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Editorial

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

This edition of *epi* information is loosely based around a theme relating to recent changes at the European Patent Office and, particularly, to the changes in the actions of the European Patent Office's International Searching Authority and International Preliminary Examination Authority.

Whilst the initial announcements relating to this were dealt within the Editorial of *epi* Information Number 4 of 2001, the situation has now become a little clearer. In particular, with regard to the European Patent Office not acting as International Search Authority, it has been made clear that the inaction of the European Patent Office as International Searching Authority has been confined to two technological areas, those of electronics and software and of biotechnology. Unsurprisingly, these are the two areas in which greatest technical growth has taken place in the last few years and in which there is most interest in development and protection of developments.

The European Patent Office have now moved to a system whereby a computerised Written Opinion and International Preliminary Examination Report is issued unless full substantive examination is specifically requested before the European Patent Office as International Preliminary Examination Authority. Furthermore, Demands are not able to be filed at the European Patent Office as International Preliminary Examination Authority for US derived PCT Applications in the above two mentioned technical areas. There is little doubt that this is having an immediate impact on the amount of work flowing into the European Patent Office, in the short term. It is likely that the short term aim of reducing backlogs at the European Patent Office will be achieved.

As stated in the previous Editorial, however, many members of the community doubt that the long term effect will be as startling. For all those cases searched and examined by the US PTO, there will come a time when the European Patent Office have to conduct their own search and examination and are unable to rely on previous conducted international searches and examinations. Furthermore, in many cases, entry into the European Regional Phase will take place no longer with guidance as to what the European Patent Office's view of the case may be. As such, it is possible that a greater backlog may arise in the future.

It is a greater shame that this action has, unfortunately, coincided with a global economic downturn, because of which many applicants are having to be much more cautious with regard to the money spent. Without the previous useful guidance from the European Patent Office as to the likelihood of patentability of cases, it is more possible that applicants will have to abandon the idea of entering the European Regional Phase of the PCT Application. This is because the risk of spending money on a case which is ultimately found, by the European Patent Office, to be invalid outweighs any potential long term benefits of valid protection. It seems that, therefore, there may be instances in which legitimate advances in technology are unable to be properly protected in Europe due to prevailing circumstances.

Redaktionsschluss für epi Information 3/2002

Redaktionsschluss für die nächste Ausgabe der epi Information ist der **16. August 2002** vorverlegt**.** Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein

Deadline for epi Information 3/2002

Our deadline for the next issue of epi Information is **16 August 2002.** Documents for publication should have reached the Secretariat by this date.

Date limite pour epi Information 3/2002

La date limite de remise des documents pour le prochain numéro de epi Information est le **16 août 2002.** Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi 25th Anniversary Seminar & Gala Dinner

Ettington Chase Conference Centre
Stratford-upon-Avon

26th October 2002

Readers will find an insert in the middle of this issue of *epi* information with the registration form and programme for the above event, that promises to be a highlight in the history of the *epi*.

A truly prestigious speaker panel will present views on the likely future of intellectual property laws and practices in Europe. A Gala Dinner for registered delegates will take place at Warwick Castle, Britain's most complete Medieval castle, after the seminar.

Registration for the seminar is by way of the form reproduced in the insert. Completed forms and payments must reach Conference Line, whose details are in the form, by 16th September 2002.

A pdf version of the form is downloadable from the *epi* website: www.patentepi.com.

Conference Line have established a dedicated e-mail address for correspondence concerning the Seminar and Gala Dinner, at episeminar@conferenceline.co.uk. The e-mail address is not available for receipt of the registration forms however.

We wish the delegates and speakers an enjoyable and stimulating time at the Seminar and dinner.

epi Seminar Organising Committee

Terry Johnson Chris Mercer Tim Powell

52nd Council Meeting
Stockholm
27 – 28 May 2002

A Council Meeting took place in Stockholm on 27th and 28th May 2002, and the usual full report of the meeting will appear in epi Information 3/2002. At this meeting the Council elected a new Board and approved the make-up of the Committees of the *epi* for the next term (2002-2005). The constituent members of the new Board and the Committees may be found at the back of this issue.

Some changes in EPO and PCT prosecution practice before the EPO – what, why, and to what effect

J. Boff (GB)

The following article addresses some (not all) of the recent changes in EPO practice, and their potential effect on the performance of the EPO.

Background

As all know, the EPO has suffered from a dramatic increase in workload over recent years. The number of direct EP and Euro-PCT applications filed in 1995 was approximately 79,000. The corresponding number for 2000 was approximately 145,000. The current estimate for 2001 is approximately 158,000. This corresponds to an average growth rate of well over 10% per annum.

In contrast, although the EPO is recruiting examiners rapidly (although not as rapidly as it would wish), examining capacity is not increasing as fast as the number of examiners, or the workload. This is because new examiners take some time to train and become fully effective, and because those examiners who take on a teaching role have less time for examination.

It could be expected that, as recently recruited examiners increase in their effectiveness, and as the training workload on older more experienced examiners diminishes, the productivity of the EPO will increase. However, for the moment, there is a position of EPO workload exceeding EPO capacity.

To attempt to overcome this shortfall in capacity, the EPO has adopted various measures with a view to improving operating efficiency. Unfortunately, some of the changes made are likely to have undesirable consequences.

PCT Procedure

PCT procedure, with its mandatory (but frequently breached) time limits for establishing the search and examination reports appeared to the EPO to be a useful area for change, particularly as demand for the PCT route has increased year on year.

Restriction on search

The President's Notice of 26th November 2001 restricted the amount of PCT searching and examination to be done for non-EPC applicants. The restriction affects limited technological areas and so is unlikely to affect numbers at large to any great extent. The technological areas concerned are ones where the problems of backlogs are perhaps greatest, and so there may be some short term alleviation in examiner workload in those areas. However, eventually these PCT applications will enter the European Regional Phase, with the need for supplementary searching and full examination, and so the affect of the change will be largely to defer work rather than remove it. On balance however this seems a useful short term measure.

PCT-Lite

By the President's Notice of 2nd November 2001, the new procedure for International Preliminary Examination of PCT applications was introduced. The EPO is of the view that a very high proportion of Demands are filed simply with the aim of postponing the National Phase, and that the new procedure will reduce the amount of examiner effort involved in examining such cases, while allowing those who want a full Preliminary Examination Report to obtain one.

As part of this procedure, unless „traditional" examination is requested by the applicant, „no-brain" Written Opinions and International Preliminary Examination Reports will issue based on the search report results. If a „no-brain" International Preliminary Examination Report issues, a refund of two-thirds of the International Preliminary Examination Fee will be given.

At present approximately 67% of PCT applications enter the European Regional Phase and so some reduction in work is to be expected, in that the remaining 33% will not require examiner effort in preparing a full International Preliminary Examination Report. However, in the absence of a full International Preliminary Examination Report, one would expect the proportion of PCT applications entering the European Regional Phase to rise. The EPO have budgeted for a slight rise in numbers but there is no way of knowing at present how big an increase will occur.

This change is therefore likely to release significant amounts of examiner time for other tasks, although at the expense of a higher number of PCT applications entering the European Regional Phase. On balance this approach is likely to achieve its aim of reducing the amount of „wasted" examiner time, but the reduction in costs in relation to the International Phase may lead to problems (see below).

Deferred Entry into Regional Phase

The Decision of the Administrative Council of 28th June 2001 Amending Rule 107(1) introduced a uniform 31 month time limit for entry into the European Regional Phase.

The aim of this measure was to reduce the number of Demands for International Preliminary Examination, so reducing the amount of examiner effort required on work with mandatory time limits.

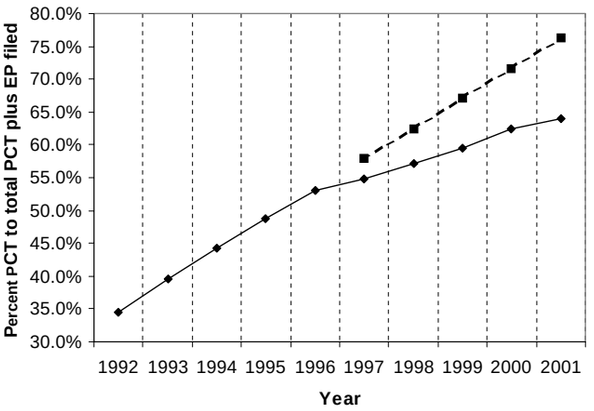
Subsequently the PCT Assembly introduced a uniform 30 month time limit for entry into national/regional phases. However, there are reservations under the PCT revisions, and such important countries as Japan, China, and South Korea still maintain the shorter 20 month time limit unless International Preliminary Examination is requested.

So long as countries such as Japan maintain reservations, the beneficial effect of this provision is likely to be small. A 10 month delay in the translation costs of the National Phase in Japan and like countries is worth having, particularly if a Demand is filed by the PCT-Lite route so that the Preliminary Examination fee is reduced. However, it is probable that over the next year or so the number of countries maintaining reservations will reduce, and so over time the number of Demands filed may well reduce significantly.

However, a side effect of this provision may be to increase the proportion of applications filed by the PCT route. At present when choosing between the direct European and PCT routes an applicant has to factor in the costs of International Preliminary Examination. Now, the applicant can, by filing a PCT application, have an option to patent in a broad range of countries without this significant large cost.

Relative costs

Cost factors have affected the choice of filing route in the past. The following graph shows the clear effect of the 1996 changes in fee structure, which radically reduced the cost of the European route. The graph also shows a trend line indicating growth assuming that there had been no change.



The effect of the PCT-Lite amendments is to reduce the Official Fees on a typical PCT application by about 25% through the two-thirds reduction in the Preliminary Examination Fee. The effect of the change in term for entry into the National/Regional Phase will in effect reduce Official Fees on a typical PCT application by over 45%. Such drastic step changes in fees will inevitably increase the **relative** attraction of the PCT route (filing a direct EP application is still cheaper in terms of Official Fees).

It is very likely that there will be a rapid return to the long term trend indicated in the graph, or even to a higher level. The EPO has factored this into account in its latest business plan, increasing the predicted proportion of PCT applications from 70% to 75% in 2006. This may however be a serious underestimate given the size in the fee reduction for the PCT route.

Such an increase in PCT applications could pose serious problems for the EPO, since PCT searching workload would increase and this, with its mandatory time limits, would displace searching of direct European filings. As the current search stock of the EPO is about 10 man months, an increasing proportion of PCT searches implies that failure to meet the PCT mandated time limit for the International Search Report could become the norm, rather than an exception.

EP procedure

Claims structure

The Decision of the Administrative Council of 13th December 2001 amending Rule 29(2) EPC is aimed at getting applicants to provide applications in a more easily examined form by restricting the scope for multiple claims in the same claim category. This may persuade some applicants to change their claiming practice, but is also likely to lead to an increase in the number of divisional applications. The work in processing more divisional applications may outweigh the saving in examiner time hoped for. It is by no means clear what overall effect this change will have.

PACE

In an effort to reduce prosecution times, and to direct search and examination to the applications applicants think important, the President's Notice of 1st October 2001 announced that requests for accelerated examination, if made by separate letter or form, would not appear on the Register or in the file of an application. The suspicion was that applicants are reluctant to request accelerated examination, as this can warn competitors of important applications. As PACE has only been used at a low level, only a marginal increase in requests was expected.

Of course, there is no sure way of knowing how many applicants were reluctant to file requests for examination, and so the effect of this provision is difficult to predict. At best, it will be useful in directing the EPO's attention to cases that applicants think important. At worst, if there is a big hidden demand for rapid prosecution, so many people will file requests that the EPO will not be able to cope.

General approach

The EPO is making good efforts to manage a difficult situation. However their current difficulties in recruitment and training are leading to delays in search and examination. These problems have led to the need for short term measures to relieve workload. The measures adopted mostly defer problems rather than remove them; however the changes in PCT practice may cause major problems for the EPO.

Impact of EPO Limitations (on acting as ISA and/or IPEA) from a U.S. Perspective

R. G. Sharkey* and W. T. Christiansen*

Over approximately the last six months the European Patent Office (EPO) has moved to effect a number of changes that impact applicants and their representatives. The changes impact patent strategies and, thus, ultimately applicants' business planning.

An example of a recent change from the EPO is the deadline for filing a divisional application. However, while that and other changes are interesting, the purpose of this commentary is to address two specific changes that affect U.S. applicants in certain technology fields. In particular, we explore the impact, from a U.S. perspective, on EPO limitations concerning the Patent Cooperation Treaty (PCT) applications for which it will act as an International Searching Authority (ISA) or as an International Preliminary Examination Authority (IPEA).

We note that, in the interests of space and avoiding redundancy with the other articles herein, we are not reiterating the details of the EPO limitations on its acting as the ISA and/or IPEA. Perhaps it would also be appropriate to note our personal bias in respect to our having had favorable and enjoyable interaction with the EPO over the years. In general, we have found the examinations competent and the examiner interviews in which we have participated at Munich or the Hague with European associates very constructive. Thus, we believe that any changes that diminish a U.S. applicant's access to the EPO via the PCT necessitate careful consideration.

First, what impact is there on a U.S. applicant where the EPO will not act as the ISA? In this situation with the international application having been filed through the U.S. Patent and Trademark Office (USPTO) acting as the U.S. receiving Office for the PCT, the USPTO will be designated as the ISA. (Possible ways to circumvent the EPO's limitations on acting as the ISA are not addressed herein.) The USPTO then conducts the search related to the PCT application. Since the USPTO is one of the major Patent Offices worldwide, is their acting as the only ISA for U.S. applicants a problem? We believe that it is. To appreciate why, one needs to step back and consider some of the reasons a U.S. applicant files a PCT application. A major reason is to defer the significant expenses associated with filing in particular nations and regions in order to „buy time" to gain more information concerning the commercial potential and patentability of the technology. With the possible exception of Japan in certain circumstances, the European regional designation under the PCT is the single most important designation for most U.S. applicants. Thus, any information that foreshadows the likely European examination of a PCT derived application is of paramount importance.

Would not a search by the USPTO acting as the ISA be identical to a search by the EPO acting as the ISA? In our view the short response is „No". The longer answer is that over the years we have observed that the results of the search of a U.S. application by the USPTO and the search of the corresponding PCT application by the EPO acting as the ISA are significantly different. When such USPTO and EPO searches are compared, they are almost never identical. Frequently, there is relatively little overlap between the references cited. Sometimes the searches do not have even one reference in common! Therefore, the EPO acting as the ISA is generating additional information relative to the USPTO search information. That information is useful to U.S. applicants in at least two ways. First, the references cited by the EPO are likely to be the ones cited by the EPO in the examination of the PCT application upon conversion into the European Regional Phase. Accordingly, U.S. applicants obtain a useful foreshadowing of patentability before the EPO. Second, a U.S. applicant can take any additional references cited by the EPO that were not cited by the USPTO (or not previously cited by applicant to the USPTO) and provide them to the USPTO in order to strengthen the validity of a patent that matures from the U.S. application.

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Therefore, we believe that there is a significant negative impact on a U.S. applicant where the EPO will not act as the ISA.

The second topic is what impact is there on a U.S. applicant where the EPO will not act as the IPEA. Conversion of a PCT application to the national and/or regional stage is typically a significant financial expenditure to an applicant. In addition to the obvious expenditures necessary for the conversion *per se*, a favorable view of patentability that has led to the decision to proceed with conversion is typically also applied to committing an applicant to additional expenditures in the form of research and/or clinical trials. As pointed out above, for most U.S. applicants the European regional designation under the PCT is the single most important designation. Thus, the Written Opinion under Chapter II of the PCT is potentially a valuable opportunity to garner information concerning whether to proceed with conversion of a PCT application into the European regional phase.

Does a U.S. applicant receive as useful information respecting future examination by the EPO of a PCT derived application, where the USPTO rather than the EPO acts as the IPEA? In our view the short answer is „No". The longer answer is that, perhaps not surprisingly, the USPTO acting as the IPEA is reasonably predictive of how a PCT application will be examined at the USPTO; and the EPO acting as the EPA is reasonably predictive of how a PCT application will be examined in the European regional phase. There just appears to be no substitute for the EPO when an applicant needs the IPEA to be reasonably predictive of how the PCT application will be examined in the European regional phase. Accordingly, a U.S. applicant loses a valuable opportunity regarding gaining information with respect to the potential for patentability at the EPO of an invention set forth in a PCT application where the USPTO rather than the EPO is the IPEA.

Furthermore, consider that many national patent offices follow the lack of unity and inventive step analysis that is commonplace at the EPO. Quite the contrary is true for the USPTO, which utilizes the same examiners for both PCT filings as well as U.S. filings. Accordingly, as these examiners have less familiarity with a lack of unity standard and inventive step standard, which differ from the U.S. restriction and obviousness standards, many examiners will inappropriately assert a lack of unity objection or a lack of inventive step objection. As many national offices apply a unity of invention standard and an inventive step standard, and accept an International Preliminary Examination Report (IPER) as the starting point for examination after conversion, U.S. applicants are faced with arguing that the USPTO applied the wrong standard and that the claims possess unity of invention and inventive step. This adds significant costs in both time and money, while placing the U.S. applicant at a severe disadvantage. Such a costly system particularly disadvantages smaller companies and individuals, as they lack the resources of large corporations.

Therefore, we believe that there is a significant negative impact on a U.S. applicant where the EPO will not act as the IPEA.

In summary, for most PCT applications, the contents of the International Search Report (ISR) and the International Preliminary Examination Report (IPER) will be dependent upon whether the USPTO or the EPO is acting as the ISA or IPEA, respectively. When issued by the EPO, the ISR and the IPER are more reflective of how a PCT application will be examined following conversion to the European regional phase. This information is vital to an applicant's business planning as to whether a PCT application merits conversion. Therefore, when U.S. applicants are denied the opportunity to use the EPO as the ISA and IPEA, there is a significant impact on the quality of the information available with which to assist an applicant in formulating the patent strategy. Given the importance of the patent strategy as a component of an applicant's business planning, a dimunition in the quality of the information available for the patent strategy will ultimately impact adversely the effectiveness of the business planning.

Finally, while we would like to see an outright reversal of the EPO's decision to deny U.S. applicants in certain technology areas the ability to use the EPO as the ISA and the IPEA, perhaps we might propose a solution that may be palatable to both U.S. applicants and the EPO. For PCT applications in the technology areas affected by present EPO changes, increase the fee charged to U.S. applicants and use the fees to increase the number of examiners and staff in those technology areas. For many years, if a U.S. applicant chose to designate the EPO as the ISA and IPEA, the fees were higher than if the USPTO were designated. Notwithstanding the fact that at times the difference in fees was rather substantial, our firm advised our Biotech applicants, for example, to designate the EPO (for reasons set forth above). In the vast majority of the cases, those applicants decided that the additional information gained by using the EPO justified the increased cost. While it is with reluctance that we propose a return to increased fees for certain U.S. applicants, it may provide the EPO with motivation to allow again any U.S. applicant to designate the EPO as ISA and IPEA and/or IPER.

The above remarks in their entirety are those of the authors and do not necessarily reflect those of SEED Intellectual Property Law Group PLLC, Seattle, Washington, USA.

Secretariat office

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

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

As you all know the *epi* Secretariat is located in Tal 29, close to the European Patent Office – only a 10 minutes walk – as well as to the „Isartor" .

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

Comme vous le savez tous, le Secrétariat de l'*epi* se trouve à proximité immédiate de Isartor, Tal 29, à seulement dix minutes à pied de l'Office européen des brevets.

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

PQC Members at work during their meeting on the *epi* premises on 17 April 2002

epi Booklet „Patents in Europe"

We would like to inform our readership that a new edition of the *epi* booklet „Patents in Europe" is now available in English, German and French.

The booklet can be ordered from the *epi* Secretariat, at a cost of 2 Euro per copy, plus postage.

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epi Art Exhibition 2003

The Spring Exhibition of *epi* Artists in the EPO main building in Munich has become a tradition in *epi*'s and EPO's cultural life. Held for the first time in 1991, it was followed by further ones in 1994, 1996, 1998 and 2000. The interesting works on display ranged from paintings to graphical and fine art works such as ceramic works, sophisticated watches and jewellery, and artistic textile creations. The exhibitions which were opened by the *epi* President and by the EPO President aroused great interest. We hope that the forthcoming exhibition will be just as successful. It is planned to take place from

13 to 31 March 2003

in the premises of the European Patent Office, Erhardtstrasse, Munich.

A prerequisite for having the exhibition held again is a large participation of artists coming from various countries. Therefore, all creative spirits among the *epi* membership are invited to participate. Please pass the information round!

Further details will be published in a later issue of epi Information.

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Revision of the European Patent Convention

A. Casalonga (FR)

INTRODUCTION

The Contracting States of the European Patent Convention have decided to amend certain provisions of the European Patent Convention. The decision was taken on November 29, 2000, and comprises a Revision Act, which has been executed by all Contracting States and must still be ratified. The revised European Patent Convention will come into force two years after ratification by the fifteenth Contracting State or two months after ratification by all Contracting States, if it takes place earlier.

A number of articles of the European Patent Convention have been amended by cancelling specific provisions relating to procedural organization, time limits etc, and referring to the Implementing Regulations which will now have to be further amended and approved by the Administrative Council of the European Patent Organization. It can be said that the new revised European Patent Convention will contain only the main legal provisions while all other provisions will be recited in the Implementing Regulations. This means that European Patent law will be more easily amended by decisions of the Administrative Council and without the necessity of convening an international Conference.

The revised Convention will permit the EPO to reorganize the examination and search of the European Patent applications. It will be possible that the substantive examiner for certain technical fields seats in the EPO branches of Den Haag or Berlin instead of Munich. In the same way searches for prior art will also be made in the main office of Munich. For a given European application the search as well as the substantive examination will be made by the same examiner contrary to the present usual practice where search and examination are performed by two different persons. The European Patent Office will probably assign certain technical fields to specific locations Munich, Den Haag or Berlin which means that corresponding examining divisions as well as opposition divisions would seat in those locations. Oral

procedures may have to be held also in Den Haag or Berlin.

Clearly, this will represent an important change in the overall procedure before the EPO.

The revised European Patent Convention also contains important changes concerning patentability requirements, certain aspects of the procedure before the EPO as well as the effects of the patent.

A. PATENTABILITY

I. Patentable inventions (Article 52)

1°) Article 52(1) EPC has been brought into line with Article 27(1), first sentence, of the TRIPs Agreement making it clear that patent protection is available to inventions of all kinds. The introduction of „ technology " to define the patentable invention may have two different consequences.

On the first hand, it may be seen as the wish to clearly limit patentability to „ technical ,, inventions and therefore insisting on the present view of the Boards of Appeal of the EPO that an invention is a technical solution to a technical problem. It could also reinforce the present interpretation of patentability of software related inventions made on the basis of the „technical effect".

On the other hand, it may also be seen as enlarging patentability to other fields of human activities. Business or commercial activities could then be regarded as the latest „technological" activities of human beings. In any case, achievements of the computer industry should more easily be admitted within the general „technological" field in the same way as agricultural and chemical activities were progressively included in the past within the frame of the patent protection.

This new introductory definition of patentable inventions in the EPC should therefore leave an open door to the future case law for better protection of new and important developments of human activities.

2°) Unfortunately, the other paragraphs of Article 52 and particularly paragraph 2 containing a list of exclusions to patentability were not cancelled contrary to the hopes which had developed some months before the Revision Conference.

Programs for computers remain formally excluded from patentability even if this exclusion is interpreted very narrowly and applied only to claims directed exclusively to computer programs „as such" and not to inventions including a computer program.

The EPO and the Boards of Appeal have always namely interpreted and applied the EPC in such a way that the formal exception from patentability did not exclude protection for software-related inventions, i.e. inventions whose subject-matter consists of or includes a computer program.

Indeed, the most recent decisions of the Boards of Appeal (see T 1173/97 – Computer program product/ IBM, OJ EPO 1999, 609) have confirmed that computer programs producing a technical effect, are patentable subject matter under the EPC.

The deletion of this exclusion initially proposed to the Revision Conference would therefore probably have had only a psychological effect. It would probably not have changed the Office practice and case law mainly based on whether subject-matter claimed as an invention has a technical character.

II. EXCEPTIONS TO PATENTABIITY (ARTICLE 53)

The exclusion of methods of treatment and diagnostic previously referred to in Article 52(4) EPC has been added to the two exceptions to patentability which appear at present in Article 53(a) and (b) EPC.

These therapeutic methods have been up to now excluded from patentability by reason of their lack of industrial applicability. Now they will be excluded from patentability for unclear and undefined reasons, possibly including the interests of public health.

It remains to be seen whether the shifting of those therapeutic methods to Article 53 will have an influence on the attitude of the national courts towards related inventions such as drugs and medical devices.

III. Novelty (Article 54)

1°) Prior rights (Article 54-4)

Pursuant to Article 54(3) EPC, in order to preclude double patenting, European patent applications having an earlier filing or priority date than the filing or priority date of a second European patent application, and which are published on or after the filing date of that second application, are considered to form part of the state of the art for the purpose of examining the novelty of this second patent application.

However, Article 54(4) EPC confines the prior art effect under Article 54(3) EPC to those Contracting States which are designated in both the earlier and the second application.

Since the fee reform of 1997, European applications as filed designate all Contracting States and designation fees are payable within 6 months of the mention of the publication of the European search report. A European application becomes prior art under Article 54(4) EPC for a given Contracting State only once the designation fee has been validly paid. This postpones the time at which the Article 54(3) prior art can be determined by at least 6 months from the publication of the application, increasing legal uncertainty.

The Revision Conference decided to delete Article 54-4 EPC, so that any European application falling under Article 54(3) will constitute prior art with effect for all the EPC Contracting States at the time of its publication.

2°) Second medical use (Article 54-5)

According to EPC, methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body are excluded from patentability. This exclusion covers not

only „methods for treatment… by therapy", but also „*uses of a substance or composition* for the treatment of the human or animal body by therapy,,, such uses, according to the case law of the Enlarged Board of Appeal being identical as regards content to the previously mentioned methods (G 5/83, „Second medical indication /EISAI", OJ EPO 1985, 64).

The exclusion from patentability of those therapeutical methods and uses, however does not hinder inventors from protecting *products, substances or compositions* which are used in such therapeutical methods. The protection obtained by claims directed to such products, substances or compositions is limited by *their therapeutical use*. Those „purpose limited" claims are somewhat peculiar. As a matter of fact those product claims are, according to Art 54(5), considered as new, even if the product, substance or composition was already known as such, for any other use i.e. for non therapeutical uses.

The Enlarged Board confirmed the patentability of such claim in a case of a „first medical indication" (G 5/83). According to the Enlarged Board, a claim directed to a *substance or composition „for use"* in the treatment of the human or animal body by therapy is directed to an invention which is not excluded from patentability.

Unclear remains nevertheless the question of novelty of inventions in case of a further therapeutical use of the same product, substance or composition.

It was namely questioned whether it could be possible to obtain a valid protection in such a case of a „second medical" indication.

In its decision G 5/83, the Enlarged Board held that the legislative purpose of Article 52(4) EPC is to free from restraint non-commercial and non-industrial medical and veterinary activities. However, in order to prevent the exclusion from going beyond its proper limits, the Board felt it appropriate to take a „special view" of the concept of the „state of the art" defined in Article 54(2) EPC. Since the legislator did not intend Article 54(5) EPC to exclude further medical uses from patent protection, the Enlarged Board developed an original solution to the problem of patent protection for these second and further medical uses.

In doing so, it made particular reference to the legal advice from the Swiss Federal Intellectual Property Office of 30May 1984 (OJ EPO 1984, 581), according to which the second or subsequent medical use may be protected by a claim directed to the „use of a substance or composition *for the manufacture of* a medicament for a specified new therapeutic application,, („Swiss" form of claim).

The national courts and appeal divisions of the patent offices of the Contracting States to the EPC have taken issue to varying degrees with the case law of the Enlarged Board of Appeal relating to the „second medical use" in the so-called „Swiss form of claim" not always following the Enlarged Board's decision.

This legal uncertainty has to be eliminated, as it is difficult to predict with any certainty whether European patent with so-called „Swiss claims" directed to a „further medical indication" will ultimately be found to be valid by the national courts in the Contracting States to the EPC. Moreover, there are considerable doubts as to whether patents of this type will actually gua rantee the intended protection sufficiently and whether they can be enforced accordingly.

A new paragraph 5 has therefore been added to Article 54 EPC to unambiguously permit patent protection for the second and each subsequent medical use of a substance or composition known for a medical use, in the same way as for its first medical use, in the form of purpose-related product protection.

It will therefore now be possible to obtain purpose limited product claim for all pharmaceutical inventions : in the case of a first medical indication, the novelty of the claimed invention is derived from the novelty of the use in therapy. The claim can be formulated as „Product of formula X for its use in a therapeutical method". The scope of the protection is broad and includes any kind of therapeutical use.

In the case of a second or further medical use, the novelty of the claimed invention is derived from the novel specific use, for example to cure a specific disease. The claim can be formulated as: „Product of formula X for curing disease Y". The scope of protection is then limited to use of the product for curing the specific disease Y stated in the claim.

Manufacturing and selling product X while especially mentioning its specific activity against disease Y should be considered as contributory infringement.

B. PROCEDURE BEFORE THE EPO

I. Date of Filing (article 80) – Languages (Art 14)

Article 80 EPC has been amended and no longer lists the requirements for the accordance of a date of filing. These will be transferred to the Implementing Regulations.

The provisions of Article 5 PLT have been introduced in Article 14. Accordingly, it will be possible to file a European patent application in any language provided that a translation in one of the three official languages of the EPO is filed afterwards.

II. Priority right (article 87)

Article 87(1) EPC has been amended to align it with Article 2 of the TRIPs Agreement, which requires that priority rights be accepted not only from first filings made in a State party of the Paris Convention but also in any WTO Member State.

Article 87-5 has also been amended with the view of simplifying the procedure of reciprocity recognition between the EPO and any „industrial property authority" i.e. in practice with the Patent Office of Taiwan.

III. EUROPEAN DIVISIONAL APPLICATION. (Article 76)

Article 76(2) EPC has been amended to ensure that only those Contracting States which remain designated in the earlier application at the time of filing of a divisional

application are deemed to be designated in the divisional application.

Article 79(1) EPC currently provides that Contracting States for which protection is sought shall be designated in the request for grant. According to amended Article 79 (1), all the Contracting States party to the Convention at the time of the filing of a European patent application shall be deemed to be designated in the request for grant.

In practice it will therefore be advisable for applicants to file divisional applications before expiry of the time period for paying designation fees of the parent application. In doing so namely, the applicant of the divisional application can designate all the Contracting States and has a further time to decide in which countries the protection of the divisional application should extend.

IV. Amendments (article 123)

The applicant's right to make amendments to the application (and, where applicable, the patent) is maintained in the new version of Article 123(1) EPC. The first sentence has been redrafted and refers now all formal conditions to the Implementing Regulations. It remains to be seen whether the Implementing Regulations will change the present practice requiring an adaptation of the description to the accepted claims as maintained in an amended form during opposition proceedings.

Amended Article 123(3) contains both a substantive and an editorial clarification. According to the new version, the European patent as a whole (i.e. the claims, description and drawings, if any) may not be amended in such a way as to extend the protection it confers (see T 1149/97 – Fluid transducer/SOLARTRON, OJ EPO 2000, 259). This principle is applicable in all proceedings before the European Patent Office, as well as in national proceedings *i.e.* before national courts. This new wording brings Article 123(3) into line with Article 138(1)(d) EPC which defines the grounds for revocation of the European patent.

V. Further Processing – Restitutio in integrum (articles 121 and 122)

1°) Article 121

The new version of Article 121 EPC broadens the scope of application of further processing and makes it the standard legal remedy in case of failure to observe time limits in the European patent grant procedure.

Further processing will be applicable in particular to the time limits for the payment of filing, search and designation fees, the national basic fees and the examination fee and the time limit for filing the request for examination. However, as before, further processing is only open to the applicant during examination of a European patent application. It is not open to the patent's proprietor or even to an opponent during opposition proceedings.

According to Article 121(4) EPC, further processing is ruled out for the priority, the time limits for appeal in Article 108 EPC, the time limits for requesting a review of a decision before the Enlarged Board of Appeal and the time limits for requests for further processing and re-establishment of rights. The time limits for payment of renewal fees are also to be excluded from further processing. Further exceptions may be provided for in the Implementing Regulations.

The time limit for filing the request will continue to be two months and will be triggered by a notification of the failure to observe the time limit or of the loss of rights brought about by the omitted act.

2°) Article 122

The scope of application of re-establishment of rights is narrowed down in view of the new provisions governing further processing.

As for the request for further processing, the request for re-establishment of rights is not open to an opponent during opposition proceedings. During opposition, only the patent's proprietor may make use of the provisions for re-establishment of rights. Thus, the present imbalance in favor of the patent's proprietor in this respect is maintained.

The period for filing the request for re-establishment of rights will continue to be two months from the removal of the cause of non-compliance with the time limit and the one-year period for admissibility of the request will continue to apply. For re-establishment of the priority period in accordance with Article 87(1) EPC it is intended to incorporate the minimum time limits fixed by the PLT 2000 (see Rule 14(4) PLT). The time limit for such requests would therefore end two months after expiry of the priority period.

Re-establishment requests will be ruled out for time limits for payment of filing fees, designation fees, examination fees as well as fees for Euro PCT applications and time limits for filing the request for examination.

It will also be ruled out for time limits for filing translations and time limits set by the EPO.

As far as the grant procedure is concerned, re-establishment will thus be largely replaced by further processing and will only be applied direct where the priority period or the time limits for requesting further processing have not been observed. The limitation of the possibilities of re-establishment of rights in the grant procedure will however be offset to some extent by the fact that, under the new provisions, re-establishment of rights with respect to the time limit for further processing will continue to be possible.

VI. Examination of the Opposition (article 101)

Article 101(1) is amended to state that the Opposition Division is not obliged to consider all the grounds for opposition referred to in Article 100 EPC. This is deemed to reflect the case law of the Enlarged Board of Appeal (G 10/91, OJ EPO 1993, 420).

The examination of grounds for opposition should be guided by the following principles according to the Enlarged Board: The Opposition Division is obliged to examine only those grounds for opposition listed in the opponent's statement. In addition to this, the Opposition

Division may in accordance with Article 114(1) EPC examine of its own motion any ground for opposition under Article 100 EPC not invoked by the opponent where said ground is relevant and prejudices the maintenance of the European patent. These principles should be reflected in the Rules implementing Article 101(1) EPC.

It remains to be seen whether this change will not be used by the Opposition Divisions for avoiding to consider in the written decision, all the grounds for revocation discussed during the procedure.

If this occurs more frequently, the risk of remittance to the first instance by the Boards of Appeal will increase, thus increasing the overall duration of the opposition procedure. The Boards of Appeal tend namely to remit the case to the first instance if they have the feeling the parties did not have sufficient opportunity to present arguments concerning certain grounds for revocation. For example, if lack of novelty as well as lack of inventive activity are presented by the opponent against the validity of the patent and if the decision of the Opposition Division revokes the patent for lack of novelty without giving any indication relating to inventive activity, the Board of Appeal taking a reverse decision on novelty will normally remit the case to the first instance in order that the patent's proprietor can present a full argumentation on inventive activity. The overall duration of the procedure may then easily double.

The only way to avoid such a difficulty is for the Opposition Division to consider all the grounds for revocation in its decision, for example giving an indication on inventive activity even if the patent is revoked for lack of novelty.

Hopefully, the new wording of Article 101 will not induce the Opposition Division to issue decisions limited to only one ground of revocation.

New Article 101(3)(b) EPC adds a clarifying point. If the proprietor of the patent requests amendments during the opposition proceedings, the Opposition Division examines whether, with reference to all the provisions of the EPC, the substantive requirements for maintaining the patent are met.

This provides a legal basis for revoking the patent if, after amendment, the requirements of for example Article 84 (lack of clarity and support of the claims by the description) or 123(3) (undue enlargement of protection) or Rules 27 or 29 EPC are not met.

VII. Petition for review by the Enlarged Board of Appeal. (New Article 112 a)

In order to make possible a judicial review of decisions of the Boards of Appeal, the Enlarged Board of Appeal has been given the competence to decide on petitions for review.

New Article 112a(1) EPC provides a petition for review that shall lie from decisions of the boards of appeal if:

(a) during the appeal proceedings a fundamental procedural defect occurred, or

(b) a criminal act may have had an impact on the decision.

These exhaustive grounds for review will be defined in more detail in the Implementing Regulations.

This wording implies that only fundamental (but not minor) procedural defects can be the basis for a petition for review. It is to be hoped that the petition for review will not be a means to review points of substantive law. It should not used to further develop the practice in proceedings before the EPO or to ensure the uniform application of the law.

It is intended that the Rule implementing this new article will provide that a petition for review may only be based on the following grounds:

– a member of the Board took part in the decision,
– the Board of Appeal comprised a person not appointed as a member of the Boards of Appeal,
– a fundamental violation of Article 113 EPC, (right to be heard)
– a fundamental procedural defect arising from failure to take into account a request made by a party.

If the defects from which a decision suffers is criminal behavior having had an impact on the decision, the possibility of review by the Enlarged Board of Appeal seems highly theoretical. As a matter of fact, the EPO has no power to establish whether a certain behavior was an offence within the meaning of criminal law. Thus criminal behavior can only be a valid ground for a petition for review following conviction of the person concerned by a criminal court. The criminal act can only be established in criminal proceedings by a sentence which is *res judicata*. The Petition for review must be filed within two months from the decision establishing the criminal act but not later than five years from the notification of the decision of the Board of Appeal.

If the petition for review is allowable, the Enlarged Board of Appeal shall set aside the decision of the Board of Appeal and shall re-open appeal proceedings before the Board of Appeal which rendered the decision. If appropriate the Enlarged Board of Appeal may order that the Board of Appeal be composed differently. In exceptional cases, the Enlarged Board of Appeal may re-open appeal proceedings before another Board of Appeal.

The revival of lost patent protection may prejudice third-party interests. Provisions are therefore made for intervening rights. In terms similar to those concerning the protection of third-party interests in case of re-establishment of rights after missing a time limit despite observance of all due care.

In the interest of a quick and effective screening of petitions for review which are clearly inadmissible or not allowable, special procedural provisions will apply to a three-member panel of the Enlarged Board. This panel shall decide in written summary proceedings; no oral proceedings shall take place before the panel.

It remains to be seen whether the Enlarged Board of Appeal will be able to restrict access to a full review of all cases, which would greatly increase the legal uncertainty and the overall duration of the opposition procedure and finally, also the duration of the court proceedings, particularly when the national court stays the proceedings until the final decision of the EPO.

VIII. REPRESENTATION.
Legal privilege (Article 134a)

A new Article 134(a) now contains all the EPC provisions dealing with the establishment of an institute, the EPI constituted by persons entitled to act as professional representatives, as well as the powers of the Administrative Council to adopt provisions governing the standards for admission as a professional representative, the conducting of qualifying examinations and the disciplinary powers to be exercised by that Institute or the EPO.

A new sub-paragraph (d) is added to Article 134a EPC for legal privilege of EPI members in the course of exercising their professional activities in relation to a European patent application or granted patent.

Article 2 of the Regulation on Discipline for professional representatives adopted by the Administrative Council of the European Patent Organization already provides that secrecy relating to confidential information must be maintained by the professional representative.

In fact, the US courts refer to European law to decide whether any attorney-client privilege applies to communications between a European patent attorney and his client or any other person. In Europe, there is no need for evidentiary privilege, neither the EPO nor its Boards of Appeal having the capacity to force a European patent attorney to disclose such information.

Thus, with a view to protecting – in the course of US proceedings – the confidence of communications between European patent attorneys and their clients, it appeared necessary to introduce a representative-client privilege applicable in EPO proceedings, equivalent to that existing in the US.

This notion is not entirely foreign to the EPC Contracting States insofar as a similar evidentiary privilege exists under certain circumstances e.g. in the United Kingdom (see the UK Patents Act, sec. 104).

Consequently, new Article 134a(1)(d) EPC confers on the Administrative Council the competence to create an evidentiary exception modeled on the US attorney-client privilege, applying to proceedings before the EPO.

This should permit in the future a recognition by US Courts of an attorney-client privilege for European Patent attorneys.

C. EFFECTS OF THE EUROPEAN PATENT

I. Interpretation of Claims
(article 69 Protocol on Interpretation)

1°) Pursuant to the current version of Article 69(1) EPC, the extent of protection of European patent is determined by the „terms" of the claims. The expressions „Inhalt", „terms", „teneur" are somewhat unclear in scope and do not have the same meaning in all three official languages. Article 69 is now redrafted without reference to the „terms" of the claims.

Article 69(2), first sentence, EPC now clarifies that the extent of protection of the European patent application is determined by the claims as contained in the published application.

Article 69(2), second sentence, EPC now not only refers to opposition proceedings, but also to the new limitation and to national revocation proceedings. A limitation of the European patent in any of these proceedings retroactively limits the extent of protection conferred by the application.

2°) The present provisions governing the extent of protection conferred by a European patent, i.e. Article 69 EPC and the Protocol on its interpretation have turned out not to achieve, to the extent desired, the goal of ensuring as uniform an application and interpretation as possible. In particular, this is the case regarding the treatment of so-called equivalents.

In order to contribute to a more uniform court practice in Europe, the Protocol on interpretation of Article 69 has been supplemented by a generic statement regarding equivalents.

However, no definition of what should be considered as an equivalent has been mentioned in the Protocol, thus leaving to the national courts the usual task of applying their own interpretation. The initial proposal of introducing a definition of equivalent largely inspired from German law has therefore failed. In fact, the proposal was inspired from the WIPO Basis Proposal for a Patent Law Treaty of 1991 which was already refused at that time.

It will now be necessary to wait for the development of case law by a possible future European Court before knowing what an „equivalent" means in Europe.

II. Centralized limitation
(New Articles 105a, 105b, 105c)

1°) Limitation Procedure

A new centralized limitation procedure has been introduced, according to which the European patent may be limited or revoked *ab initio* at the request of the patent proprietor. Limitation or revocation may be requested at any time. The limitation procedure remains an *ex-parte* procedure. Examination of the patentability of the limited patent will not be made by the EPO so that a speedy decision from the EPO could be expected.

Article 105a (2) EPC gives priority to opposition proceedings so as to prevent limitation procedures occurring where opposition has already been lodged. The Implementing Regulations will state that limitation proceedings are to be stayed until opposition proceedings have been completed. The central limitation procedure before the EPO does also not take precedence over national proceedings (revocation proceedings in particular). Where parallel cases do occur, the national proceedings can be suspended or continued in accordance with the provisions of the relevant national law. Where national proceedings resulting in limitation have already been concluded, the limitation can be extended to further Contracting States via central limitation proceedings before the EPO. Limitation of a European patent in proceedings before the EPO does not preclude further limitation in national proceedings.

Under Article 105b(1) EPC, the limitation procedure requires the EPO to examine whether the requirements laid down in the Implementing Regulations for a requested limitation or revocation have been met. This means in particular establishing whether the requested amendment of the claims actually limits the patent or is designed to protect something else, and whether the requirements of clarity of the claim and support by the description (Article 84 EPC) are met. The EPO will also check that no new matter is introduced and that the scope of protection is not enlarged (Article 123(2) and (3) EPC).

However, the EPO will not be required to examine whether the aim of the limitation, e.g. delimitation with respect to a particular prior art is achieved, or whether the subject matter of the limited patent is patentable.

The precise procedure to be followed is to be laid down in the Implementing Regulations. Decisions of the examining divisions in limitation proceedings are subject to appeal before a Board of Appeal.

Under Article 105c EPC, when the EPO publishes the decision to limit the European patent, it will publish an amended European patent specification containing, in accordance with the Implementing Regulations, the new version of the claims, a translation thereof into the official languages of the EPO and, where appropriate, the description and drawings as amended.

If the amended European patent specification is not available in an official language of the Contracting State in which the patent is valid, under Article 65 EPC that State may demand that a translation be filed.

2°) Effects of the limitation (Article 68)

When the decision to revoke or limit the European patent in accordance with Article 105b(3) EPC is published, the effects of the European patent as granted are cancelled *ab initio* in full or in part in respect of all the Contracting States in which it was valid.

If, however, prior European or national rights are cited during the limitation procedure in respect of certain Contracting States, the patent may be limited for these States only by means of a separate set of claims.

The new version of Article 68 EPC incorporates limitation proceedings and national revocation proceedings into the provisions governing opposition proceedings, whereby the European patent is deemed not to have had effect, as from the outset, to the extent that the patent has been revoked or limited. Article 68 EPC thus uniformly establishes the retroactive effect of limiting or revoking a European patent in opposition, limitation and national revocation proceedings.

The inclusion of national revocation proceedings reflects the fact that the revocation of European patents now has an *ex tunc* effect in all Contracting States, and it formalizes the harmonization achieved in that respect.

Furthermore, Article 138 has been amended to have the proprietor's right to limit a European patent in national proceedings relating to its validity expressly enshrined in the Convention. This establishes self-limitation by the patent proprietor as a practice, which is recognized in most Contracting States and formalizes and extends the degree of harmonization achieved in that respect. This is particularly useful in view of the forthcoming accession of new Contracting States.

Revision des EPÜ

Der Vorentwurf der Ausführungsbestimmungen wird in Kürze veröffentlicht.

Diejenigen *epi*-Mitglieder, die dazu Bemerkungen machen möchten, sind gebeten, dem EPPC-Mitglied ihres Landes (siehe die Liste der Ausschussmitglieder auf Seite 55 dieser Ausgabe) oder dem *epi*-Sekretariat (e-mail: info@patentepi.com) ihre Ansicht mitzuteilen. Diese Ansichten werden bei der Ausarbeitung einer Stellungnahme des *epi* sorgfältig berücksichtigt.

Revised EPC

The first draft of the Implementing Regulations is due to be published soon.

Any *epi* members wishing to comment on the draft are welcome to submit their views to their EPPC member (see the list of members on page 55 of this issue) or the *epi* Secretariat (e-mail: info@patentepi.com). These views will be considered carefully in formulating an *epi* position.

Révision de la CBE

L'avant-projet de Règlement d'exécution devrait être publié prochainement.

Les membres de l'*epi* sont priés de faire parvenir leurs commentaires par l'intermédiaire de leurs délégués à la commission EPPC (voir liste page 55 de ce numéro) ou du Secrétariat de l'*epi* (e-mail: info@patentepi.com). Il sera tenu compte de ces commentaires pour la rédaction d'une prise de position de l'*epi*.

VPP Frühjahr-Fachtagung 2002
Ludwigsburg, 2.-3. Mai 2002

Stand und Perspektiven der Entwicklung des Europäischen Patentsystems

Dr. h.c. Ingo Kober, Präsident des Europäischen Patentamts

Sehr geehrte Damen und Herren,

ich freue mich, wieder auf einer Ihrer Fachtagungen sprechen zu können. Gelegenheit dazu hatte ich erstmals im November 1996, kurz nach meinem Amtsantritt und zuletzt Ende 1999, als ich Ihre Herbsttagung in Königswinter eröffnen durfte.

Zentrale Themen waren Ende der '90-er Jahre die Kosten des europäischen Patents, die Übernahme der Biotechnologie-Richtlinie in das EPÜ, die Revision des Übereinkommens, die Erweiterung der Organisation und die Perspektiven für das Gemeinschaftspatent. In einer ganzen Reihe von Punkten sind wir in den vergangenen Jahren deutlich vorangekommen, einige wie z. B. das Gemeinschaftspatent werden nach wie vor intensiv und kontrovers diskutiert. Das neue Jahrtausend, die fortschreitende Globalisierung und eine ungebrochen dynamische Entwicklung von Technik und Wirtschaft haben uns aber auch einige neue Fragen und Aufgaben gebracht, die wir im Interesse der Benutzer des europäischen Patentsystems zu beantworten und zu bewältigen haben.

Bevor ich auf die Entwicklung des Amts, der Organisation und des europäischen Patentrechts im einzelnen zu sprechen komme, gestatten Sie mir ein paar grundsätzliche Bemerkungen zu einer Entwicklung, mit der nicht nur das EPA, sondern alle prüfenden Patentämter heute konfrontiert sind.

Bewältigung des Arbeitsaufkommens

Meine Damen und Herren, Förderung und Schutz von Innovation gehören heute zu den Top-Prioritäten jeder Wirtschaftspolitik. Der effektive Schutz von Erfindung und Innovation gilt als Schlüssel zu wirtschaftlichem Erfolg und Wohlstand. Patente sind zur zentralen Voraussetzung für Investitionen und die Bereitstellung von Risikokapital geworden. Eine Entwicklung, die Patentrechtler nur begrüßen können und stets gefördert haben. Es ist aber auch eine Entwicklung, die zeigt, daß das Patentwesen bereits seit geraumer Zeit einem Wandel unterliegt, dessen voller Umfang sich erst allmählich abzeichnet.

Während die klassischen Patentrechtstheorien der Erfinder und die einzelne Erfindung im Mittelpunkt der rechtlichen und wirtschaftlichen Betrachtung sahen, geht es heute zunehmend um die Bildung sogenannter Patentportfolios und deren Einsatz im Wettbewerb. In diesem Zusammenhang kommt es nicht mehr nur auf den Schutz der einzelnen Erfindung an. Worauf es auch, und in vielen Fällen vor allem, ankommt, ist die Position eines Unternehmens auf den globalen Märkten und an den Börsen. Und die wird zunehmend mitgeprägt durch einen möglichst umfangreichen Bestand an Schutzrechten. Patentportfolios spielen auch eine zunehmend entscheidende Rolle bei der Bildung strategischer Allianzen und bei Fusionen. Patente stützen nicht mehr allein eigene Produktionslinien, sondern sind selbst zu Produkten geworden, die am Markt gehandelt werden. Damit stehen in vielen Fällen nicht mehr der rechtliche Schutz der Erfindung und seine Durchsetzung im Vordergrund, sondern die Vermarktung von Optionen zur ausschließlichen Nutzung innovativer Technologien. Hierin unterscheidet sich der aktuelle Trend auch von den Netzwerkstrategien, über die vor allem japanische Unternehmen bestimmte Technologiebereiche patentrechtlich abzusichern versuchen.

Die weltweit gestiegenen Einnahmen aus Patentlizenzgebühren von rund 17 Milliarden US-Dollar im Jahr 1990 auf geschätzte 115 Milliarden Dollar im Jahr 2001 belegen den angesprochenen Trend. Wirtschaftswissenschaftler schätzen, daß Patentlizenzeinnahmen heute etwa 11 % der Nettogewinne aller börsennotierten Gesellschaften ausmachen.

Wenn wir heute davon sprechen, daß wir in einer „Wissensgesellschaft" leben, dann bedeutet dies also nicht nur, daß sich das Wachstum des technischen Wissens exponentiell beschleunigt, sondern auch, daß die Ausschöpfung und systematische Verwertung dieses Wissens auf der Grundlage weltumspannender technischer Schutzrechte zu einem Eckpfeiler der Strategien der Unternehmen im globalen Wettbewerb geworden ist.

Die kurz und mittelfristigen Folgen dieser Entwicklung sind erst im Ansatz erkennbar.

Was wir heute definitiv beobachten können, ist ein beinahe dramatischer Anstieg der weltweit eingereichten Patentanmeldungen. Die Gesamtzahl der Anmeldungen ist beim japanischen Patentamt von 370.000 im Jahr 1995 auf 450.000 im Jahr 2001 gestiegen, beim amerikanischen Amt im gleichen Zeitraum von 210.000 auf über 300.000, und beim Europäischen Patentamt von 78.000 auf knapp 160.000. Auch die großen prüfenden Patentämter unserer Vertragsstaaten sind mit deutlichen Zuwächsen konfrontiert.

Was die Zuwachsraten angeht, ist das EPA mit über 100 % das von dieser Entwicklung am weitaus stärksten betroffene Amt. Dazu kommt, daß unser Amt nicht nur europäische Patente zu erteilen hat, sondern darüber hinaus im Rahmen des PCT die Aufgabe einer internationalen Recherchen- und Prüfungsbehörde mit weltweiter Zuständigkeit wahrnimmt. Da etwa 60 % aller internationalen Anmeldungen vom EPA recherchiert und geprüft werden, bekommen wir auch den gewaltigen Anstieg bei den PCT-Anmeldungen massiv zu spüren. Ergebnis dieser Entwicklung ist auch, daß heute 67 % aller Anmeldungen zum europäischen Patent auf dem PCT-Anmeldeweg eingereicht werden.

Weil das EPA bei der Durchführung von Recherche und vorläufiger Prüfung zu internationalen Anmeldungen an enge gesetzliche Fristen gebunden ist, die für die Prüfung europäischer Patente so nicht gelten, hat die beschriebene Entwicklung zu einer Konzentration der Recherchen- und Prüfungskapazitäten des Amts im Bereich seiner PCT-Aufgaben geführt, die das europäische Erteilungsverfahren zusätzlich belastet. Dies erklärt, warum der rapide Anstieg der Anmeldezahlen in den Jahren 1996 bis 2000 zunächst zu einem Rückgang der Zahl der erteilten europäischen Patente führen mußte, und dies, obwohl das Amt bereits 1996 begonnen hatte, seine Kapazitäten dem steigenden Bedarf anzupassen.

Die Erhöhung der Prüfungs- und Recherchenkapazitäten, die Steigerung von Effizienz und Produktivität und die weitere Optimierung unserer Verfahren haben wir seitdem mit höchster Priorität betrieben, um den gewaltigen Herausforderungen unter Wahrung der Qualitätsstandards wirksam begegnen zu können.

Nicht ohne Erfolg, wie die innerhalb eines vergleichsweise kurzen Zeitraums erreichte Produktionssteigerung belegt. Ein gegenüber 1995 zu verzeichnender Anstieg bei der Recherchentätigkeit um rund 60 % und ca. 20 % im Prüfungsbereich ist auch für ein großes Patentamt eine gewaltige Leistung. Die im vergangenen Jahr erreichte Trendwende bei der Zahl der erteilten Patente - eine Steigerung von immerhin 26 % gegenüber dem Vorjahr (von 27.500 auf knapp 35.000) zeigt, daß wir auf dem richtigen Weg sind. Dies gilt umsomehr, als die Mehrzahl der von uns ergriffenen Maßnahmen erst im laufenden und dem folgenden Jahr voll wirksam werden.

Dies gilt zum Beispiel für die bereits erwähnte Personalaufstockung im Prüferbereich von 1.900 Prüfern im Jahr 1995 auf rund 3.200 Ende des letzten Jahres. Aber auch für die amtsweite Einführung der sog. BEST-Prüfung, die innerhalb der nächsten 3-4 Jahre abgeschlossen sein wird und von der wir uns eine weitere und sehr deutliche Effizienzsteigerung erwarten. In beiden Fällen hat der notwendige Aus- und Fortbildungsaufwand die Wirksamkeit der getroffenen Maßnahmen noch nicht voll zur Geltung kommen lassen.

In diesem Zusammenhang sind auch die Änderungen im Rahmen der PCT-Verfahren anzusprechen, die seit Anfang des Jahres wirksam geworden sind. Mit der Verlängerung der Fristen zum Eintritt in die nationale oder regionale Phase in den sogenannten Kapitel I-Fällen auf 30 bzw. 31 Monate (Artikel 22 PCT, Regel 107 EPÜ) sind Anmelder, die an einer vorläufigen Prüfung ihrer internationalen Anmeldung kein Interesse haben, nicht mehr gezwungen, eine solche zu beantragen, um in den Genuß der 30 bzw. 31 Monatsfrist zu kommen. Dies wird schon sehr bald zu einer spürbaren Entlastung unserer PCT-Prüfungsabteilungen führen. Während heute in etwa 80 % aller Euro-PCT-Anmeldungen die Durchführung einer vorläufigen internationalen Prüfung beantragt wird, dürfte dieser Anteil mittelfristig auf etwa 50 % zurückgehen.

Zu weiteren Entlastungen im PCT-Bereich werden die Beschränkungen der Zuständigkeit des EPA als internationale Recherchen- und Prüfungsbehörde führen, die nach der Änderung der PCT-Vereinbarung zwischen der WIPO und dem EPA eingeführt worden sind. Das Amt kann nun seine Zuständigkeit für Anmeldungen aus Staaten, die über eine eigene PCT-Behörde verfügen, mengenmäßig oder für einzelne technische Gebiete beschränken oder ganz aufheben. Auf dieser Grundlage hat das EPA beschlossen, ab dem 1. März 2002 zu PCT-Anmeldungen aus den USA, die Geschäftsmethoden oder biotechnologische Erfindungen betreffen, keine internationale Recherche und vorläufige Prüfung mehr durchzuführen. Auf dem Gebiet der Telekommunikation gilt die Beschränkung nur für die vorläufige Prüfung. Wir werden regelmäßig überprüfen, ob die damit angestrebte Entlastung des Amts in diesen, von dem gestiegenen Anmeldeaufkommen besonders betroffenen Bereichen, in dem erwarteten Umfang eintritt, und, falls erforderlich, weitergehende Beschränkungen vornehmen.

Als weitere Maßnahme auf dem PCT-Sektor haben wir Anfang des Jahres ein rationalisiertes Verfahren zur Durchführung der internationalen vorläufigen Prüfung eingeführt. Anmelder, die für dieses Verfahren optieren, erhalten gegen eine reduzierte Gebühr einen standardisierten vorläufigen Prüfungsbericht. Auf Wunsch erstellt das EPA aber auch weiterhin einen ausführlichen Prüfungsbericht.

Die Gesamtheit der im Bereich PCT ergriffenen Maßnahmen wird es dem Amt erlauben, die dort freiwerdenden Kapazitäten auf die Bearbeitung europäischer Anmeldungen zu konzentrieren.

Aber auch im europäischen Verfahren haben wir einiges getan, um die Arbeit unserer Prüfer noch effizienter zu machen und die Möglichkeiten der Anmelder, im Einzelfall sehr rasch zu einem Patent zu kommen, weiter zu verbessern.

Ich möchte dazu vor allem einige Änderungen der Ausführungsordnung ansprechen, die seit Beginn des Jahres in Kraft getreten sind bzw. am 1. Juli in Kraft treten werden. Dazu gehört beispielsweise die Neufassung der Regel 29 (2) EPÜ, mit der der Grundsatz, daß in einem europäischen Patent nur ein unabhängiger Anspruch pro Kategorie gewährt werden kann, bekräftigt und gesetzlich fixiert wird. Wir erwarten uns davon mittelfristig einen Rückgang der Anmeldungen mit einer unübersichtlich hohen Anzahl von Ansprüchen, die schon heute unter dem Gesichtspunkt der Klarheit der Ansprüche (Art. 84 EPÜ) meist nicht gewährbar sind.

Die Änderung der Regel 51 EPÜ, die am 1. Juli in Kraft treten wird, ist auf eine deutliche Verkürzung der Endphase des Erteilungsverfahrens gerichtet. Die Zusammenfassung der Aufforderung zur Zustimmung zu der zur Erteilung vorgesehenen Fassung (heute Mitteilung nach Regel 51 (4)) mit der Aufforderung zur Einreichung von Übersetzungen der Ansprüche und zur Zahlung der Erteilungsgebühr (heute Mitteilung nach Regel 51 (6)) wird die durchschnittliche Dauer des europäischen Erteilungsverfahrens um rund fünf Monate verkürzen.

Nicht zuletzt möchte ich unser Programm zur beschleunigten Bearbeitung europäischer Patentanmeldungen – PACE – auch diesmal wieder ansprechen. Immer noch wird davon nur in sehr begrenztem Umfang Gebrauch gemacht, was dafür spricht, daß viele Anmelder an einer raschen Erteilung des europäischen Patents nur in Einzelfällen interessiert sind. So wurden im vergangenen Jahr lediglich 2,8 % der europäischen Recherchen und 5,4 % der Prüfungen im Rahmen des PACE-Programms durchgeführt. Um das Programm auch für Anmelder attraktiv zu machen, die vermeiden wollen, daß das Interesse an der raschen Bearbeitung spezifischer Anmeldungen allgemein bekannt wird, werden seit Herbst letzten Jahres PACE-Anträge nicht veröffentlicht und im nicht-öffentlichen Teil der Patentakte abgelegt.

Insgesamt bin ich zuversichtlich, daß die ergriffenen Maßnahmen und eingeleiteten Reformen schon sehr bald deutlich Wirkung zeigen und zu einer spürbaren Senkung der durchschnittlichen Verfahrensdauer vor dem EPA beitragen werden. Nach unseren Planzahlen ist mit einem Abbau der Rückstände bei europäischen Recherchen innerhalb der nächsten 1-2 Jahre zu rechnen. Bei der Prüfung werden die Rückstände aller Voraussicht nach bis Ende 2005 abgearbeitet sein.

Ob und inwieweit uns dies tatsächlich gelingt, wird aber auch davon abhängen, ob sich die 1. eingangs aufgestellte Hypothese vom Funktionswandel im Patentrecht langfristig bestätigt und 2. sich das Anmeldewachstum ungebrochen fortsetzt. Dies werden wir sehr genau beobachten müssen. Dazu gehört nicht nur die sorgfältige Analyse der Anmeldeentwicklung, sondern auch die Auseinandersetzung mit den patentkritischen Stimmen, die im Zuge der Politisierung des Patentrechts mehr Gewicht bekommen haben. Ich denke dabei vor allem an die Kritik aus dem Bereich der sog. Open-Source-Bewegung und die Bedenken gegenüber einem zu weit gehenden Schutz bei biotechnologischen Erfindungen. In beiden Fällen wird auch die innovationsfördernde Wirkung des Patentschutzes im Grundsatz in Frage gestellt. Wir werden uns mit den vorgebrachten Argumenten vor allem dann intensiver auseinandersetzen müssen, wenn wir über Reformen nachdenken, die zu tiefgreifenden Veränderungen in der derzeitigen Struktur des europäischen und internationalen Patentsystems führen.

Meine Damen und Herren, abgesehen von der Bewältigung des Wachstums gibt es knapp 30 Jahre nach Abschluß des EPÜ natürlich auch in rechtlicher und technischer Hinsicht Anpassungs- und Modernisierungsbedarf. Es geht dabei im wesentlichen um 3 Bereiche:

- Anpassung des EPÜ an aktuelle technische und rechtliche Entwicklungen
- Vereinfachung des Erteilungsverfahrens, Kostensenkung
- Ausbau des EPÜ (Streitregelung, Gemeinschaftspatent).

  In den ersten beiden der genannten Bereiche sind mit der im Jahr 2000 erfolgreich durchgeführten Revision des EPÜ und dem Abschluß des Londoner Abkommens zur Sprachenregelung wichtige Weichenstellungen vorgenommen worden, die Attraktivität und Funktionsfähigkeit des EPÜ auch für die Zukunft erhalten wird.

Revision des EPÜ

Mit der Revision 2000 des EPÜ ist das europäische Patentsystem – unter Wahrung seiner bewährten Grundlagen – in wichtigen Punkten modernisiert worden. Bei einer ganzen Reihe von Bestimmungen ging es um notwendige Anpassungen an Vorgaben aus dem TRIPS-Übereinkommen oder dem neuen WIPO-Vertrag zur Harmonisierung patentrechtlicher Formerfordernisse. Ein großer Teil der Vorschläge zielte auf die weitere Vereinfachung und Beschleunigung des europäischen Erteilungsverfahrens und andere auf die Erweiterung und Verbesserung der Rechtsbehelfsmöglichkeiten. Aber auch wichtige materiellrechtliche Änderungen bei den Patentierbarkeitserfordernissen, bei den Bestimmungen über den Schutzbereich europäischer Patente und im Bereich der institutionellen Vorschriften sind vorgenommen worden.

Die von der Diplomatischen Konferenz 2000 angenommenen Texte und die ergänzenden Beschlüsse des Verwaltungsrats über die Neufassung des EPÜ und die bei Inkrafttreten der revidierten Fassung maßgeblichen Übergangsbestimmungen sind sämtlich in der Sonderausgabe Nr. 4 zu unserem Amtsblatt 2001 veröffentlicht. Mit dem Inkrafttreten der neuen Bestimmungen rechnen wir in etwa drei bis fünf Jahren wenn alle Vertragsstaaten ihre Ratifikationsurkunden hinterlegt haben dürften.

Bislang ist die revidierte Fassung des Übereinkommens von Bulgarien, Estland , der tschechischen Republik und der slowakischen Republik ratifiziert worden. Diese haben die Ratifikation im Zusammenhang mit ihrem zum 1. Juli wirksam werdenden Beitritt zur geltenden

Fassung des EPÜ vorgenommen. Da auch die übrigen Beitrittskandidaten verpflichtet sind, bei ihrem Beitritt auch die revidierte Fassung des Übereinkommens zu ratifizieren, rechnen wir noch in diesem Jahr mit weiteren Ratifikationen aus dem Kreis dieser Staaten.

Die Ende April erfolgte Fertigstellung des Entwurfs einer im Lichte der revidierten Fassung des Übereinkommens völlig überarbeiteten Ausführungsordnung zum EPÜ wird den Ratifikationsprozeß weiter erleichtern und beschleunigen. Es ist vorgesehen, den vollständigen Entwurf der neuen Ausführungsordnung noch im Laufe dieses Monats der Öffentlichkeit über das Internet zugänglich zu machen. Den interessierten Kreisen soll damit Gelegenheit gegeben werden, zu den für die Praxis besonders wichtigen Ausführungsbestimmungen umfassend Stellung zu nehmen. Es ist in der Tat so, daß die Revision des Übereinkommens in vielen Punkten erst durch die Ausführungsordnung konkrete Gestalt erhält. Dies gilt vor allem für die verfahrensrechtliche Ausgestaltung des Prüfungs- und Einspruchsverfahrens, des neuen Verfahrens zur Überprüfung von Entscheidungen unserer Beschwerdekammern, des Beschränkungsverfahrens und der Neuordnung der Rechtsbehelfe bei Fristversäumnissen.

Die neue Ausführungsordnung soll dem Verwaltungsrat im Dezember zur Beschlußfassung vorgelegt werden und würde dann zusammen mit der revidierten Fassung des Übereinkommens in Kraft treten.

Lassen Sie mich, bevor ich diesen Punkt abschließe, noch eine Frage ansprechen, die im Rahmen der Revision 2000 zwar diskutiert, aber nicht abschließend gelöst werden konnte. Es geht um die Frage der Schutzfähigkeit von softwarebezogenen Erfindungen. Die Konferenz hatte sich damals gegen die vom Verwaltungsrat vorgeschlagene Streichung der Computerprogramme aus der Liste der nicht patentfähigen Gegenstände in Artikel 52 (2) EPÜ ausgesprochen, um einer Regelung auf EU-Ebene nicht vorzugreifen.

Mit dem Vorschlag der Kommission für eine Richtlinie zum Schutz computerimplementierter Erfindungen vom 20. Februar 2002 liegt der Entwurf für eine solche Regelung nun vor. Obwohl der Entwurf in einzelnen Punkten sicherlich noch intensiver Beratung bedarf, haben wir den Eindruck, daß die Vorschläge im wesentlichen mit der bestehenden europäischen Erteilungspraxis kompatibel sind. Zu Diskussionen wird sicher der generelle Ausschluß von Ansprüchen führen, die auf das Speichermedium gerichtet sind, das Träger des zu schützenden Programms ist. Dies insbesondere weil solche Ansprüche für die Durchsetzung des Patentschutzes in der Praxis sehr wichtig sind, was sowohl vom Bundesgerichtshof wie auch den Beschwerdekammern des EPA anerkannt worden ist. Man darf also gespannt sein, ob es gelingt, die Bedürfnisse der Praxis mit den Petita der Kritiker eines zu weit gehenden Patentschutzes zu versöhnen.

Sprachen- und Streitregelung

Während die Revision des Übereinkommens vor allem auf die Verbesserung und Modernisierung des europäischen Patenterteilungsverfahrens und seiner Grundlagen gerichtet ist, geht es bei den von der französischen Regierungskonferenz 1999 initiierten Arbeiten zur „Kostensenkung" und „Streitregelung" um wichtige Verbesserungen für die sog. Nacherteilungsphase.

Erste konkrete Ergebnisse der Pariser Initiative liegen bereits vor. Das von der Arbeitsgruppe „Kostensenkung" auf der Regierungskonferenz in London im Oktober 2000 vorgelegte Übereinkommen über die Anwendung von Artikel 65 EPÜ hat breite Akzeptanz gefunden und ist bereits von insgesamt zehn EPÜ-Staaten (CH, DE, DK, FR, LI, LU, MC, NL, SE, UK) unterzeichnet worden.

Bei diesem Übereinkommen geht es um die Schaffung sachgerechter Übersetzungserfordernisse für europäische Patente. Eine Thematik, die uns seit Jahren beschäftigt und von ganz erheblicher Bedeutung für die Benutzer des europäischen Patentsystems ist. Mit dem Übereinkommen verpflichten sich die Vertragsparteien, auf die Einreichung von Übersetzungen europäischer Patente in ihrer Landessprache ganz oder weitgehend zu verzichten. In der Praxis bedeutet dies, daß Inhaber europäischer Patente künftig keine Übersetzung der europäischen Patentschrift vorlegen müssen, wenn das Patent für Staaten erteilt ist, in denen eine der EPA-Sprachen Amtssprache ist. Wo dies nicht der Fall ist, also beispielsweise in Schweden, muß der Anmelder eine Übersetzung der Patentschrift in die schwedische Sprache nur vorlegen, wenn das Patent nicht in der von Schweden bestimmten EPA-Sprache vorliegt.

Das Übereinkommen steht allen EPÜ-Vertragsstaaten offen, für sein Inkrafttreten ist die Ratifikation durch mindestens acht Vertragsstaaten erforderlich, darunter die drei Staaten, in denen 1999 die meisten europäischen Patente wirksam geworden sind (DE, FR, UK).

Damit ist ein Durchbruch in der Sprachenfrage erzielt worden, der das europäische Patentsystem künftig noch attraktiver und deutlicher kostengünstiger machen wird. Über 50 % der derzeit anfallenden Übersetzungskosten lassen sich einsparen, wenn das Übereinkommen für 12 Staaten in Kraft tritt. Es liegt nun an den Regierungen der Vertragsstaaten, auf eine rasche Ratifikation hinzuwirken. Eine ganz entscheidende Rolle kommt dabei der Regierung Frankreichs zu, die mit der Einberufung der Pariser Regierungskonferenz die Grundlagen für das Übereinkommen geschaffen hat.

Die Konferenz in London hat aber auch in der Frage eines einheitlichen Streitregelungssystems für europäische Patente Fortschritte erzielt. Nach dem in London präsentierten Konzept wären für Streitigkeiten aus europäischen Patenten – also Verletzungs- und Nichtigkeitssachen – spezialisierte Gerichte ausschließlich zuständig. Noch nicht ganz klar war in London, ob erstinstanzlich nationale Gerichte diese Aufgaben wahrnehmen sollen oder ein zentrales europäisches Gericht. Unstreitig ist jedenfalls, daß in 2. Instanz ein Europäisches Patentgericht für die weitere Rechtsvereinheitlichung im Gel-

tungsbereich eines künftigen fakultativen Übereinkommens sorgen soll. Weil der Sachverhalt schwierig und komplex ist und im Detail noch einige Fragen offen sind, hat die Regierungskonferenz auf Antrag der Arbeitsgruppe das Mandat zur Ausarbeitung eines vollständigen Entwurfs für ein Streitregelungsabkommen verlängert. Die Gruppe hat dazu ein „steering committee" eingesetzt, das derzeit mit maßgeblicher Unterstützung des EPA die erste Fassung eines solchen Entwurfs erstellt, der Ende des Jahres der Arbeitsgruppe zur weiteren Erörterung zugeleitet werden soll. Diese wird dann auch darüber zu befinden haben, ob auf der Grundlage der vorgelegten Texte eine Regierungskonferenz zur Verabschiedung des Streitregelungssystems einberufen werden kann und wann diese gegebenenfalls stattfinden soll.

Die Arbeiten der Pariser- und Londoner Regierungskonferenz haben gezeigt, daß auch in schwierigen Fragen Fortschritte möglich sind, die ganz erhebliche Verbesserungen des europäischen Patentsystems erwarten lassen.

Gemeinschaftspatent

Mit dem Verordnungsvorschlag für ein Gemeinschaftspatent vom 1. August 2000 hat die Europäische Kommission eine erneute Initiative zur endgültigen Verwirklichung des Gemeinschaftspatents ergriffen. Die Einzelheiten des Verordnungsvorschlags und die von der Kommission vorgeschlagene Verbindung zwischen dem Gemeinschaftsrecht und dem Europäischen Patentübereinkommen – Beitritt der Europäischen Gemeinschaft zum EPÜ - sind inzwischen hinlänglich bekannt, und ich brauche sie daher nicht näher zu erläutern.

Die bisherigen Beratungen der Kommissionsvorschläge haben allerdings gezeigt, daß in den Kernfragen – Sprachen- und Streitregelung sowie der Finanzierung des neuen Systems – zwischen den Mitgliedstaaten noch ganz erhebliche Meinungsunterschiede bestehen. Besonders gravierend ist, daß einige Staaten die Einführung des Gemeinschaftspatents offenbar nur akzeptieren wollen, wenn ihre nationalen Patentämter im Rahmen des europäischen Patenterteilungsverfahrens bestimmte Aufgaben durchführen können. Gedacht ist dabei insbesondere an die Erstellung von Recherchen zu europäischen Patentanmeldungen aber auch an die Mitwirkung im europäischen Prüfungsverfahren.

Ging es bei den Arbeiten am Gemeinschaftspatent bisher ausschließlich um die Schaffung eines EU-weit einheitlichen und gemeinsamen Rechts der EU-Mitgliedsstaaten für die Phase nach Erteilung des europäischen Patents, so stehen nun massive Eingriffe in die zentrale Struktur des europäischen Erteilungsverfahrens zur Diskussion. Es geht dabei um die Schaffung der rechtlichen Grundlagen für eine Beteiligung der nationalen Patentämter an den Verfahren vor dem EPA und deren Tätigwerden als PCT-Behörde. Damit ist die Frage der Arbeitsverteilung EPA – nationale Ämter zu einem Thema geworden, das die Debatte um das Gemeinschaftspatent schwer belastet.

Es ist daher nicht überraschend, daß es trotz gewaltiger Anstrengungen der schwedischen und belgischen EU-Präsidentschaft und nachhaltiger Bemühungen der EU-Kommission im Dezember letzten Jahres nicht gelungen ist, den erforderlichen Konsens unter den EU-Mitgliedstaaten über die Eckpunkte des künftigen Gemeinschaftspatentsystems herbeizuführen, und die im Hinblick auf das Gemeinschaftspatent für Juni 2002 geplante EPÜ-Revisionskonferenz abgesagt werden mußte.

Ob es nun der spanischen Präsidentschaft gelingt, in den Sachfragen substantielle Fortschritte zu erzielen bleibt abzuwarten. Die jüngsten Empfehlungen des Europäischen Parlaments zur Einführung eines Fünf-Sprachen-Regimes „à la Alicante" für das Verfahren zur Erteilung von Gemeinschaftspatenten zeigt, daß das Bemühen zur Schaffung einer sachgerechten Sprachenregelung immer mehr von politischen Zielsetzungen überlagert wird. Dies gilt auch für die Frage der Finanzierung des geplanten Gemeinschaftspatentsystems, wo finanzpolitische Erwägungen der EU-Mitgliedstaaten mit dem Bestreben zur Schaffung eines kostengünstigen Gemeinschaftspatents kollidieren. Die bereits angesprochenen Bestrebungen zur Dezentralisierung des europäischen Patentsystems sind ebenfalls Ausdruck einer Tendenz zur stärkeren Betonung der nationalen Interessen gegenüber dem gemeinsamen europäischen Anliegen.

Die europäische Industrie hat in diesem Zusammenhang bereits im letzten Jahr klar gemacht, daß sie sich gegen jede Form der Dezentralisierung des europäischen Erteilungsverfahrens ausspricht. Befürchtet werden eine Zersplitterung und eine Renationalisierung des Patentwesens in Europa, die in direktem Widerspruch zu den Bedürfnissen der Anmelder in einem sich immer mehr vereinheitlichenden europäischen Markt stehen und mit dem ursprünglichen Konzept eines einheitlichen Gemeinschaftspatents nicht vereinbar sind. Bleibt zu hoffen, daß die Stimme der Benutzer in Brüssel gebührend wahrgenommen wird und für das Gemeinschaftspatent sachgerechte Lösungen gefunden werden.

Ob dies gelingt, werden wir vielleicht schon am 21. Mai erfahren, wenn der Binnenmarktrat erneut versuchen wird, einen gemeinsamen Standpunkt zu den Eckpunkten des geplanten Gemeinschaftspatents festzulegen.

Erweiterung der EPO

Abschließend noch ein paar aktuelle Informationen zur bevorstehenden Erweiterung der Europäischen Patentorganisation. Zunächst ist eines klar, sozusagen im Bereich der Innenpolitik der Organisation: Der Verwaltungsrat der EPO wird bei in absehbarer Zukunft 30 Mitgliedstaaten seine Arbeitsweise überdenken müssen. Das geschieht gegenwärtig auch. Das unmittelbare Ziel ist dabei zunächst, die Entscheidungsmechanismen zu straffen und auf diese Weise die Arbeit des Rats effizienter zu gestalten. Daneben bahnt sich allerdings auch eine Entwicklung an, die darauf gerichtet ist, dem Rat und

insbesondere seinem Präsidenten erheblich größere Einwirkungsmöglichkeiten auf die Arbeit des Amtes zu eröffnen, als dies bisher der Fall war. Hier wird darauf zu achten sein, daß die vom EPÜ vorgegebenen Aufgabenverteilungen respektiert und die Entstehung von Doppelstrukturen vermieden wird. Ich denke, daß auch die interessierte Öffentlichkeit gerade dieser Aspekt aufmerksam verfolgen soll. Fehlentwicklungen auf diesem Gebiet würden die Arbeitsmöglichkeiten des Amtes sicher sehr negativ beeinflussen.

Zum Erweiterungsprozeß konkret: Wie bereits im Zusammenhang mit der Ratifikation der Revisionsakte angesprochen, haben Bulgarien, Estland, die tschechische Republik und die slowakische Republik ihre Beitrittsurkunden zum EPÜ im April hinterlegt. Diese Staaten werden ab dem 1. Juli 2002 Mitglied der Europäischen Patentorganisation sein. Für September erwarten wir den Beitritt Polens, Sloweniens und Rumäniens. Weitere ost- und mitteleuropäische Staaten werden Anfang und Mitte des nächsten Jahres beitreten. Die patentrechtliche Wiedervereinigung Europas wird damit ihren vorläufigen Abschluß finden. Mit dieser erfreulichen Perspektive möchte ich meine Ausführungen abschließen.

Vielen Dank für Ihre Geduld und Aufmerksamkeit.

Virtual Monopoly
Christopher G Pike, Nicholas Brealey Publishing, 2001

J. Spaargaren* (GB)

Christopher Pike is not your run-of-the-mill intellectual property adviser. Although qualified as a patent and trade mark attorney, his experience in dealing with business management issues comes through very directly when reading this book.

It is not always appreciated that there is a whole host of available strategies for businesses which are, knowingly and in some cases not, involved in generating intellectual property. Intellectual property generators often need commercially minded guidance appropriate to their markets and their approach to business as to how their intellectual property can be used to create value. Pike has identified and crystallised models and concepts in a way which makes the grander themes of intellectual property, often held as an impenetrable area for those outside its day-to-day practice, readily understandable. He sets out a useful vocabulary of concepts and terms, describing intellectual property as a currency used in buy-sell relations and for measuring creative advantage.

Virtual Monopoly provides various templates for developing an intellectual property position, including the „value-added monopoly" model and the „monopoly-in-a-box" model. The book also provides advice on how to avoid the pitfalls in the intellectual property landscape, including one to be particularly wary of: the „big cliff". Alternatives when dealing with contentious issues are described, in the words of the author, as deciding which „fight club" to join, and the whole book is animated in a similar manner.

Against a background of current developments, such as globalisation and harmonisation, the author makes a strong case for a reappraisal of prevalent approaches to handling intellectual property, and provides vivid examples of companies that are doing it right. Whilst business models for dealing with intellectual property are often seen as commercially sensitive know-how developed by a company and therefore difficult to ascertain, Pike brings a whole range of models out into the open.

I suspect that Pike may be at the forefront of a new area of consulting which is much needed but so far overlooked. The book he has written will surely be a useful tool to a broad range of readers, particularly those looking for modern approaches to intellectual property strategy. Whilst other books on IP may be found hidden in the law section of a bookshop, this will almost certainly be found in amongst the bestselling management books.

* Director, Electronic Intellectual Property, London

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

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de discipline (epi)
AT – W. Katschinka	FI – P. C. Sundman	IT – B. Muraca
AT – P. Révy von Belvard	FR – P. Gendraud	LI – P. Rosenich
BE – G. Leherte	FR – J.-P. Kedinger	LU – J. Waxweiler
CH – K. Schmauder	GB – S. Wright	NL – J. de Vries
DE – W. Fröhling	GB – G. Szabo	NL – A. Ferguson
DE – G. Keller	GR – T. Kilimiris	PT – A. J. Pissara Dias Machado
DK – U. Nørgaard	IE – G. Kinsella	SE – P. O. Rosenquist
ES – V. Gil Vega	IT – G. Mannucci	TR – T. Yurtseven

Disziplinarausschuss (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
CH – C.-A. Wavre	FR – M. Santarelli	GB – J. Boff
DE – W. Dabringhaus		

Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
CH – C. Bertschinger	GB – E. Lyndon-Stanford	IT – E. Klausner
DE – H. Lichti	GR – C. Kalonarou	SE – C. Onn
FR – A. Armengaud Aîné		

epi-Finanzen	epi Finances	Finances de l'epi
AT – P. Pawloy	DE – M. Maikowski	IT – S. Bordonaro
BE – P. Vandersteen	DK – K. Vingtoft	LU – J. P. Weyland
CH – T. Ritscher	FR – H. Dupont	SE – B. Erixon
	GB – C. Mercer	

Geschäftsordnung	By-Laws	Règlement intérieur
CH – C. E. Eder*	FR – T. Schuffenecker	GB – T. L. Johnson
DE – L. Steiling		

Standesregeln	Professional Conduct	Conduite professionnelle
AT – E. Kunz	FI – J. Kupiainen	LU – J. Bleyer
AT – E. Piso	FR – J. Bauvir	NL – F. Barendregt
BE – P. Overath	FR – P. Vidon	NL – F. Dietz
CH – U. Blum	GB – J. D. Brown*	PT – N. Cruz
DE – H.-H. Wilhelm	GB – J. Gowshall	PT – F. Magno (Subst.)
DE – K. Zimmermann	GR – A. Patrinos-Kilimiris	SE – L. Stolt
DK – L. Roerboel	IE – M. Walsh	SE – M. Linderoth
ES – C. Polo Flores	IT – A. Perani	TR – K. Dündar
		TR – E. Dericioglu

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Europäische Patentpraxis	European Patent Practice	Pratique du brevet européen
AT – M. Beer	ES – E. Armijo	IT – A. Josif
AT – G. Widtmann	ES – L. A. Duran	LU – Bruce Dearling
BE – E. Dufrasne	FI – E. Grew	NL – W. Hoogstraten
BE – J. van Malderen	FI – A. Weckman	NL – L. J. Steenbeek
CH – W. Bernhardt	FR – A. Casalonga*	NL – R. Jorritsma (Substitute)
CH – E. Irniger	FR – J. Bauvir	PT – P. Alves Moreira
CY – C. Theodoulou	GB – P. Denerley**	PT – N. Cruz
DE – G. Schmitt-Nilson	GB – I. Muir	SE – A. Bornegård
DE – F. Teufel	GR – D. Oekonomidis	SE – M. Holmberg
DK – P. J. Indahl	IE – P. Shortt	TR – A. Deris
DK – P. R. Kristensen	IE – C. Lane (Substitute)	TR – O. Mutlu
	IT – E. de Carli	TR – S. Coral (Substitute)

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DE – G. Leissler-Gerstl	GR – T. Margellos	SE – T. Onn*
DK – E. Christiansen	IE – L. Casey	TR – S. Arkan
Stellvertreter	Substitutes	Suppléants
AT – P. Kliment	DK – A. Secher	IT – P. Rambelli
BE – G. Voortmans	FI – J. Salomäki	NL – A. Hulsebos
CH – K. Schwander	FR – M. Le Pennec	PT – J. de Sampaio
DE – L. B. Magin	GB – J. Laredo	SE – M. Linderoth
		TR – B. Kalenderli
Beobachter (Examination Board Members on behalf of the epi)	Observers	Observateurs
CH – M. Seehof	GB – I. Harris	IT – G. Checcacci
DE – P. Weinhold		

Biotechnologische Erfindungen	Biotechnological Inventions	Inventions en biotechnologie
AT – A. Schwarz	FR – M. le Pennec	NL – J. Kan
BE – A. De Clercq	FR – J. Warcoin	PT – J. E. Dinis de Carvalho
CH – D. Wächter	GB – S. Wright	PT – A. Canelas (Substitute)
DE – G. Keller	GB – C. Mercer**	SE – L. Höglund
DK – B. Hammer Jensen*	IE – C. Gates	TR – H. Cayli
ES – A. Ponti Sales	IT – G. Staub	TR – C. Özbay
FI – M. Lax	IT – D. Pieraccioli (Substitute)	

EPA-Finanzen	EPO Finances	Finances OEB
DE – W. Dabringhaus	FR – S. le Vaguerèse	GB – J. Boff*
ES – I. Elosegui de la Pena		

Harmonisierung	Harmonization	Harmonisation
BE – F. Leyder*	ES – J. Botella	GB – J. D. Brown**
DE – R. Einsele	FR – S. le Vaguerèse	NL – L. Steenbeek
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BE – F. de Corte	FR – J. J. Martin	LU – B. Dearling
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CY – C. Theodoulou	GR – H. Papaconstantinou	NL – A. Huygens
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Interne Rechnungsprüfer / **Internal Auditors** / **Commissaires aux Comptes internes**

Ordentliche Mitglieder	Full Members	Membres titulaires
CH – A. Braun		DE – R. Zellentin

Stellvertreter	Substitutes	Suppléants
DE – D. Laufhütte		DE – R. Keil

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