of the education and training of German patent attorneys. Since January 1, 1999 it is required of candidates who want to be admitted to the patent attorney examination to have successfully completed law studies at a university and to have passed a separate law examination. Leaving aside the specific field of intellectual property right, the law curriculum is fixed and comprises the following:

- basics of civil law
- commercial law
- corporate law
- employment law

- competition law
- general procedural law
- public law
- European law
- contractual law
- patent attorney law.

In view of this additional legal university-level training, and based on the fact that the patent attorney's domain, on the one hand, is to assess the *validity* of an intellectual property right, especially a patent and, on the other hand, to delineate the *scope of protection or infringement* of an intellectual property right, especially a patent, we, the patent attorneys in Germany, believe that we ought to be granted the right of representation before a Community patent court and/or an EPLP court, consequently competing with lawyers who, in general, have no detailed technical or scientific knowledge. The client ought to be given the choice whether he or she wishes to be represented by a competent patent attorney or a competent lawyer or by a team of both patent attorney and lawyer, when going to court because, with issues like validity and/or infringement of a patent, the court will deal primarily with the technical aspects, and only in second place with legal questions.

It is my own personal opinion that an engineer or natural scientist with an additional legal background is just as well suited to accomplish the tasks I have just outlined as a legal practitioner with additional training in technical fields or natural sciences. They both should be sufficiently competent so that a cost-intensive counselling team, as we know them from the United States, can be avoided.

Ultimately, sheer competition should decide!

Let me add a few remarks concerning Austria and the United Kingdom:

In Austria, patent litigation in the first instance is under the exclusive jurisdiction of the commercial court in Vienna (Handelsgericht Wien). The court is composed of two professional judges and one expert lay judge. That applies also to interlocutory (preliminary) injunctions. This basic principle dates back to 1896. Since 1947 the patent attorney is the expert lay judge. In other words, the patent attorney sits on the Bench as the „technically qualified judge“. This model should be given serious consideration for a Community court or EPLP court, too. And I should just like to add that I think, no matter what, the technically qualified judge is an absolute necessity for such a court. Only if that requirement is fulfilled, will it be possible to get reasonable decisions within an adequate time frame and at relatively low cost, without appointment of time- and cost-intensive experts.

In this context, I should like to quote from the Amendment of 1984 to the Austrian Patent Act where it is stated with regard to patent infringement proceedings: „Patent infringement proceedings regularly require knowledge not only in engineering, chemistry, and the like, which cannot be expected of a professional judge, but may be taken for granted with an expert

law judge – i.e. patent attorney – to be called in by the Bench.“

The Vienna court of appeals likewise is composed of two professional judges and a patent attorney in the capacity of expert lay judge. It goes without saying that the patent attorney is chosen in accordance with the particular technical field at issue.

Otherwise the position of the Austrian patent attorney before the courts is comparable to that of the German patent attorney, and it is likewise cast into law. The Austrian patent attorney must be given the floor upon request, as is the case in Germany. According to my own experience in Austria the lawyers merely state the requests of the parties, while all the pleading is done by patent attorneys. It would certainly be an instructive experience for members of the European Commission, the European Court of Justice, the national Parliaments and/or the European Parliament who are concerned with the issue of establishing a „European Patent Court“ to take part, unannounced and undisclosed, as an observer in oral proceedings in a patent lawsuit before the Vienna commercial court.

It is a matter of course that the patent attorney in Austria, as in Germany, the United Kingdom, France and, I believe, in all other European countries, is responsible for the preparation and continued accompanying of a patent infringement suit, from the first warning of patent infringement to the very last instance.

As regards the rights of cooperation of a patent attorney or patent agent, the United Kingdom has come to be on par now with Germany and Austria. Before the High Court of Justice, the „Patent Agent Litigator“ now enjoys the rank of a solicitor. Besides, the patent agent has the right of representation before the Patents County Court anyway (Article 292 Copyright, Designs and Patent Act). In the Patents County Court, a registered patent agent is allowed to do everything *himself*, in other words also act as barrister.

The Patents County Court was instituted about 10 years ago, because High Court patent actions were extremely lengthy and expensive, and there was need for quicker and significantly less costly actions. This need was recognized by a number of government committees going back to the Sargent Committee in 1929, and possibly earlier. The Patents County Court introduced two new ideas in order to overcome the drawbacks mentioned of the still existing High Court procedures:

- First: a streamlined procedure, and
- Second: representation by patent agents.

As regards representation, I was told the situation at present is such that in about 50% of all cases the parties are represented by patent agents, the rest by solicitors and/or barristers.

This is a perfect competitive situation which should be followed by the European institutions. !!

Competence rather than *compulsion* ought to make the race!

I went to greater length explaining the situation in Germany, Austria, and the United Kingdom because

these countries are the home of more than (2/3) two-thirds of all patent attorneys in Europe. The patent attorneys of these countries and their education and training should be the benchmark for the position of the patent attorney before a „European patent court“, rather than the smallest common denominator to be found as – unfortunately – so often is the case in Europe. By the way, if patent attorneys from the countries named were denied the rights of representation mentioned, before a European court, this would amount to an unacceptable, unconstitutional prohibition of exercising their profession at least as far as the validity part is concerned. In other European countries, patent attorneys are more or less arbitrarily restricted in their possibilities of cooperation in court. This is so in spite of the fact that the patent attorney in those countries, too, is responsible for preparing a patent infringement case and accompanying it to the last instance of the judiciary. Let me just remind you of the (exclusive) responsibility of French and Belgian patent attorneys in so-called „saisie-contrefaçon“ cases. There is no doubt about the patent attorney's competence in technical matters and aspects of the patent law. It is merely due to tradition that, in other countries, the patent attorney is prevented from unfolding all his professional skills, as would be required in these modern times. By instituting the Patents County Court, the United Kingdom has just shown us how that situation can be changed.

We also find, as part of the tradition, in some European countries still underdeveloped structures of professional education and training. Improvement in this area is an absolute necessity and could be modelled along the lines of the additional legal training and examination requirements in Germany, Austria, and the United Kingdom. Practical training in patent matters is a prerequisite anyway for becoming a European patent attorney and thus may be taken for granted.

As I said before, it is a characteristic of the great majority of patent attorneys in Europe that they have spent an extremely long period learning (up to five years) both in practice and by additional law studies. Thus they are highly qualified and competent and enjoy privileges in court. This majority should be the joker in the game of deciding on who gets the right of representation before a „European patent court“. The only thing that should matter, in terms of representation, should be competition between lawyers specialized in patent law and patent attorneys specialized in procedural law. Competition might even go so far that any statutory requirement to be represented by a lawyer or patent attorney in a „European patent court“ could be dispensed with. (DEREGULATION).

Now, I should like to try to give you a summary of the various advantages of a „European Patent Litigator“ some of which already may have become clear to you. In other words, what are the advantages of the patent attorney's right of representation before a community patent court or an EPLP court?

1. One representative is sufficient, instead of the two or three so far, especially when technical questions are the primary problem to be solved.
2. The case is conducted by a technically qualified person with a deep understanding of the technology concerned, thus bringing forth better arguments and hence better decisions.
3. A patent attorney is far more inclined than lawyers to concentrate on the technical core aspect of the respective case and waste less time on legastic niceties, thus reducing time and hence costs.
4. A patent attorney expects to have an ongoing commercial relationship with his/her client and thus is motivated to keep fees as reasonable as possible, hence reducing costs.
5. A patent attorney can keep all stages of proceedings under control, thus reducing time and hence costs.
6. A patent attorney's expertise, in combination with technically trained judges on the Bench, make it superfluous to appoint experts who normally are unfamiliar with patent law and, therefore, often draw the wrong conclusions, thus reducing time and hence costs.

In most European countries the technical and legal qualification of the patent attorney should be sufficient for admission as a „European Patent Litigator“ to act in a Community court or EPLP court.

However, we have to keep in mind that, at least in some countries, more emphasis must be given to legal education and training of patent attorneys, especially in law of civil procedure. It would be best if this were organized on a European level, perhaps along with the rules of procedure as yet to be worked out for the court as yet to be established as Community court or EPLP court.

Once more, I am convinced that free competition would give us a kickstart and get us ahead quickly. Patent attorneys who are not sufficiently well qualified in law will not wish to be retained to go to court anyway, or they will simply lose business after a little while.

The qualified patent attorney will in his capacity as „European Patent Litigator,“ survive free competition with lawyers or teams of patent attorneys and lawyers.

We deserve this chance! After all, patent attorneys can draft patents and ward off attacks in opposition proceedings or launch attacks in nullity proceedings. So why should they not be duly qualified and able to defend a patent in a lawsuit or protect it against claims asserted by third parties?

As I said before, a „European patent court“, in the first place, is intended to deal only with the aspects of validity and/or infringement or scope of protection of a patent. The procedural law required for completion of the envisaged court system still is a mystery and, therefore, will have to be reverted to later on.

Just like patent attorneys had to become familiar with the procedural rules of the EPC, unknown before to patent attorneys from many European countries, all those of us who are interested in conducting litigation,

whom I would just like to call „European Patent Litigators“, no doubt, will be able to learn and master the rules of the „European patent court“ to be.

Finally, I should like to mention that a *general political need exists for patent attorneys in Europe to be included as representatives before any future European court because it was this group of professionals who helped so much to make the protection of intellectual property a European issue and who took an active part in the development of the respective legal provisions for the protection of intellectual property and who, as a consequence, dispose of all the knowledge required for its implementation. Incorporating patent attorneys in pro-*

ceedings assures that input from the practical side will assist in the establishment and further development of a European court system. These resources should be tapped rather than wasted.

From the political point of view, it should not be taken lightly that ACCEPTANCE of a future European patent court, of course, will depend greatly on patent attorneys not being excluded from it. After all, they are the ones who have been involved in these matters in the member states of the European Union and those of the European Patent organization.

Thank you for your attention and great patience in bearing with me for so long.

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Is there a Case for Removing Computer Programs from the List of non-Inventions?

Robert Jehan (GB)

I have been prompted to write this article as a result of the ongoing debate as to whether to remove from the list of „non-inventions“ programs for computers and, possibly, business methods. As much of the debate focuses on the European Patent Convention I shall refer to this, although my opinion is of course equally applicable to the national European laws.

Notwithstanding the fact that I fully support the patentability of appropriate computer software and indeed am „guilty“ of having filed and prosecuted many patent applications and defended many patents for computer software, I dread the thought that the list of „non-inventions“ in Article 52(2) of the European Patent Convention may be amended to remove reference to programs for computers. Not only is such an amendment unnecessary but the „legal“ test which would then be

imposed by way of „justification“ would trample upon a perfectly sensible law and alter it far beyond current expectations. Deletion of *any* of the items in this list (save for business methods as I explain below) would ignore the wider implications and, in my view, would destroy the existing framework of patentability and lead to a terrible legal fog (useful to patent attorneys and lawyers but not applicants or patentees).

Even if all the debate concludes that it is necessary to remove computer programs from the list of non-inventions in order to be able to offer to the computer (software) industry adequate protection for its inventions (which necessarily means that it has not getting adequate protection with the current legal framework), we must not lose sight of what types of invention the

patent system was originally intended to and still should protect.

Patent law has, for a very long time now, quite rightly refrained from placing positive constraints on the definition of the term „invention“. Of course, we cannot provide a general definition of the term „invention“ because every invention extends life's body of knowledge and understanding. Any general definition set in law would therefore become dated and would eventually open wide gaps in protection for new inventions falling outside the limited definition. Yet, the proposals being debated and the current state of the law relating to computer programs fall into this trap. How can we determine what inventions are „technical“ in character in particular as new commercial fields develop. Invariably, it takes time for new commercial fields to develop and for them to be accepted as new technologies.

Preliminary

For ease of reference, Article 52(2) of the European Patent Convention reads as follows:

„(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (d) presentations of information.“

With the proviso that (paragraph 3 of Article 52):

„(3) the provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activity as such.“

The European Patent Office has now indicated, most recently by T935/97 and T1173/97, that it will grant patents for applications with claims directed to computer programs which are able to provide a „technical effect“ beyond the simple functioning of a computer, in practice ignoring the exclusion to programs for computers in Article 52(2) and the proviso of paragraph 3 of Article 52.

A similar position is being sought in the debate relating to business methods.

However, from where is the impetus for the change(s) coming? Politicians (basically).

Where is the legal basis for the current case law „supporting“ the sought after changes? Nowhere.

Would deletion of programs for computers (and business methods) from Article 52(2) provide the legal basis for supporting the current legal position? No.

A Review of the Law

All this debate seems to ignore the basic principles laid down in patent law.

1) *The European Patent Convention*

Patentability is clearly and succinctly set out in paragraph 1 of Article 52, which states:

„European patents *shall* be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.“
[Emphasis added]

This is the only provision in the European Patent Convention which sets out the requirements to patentability (save for the exclusions of Article 53). The remainder of Article 52 and Articles 54, 56 and 57 exist merely to explain Article 52(1). The term „invention“ is explained in Article 52(2) (quite correctly by an exclusionary list since by definition we cannot know what an invention is); the term „novel“ is explained in Article 54; the term „inventive step“ is explained in Article 56; while industrial applicability is explained in Article 57.

It is important to note that Article 52(1) provides that a patent *shall* be granted if the patentability conditions of Article 52(1) are met. (For the sake of conciseness, I shall not consider the requirements of form of the application and procedure required to obtain grant of a patent.)

In other words, there is no discretion allowed. If the conditions are met a patent shall be granted. It follows also that no other patentability requirement can be lawfully set without an amendment to Article 52(1).

2) *TRIPS and the Proposed Change to the EPC*

Article 27 of TRIPS states 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.“

Although the EPO is not bound by TRIPS, it has agreed to take it into consideration and indeed the following amended text to Article 52(1) EPC is currently being proposed:

„(1) European patents shall be granted for any inventions *in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.*“ [proposed amendments in italic]

Both with TRIPS and with the proposed new wording of Article 52(1) EPC there is *no* change in the requirements for patentability, merely a clarification that patents shall be granted for inventions in all fields of technology. The term „all fields of technology“ does not represent the nature of the invention itself but the field in which it lies (for example, the invention may lie in the field of computing, that is to do with computers, but may be of any nature, for example may relate to displaying information and so on).

Therefore, as long as the claimed „invention“ is not a „non-invention“ within the list of Article 52(2), meets the requirements of novelty, inventive step and industrial applicability and falls within any field of technology, a patent *shall* be granted therefor. This is again a mandatory requirement which allows no discretion on the part of a Patent Office.

3) Requirement for a Technical Effect

The law sets no other patentability requirement to be met and certainly no need for the invention to provide a technical effect. Indeed, nowhere in the European Patent Convention is there mention of a technical effect. Only in Rule 27 of the Implementing Regulations, is the word „technical“ mentioned in connection with the application, and I discuss the effect of this below.

An unfortunate interpretation of Article 52(2) was provided in decision T579/88 ([1991] 2 EPOR 120), in which it was mentioned that the non-technical exclusions of Article 52(2) in combination with Rule 27(1) must imply that Article 52(1) is directed only to technical inventions. However, Article 52(2) does not say this and to seek to expand the excluded list in such a manner finds no support in statute and does not tie in with the intentions of the legislator. Nevertheless, the findings in this decision are being followed more and more, not only in the European Patent Office but also in some of the national Patent Offices.

Such an interpretation of Article 52 could lead to a difficult and troublesome practice relating to the list of „non-inventions“ and indeed to the assessment of patentability of all inventions. The obvious example here is programs for computers.

4) Rule 27

Rule 27(1) states that:

- „(1) The description shall:
- (a) specify the technical field to which the invention relates;
 - ...
 - (c) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;
 - ...
 - (2) The description shall be presented in the manner and order specified in paragraph 1, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.“

This wording does not and cannot alter the scope of Articles 52, 56 or 57 for the following reasons. First, the Implementing Regulations do not define substantive law. Secondly, should Rule 27 be deemed to set an additional patentability requirement, it would be in conflict with the Articles of the Convention and would thereby be inapplicable by virtue of Article 164(2).

Thirdly, paragraph (1) of Rule 27 does not specify a mandatory requirement which must be met but only a *preferred* content of the description. Paragraph (2) of this Rule, which is invariably ignored, contemplates in respect of inventions which are different *in nature* to the type of invention contemplated in paragraph (1) of the Rule, that the description may be presented in a different manner, if so doing would afford a better understanding

(of the invention). The „nature“ of invention contemplated in paragraph (1) is one which is technical, which addresses a technical problem and which purports to solve this problem. Therefore, by paragraph (2), an invention which is different in *nature* might not be technical, might not address a problem with the prior art and might not purport to solve such a problem. This ties in with paragraph (1) and falls clearly within the patentability provisions of Articles 52, 56 and 57, with TRIPs and with the proposed amendment to Article 52(1).

Another Look at the List of „Non-Inventions“

What do we mean by the list of „non-inventions“?

Stated in this way, the answer is evident to all of us, including the new recruits into our profession. It is a list of „things“ which are not considered to be inventions. We have no problem with discoveries, scientific theories, mathematical methods, aesthetic creations, mental acts and presentation of information. We are comfortable to accept that they do not constitute „inventions“ *per se* for reasons specific to each category. Of course, they may be patentable when they are used in an industrially applicable manner, in which case a patent may be obtainable for the application of the non-invention (for example an application of a discovery or mathematical method) or for the method or apparatus for producing the non-invention (for example, for a system for presenting information). We are equally comfortable that these patentable applications or systems fall within the proviso of Article 52(3).

Yet, when we consider computer programs this logic seems to be missing. The same seems to be the case with business methods which are being considered for patentability only as a result of political and peer (other Patent Offices) pressure.

Our discomfort with computer programs seems to result from forgetting what computer programs are and from confusing these with the technology which operates a computer.

1) Back to Basics with computers

We are no doubt all familiar with the terms „hardware“ and „software“.

Simply stated, computer „hardware“ is those parts of a computer formed of hard components, typically of semiconductor material, metal, plastics and so on; that is those parts you can hit when the computer becomes terribly frustrating.

Computer „software“ on the other hand is the collection of electrical signals which pass through the hardware and enable the computer to perform the intended function. Since it comprises electrical signals, we can't hold software and therefore cannot hit it when it frustrates us (and typically it is software which creates the frustration!).

More specifically, the hardware is configurable into millions of different simple electronic circuits through which electrical signals, usually data, passes for process-

ing. The software configures the electronic circuits, that is creates the circuits. A simple analogy is a network of pipes and valves through which water passes. The „software“ sets the valves as desired to determine how the water passes.

Software actually consists of electrical voltage signals in binary format, that is a low voltage (typically 0 volts) and a high voltage (just a few volts). This is where the famous 1s and 0s come from.

In summary, software performs a predetermined function using the hardware components of the computer. It is generally that function which is patented.

One very important factor which results from this is that the functions performed by computers can be replicated in electronic circuit format, typically as a set of electronic components on a printed circuit board. In practice, such a circuit would already be configured in component form and therefore would not need „software“ for configuration. Indeed, the physical circuit version of a function performable by a computer often has technical advantages of speed and (dare I say) reliability. However, due to their lack of configurability, such circuits become far too large to be practicable.

Returning to computers, as a result of their complexity it is not practicable for a software engineer to „program“ in 1s and 0s so programming languages have been developed, such as Basic, C, FORTRAN, Java, and so on. These languages are not particularly different in intention from „human“ languages. What they do is describe semi-complex functions in one or two words, taking away from the programmer the need to describe those functions in terms of electrical signals. Taking as an example the word „print“ found in many programming languages, this word, when translated into the electrical signals (source code) controls the display/printing hardware components to display or print the information following that command. The programmer normally does not know what this source code is or indeed how the function is performed.

Therefore, a programming language is distinct from the electrical signals which configure the computer hardware.

2) *What is a Computer Program?*

A computer program is the totality of the words written in a programming language to represent the software which would reside in and work within the computer, in other words it is a written description of the functions to be performed by the computer. Indeed, a computer program is useless to a computer until it is translated into the electrical signals which operate the computer. In this respect, it is no different from a food recipe.

So if we were to allow patenting of a written description of an inventive and patentable function performed by a computer, should we not also allow the patenting of any description of any invention (mechanical, electrical, chemical, biochemical and so on), for example a patent specification describing an invention? Of course not, it would be absurd. A written description is a literary work

protected by copyright law. Similarly, a computer program is nothing more than a literary work.

3) *The List of non-Inventions Revisited*

Article 52(2)(c) mentions programs for computers, it does not mention computer software and never has. Indeed, there has not been any prohibition on the patenting of computer software or of the functions it performs. (In case you disagree, I would suggest reviewing the decisions which refused patent applications apparently for computer software in the light of the other „non-inventions“ in Article 52(2), as all the decisions I have seen involved „inventions“ falling within other categories of the list.)

4) *The Requirement for a Technical Effect for all the „non-Inventions“*

On a purely legal basis (rather than political), if we were to accept the removal of computer programs from Article 52(2), we should remove all the other (apart possibly from business methods) „non-inventions“ because exactly the same „logic“ would apply. A mathematical method would only be patentable if it had a technical effect, and so on. Without a technical effect, a mathematical method would be no more than that thing as such and therefore not patentable.

However, in order to have legal basis for the requirement for a technical effect, we would need to amend Article 52(1) to specify that an invention must have or be able to provide a technical effect. The dire consequences of this are touched upon below.

Of course, these arguments do not sit comfortably with business methods which at present are not patentable even if they do involve a technical effect. However, they are patentable in the United States and in South Korea so Europe must follow suit, mustn't it? Are we to ignore the original reason for including business methods in the list of „non-inventions“? Apparently so.

What is the Legal Effect of the Requirement for a Technical Element?

Notwithstanding the above, it might be tempting to adopt the view that all of this does not really matter. We can live with the change in law and just amend our advice to our clients accordingly.

1) *Assessment of a Technical Effect*

How are we to understand and apply the test of „technical effect“? It is nowhere explained in statute so the best we can do is to fumble. Is this wise?

We already have fun and games with those provisions which are clearly defined in law, attempting to alter or expand the definitions carefully devised by the legislator.

For example, inventive step is clearly explained in article 56 with reference to the state of the art and the skilled person. Notwithstanding this, we have to fight the „problem and solution“ test which has no foundation in statute and which is more often than not

applied incorrectly. A review of all the awkward decisions on this subject supports this point.

Another example is the interesting position we have at present in relation to added subject matter in claims which are limited by the added subject matter (see EPO decision G1/93). Is this position supported by Article 123(2)? No.

Another example is the constant abuse of the opposition/appeal procedure despite clear legal procedure in the European Patent Convention and accompanying Rules.

Nevertheless, should we allow the requirement for a technical effect? Without statutory definition of what we mean by this, legal tests and standards are going to be all over the place.

Are we going to start looking for and using experts in „technicality“, that is people who can give expert evidence as to what is and what is not technical in character? Let us consider just two simple examples (ignoring novelty and inventive step which are separate issues).

a) *A patent claim to an icon or window produced at or proximate the centre of a computer screen or display.*

It is tempting to argue that this has no technical effect. However, one could argue that with such an arrangement the cursor is likely to be closer to the icon than a „prior art“ icon at an edge of the screen/display and therefore that the icon can be accessed faster and more easily, which is technical.

b) *A cake with strawberries evenly arranged around the periphery of the top of the cake.*

Certainly this is not technical! However, one could argue that this arrangement increases the likelihood of each slice of cake having a strawberry and hence of pleasing every person given a slice of cake and that this is technical (the arrangement of components of a product such that on cutting each cut part retains a certain form/make up).

You may very well disagree with these two examples and in litigation seek to disprove the positions. Where would the experts be found (maybe people with a technicality qualification!)? How would one assess the chances of success and hence how would one advise the client?

These points may very well provide a significant amount of legal enjoyment in the profession but hardly make a good legal framework for users of the patent system.

2) *Exclusion of Currently Patentable Inventions*

In practice the changes I have been discussing would significantly expand the list of excluded inventions with the consequence that many types of invention currently patentable could no longer be patented.

One example is games. MonopolyTM was patented as a collection of components which interact with one another and avoided the exclusion to „schemes, rules and methods for playing games“. However, where is the technical element? Apparently nowhere and therefore this game and other board games would no longer be

patentable. If so, we would have suddenly removed a very important protective right from a large industrial sector. Copyright is hardly adequate.

No doubt other examples will become apparent to you.

Do We Need Patent Protection for Computer Programs *per se*?

Of course, we must not lose sight of having to provide for the economically very important computer and software sectors adequate protection for inventions which should legitimately be protectable by patents.

However, one could hardly say that the computer and software sectors have been stifled over the past twenty years or so because of lack of incentive for developing new products. Moreover, many tens of thousands of patents have been granted for computer software related inventions, which points to the fact that the software industry has been making good use of the patent system in its present form.

Let us now consider briefly the question of what a software developer sells (rather licenses). The „old“ but still relevant form is a floppy disc or CD-ROM. The „new“ form is by direct transfer of the source code to the user's computer via the Internet and the like.

Whichever form, is used, what is typically transferred to the user is the source code and not the computer program (that is the source code is compiled, generated, and this is then stored on CD-ROM or transferred directly). I shall return to this later.

As discussed above, the core of all software inventions is the function performed by the software and indeed there is no proposed change in the law which would alter the fact that the claims must be limited to the performable function of the software. The best way to achieve this is by patent claims which protect the function *per se* (as method claims) and (in apparatus claims) unspecified apparatus elements (means) for performing that function. This is important not only because we can hardly predict what will happen to the technology in the twenty years following the filing of a patent application but also because part of a program could be replicated in electronic circuit form, such as when the invention lies in a scientific field (measurement, control and so on).

A patent with claims covering only the function performable by the source code and covering unspecified means would still encompass CD-ROMs carrying the source code and the direct transfer of source code because the source code will inevitably provide the elements essential for carrying out the invention. We may still wish to cover the item sold or licensed *per se* but this is a matter of claim formulation, as clearly provided for by Article 52(3). It is not a matter of trying to change the fundamentals of a law which already allows protection for such inventions, as demonstrated by the many patents granted for software.

The law in the United States has allowed for some time patent claims directed to a carrier in which specified computer programs (source code) is provided. Indeed

when one considers what is sold (licensed) the logic is clear. Moreover, when one considers the proviso of Article 52(3) EPC a patent claim to the carrier seems to fit well.

With respect to direct transfer of source code we need to be more careful. The wish is to protect the *software* under the provisions of primary infringement *but* when in the form of source code. This begs for a suitable claim formulation and not necessarily a removal of programs for computers from Article 52(2).

In terms of what computer software we should allow for patenting, this should be any software which meets the requirements of Article 52(1) and which does not constitute in fact one of the „non-inventions“ in the list of Article 52(2). This is considerably wider than requiring

the software to perform a technical function and, I submit, follows the original intention of the legislator with respect to what type of inventions should and should not be permitted to be patented.

Conclusions

It is therefore suggested that there is no need to amend Article 52(2) to protect computer software and that the legal test which is being used now but which would be imposed forcefully after amendment of Article 52(2) would lead to unjustified legal uncertainty for users of the patent system and removal from patentability of many categories of now patentable inventions.

Some Observations on the Controversy on »Software Patents«

A. H Horns¹ (DE)

1. New players introducing themselves

The Munich Diplomatic Conference on the Revision of the EPC had closed on November 29, 2000 after having decided that programs for computers are *not* to be deleted from the list of non-patentable subject-matters listed in Article 52 (2) (c) EPC; a respective provision of the »Basic Proposal« had been overruled by 16 of 20 votes. Ralph Nack and Bruno Phélip wrote in their report for AIPPI:

„At the Diplomatic Conference, France, Denmark, and Germany proposed to postpone the deletion of computer programs and all other EC member states except for Austria supported this proposal. The background of this initiative were the massive protests against software patents by a number of software developers.“²

What had happened? First drafts of the »Basic Proposal« did exhibit strong confidence that at least the computer software clause should be removed from Article 52. But eventually this attempt failed due to a vast majority of the EPC member states votings, and it will depend on the view to be taken by the EU whether or not such amendment will pass a »second basket« conference to be held later in 2002. Allegedly this move was caused by some public uproar of activists, namely of the »Open Source Software« (OSS) scene,³ fearing that removal of said

clause would open the gates for a flood of unwanted software patents.⁴

Obviously, political matters in the field of IP have created more and more public awareness compared with years before. Groups have introduced themselves into the arena which did not even exist before. Their main medium is the Internet. Hence, now we have a somewhat divided public with regard to IP matters:

- On the one hand, there are well-known established groups like governments, professional organisations and academic research institutes. These groups traditionally have their own traditional paper-based communication channels and do not act primarily in the public spaces newly created by the Internet.
- On the other hand, a bunch of Non-Governmental Organisations (NGOs) have little or no connection to the said traditional paper-based communication channels but make creative use of the Internet.

As a matter of fact, journalists and even politicians like MPs (or, at least, their secretaries) more and more get savvy with Internet usage and can be reached by the particular part of the public which prefers to express their ideas and opinions in the »Cyberspace«. Moreover, NGOs can gain a lot of organisational power at very low cost on an international scale by utilising the Internet.⁵ Therefore, I conclude that it is of urgent importance that in particular members of the IP professions including professional representatives before the EPO get more aware of the developments perceivable only in the on-line world of the Internet. The current situation can roughly be sketched as follows:

1 Axel H Horns, PAK, epi. The author's e-mail address is horns@pobox.com

2 Ralph Nack and Bruno Phélip in „AIPPI Report on the Diplomatic Conference for the Revision of the European Patent Convention“; available on-line under <http://www.aippi.org/reports/report-EPO-Dipl.Conf.htm>

3 See Ilkka Tuomi: „Internet, Innovation, and Open Source: Actors in the Network“; on-line under http://www.firstmonday.org/issues/issue6_1/tuomi/index.html

4 Software patents stay banned in Europe - for now. By: Graham Lea, The Register, Posted: 22/11/2000 at 16:15 GMT; on-line via <http://www.theregister.co.uk/content/archive/14933.html>

5 See Giorgio Di Pietro, IPTS, „NGOs and the Internet: Use and Repercussions“ <http://www.jrc.es/pages/iptsreport/vol48/english/TRA3E486.htm>

2. The EuroLinux coalition

In 1999, when the preparatory work for the Diplomatic Conference was underway, a number of activists mainly organised via the Internet under the umbrella of the EuroLinux Alliance⁶ started activities against patentability of software-related inventions. Members of the EuroLinux Alliance are:

- FFII e.V.; „Förderverein für eine Freie Informationelle Infrastruktur“, Germany⁷
- AFUL; „French Speaking Association of Users of Linux and Free Software“, France⁸
- APRIL; „Association Pour la Recherche en Informatique Libre“, France⁹
- Italian Initiative Against Software Patents, Italy¹⁰

There are a number of sponsors from the commercial sector, among them some wide known software companies:¹¹

- SuSE AG, Nuremberg (Major LINUX Distributor)
- Innominate AG, Berlin (LINUX Support Services)
- Phaidros Software AG, Ilmenau (UML-based Software Engineering)

and numerous others.

The most prominent action undertaken by this coalition was the so-called »EuroLinux Petition for a Software Patent Free Europe«:¹²

„This petition is directed to the European Parliament. Its goal is to warn European Authorities against the dangers of software patents. This petition is supported by the EuroLinux Alliance together with European companies and non-profit associations. Please make this petition well known to everybody concerned.

- *I am concerned by current plans to legalise software patents in Europe, considering their damaging effect on innovation and competition.*

- *I am concerned by the possible use of software patents to patent business methods, education methods, health methods, etc.*
- *I am concerned by the current track record of abuses from the European Patent Office, especially by their tendency to abuse their judicial power to extend the scope of patentability.*
- *I am surprised that no economic report has ever been published by European Authorities to study the impact of software patents on innovation and competition.*
- *I urge decision makers at all levels in Europe to enforce the Law, which clearly prohibits patenting pure computer programs, instead of changing it.*
- *I urge decision makers at all levels in Europe to reconsider their current plans and to make sure patents are not abused to prohibit or restrict the dissemination of computer programs and intellectual methods.“*

The petition is open for endorsement by everybody. Provided by EuroLinux is a HTML web form where full name, address and job position are to be entered by all those who want to support this motion. EuroLinux claims to have gathered more than 60,000 entries at the end of the year 2000 and the petition list has not been closed up to now.

In view of the allegations set out in the petition, EuroLinux was in particular rather successful to deliver to the public a message saying that the EPC presently does not allow software patents and, hence, the current practice of the EPC is blatantly illegal. Consequently, the proposed amendment to Article 52 was said to be a statutory change allowing such software patents so that in future the current daily practice can be made legal. Although this position is completely wrong as can be seen from the precise wording of the EPC as well as from the arguing set out in various decisions of the Office, many computer experts, journalists and even politicians shared this view, at least as far as can be seen in the in the German press. One reason for the quantity of resonance as well as for the broad and willing public reception of the EuroLinux position was that patent law is indeed very complicated and very few efforts have been done to explain its implications to a broader public in the past.

Moreover, several e-mail discussion lists on software patents have been opened, one of them e.g. by FFII.^{13,14} Regardless on whether it was deliberately made due to tactical reasons or inadvertently due to true cluelessness, the major and striking impression of the dialogues happening there is that the anti-patent activists do not have any substantial knowledge of the basic concepts of patent law, and some of those behave as if they might even be proud thereof. Few German patent attorneys had joined the list and started to attempt to explain the law but nevertheless all efforts to reach a mere formal common understanding of the problems related to pat-

6 EUROLINUX Alliance self-defining as „The EuroLinux Alliance for a Free Information Infrastructure is an open coalition of commercial companies and non-profit associations united to promote and protect a vigorous European Software Culture based on Open Standards, Open Competition and Open Source Software such as Linux. Corporate members or sponsors of EuroLinux develop or sell software under free, semi-free and non-free licenses for operating systems such as GNU/Linux, MacOS or Windows.“; available on-line under <http://www.eurolinux.org/> since June 17, 1999.

7 FFII e.V. self-defining as „Ein gemeinnütziger Verein, in dem Projektgruppen für GNU/Linux, FreeBSD, Java, Schnittstellenspezifikationen, Normen, Lexika, Enzyklopädien, Fonts und sonstige gemeinnützige Informationswerke arbeiten können. Gemeinnützigkeit macht unsere Satzung an Merkmalen wie Schnittstellenoffenheit, Quellenoffenheit und freie Verfügbarkeit fest.“ See on-line under <http://www.ffii.org/>

8 AFUL self-defining as „L'AFUL est l'Association Francophone des Utilisateurs de Linux et des logiciels libres. C'est une association loi de 1901 dont l'objectif principal est de promouvoir, directement ou indirectement, les logiciels libres et en particulier les systèmes d'exploitation libres, principalement ceux basés sur les normes POSIX ou dérivées, dont le plus connu est le système Linux muni de l'environnement GNU (article 2 des statuts).“ See on-line under <http://www.aful.org>

9 APRIL self-defining as „L'Association pour la Promotion et la Recherche en Informatique Libre (APRIL) est une association à but non lucratif [...]. L'association a pour objet d'engager toute action susceptible d'assurer la promotion, le développement, la recherche et la démocratisation de l'informatique libre. [...]“ See on-line under <http://www.april.org>

10 „Contro i brevetti del software - L'uso dei brevetti è in crescita nel mondo. Gli uffici dei brevetti sono sempre più pronti ad accettare nuove forme di monopolio. Adesso si sta aggiungendo la pratica di rilasciare brevetti sul software, che renderà la vita molto difficile agli sviluppatori di software libero.“ <http://no-patents.prosa.it/index.en.html>

11 See the list of sponsors under <http://petition.eurolinux.org/signatures.html>

12 http://petition.eurolinux.org/index_html?LANG=en

13 An archive of this e-mail discussion list is available under <http://swpat.ffii.org/archive/emails/swpat/>

14 A corresponding e-mail discussion list maintained by AFUL is available under <http://www.aful.org/pipermail/patents/>

enting software-related inventions seem to be in vain. For example, a number of activists did not even know that there is a difference between European „A“ Documents exhibiting patent applications as filed by the applicant, on the one hand, and „B“ documents exhibiting patents as granted by the EPO, on the other hand. Still after having been told of this difference, they started advertising an on-line „Gallery of Horror“ with examples of alleged bad patent practise.¹⁵ However, a closer inspection uncovered that the ultra-broad patent claims which were presented as if granted by EPO and quoted there had actually been taken from „A“ documents.¹⁶ It took additional weeks until said activists eventually decided to take down the non-granted claims from their web site and replace them by properly granted wordings. I tell this here for not to speak of the insurmountable hurdles to gain a common ground of understanding of concepts like »technical invention« or the like during the e-mail dialogue. The lack of any common language was striking.

In particular, FFII e.V. was very busy in 2000 to promote a draft concept for amendments to patent law:¹⁷

- *„Freedom to Publish original Information Works: Rights derived from patents may be used against the industrial application of computer programs but not against their publication or distribution. This can be achieved by a simple modification of national law.*
- *Freedom of Access to Communication Standards: When someone „sets standards“ using software market power, these standards must be free of private claims. Representants of public functions have to base their communication with citizens on open standards.*
- *Precisation of Patentability Criteria: The Lawmaker passes a resolution stating a consistent and concise interpretation of Art 52 EPC and corresponding articles of national law. As far as necessary, lawcourts are brought back on the path of this interpretation, which represents the original spirit of the law, by explanatory amendments to patent laws.*
- *Adequate systems for promotion of information innovation: Adequate systems for stimulating and rewarding information innovations and other mental labour are to be devised. This may mean a combination of soft exclusion rights, voting-based rewarding systems and a stronger public commitment to the funding of research and education.*
- *Debureaucratisation and Internationalisation of the Patent System: It is made possible to register patents instantly and free of charge by publishing them according to standardised requirements on the Net. On the other hand, a market for patentbusters is created. The polluter-pays-principle is established: the costs of the patent system are born by the owners of unjustified patents.*¹⁸

15 <http://swpat.ffii.org/vreji/pikta/index.en.html>

16 <http://www.fitug.de/debate/0012/msg00035.html>

17 Literally quoted text portions; English language grammar problems also in the original website.

18 <http://swpat.ffii.org/news/patg2C/indexen.html>

These views were not only distributed via Internet channels but also covered by lobbying letters sent by mail to dozens of politicians. The FFII proposals in their details would mean that statutory criteria for patentable subject-matters would be set extremely narrow, blocking not only patenting of software-related inventions but also other inventions which theoretically could have been obtained by exercising brute computing force:¹⁹

“A 'technical' process is one that uses natural forces to directly cause a transformation of matter. Objects that contain both technical and non-technical features are inventions only if the part that is claimed to be new and inventive, i.e. the core of the invention, lies in the technical realm. A technical process controlled by a computer program on known hardware is an invention if and only if it uses natural forces in a new way to directly cause a success in production of material goods that could not have been predicted by mere computation based on prior knowledge.”

The public sector would be discouraged from providing substantial patent examination services to the public:²⁰

„It is made possible to register patents free of charge without examination and without annual fees by a standard-conformant publication in the Internet. Such patents become valid immediately upon registration. In return, additional incentives for patent invalidation proceedings are created. If someone succeeds in invalidating or narrowing a patent, he receives, in addition to the reimbursement of litigation costs, an attractive incentive payment from the owner of the bad patent. Instead of the long and ineffective official examination, a private professional group of patent busters shall protect the public from invalid patents. The official examination continues to exist, but is conducted only at the request of the applicant. It can be conducted either by the patent office or by certified examination institutes at home and in foreign countries.”

Obviously FFII seems to be unaware of the existence of utility models. Moreover, in the proposed FFII system, the general public would not be able to get authoritative advice on enforceable patents because of they are scattered all around the Internet. Furthermore, the incentive payment would impose a huge financial risk in particular on small and medium entities (SMEs). In total, the FFII proposal is practically unworkable in its details and seems to be designed to restrict the patent system into a limited niche area of the information society. Supporters for such initiatives are not only recruited from the scene of OSS activists but also from commercial entities which, for whatever reasons, have decided not to participate in the patent system but to fight against it.

19 <http://swpat.ffii.org/stidi/eurili/indexen.html>

20 <http://swpat.ffii.org/xatra/patg2C/indexen.html>

3. The role of OSS

However, it is important to obtain a proper understanding of the role of »Open Source Software« (OSS) in the patent debate. Open Source does not just mean that merely the source code of a piece of software is open to the public. The concept of Open Source also comprises that everyone is entitled to make free use of the software including creation of derivative works.²¹ As a matter of fact, OSS is an impressive success story.²² But why should OSS activists be privileged in view of patent law? I do not give legal arguing here.²³ There is a certain *political* implication which should be taken well into account. The European Union in general and the German government in particular are eager to promote e-commerce over the Internet in order to boost their economical situations. However, consumers and other trade circles show a somewhat reluctant attitude towards this new way of running an economy. From polls it is well known that consumers as well as business professionals lack sufficient confidence in the software basis of e-commerce. They fear malicious functions deliberately implemented e.g. by the software vendor. And, experts say that fostering OSS might be a suitable way to overcome this problem.²⁴ There is no theory saying that each and every end user of OSS should inspect the source code thereof in order to uncover bugs and malicious code before using it. This would be completely unrealistic simply because of few people have sufficient knowledge. But nevertheless and as a matter of fact there is a sufficient number of experts in the field not bound by

loyalty to a certain government agency or a certain company forming some kind of informed and competent public exercising all scrutiny when working on the source code. Hence, it is believed that it would be very difficult to introduce malicious code e.g. into the LINUX kernel sources.^{25,26} This message has been recognised on the political stage. For example, the European Union²⁷ as well as the German government²⁸ are now supporting and funding OSS projects.²⁹ In particular, the German Secretary for Economical Affairs had made significant efforts to foster the debate on the implications of OSS, also in particular with regard to the patent system.^{30,31} It should be understood that it would not be a good starting position for IP professionals to shrug the shoulders when the political debate comes to the topic of the potential threat to OSS in view of possible legal action by patent holders against OSS activists e.g. based on alleged contributory infringement by means of sending OSS around the globe using the Internet. If politicians tend to love OSS they do so due to reasons which are well beyond the scope of particular political goals in the IP field. Moreover, as a matter of fact, the political issues around OSS are not severely affected by any observations regarding the question whether or not OSS tends to be more innovative than proprietary software. The role of OSS in the current debate on the shape if the information society is not that of an outstanding source of technical inventions. *The innovative role of OSS is simply due to the effects of its license model.*³²

21 See e.g. the classical definition under <http://www.gnu.org/philosophy/free-sw.html>

22 Steve Lohr: „Code Name: Mainstream – Can 'Open Source' Bridge the Software Gap?"; New York Times 2000-08-28; on-line via <http://www.nytimes.com/library/tech/00/08/biztech/articles/28code.html>

23 A brief discussion of the relationship of free speech and patent law with regard to OSS is presented in my paper „Der Patentschutz für software-bezogene Erfindungen im Verhältnis zur „Open Source“-Software...“ on-line under <http://www.jurpc.de/aufsatz/20000223.htm>

24 See e.g. Bernd Lutterbeck et al.: „Sicherheit in der Informationstechnologie und Patentschutz für Software-Produkte – Ein Widerspruch?"; on-line available under <http://www.sicherheit-im-internet.de/download/Kurzgutachten-Software-patente.pdf>

25 Kristian Köhnstopp et al.: „Sicherheit durch Open Source? Chancen und Grenzen"; Datenschutz und Datensicherheit (DuD) 9/2000 pp. 508-513

26 Brendan I. Koerner: „The World's Most Secure Operating System"; on-line via <http://www.thestandard.com/article/display/0,1151,17541,00.html>

27 See e.g. „European working group on libre software"; on-line under <http://eu.conecta.it/>

28 For example, the Berlin Open Source Software Competence Center (<http://www.berlios.de>) is co-funded by the German Secretary for Economical Affairs; cf. on-line <http://www.sicherheit-im-internet.de/themes/themes.phtml?ttid=2&tsid=162&tid=553&page=0>

29 There is a further implication which is utmost sensitive and discussed behind closed doors, if so at all. The European economy as well as the public sector strongly depend on PC operating systems and office software from a single quasi monopolist vendor seated in the U.S. What if this vendor would voluntarily or under pressure co-operate with the competent U.S. Government Agencies to implement hidden functions into the closed-source software? It is clear that no official statements exist in this regard. But, not very surprising, the public is willing to make its own thoughts on every suspicious fact which has come to the surface; c.f. e.g. Thomas Greene: „Microsoft collaborating with US spymasters", posted: 05/09/1999 at 09:26 GMT, on-line under <http://www.theregister.co.uk/content/archive/6598.html> Taken these reported facts for granted, European politicians would have no other choice than to establish a system for ensuring production of inspectable software which cannot be controlled by foreign powers. From this point of view, OSS policy has some contact points with national and regional security and economical well-being.

4. The big threat to come

The public dispute on patenting of software-related inventions together with the controversy on biotechnology patenting spark and fuel other discussions concerning the role of the current patent system in its entirety:

- On the one hand, the patent system is seen as an instrument to restrict free competition on the market by a system of monopolies. Hence, some critics argue that patents should be allowed only to the extent that

30 <http://www.sicherheit-im-internet.de/themes/themes.phtml?ttid=2&tsid=212&tid=88&page=0>

31 <http://www.sicherheit-im-internet.de/themes/themes.phtml?ttid=2&tsid=212&tid=588&page=0>

32 Nevertheless, caution should be exercised when analysing statements like that of Linus Thorwalds downplaying technical innovations in the context of the LINUX operating system based e.g. on an interview „Linus Thorwalds: 'Der Markt ist ein strenger Lehrer'" in: Computerwoche 41/2000, pp. 9-10: „Technisch ist in Linux kaum etwas radikal Neues. Was Betriebssysteme heute machen, ist im Wesentlichen alles schon in den 60er Jahren entworfen worden". It is most probably common sense among members of the LINUX developer community that patent offices exhibit bad practise by allowing patenting of obvious subject-matters. Their view might be that an »Innovation« in a more rigid and preferred sense is a much more dramatic and rare occurrence than the small »sequential« inventions which are everyday business in the IP world. Hence, maybe that Thorwalds' statement does not mean that e.g. the LINUX kernel doesn't comprise patentable inventions in the ordinary meaning of the daily IP routine work.

the overall economical benefits outweigh its costs. This is the *neo-liberal* critics of the patent system.^{33,34,35,36,37,38}

- On the other hand, the current patent system is seen as an instrument of globalised hypercapitalism in the hands of big business. This is the *anti-capitalist* critics of the patent system.³⁹

Obviously both kinds of criticism taken together are quite contradictory. Nevertheless, some activists seem to argue on both tracks. Politicians might, depending on the stakes of their respective supporters, be readily prepared to adopt such criticism if they can improve their own position. Hence, it would not be very surprising if we would see an emerging general patent debate in this decennium, not unlike the other general patent controversy^{40,41} of the nineteenth century.

My wish is that more patent professionals will be well aware of the ongoing debate, in particular on but not limited to the Internet, on the question of the macroscopic economical benefits of the patent system. And probably it would be a good idea to make suitable contributions to said controversy. Otherwise, other groups will rule the field. It should not be too much

difficult to demonstrate positive overall economic effects of granting patents on proper innovations deserving this label. With regard to, for example, the pharmaceutical sector this task seems to be rather trivial but perhaps the IT sector is different. To this end, the effect of patents on the software market should be analysed carefully.⁴² Maybe different segments of the software markets have to be treated separately:

- Software which is visible *per se* on the end user market, e.g. office software etc., and
- Software which runs on embedded systems and which, hence, is not visible *per se* on any end user market but is sold only as part of other goods, e.g. mobile phones etc.

Under any circumstances ill-considered and unworkable amendments of the substantial conditions for patenting in Article 52 EPC further restricting patentable subject-matters as desired by Eurolinux Alliance should be avoided because of they would severely harm the patent system in its entirety. Any problems caused in the context of patents in the field of IT, in particular in conjunction with OSS, might better be solved by carefully redesigning the effects of granted patents.

33 See, for example, Brian Kahin: „The Expansion of the Patent System: Politics and Political Economy“; on-line via http://www.firstmonday.org/issues/issue6_1/kahin/index.html

34 Also Pierre Desrochers: „Le Marché Libre: The Case against the Patent System“; on-line via <http://www.quebecoislibre.org/000902-3.htm>

35 Also Markus Krummenacker: „Are 'Intellectual Property Rights' Justified?“; on-line via <http://www.n-a-n-o.com/ipr/extro2/extro2mk.html>

36 Also Francois Rene Rideaux: „Patents Are An Economic Absurdity“; on-line via <http://fare.tunes.org/articles/patents.html>

37 Also a report in the daily newspaper Frankfurter Allgemeine Zeitung on 2000-11-20, page 19: „Mehr Markt soll die Politik in ihre Schranken verweisen“. This article says that on the annual general meeting of the Mont Pelerin Society, a global organisation of liberal movement, the patent system in general was heavily under attack, in particular by Mr. Jesús Huerta de Soto of the Universidad Complutense, Madrid.

38 Also James Bessen, Eric Maskin: „Sequential Innovation, Patents, and Imitation.“ Working Paper. On-line available via <http://www.researchoninnovation.org/patent.pdf>

39 This position plays a significant role within the context of the anti-WTO activities held in Seattle in 1999 and later on elsewhere. See for example „Peoples' Global Action against 'Free' Trade and the WTO“, Issue number 4, October 1999, on-line under <http://www.users.globalnet.co.uk/~firstcut/pgab4.html> „Activists from diverse groups and movements around the world are discussing, networking and organising for an International Day of Action on November 30th. On this day, ministers of 134 governments will be in Seattle for the 3rd conference of the World Trade Organisation (WTO), at which they will decide on new policies that will further escalate the exploitation of our planet and its people by the global capitalist system. The 'key players' (the Northern governments, especially those of the USA and the European Union) want to [...] strengthen intellectual property rights and patents on life, and further capitalist globalisation through a new round of free trade talks.“

40 See F. Machlup and E. Penrose: „The Patent Controversy in the Nineteenth Century.“ J. Econ. Hist. 10 (1950), p.1, 16

41 See also Wolfgang Bernhardt, Rudolf Krasser: „Lehrbuch des Patentrechts“; München: C.H. Beck, 4th edition, 1986, pp. 52 – 54.

42 The German Secretary for Economic Affairs has launched an empirical investigation in December 2000 to be carried out by the „Institut für Systemtechnik und Innovationsforschung“ (ISI) of the Fraunhofer Gesellschaft (FhG). The results are to be expected during summer 2001.

Implications of recommendations in the Guidelines concerning the use of Rule 45 EPC

D. R. Terrell (BE)

1) Introduction

The drawing up of the European Search Report, declaration or partial search report is governed by Article 92 and Rules 44 to 46 EPC. Rule 45 EPC stipulates that:

If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as it is practicable, draw up a partial search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report.

The issuing of a partial search report under Rule 45 EPC thus rests upon the opinion of the Search Division that the European patent application does not comply with the provisions of the European Patent Convention. However, under Article 97 EPC, it is the Examining Division, not the Search Division, which is empowered to issue a decision upon whether or not the European patent application complies with the provisions of the European Patent Convention. This dichotomy was addressed in respect of Rule 46 EPC in decision T631/97 in which it was held that:

Having regard to Opinion G2/92, in a case where an applicant fails to pay further search fees when requested to do so by the search division under Rule 46(1) EPC, Rule 46 EPC does not prohibit a review by the Examining Division of the correctness of the Search Division's finding of lack of unity of invention.

The Guidelines for Examination in the EPO (henceforth referred to as Guidelines), until the most recent amendments, took Rule 45 EPC to cover the following instances (see Guidelines B-III,3.12):

- i) the application appears to relate to subject-matter excluded from patentability under Articles 52(2), 52(4) or 53 EPC;
- ii) the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for part of a claim; and
- iii) there are claims above the number of ten for which no additional fee has been paid.

The most recent amendments to the Guidelines for Examination in the EPO largely concern attempts to deal with applications with parameter claims and unsubstantiated broad claims. In particular they deal with the prior art search carried out by Search Divisions under

Article 17 EPC or by BEST examiners under Articles 18 & 96 EPC. They particularly emphasise the expanded use of a declaration or partial search report under Rule 45 EPC to deal with such applications.

This contribution seeks to explore the consequences of the increased use of declarations or partial search reports under Rule 45 EPC and advocates the use of an alternative approach in the case of parameter claims, which enables the justifiable concerns of the EPO concerning applications with parameter claims to be dealt with in an entirely objective manner.

2) Search procedure under the current version of the Guidelines

The report, declaration or partial search report drawn up by a search examiner or a BEST examiner must indicate whether the subject of the search was restricted and which claims have or have not been searched. If any restrictions were applied, these must be detailed on supplemental sheet B, according to the categories of restrictions provided for on that sheet:

- a) if there are claims above the number of ten for which no additional fee has been paid;
- b) if the Search Division considers that the EP-A does not comply with the requirement of unity of invention, within the meaning of Article 82 EPC under Rule 46 EPC; and
- c) if the Search Division considers that the EP-A does not comply with the provisions of the EPC to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims under Rule 45 EPC.

In the first case an indication is made in the declaration that a meaningful search has not been possible on the basis of all claims. In the second case claims searched completely, searched incompletely and not searched at all are indicated in the partial search report. In both cases, the reasons should be indicated (for example, subject-matter not patentable, insufficiently clear claims etc.).

Category c)

As regards category c), there is no case law known to the author on which to base an objective decision by a search examiner or a BEST examiner under Rule 45 EPC. The current Guidelines lay down criteria under which a partial search report under Rule 45 EPC may be drawn up.

Guidelines B-III,3.12 states that the search examiner may exclude certain subject-matter from his search:

- i) if the application appears to relate to subject-matter excluded from patentability under Articles 52(2), 52(4) or 53 EPC;
- ii) if the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for part of a claim.

Guidelines B-VIII,6 states that:

„A declaration or partial search taking the place of the search report under Rule 45 may result from the application not meeting the relevant requirements of the EPC to such an extent that a meaningful search of the claims, or of some of the claims, or part of a claim, is impossible“.

Furthermore, it further states that:

„the word ‚meaningful‘ is a question of fact for the Search Division to determine.....[that] the word ‚meaningful‘ should be construed reasonably‘... [and that] the word ‚meaningful‘ should not be construed in such a way that Rule 45...[is]... invoked simply because a search is difficult.“

It then states that:

„...it may be the case that a given claim could theoretically be searched, but that nevertheless, the Search Division comes to the conclusion, under a proper consideration of the relevant provisions of the EPC, that it would not be meaningful to do so, in the sense that it would not serve any useful purpose to do so having regard, for example, to any possible future prosecution of the application“.

Guidelines B-VIII,6 then goes on to discuss a number of non-limiting examples which illustrate where Rule 45 EPC might find application:

- i) if there is a broad or speculative claim supported by only a limited disclosure covering a small part of the claim;
- ii) if there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought;
- iii) if the applicant's choice of parameter to define his invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all.

3) Previous practice

Prior to the introduction of the current Guideline, broad or speculative claims supported by only a limited disclosure covering a small part of the claim were adequately dealt with by the Examining Division under Article 56 EPC (see T939/92, T694/92 & T583/93) and Article 84 EPC (see T133/85).

Applications in which there are so many claims, or so many possibilities within a claim, that it becomes unduly

burdensome to determine the matter for which protection is sought were also dealt with under Article 84 EPC (see T246/91, T133/85).

In the case of parameter claims with an inaccessible parameter by virtue of an inadequately disclosed evaluation technique e.g. by using an inadequately described commercially unavailable measuring apparatus, these have been dealt with under Article 84 EPC. As regards other parameters, the patent has been granted and the opposition procedure has been relied upon to eliminate patents in which the patentee has attempted to re-patent prior art via a parameter claim.

4) Consequences of a declaration or partial search report under Rule 45 EPC

A declaration or partial search report issued by a Search Division under Rule 45 EPC is not subject to appeal, since it does not represent a decision as required by Article 106(1) EPC and Search Divisions are not bodies stipulated in Article 106(1) EPC. The applicant has two options: to file a divisional application, under Article 76 and Rule 25 EPC, concerning the unsearched subject-matter while the parent application was still pending up to the acceptance of the text for grant under Rule 51(4) EPC or, once the application had been handed over to the Examining Division under Article 17 & 18(1) EPC, to request a decision from the Examining Division under Rule 69 EPC concerning the exclusion or not of subject-matter excluded from search by the Search Division from the examination of the application.

If the Examining Division decides under Rule 69 EPC against the opinion of the Search Division, can examination be carried out on the application including the unsearched subject-matter? The only Article or Rule of the Convention that could apply is Rule 86(4) EPC, but this would only apply in the event of amended claims. As regards case law, could opinion G2/92:

An applicant who fails to pay further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it.

be applicable due to the parallel nature of Rules 46 and 45 EPC? If so, decision T631/97 might be applicable, which would mean that, even though the subject-matter had not been searched, the subject-matter would not necessarily be excluded from consideration by the Examining Division even though a further search would be necessary.

In the event that the Search Division's decision under Rule 45 EPC is maintained by the Examining Division, the Examining Division also being bound by the Guidelines under Article 10(2)(f) EPC, there are two options: either the subject-matter can be filed as a divisional application, under Article 76 and Rule 25 EPC, while the parent application was still pending up to the acceptance of the

text for grant under Rule 51(4) EPC, but with the likelihood that a second Search Division, being also bound by the Guidelines under Article 10(2)(f) EPC, will issue a declaration under Rule 45 EPC, or an appeal can be filed against the decision of the Examining Division under Article 106(1) EPC. The latter is an option with considerable risks and costs for the applicant, although the Boards of Appeal, unlike the Search and Examining Divisions, are not bound by the Guidelines (T162/82 and T603/89), only having to comply with the provisions of the EPC as stipulated in Article 23(3) EPC.

In the event of a favourable decision by a Board of Appeal, the same questions arise as discussed above in connection with a favourable decision by the Examining Division.

This procedure means that a review of the Search Division's opinion could be potentially carried out by two independent instances: the Examining Division and a Board of Appeal. If the search was carried out by a BEST Examiner, there is only one independent instance, a Board of Appeal, an instance with considerable risks and costs for the applicant and the EPO, hence disadvantaging the applicant.

5) Use of Rule 45 EPC envisaged by the current Guidelines

It is therefore clear that the issue of a declaration or partial search report under Rule 45 EPC in all likelihood forces an applicant into a situation in which he has to appeal a decision by the Examining Division to maintain the Search Division's decision under Rule 45 EPC, an option with considerable risks and costs for the applicant. Therefore, Rule 45 EPC is a blunt instrument and should only be used in cases, where no alternative approach is possible.

Furthermore, it calls upon a search examiner to make far-reaching decisions under Articles 83, 84 and 56 EPC, which is neither within his remit nor within his competence, these belonging to the province of the Examining Divisions. The current Guidelines therefore take the search examiner outside his remit and into the realms of examination. This represents a blurring of where the search of an application ends and where the examination of the same application begins and infringes the avowed intention of the EPO to maintain a separation in time between the search and examination steps. EPO representatives have, moreover, stated that a change in the EPC in this regard would lead to considerable political problems and would have severe consequences¹⁾. However, the EPO is apparently prepared to sanction this blurring of the end of the search and beginning of the examination, judging by a proposal made by the EPO at the 30th SACEPO Meeting (17-18 June 1999 in Munich) in which in the context of a proposal for treatment of „complex applications“ and broad claims the search examiner would execute the search taking into account the future examination²⁾. This amounts to a decision, which, under Article 106(1) EPC, an applicant cannot contest. Decisions under Articles 83, 84 and 56 EPC fall

within the remit and competence of an Examining Division, but the Examining Division is also bound by the Guidelines under Article 10(2)(f) EPC and hence, in view of B-VIII,6, is likely to maintain the decision of the Search Division based thereon.

The envisaged use of Rule 45 EPC represents a clear infringement of Article 113(1) EPC, which has been a cornerstone of EPO case law from its inception. Article 113(1) EPC guarantees that any decisions made by the EPO will be open and fair:

The decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had the opportunity to present their comments.

No response by the applicant to a decision made in the course of a search by a Search Division is envisaged by the EPC. Response by the applicant is possible under Article 96 EPC, if an Examining Division states its intention to maintain the decision of the Search Division during examination proceedings, as it is also bound by the Guidelines under Article 10(2)(f) EPC. However, the absence of substantive arguments supported by evidence infringes Article 113(1) EPC.

Article 113(1) EPC is an element of the principle of good faith. If not adhered to there is a substantial procedural objection (violation). The Examining Division is therefore obliged to discuss the arguments of the parties. Article 113 EPC is to be understood as meaning that the facts, the legal considerations and the logical reasoning which have led to a particular decision must be given. There is a substantial procedural violation if arguments of the parties are not discussed. According to decision T951/92:

In the context of the examining procedure under Articles 96, 97 & 113(1) is intended to ensure that before refusing an application for non-compliance with a requirement of the EPC is issued, the applicant is informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance is based, so that he knows in advance of the decision both that the application may be refused and why it may be refused, and so that he may have a proper opportunity to comment upon such reasons and/or to propose amendments so as to avoid refusal of the application.

Furthermore, in J7/82, it was held that:

there had been a breach of the provisions of Article 113(1) EPC and a substantial procedural irregularity, because the decision at issue had completely ignored the arguments which had been addressed to it by the party and had based itself on grounds on which the applicant had had no opportunity to comment.

As regards parameter claims, the criteria suggested in the amended Guidelines are arbitrary. The attempted claiming of known prior art by means of an inaccessible parameter by virtue of an inadequately disclosed evaluation technique, e.g. by using an inadequately described commercially unavailable measuring apparatus, can be dealt with by the Examining Division under Article 84 EPC, as mentioned above. However, issuing a partial

search report under Rule 45 EPC simply because a parameter has not been used in the scientific literature searched by the Search Division is not reasonable, if the parameter has been disclosed in such a way that it can be determined by one skilled in the art, because (i) the European search is far from exhaustive, not including, for example, commercial data sheets and other non-patent literature; and (ii) does not recognize/reward the inventivity of the inventors, who may have found a parameter which relates to a particularly desirable technical effect.

6) Alternative strategy vis à vis parameter claims:

A far fairer and more objective way of dealing with parameter claims is that adopted by the USPTO. Here an Examiner alleges anticipation by a prior art document or by several prior art documents independently, since he does not have the facilities to carry out the necessary tests himself, thereby challenging the assignee to refute these allegations with evidence. Often this will require the assignee to submit a 37 CFR 1.132 declaration based on reproducing the material disclosed in the prior art document (assuming that this material is sufficiently enabled to allow it to be sufficiently reproduced to be able to determine the parameter concerned) and showing that the material does not exhibit the particular parameter. This is a clearly defined and objective pro-

cedure based on evidence supplied by the assignee. Alternatively the patent could be granted and could be challenged using such evidence in a negative sense in an Opposition procedure.

7) Conclusions:

The issue of a declaration or partial search report by the EPO under Rule 45 EPC is a serious sanction against an applicant with far-reaching consequences. It should, in my opinion, only be contemplated by a search examiner or BEST examiner and maintained by an Examining Division, in one of the following circumstances: there is non-compliance with Articles 52(2), 52(4) or 53 EPC as interpreted by EPO case law, the application is totally inconsistent making a meaningful search impossible or there is non-payment of claims fees under Rule 31 EPC.

8) Reference

- 1) A. Casalonga, epi information 56 (2/2000): Supplemental report of the EPPC concerning the revision of the EPC.
- 2) A. Casalonga, epi information 46 (2/2000): Report of the EPPC meeting of 23rd November, 2000 (see under point I).

Preliminary Review under Rule 40.2(e) – Remuneration Only!

M. A. Störzbach (CH)

There was a time, when the PCT allowed to pay one (or more) additional search fees to the International Searching Authority (ISA), e. g. the European Patent Office (EPO), under protest. The protest had to be considered by a „three member comité“, represented within the EPO by a Board of Appeal. If the Board considered the protest justified in whole or in part, the respective search fees were reimbursed¹. There is, however, no clear provision, that the finding of non-unity should explicitly be reversed if the comité did esteem it inappropriate. Nevertheless, the reasoning of the decision of the comité did show its opinion in this respect. This may be important if a designated or elected office requests e. g. filing of divisional applications for the second and further invention, or even requires the payment of the additional fee as allowed under Art. 17(3)b PCT². A reimbursement

of an additional search fee without reasoning does not discern between the fact that the objection of non-unity does not apply, and the fact that the ISA should have established the full search in spite of non-unity because the additional invention could be searched with only negligible additional efforts³.

On 1 July 1992, Rule 40 has been amended introducing a fee to be paid if the comité (Board of Appeal) should review the decision of the search examiner, however only after the protest has been subjected to a preliminary review. The introduction of the protest fee explicitly served the purpose to delimit unnecessary use of filing protest against a finding of non-unity by the search authority⁴.

For dealing with the prior review, within the EPO, revision panels of members of the Search Division have been defined.

Now, the review panel within the European Patent Office responsible for the preliminary review only takes into consideration the non-unity justifications for exactly

1 (PCT, as in force until 1 July 1992)

2 „(b) The national law of any designated state may provide that, where the national Office of that State finds the invitation, referred to in subparagraph (a), of the International Searching Authority justified and where the applicant has not paid all additional Fees, those parts of the international application which consequently have not been searched shall, as far as effects in that State are concerned, be considered **withdrawn unless a special fee** is paid by the applicant to the national Office of that State.“ (Emphasis added)

3 PCT International Search Guidelines, in force from 18 September 1998, VII-12.

4 PCT Gazette, Special Issue, **20/1991** (1991) p. 8128.

those inventions for which an additional search fee has been actually paid, and grants reimbursement of the search fee(s) if the justification of non-unity relating to one or the other of these inventions is not sufficient. A reasoning for the grant of the reimbursement is not given, only the remark that the justification for requiring additional fees has been deemed insufficient. Furthermore, in view of the reimbursed search fees, particularly if all search fees have been reimbursed, the protest is deemed to be fully admitted. However, the justification of requiring additional search fees is not repealed regarding all its effects, particularly in view of other claims for which no additional search fees had been paid and whose quality of defining additional inventions is dependent on the justification which has been appreciated insufficient. Furthermore, the International Search Report still contains the finding of the ISA that it has identified more than one invention as if this finding has been either contested nor found unjustified.

In consequence, to obtain a complete search, the applicant is pressed to pay for every and all allegedly existing inventions an additional search fee. Thereby, he runs the risk not to get the fees reimbursed for inventions, i. e. claims, which may not be worthwhile to pay for them. In any case, however, the statement of the ISA of the number of inventions remains.

The consequences of this manner of dealing with the provisional review shall be illustrated by an example. Suppose an international patent application under the PCT with 10 claims. Claim 1 is an independent claim, the further claims 2 to 10 are dependent, but contain rather different features. Non-unity had been found a posteriori based on a document which is supposed to destroy novelty of claim 1, and due the very different claims 2 to 10, each had been accorded an individual invention, resulting in a request for 8 additional search fees, claims 1 and 2 being covered by the fee initially remitted. After having paid at least one additional search fee with protest, the following variants of further procedure and results may occur:

A) One or more additional search fees are paid, yet neither the review panel nor the Board of Appeal considers the finding of non-unity incorrect: the „paid“ inventions are searched, the finding of non-unity upheld.

B) The situation as regards novelty of claim 1 is not so evident that the review panel is able to consider the justification of non-unity insufficient, and invites to pay the protest fee. The protest fee being paid, the Boards of Appeal have decided that the non-unity objection can not be upheld without restriction to specific inventions⁵, hence implicitly all the claims pertain to one single invention, and this even if only one additional search has been paid. If the search report established thereafter actually covers all inventions, and does or not contain the

statement that several inventions had been found by the ISA, could unfortunately not be ascertained.

C) The situation as regards novelty of claim 1 is obvious to the review panel, maybe after taking into account the statement of the applicant. The result is that the applicant gets the search fee reimbursed, yet the finding of non-unity is still contained in the International Search report, and there is no option to pay the protest fee. In consequence, the applicant may be confronted with the requirements of the designated/elected offices to pay additional fees and to file divisional application for the second and each further invention without having at least a reasoning in hand, from which it can be derived that the finding of non-unity is not shared by the revision instance.

This manner of implementing the preliminary review and possibly also the protest procedure deprives the applicant of the full relief from the finding of non-unity of invention just in clear cases, and leaves him alone with the risk that he has to explain more or less explicitly to designated/elected offices that unity of invention prevails in spite of the finding of non-unity. Furthermore, it is somewhat disturbing that the revision panel or a Board of Appeal find the justification for non-unity incorrect and revokes it, however the statement itself remains in the search report.

It is still worthwhile to note that the PCT International Search Guideline⁶ and the Administrative Instructions under the PCT⁷ stipulate that in cases where the applicant has paid additional search fees under protest – if the protest has been granted by the review panel or the board of appeal, is not mentioned and, therefore, should not matter – the applicant has to be „informed promptly of any decision about the compliance with the requirement of unity of invention“. This may be understood that a decision about *unity of invention* is to be taken by the review panel as well as by the Board of Appeal, and reimbursement of the search fee is merely a material consequence thereof. Furthermore, subsequently to the rules for dealing with the protest, the Search Guidelines emphasise that the decision about unity of invention rests with the ISA⁸. This repetition of the responsibility of the ISA in this place can only be understood to apply to the preliminary review and the protest, and it seems to require a decision about the unity of invention in first place, and not only if a reimbursement of the search and possibly the protest fee is equitable.

Furthermore, by paying the search fee (and any additional search fee), the applicant has obtained the right that the whole invention defined by the corresponding claims is searched. In case of an incorrect finding of non-unity which is reversed by the board of appeal or the revision panel, the whole finding of non-unity has to be repealed. In other words, the assessment if unity of the invention prevails or not, has to be iterated as far as it is found incorrect, i. e. in the extreme from the origin, and any claims which are so far concerned by the

5 W0001/89: „... the invitation to pay additional fees is not legally effective ...“; W0036/90 (7 inventions found in claim 1, 6 additional fees requested, 2 additional fees paid: „... In these circumstances, the Board considers that the request for the payment of **six** additional search fees is not justified.“ (Emphasis added)

6 PCT International Search Guidelines in force from 18 September 1998, VII-13.

7 Administrative Instructions under the PCT

8 PCT International Search Guidelines, loc. cit. VII-4

original considerations of the ISA, should be included in this reassessment, independently of if these claims have been paid additional search fees for. Or, in other terms, it appears unjustified that the applicant is punished by the requirement to pay all additional search fees due to a finding which may prove unjustified.

With regard to the example given above, only one additional search, e. g. for claim 3, should suffice to initiate reconsideration if the subject matter of claim 3 constitutes an invention separate of claim 2 and if the finding is appropriate that claim 1 does not constitute a link of the dependent claims. If it is found that claim 1 may serve as such a link, then not only claim 3, but also claims 4 to 10 adhere automatically to the one and only invention defined by the set of claims, and must be included in the search – because this is what would have been had to be done if unity of invention had been correctly recognised from the beginning. Any other solution does not only deprive the applicant from full relief from an inappropriate finding of the ISA, but imparts on him further burdens in the following national/regional phases.

In conclusion, deviating from the apparent present praxis of the EPO of dealing with additional search fees paid under protest, it is deemed at least equitable with respect to the right of the applicant to receive a complete search if not required by the gist of the Administrative Guidelines under the PCT and the PCT International Search Guidelines that the protest and the preliminary review should render an explicit decision about the unity of invention of the subject matter of the claims additional search fees have been paid for. Reimbursement of the additional search fees may then be ordered either because unity of invention has been stated, or because the search could be performed with only minor additional efforts. Furthermore, if the finding of non-unity of invention of the search examiner has been found inappropriate, the effects of this finding should be completely reversed, particularly also with respect to claims no additional fees has been paid for. This would provide perfect relief to the applicant, in contrast to the sole reimbursement which leaves the burden of a more complicated further prosecution of his patent application to the applicant.

Redaktionsschluss für epi Information 2/2001

Redaktionsschluss für die nächste Ausgabe der epi Information ist der **11. Mai 2001**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for epi Information 2/2001

Our deadline for the next issue of epi Information is **11 May 2001**. Documents for publication should have reached the Secretariat by this date.

Date limite pour epi Information 2/2001

La date limite de remise des documents pour le prochain numéro de epi Information est le **11 mai 2001**. 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
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