

e**pi** **Information**

Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

Heft · Part · Fascicule 2 Juni · June · Juin 2007



Carl Heymanns Verlag

ISSN 1434-8853

2007 **2**



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Verlag · Publishing House · Maison d'édition

Carl Heymanns Verlag GmbH
Ein Unternehmen von Wolters Kluwer Deutschland
Luxemburger Straße 449
D-50939 Köln
Tel. (0221) 94 373-7000
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Kundenservice: Tel. (02631) 801-2222
e-mail: info@wolterskluwer.de
<http://www.heymanns.com>

Anzeigen · Advertisements · Publicité

Carl Heymanns Verlag GmbH
Ein Unternehmen von Wolters Kluwer Deutschland

Druck Printing Imprimeur

grafik + druck, München

ISBN 978-3-452-26531-9
ISSN 1434-8853

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Vierteljahreszeitschrift

Abonnement im Mitgliedsbeitrag enthalten,
für Nichtmitglieder € 42,00 p. a. zzgl. Ver-
sandkosten (€ 9,90 Inland / € 14,00 Aus-
land), Einzelheft € 12,60 zzgl. Versandkosten
(ca. € 2,27 Inland / ca. € 3,20 Ausland)
je nach Heftumfang. Preise inkl. MwSt. Auf-
kündigung des Bezuges 6 Wochen vor Jah-
resende.

Quarterly Publication

Subscription fee included in membership fee,
for non-members € 42,00 p. a. plus postage
(national € 9,90 / abroad € 14,00), indivi-
dual copy € 12,60 plus postage (national
about € 2,27 / abroad about € 3,20) de-
pending on the size of the issue, VAT inclu-
ded. Cancellation of subscription is requi-
red 6 weeks before any year's end.

Publication trimestrielle

Prix d'abonnement inclus dans la cotisation,
pour non-membres € 42,00 p. a., frais d'en-
voi en sus (national € 9,90 / étranger
€ 14,00), prix à l'unité € 12,60, frais d'en-
voi en sus (national environ € 2,27, étran-
ger environ € 3,20) selon le volume du nu-
méro, TVA incluse. Résiliation de l'abonne-
ment 6 semaines avant la fin de l'année.

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Editorial

T. Johnson (GB)

„The King is dead!“ – „long live the King!“ Those amongst our readers of a particularly Shakespearean tendency will know of this salute on the accession of a new Monarch. Whilst not in any way suggesting the demise of outgoing President Pompidou – Mark Twain’s words about exaggeration on that front spring to our mind – nevertheless we salute the arrival of Alison Brimelow, ex-head of the (then) U.K. Patent Office (now U.K. Intellectual Property Office, UKIPO). We are sure she will carry on the work of President Pompidou, who will no doubt look back over his tenure with no little satisfaction as to the state in which he leaves the Office. Nevertheless there will be much for Ms. Brimelow to address. We know that our new President has not been idle whilst waiting to accede to the top post, her tenure at the U.K. Office is testament to that. We wish her well for the ensuing years, and on behalf of the *epi* look forward to our organisation, part of the European Patent Organisation by virtue of the Founding Regulation, forging a good rapport with her.

On behalf of the Editorial Committee, we also hope to be able to publish an article by Ms. Brimelow in a future issue.

Momentous times indeed! – and we also remind our readers of the 30th anniversary of the *epi*, to be celebrated by a special symposium in Nuremberg where interesting topics will be discussed, as mentioned in this issue. The date the 22nd October is just about 30 years to the day that our Institute was founded – the Founding Regulation on the establishment of our Institute entered into force on 21st October, 1977. A lot has happened in those 30 years; more will no doubt come to pass in the ensuing 30 years, and beyond.

As the Chinese proverb (or is it curse?) says, „may you live in interesting times“. If you read the Report of the last Council Meeting in this issue, you will see that the times are certainly interesting, and no doubt will be for Ms. Brimelow too. We wish her and all our readers, a happy and relaxing summer period to reflect on the present and the future!

Nächster Redaktions- schluss für epi Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **17. August 2007**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **17 August 2007**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de *epi* Information est le **17 août 2007**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Themed issue 1/2008

„Effects and Expectations of EPC 2000“

Submissions are requested as soon as possible.

epi 30th Anniversary Celebration

W. Baum
Secretary General

In 1977 the Institute of Professional representatives before the European Patent Office was founded. The *epi* Council has decided to celebrate the 30th anniversary of the Institute together with leading strategists in the field of Intellectual Property. The 30th Anniversary of the *epi* will be held on the occasion of the 63rd Council meeting in

Nuremberg
MARITIM Hotel (Frauentorgraben)
on
Monday, 22 October 2007
Beginning 14:00

The event will comprise two parts:

1. Monday afternoon will be dedicated to a seminar with presentations on the following issues:

„The future of patenting in Europe“, with key-note speakers from *epi*, EPO, European Commission and European Parliament, and

„Education for the future of patenting in Europe“, with key-note speakers from *epi*, CEIPI, European Patent Academy and Institut Européen Entreprise et Propriété Intellectuelle (IEEPI).

Each presentation will be followed by an open debate. The seminar will end at 18:00.

2. Gala dinner at the Nuremberg Town Hall, starting at 19:30.

Attendance of *epi* members and hotel accommodation will be at the members' own expense.

Those members who would like to book a room at the MARITIM Hotel are invited to contact the *epi* Secretariat by 30 August. More details will be published on the *epi* website at a later date.

Next Board and Council Meetings

Board Meetings

74th Meeting, 15th September 2007, Sofia

75th Meeting, 1st December 2007, Munich

76th Meeting, 29th March 2008, Rome

Council Meetings

63rd Meeting, Nuremberg, 22nd-23rd October 2007

64th Meeting, Vilnius, 26th-27th May 2008

65th Meeting, Munich, 24th-25th November 2008

CPE Seminars

These seminars are organised by the *epi* in the framework of the current project of Continuing Professional Education, some of those seminars are organised in collaboration with the European Patent Academy of the EPO.

24 September 2007, Copenhagen, in „Charlottenhaven“

„Amendments to European Patent applications during examination“

Report of EPC 2000 Seminar in Bucharest

R. Vasilescu (RO)

The EPC 2000 Seminar held in Bucharest on 31 May 2007 was attended by 22 participants, with 2 tutors, namely Raluca Vasilescu from Cabinet Oproiu and Cristina Popa from Rominvent, coordinated by the *epi* Board Member Mrs Margareta Oproiu.

The programme of the Seminar has started with the amendments having an impact on the profession (namely client-attorney privilege), because the tutors believed this topic could be a point for discussion with the aim of introducing this privilege in the National laws governing the profession.

After this, the two tutors presented alternatively the changes of the main types of procedures in their natural

order, beginning with the application /entry into regional phase, continuing with substantive examination issues, further processing and the reinstatement of rights and ending with after-grant procedures, such as opposition, revocation and limitation proceedings.

The Seminar Coordinator, Mrs. Oproiu, has summarized the essential aspects of each section and compared them with the provisions of the National law for the same type of procedures.

The participants have expressed the wish to have another Seminar next year, to discuss how the changes were implemented.



Photos: Silvia Ene

EPC 2000 Seminars Calendar 2007

The *epi* together with the EPO Academy has provided a three-days training on EPC 2000 for national trainers nominated by *epi* Board Members. These trainers are now prepared to give lectures in their respective countries.

The first national seminars have already taken place.

A calendar of the scheduled seminars is available on the *epi* website at <http://216.92.57.242/patentepi/english/300/380/>

For further information, please contact Mrs Fromm at the *epi* Secretariat.

Beside the national seminars, so-called „regional seminars“ will also be organised. For these regional seminars it is foreseen that the *epi* lecturer will *possibly* be assisted by an EPO speaker. A Benelux regional seminar has

already been scheduled for 16 and 17 October 2007 in Eindhoven. Further regional seminars are under discussion for the time being. As soon as the seminars are scheduled, the dates will be published on the *epi* website and invitations will be sent to the Professional Representatives from the relevant region. Invitations to each seminar are sent by e-mail. Therefore you are kindly requested to check your e-mail address in the database of the EPO. A large number of professional representatives are registered in this database under the general company e-mail address, which explains that some *epi* members do not receive our information directly. Should our e-mail correspondence reach you directly, please forward your personal e-mail address to the EPO, gchiste@epo.org

Bericht über die 62. Ratssitzung Krakau, 21.-22. Mai 2007

Die 62. Ratssitzung des *epi* fand im wunderschönen Krakau, PL, statt.

Präsident Chris Mercer eröffnete die Sitzung mit einem Dank an die polnische Delegation für die ausgezeichnete Organisation der Sitzung.

Das Protokoll der 61. Ratssitzung in Istanbul am 16. und 17. Oktober 2006 wurde mit einigen kleineren Änderungen, die Herr Eder beantragt hatte, angenommen.

Herr Mercer berichtete, dass er, wie vom Rat auf der letzten Sitzung gewünscht, das EPA (DG5) wegen der EPA-Website angesprochen hatte, auf der der Eindruck erweckt wurde, dass die Kosten einer Patentierung nach dem EPÜ durch Anwaltsgebühren entstünden. Das EPA hatte sich geweigert, diesen Punkt von seiner Website zu streichen, da er auf statistischen Daten beruhe und insofern korrekt sein müsse. Der Rat beauftragte Herrn Mercer damit, dieses Argument mit der künftigen Präsidentin des EPA, Frau Alison Brimelow, wieder aufzunehmen.

Die nächsten Wahlen zum Rat finden Anfang 2008 statt. Ein Wahlausschuss mit drei Mitgliedern musste ernannt werden. Der Rat wählte Herrn Heinz Breiter (CH), Herrn Tivadar Palagyi (HU) und Herrn Klaus Peter Raunecker (DE) als Wahlausschuss für die nächsten Wahlen zum Rat.

epi-Finanzausschuss – als Ersatz für Frau Ingmar Webjörn, die zurückgetreten ist, wurde bis zum Ende der Amtsperiode dieses Ausschusses, Mai 2008, als Ersatz Herr Klas Norin gewählt.

Ausschuss für Online-Kommunikation – Dieser Ausschuss war angesichts der Bedeutung von Online-Anmeldungen neu gestaltet worden. Seine Mitglieder sind Roger Burt (GB) (Vorsitzender), Debra Smith (GB), Kurt Stocker (DE), Luciano Bosotti (IT), Antero Virkkala (FI) (Sekretär), Johan van der Veer (NL), Jean-Robert Callon de Lamarck (FR) und Peter Indahl (DK) (Verbindungsmitglied zum Ausschuss für europäische Patentpraxis (EPPC)). Die Mitgliederzahl des Ausschusses wurde durch Ratsbeschluss von 7 auf 8 erhöht.

EPÜ 2000 – Von Vize-Präsident Nuss lag ein Bericht über ein Seminar „Training the Trainers“ vor, das aus Sicht des *epi* sehr erfolgreich war. Frau Kaminski berichtete aus Sicht des PQC. Eine große Zahl von Folgeseminaren sind in den Mitgliedsländern in Vorbereitung. Auch regionale Seminare werden organisiert, ein erstes im Oktober 2007 in NL, BE und LU. Das EPA wird sich daran anscheinend nur beteiligen, wenn es mindestens 100 Teilnehmer gibt.

Der Rat *stimmte* der Bildung einer vom Präsidenten zu benennenden Arbeitsgruppe zu, die die Bedingungen für eine angemessene Aus- und Weiterbildung erarbeiten soll. Es gab auch eine Diskussion über die *Vergütung* für *epi*-Tutoren. Der Rat war sich einig, dass eine solche

Vergütung gezahlt werden soll. Der PQC wird einen Vorschlag erarbeiten.

Ad-hoc-Ausschuss/Änderungen der *epi*-Gründungsvorschriften und der Geschäftsordnung – Herr Speiser berichtete über die Arbeit des Ausschusses bis jetzt, die im Wesentlichen darin bestand, Änderungen der Gründungsvorschriften zu erarbeiten, und Änderungen der Geschäftsordnung, die den Vorstand des *epi* mit mehr Handlungsberechtigung ausstatten soll, damit er Tag für Tag die Interessen des Instituts wahrnehmen kann. Es gab eine größere Diskussion über die bereits in der Geschäftsordnung vorgeschlagenen Änderungen und darüber, wie sie mit den Gründungsvorschriften in Einklang gebracht werden können. Die Arbeit des Ad-hoc-Ausschusses wird hoffentlich noch in diesem Jahr zu einem Vorschlag an den Verwaltungsrat führen.

EPPC – Der Vorsitzende Herr Lyndon-Stanford legte einen langen Bericht über die Arbeit des Ausschusses seit Istanbul vor.

- (i) Der Rat nahm die Überarbeitung des Zuständigkeitsbereichs des Ausschusses an, in der Angelegenheiten, die Online-Kommunikation und Biotechnologie betreffen, ausgeklammert werden.
- (ii) Es gab Diskussionen über die Punkte „ruhende Patente“, die EU-Richtlinie über kriminelle Maßnahmen, Vertretung vor dem EPLA und die Kommissionsmitteilung über die Zukunft des Patentsystems in Europa. Auf künftigen Sitzungen wird weiterhin über die Arbeit zu diesen Punkten diskutiert werden.

Es gab eine Diskussion über ein Projekt „Kriterien der Produktqualität“ des Verwaltungsrats; der Verwaltungsrat hat jetzt eine Arbeitsgruppe gebildet, die sich mit dem Qualitätsstandard des Produktes, d. h. der erteilten Patente beschäftigt. Eine gedankliche Schule vertritt die Ansicht, dass zu viele „triviale“ Patente erteilt werden, eine andere, dass auch eine „einfache“ Erfindung gleichwohl ausgefeilt und von kommerziellem Wert sein kann. Diese Ansichten führen generell zur Betrachtung des *inventive step*. Das Institut wird weiterhin an diesem Thema arbeiten und dem EPA zum *inventive step* ein Papier vorlegen.

Bei EPPC und Harmonisierungsausschuss gibt es eine Überlappung. Die Vorsitzenden dieser Ausschüsse und der Präsident werden die künftige Arbeitsweise besprechen.

Disziplinarbeschwerdekammer – Generell gibt es zwei Arten von Fällen und zwar (i) Einspruch gegen Prüfungsergebnisse und (ii) andere. Man kam überein, dass die Disziplinarbeschwerdekammer die bisherigen nicht bearbeiten soll. Man einigte sich, dass alle Fälle, die den EPPC betreffen, von diesem Ausschuss bearbeitet werden.

Die Berichte des Präsidenten, des Generalsekretärs und des Schatzmeisters wurden vorgelegt und besprochen. Der Generalsekretär sagte, dass es 8.613 Mitglie-

der aus 32 Ländern gibt. Auch wurde ein Vertrag mit einer neuen Software-Firma, der BCS, geschlossen. Die Firma ist verantwortlich für Hard- und Software, Massene-mail-Versendung und Buchhaltungssoftware. Der Schatzmeister sagte, dass die Zahlung der Mitgliedsbeiträge durch Online steige. Es gab eine größere Diskussion über die Finanzen allgemein unter Beteiligung des Finanzausschusses. Auch die internen Rechnungsprüfer sagten, dass in ihren Augen der Bericht des Schatzmeisters richtig war. Alle Berichte wurden vom Rat angenommen, der auch den Schatzmeister *entlastete*, nachdem der Haushalt, den er für 2006 vorgelegt hatte, angenommen worden war.

Privileg – Gegenwärtig bezieht sich dieses nur auf Mitteilungen im Zusammenhang mit dem EPA. Bezüglich des attorney/client privilege gibt es national keine Harmonisierung in den Mitgliedsstaaten. Der Präsident schlug vor, ein Papier zum nationalen Privileg zu erarbeiten und dem Verwaltungsrat vorzulegen, in der Hoffnung, dass der Verwaltungsrat auf die Mitgliedsstaaten Einfluss nehmen kann. Der Rat *stimmte* der Erarbeitung eines solchen Papiers zu.

Der Präsident gab Ernennungen bekannt und merkte für den Rat die folgenden Termine vor:

Herr Benoît Battistelli (FR) – stellvertretender Vorsitzender des Verwaltungsrats

Herr Markus Hössle (DE) – Direktor des CEIPI

Herr Terry Johnson (GB) – Mitglied der Disziplinarbeschwerdekammer

Herr Peter Vermeij (NL) – Vize-Präsident DG2 des EPA

Die nächsten Ratssitzungen: 63. Sitzung, am 22. und 23. Oktober 2007 in Nürnberg; 64. Sitzung, am 26. und 27. Mai 2008 in Vilnius; 65. Sitzung, am 24. und 25. November 2008 in München.

30. Jahrestag des *epi*: Er soll am Montag, 22. Oktober 2007 von 14 – 18 h in Nürnberg als Teil der 63. Ratssitzung stattfinden. Das vorläufige Programm ist wie folgt:

14.00 h: Die Zukunft der Patentanmeldung in Europa, mit Hauptrednern von *epi*, EPA, Europäischer Kommission und Europäischem Parlaments.

Kaffeepause

16.15 h: Die für die Zukunft der Patentanmeldung in Europa benötigte Ausbildung, mit Hauptrednern von *epi*, CEIPI und IEEPI.

Die Sprechzeit für die Ausführungen wird jeweils etwa 10 Minuten betragen. Für Diskussionen wird viel Zeit zur Verfügung stehen.

18.00 h: Ende

Es wird daran erinnert, dass das EPÜ vom 5. Oktober 1973 am 7. Oktober 1977 in Kraft getreten ist. Die Vorschriften (Gründungsvorschriften) über die Gründung eines Instituts der beim EPA zugelassenen Vertreter traten am 21. Oktober 1977 in Kraft. Das EPA wurde am 2. November 1977 eröffnet.

Entwurf der Beschlüsse

62. Ratssitzung, Krakau, 21.-22. Mai 2007

- Herr K. P. RAUNECKER wurde als Mitglied des Wahlausschusses gewählt.
- Herr K. NORIN wurde als Mitglied des *epi*-Finanzausschusses bis zum Ende der laufenden Amtszeit des Rates gewählt.
- Die Anzahl der Mitglieder des Ausschusses für Online-Kommunikation (OCC) wurde von sieben auf acht erhöht.
- Die folgenden Personen wurden als Mitglieder des OCC gewählt: R. Burt (GB), D. Smith (GB), K. Stoker (CH), L. Bosotti (IT), A. Virkkala (FI), J. Van der Veer (NL), J-R. Callon de Lamarck (FR), P. Indahl (DK).
- Es wird eine kleine Arbeitsgruppe gebildet, die die Aufgabe hat, für die nächste Ratssitzung Vorschläge betreffend die Ernennung einer Kontrollperson für Fragen der Ausbildung sowie Vorschläge für die Bezahlung von Personen zu unterbreiten, die mit Angelegenheiten der Ausbildung beschäftigt sind.
- Probleme, die in den Zuständigkeitsbereich des OCC fallen, werden vom derzeitigen Zuständigkeitsbereich des EPPC ausgenommen.
- Das Schreiben an WIPO bezüglich des abgeänderten Entwurfs der PCT-Richtlinien wurde angenommen.
- Der Entwurf des *epi*-Positionspapiers zum *Joint Assessment* wird ans EPA geschickt.
- Das Positionspapier zur vorgeschlagenen Richtlinie für kriminelle Maßnahmen wurde unter Einschluss des Schutzes von Know-how angenommen.
- Die Antwort auf das Papier des Kommunikationsausschusses für die Zukunft von Patenten in Europa wird auf der nächsten Ratssitzung erneut vorgelegt.
- Das Positionspapier zum "Umgang mit vertraulichen Dokumenten durch das EPO" wurde angenommen.
- Das Positionspapier zum "Zugang zu nicht veröffentlichten Dateien, *Smart Cards*, Verwaltung" wird als Schreiben an das EPA geschickt.

13. Das Positionspapier zur "Vertraulichkeit des MSBA" wurde angenommen.
14. Das Positionspapier zu "Aufnahme und Protokoll von mündlichen Verhandlungen der Beschwerdekammer" wird an das EPA geschickt.
15. Die 65. Ratssitzung wird am 24. und 25. November 2008 in München stattfinden.
16. Die vier Tutoren, die am Seminar „Training the Trainers“ vom 2. bis 4. Mai 2007 teilgenommen haben, Frau HEGNER, Herr LEYDER, Frau MODIANO und Herr VISSER, werden eine Remuneration erhalten.
17. Das *epi* wird jedem Tutor der EPC 2000-Folgeseminare eine Remuneration zahlen. Die Auslagen der Tutoren werden gemäß dem *epi*-Standard erstattet.
18. Die Pauschale für unvorhergesehene Ausgaben wird von 50 € auf 60 € angehoben.
19. Die Kosten für Rats- und Vorstandssitzungen werden aufgesplittet, sodass sie im *epi*-Haushalt detailliert erscheinen.
20. Sekretariatskosten werden nicht den Seminaren zugeschlagen und müssen im Budget des Sekretariats erscheinen.
21. Der Haushalt 2006 wurde angenommen und dem Schatzmeister wurde Entlastung erteilt.

Report of the 62nd Council Meeting Krakow, 21st – 22nd May, 2007

The 62nd Council Meeting of *epi* took place in the beautiful city of Krakow, PL.

President Chris Mercer opened the meeting, with thanks to the Polish Group for their excellent organisation of the meeting.

The Minutes of the 61st Council Meeting, Istanbul 16th – 17th October, 2006 were approved following an agreed minor amendment put forward by Mr. Eder.

Mr. Mercer reported that he had as requested by Council at the last meeting, approached the EPO (DG5) concerning the EPO website, which gave the impression that the cost of patenting under EPC was a result of attorney fees. The EPO had declined to withdraw this item from the website on the grounds that it was based on statistical data, and must therefore be accurate. Council instructed Mr. Mercer to follow up on the issue with the incoming President of the EPO, Ms. Alison Brimelow.

The next Council Election will take place at the beginning of 2008. An Electoral Committee of three members had to be appointed. Council elected *nem con*, Mr. Heinz Breiter (CH), Mr. Tivadar Palagyi (HU) and Mr. Klaus Peter Raunecker (DE) as the Electoral Committee for the next Council elections.

epi Finances Committee – Mr. Klas Norin was elected to this Committee until May 2008, the remainder of its term, in place of Mrs. Ingmari Webjörn, who has resigned from the Committee.

On-line Communications Committee – This Committee had been reformed in view of the relevance of on-line filing. The members are Roger Burt (GB) (Chairman), Debra Smith (GB), Kurt Stocker (DE), Luciano Bosotti (IT), Antero Virkkala (FI) (Secretary), Johan van der Veer (NL), Jean-Robert Callon de Lamarck (FR) and Peter Indahl (DK) (EPPC Liaison Member). The Committee size was increased from 7 to 8 Members on a vote of Council.

EPC2000 – There was a report by Vice President Nuss on a Seminar „Training the Trainers“ which has been very successful from the *epi* point of view. Mrs. Kaminski reported from the PQC point of view. National follow-up seminars are in preparation in a large number of Member States. Regional Seminars will also be organised, the first such Regional Seminar will be held for NL, BE and LU in October 2007. The EPO it seems would only participate if there were at least 100 participants.

Council *approved* the setting up of a working group, to be convened by the President, to study the provision of adequate training and education. There was also a discussion on *remuneration* for *epi* Tutors. The Council agreed that there should be such remuneration. The PQC will put forward a proposal.

Ad Hoc Committee/amendments to *epi*'s Founding Regulation and the By-Laws – Mr. Speiser reported on the work of the Committee to date, which was effectively to provide amendments to the Founding Regulation and of the By-laws to provide the Board of the *epi* with greater powers to act on a day-to-day basis in the interests of the Institute. There was an extended discussion over amendments already proposed in the By-laws, and on bringing them into alignment with the Founding Regulation. The work of the Ad Hoc Committee will continue hopefully to bring a proposal to the Administrative Council later this year.

EPPC – There was a long report from Mr. Lyndon-Stanford, Chairman, on the Committee's activities since Istanbul.

- (i) The Council *approved* revision of the terms of reference of the Committee to exclude on-line communication questions as well as biotech.
- (ii) There were discussions round the topics of „sleeping patents“, the EU Directive on Criminal Measures, Representation before the EPLA and the Commission Communication on the future of

the Patent System in Europe. There will be continued work on these topics, for discussion at future meetings.

There was a discussion on an AC project „Product Quality Criteria“, the AC now having set up a Working-Group looking at a standard for the quality of the product i.e. granted patents. One school of thought considers that too many ‘trivial’ patents are granted, another considering that a „simple“ invention can nevertheless be sophisticated and of commercial value. These views generally lead to a consideration of inventive step. The Institute will continue work on this subject, with a view to submitting a position paper to the EPO on inventive step.

There is some overlap between the EPPC and Harmonisation Committees. The Chairs of these Committees and the President will discuss future handling of work.

Disciplinary Board of Appeal – There are generally two kinds of cases, namely (i) appeals from exam results, (ii) others. It was agreed that the former may not be suitable for handling by the DBA. It was agreed that any cases of interest to the EPPC will be raised with that Committee.

The Reports of the President, Secretary General and Treasurer were presented and discussed. The Secretary General reported membership as 8613 from 32 countries. Also, a contract with a new software company, BCS, had been concluded. The company will be responsible for hard and software, gross e-mailings, and accounting software. The Treasurer reported an increase in on-line payment of membership fees. There was an extended discussion on finances in general, including contributions from the Finance Committee. The Internal Auditors also reported in their view the Treasurer’s report was correct. All the reports were adopted by Council, who also *discharged* the Treasurer after approval of the accounts he had presented for 2006.

Privilege – At present, this only applies to communications in relation to the EPO. There is no consistency in the Member States concerning attorney/client privilege *nationally*. The President proposed that a paper be pre-

pared on national privilege, to be presented to the Administrative Council, in the hope that the AC could influence Member States. Council *approved* preparation of such a paper.

The President noted for Council the following appointments:

Mr. Benoît Battistelli (FR) – Deputy Chairman of the Administrative Council

Mr. Markus Hössle (DE) – Director of CEIPI

Mr. Terry Johnson (GB) – Member of Disciplinary Board of Appeal

Mr. Peter Vermeij (NL) – EPO Vice-President DG2.

Next Council Meetings: 63rd meeting, 22nd – 23rd October, 2007, Nuremberg; 64th meeting, 26th – 27th May, 2008, Vilnius; 65th meeting, 24th – 25th November, 2008, Munich.

epi 30th Anniversary: This is proposed to be on Monday, 22nd October, 2007, 14.00 – 18.00 hrs. in Nuremberg, as part of the 63rd Council Meeting. The draft programme is:

- 14.00: The future of patenting in Europe, with key-note speakers from *epi*, EPO, EC and EP.
- Coffee break
- 16.15: Education required for the future of patenting in Europe, with key-speakers from *epi*, CEIPI and IEEPI.

The key-note speakers will be given about 10 minutes each for their presentations. Ample time will be reserved for discussions.

- 18:00: End

It is to be recalled that EPC of 5 October 1973 entered into force on 7 October 1977. The Regulation (Founding Regulation) on the establishment of an institute of professional representatives before the EPO entered into force on 21 October 1977. The EPO opened on 2nd November, 1977.

Draft decisions

62nd Council meeting, Krakow, 21-22 May 2007

1. Mr. K. P. RAUNECKER was elected a member of the Electoral Committee.
2. Mr. K. NORIN was elected a member of the *epi* Finances Committee until the end of the current Council term.
3. The number of members of the Online Communications Committee (OCC) was increased from seven to eight.
4. The following persons were elected as members of the OCC: R. Burt (GB), D. Smith (GB), K. Stocker (CH), L. Bosotti (IT), A. Virkkala (FI), J. Van der Veer (NL), J-R. Callon de Lamarck (FR), P. Indahl (DK).
5. A small working group will be set up with the task of working out proposals for the next Council meeting, concerning the appointment of a supervisor in educational matters as well as proposals for the remuneration of people involved in educational matters.

6. Questions falling within the terms of reference of the OCC will be excluded from the present terms of reference of the EPPC.
7. The letter to WIPO concerning the draft amended PCT Receiving Office Guidelines was approved.
8. The draft *epi* position paper on Joint Assessment (of search and examination procedure) will be sent to the EPO.
9. The position paper on the Proposed Directive on Criminal Measures was approved with inclusion of the protection of know-how.
10. The response to the Communication of the European Commission on the Future of Patents in Europe paper will be presented again at the next Council meeting.
11. The position paper on „Handling of confidential documents by the EPO“ was approved.
12. The position paper on „Access to unpublished files, smart cards, administration“ will be sent as a letter to the EPO.
13. The position paper on „Confidentiality of the MSBA“ was approved.
14. The position paper on „Recording and minutes of Board of Appeal oral proceedings“ will be sent to the EPO.
15. The 65th Council Meeting will be held in Munich on 24th-25th November 2008.
16. The four tutors Mrs. HEGNER, Mr. LEYDER, Ms. MODIANO and Mr. VISSER, who have participated in the „Training the Trainers“ seminar from 2 to 4 May 2007, will be remunerated.
17. *epi* will remunerate the trainers for tutoring the EPC 2000 follow-up seminars. Expenses incurred by the trainers will be reimbursed according to the *epi* standards.
18. The flat rate for incidental expenses will be raised from 50€ to 60€.
19. Costs of Council and Board meetings will be itemized so that they are accurately reflected in *epi*'s accounts.
20. Secretariat costs are not to be allocated to seminars and should remain visible in the accounts of the secretariat.
21. The 2006 accounts were approved and the Treasurer was discharged from liability.

Compte rendu de la 62ème réunion du Conseil Cracovie, 21–22 mai 2007

La 62ème réunion du Conseil de l'*epi* a eu lieu en Pologne dans la belle ville de Cracovie.

Le Président Mercer ouvre la séance et remercie la délégation polonaise pour l'excellente organisation de la réunion.

Le compte rendu de la 61ème réunion du Conseil qui s'est tenue à Istanbul les 16 et 17 octobre 2006 est adopté après approbation d'une modification mineure proposée par M. Eder.

M. Mercer rapporte que, à la demande du Conseil, il a contacté l'OEB (DG5) au sujet du site Internet de l'OEB, lequel donne l'impression que les coûts d'un brevet européen résultent uniquement des honoraires des mandataires. L'OEB a refusé de retirer cette publication de son site en expliquant que cette information repose sur des statistiques et qu'elle doit par conséquent être exacte. Le Conseil demande à M. Mercer de poursuivre cette question avec le Président entrant, Mme Alison Brimelow.

Les prochaines élections du Conseil auront lieu au début de l'année 2008. Une Commission pour les élections au Conseil, composée de trois membres, doit être élue. Le Conseil élit à l'unanimité M. Heinz Breiter, M. Tivadar Palagyi (HU) et M. Klaus Peter Raunecker (DE) en tant que membres de la Commission pour les élections en vue des prochaines élections du Conseil.

Commission des Finances de l'*epi* – M. Klas Norin est élu membre de cette commission jusqu'à la fin de la période d'exercice en mai 2008, en remplacement de Mme Ingmari Webjörn qui a démissionné de la Commission.

Commission pour les Communications en ligne – Cette commission a été remaniée en raison de l'importance croissante des dépôts en ligne. Les membres de la Commission sont les suivants: Roger Burt (GB) (Président), Debra Smith (GB), Kurt Stocker (DE), Luciano Bosotti (IT), Antero Virkkala (FI) (Secrétaire), Johan van der Veer (NL), Jean-Robert Callon de Lamarck (FR) et Peter Indahl (DK) (Liaison avec l'EPPC). Le Conseil approuve par un vote que l'effectif de la Commission soit porté de sept à huit personnes.

CBE2000 – Le Vice-Président Nuss présente un rapport sur le Séminaire „Training the Trainers“, lequel a eu selon l'*epi* beaucoup de succès. Mme Kaminski donne le point de vue du PQC. Des séminaires suivront au plan national et sont déjà en préparation dans de nombreux états membres. Des séminaires au plan régional sont également prévus, le premier de ce type étant organisé pour le Benelux en octobre 2007. Il semble que l'OEB ne participera pas si le nombre des participants n'atteint pas cent personnes.

Le Conseil approuve la mise en place par le Président d'un groupe de travail, lequel aura pour tâche d'élaborer

des propositions relatives à la formation. La question de la rémunération des tuteurs est également soulevée et le Conseil se prononce en faveur de celle-ci. La Commission de Qualification Professionnelle fera une proposition.

Commission Ad Hoc pour la révision du règlement de création de l'*epi* et Règlement Intérieur – M. Speiser présente le travail de la commission dont la tâche était de modifier le Règlement de création de l'Institut de même que le Règlement intérieur en vue de donner au Bureau de l'*epi* des pouvoirs étendus et de permettre à celui-ci de prendre des décisions au jour le jour au mieux des intérêts de l'*epi*. Une longue discussion s'ensuit au sujet des amendements déjà proposés au Règlement intérieur et de leur mise en conformité avec le Règlement de création. La commission Ad Hoc continuera son travail et fera une proposition qui sera présentée au Conseil d'Administration dans le courant de l'année.

EPPC – Le Président de la Commission, M. Lyndon-Stanford, fait un long rapport sur les activités de la commission depuis la dernière réunion du Conseil à Istanbul.

- (i) Le Conseil approuve que les questions relevant des attributions de la Commission OCC et de la Commission pour les Inventions en biotechnologie soient exclues des attributions actuelles de la Commission EPPC.
- (ii) Puis le débat s'ouvre sur des questions telles que les „brevets dormant“, la Directive relative aux mesures pénales visant à assurer le respect des droits de la Propriété Intellectuelle, la représentation devant le „EPLA“ et la communication de la Commission sur l'avenir du système des brevets en Europe. Ces questions seront étudiées et seront présentées pour discussion lors de prochaines réunions.

Un débat s'ouvre sur un projet du Conseil d'Administration „Critères de qualité du produit“, le Conseil d'Administration ayant mis en place un groupe de travail pour veiller au respect de critères de qualité du produit, à savoir les brevets délivrés. Certains considèrent qu'un trop grand nombre de brevets „triviaux“ est délivré. D'autres pensent qu'une invention „simple“ peut s'avérer néanmoins sophistiquée et avoir une valeur commerciale. Ces points de vue mènent généralement à considérer l'activité inventive. L'Institut va continuer d'étudier la question afin de soumettre à l'OEB une prise de position sur l'activité inventive.

Comme il existe un certain recoupement des activités des commissions EPPC et Harmonisation, les présidents de ces commissions et le Président discuteront d'une future répartition du travail.

Chambre de recours en matière de discipline – Deux types de cas se présentent généralement, (1) les recours concernant les résultats d'examen, (ii) les autres. Le Conseil pense que les premiers ne devraient pas relever de la compétence de la Chambre de recours en matière de discipline. Il est convenu que les cas qui pourraient présenter un intérêt pour l'EPPC seront soumis à cette commission.

Puis sont présentés les rapports du Président, du Secrétaire Général et du Trésorier. Le Secrétaire Général

rapporte que les membres de l'*epi* sont actuellement au nombre de 8613, répartis entre 32 pays. Un contrat a été conclu avec une nouvelle compagnie d'informatique, BCS. Cette compagnie sera responsable du matériel et des logiciels, des envois e-mail groupés et du logiciel de comptabilité. Le trésorier annonce une augmentation du nombre de paiements en ligne des cotisations. Il s'ensuit une longue discussion relative aux finances en général et aux contributions de la commission des finances de l'*epi*. Les commissaires aux comptes internes déclarent que le rapport du trésorier est correct. Tous les rapports sont adoptés par le Conseil, lequel approuve les comptes de l'exercice 2006 et donne quitus au trésorier.

Principe de confidentialité et privilège – Cette disposition ne s'applique actuellement qu'aux communications avec l'OEB. Il n'existe pas de réglementation au plan national dans les Etats membres en ce qui concerne le principe de confidentialité et de privilège des échanges entre le client et son mandataire. Le président propose qu'un document sur la confidentialité et le privilège au plan national soit présenté au Conseil d'Administration dans l'espoir que ce dernier puisse exercer son influence sur les Etats membres. Le Conseil approuve la préparation d'un tel document.

Le président note les nominations suivantes:

M. Benoît Battistelli (FR) – Président adjoint du Conseil d'Administration

M. Markus Hössle (DE) – Directeur du CEIPI

M. Terry Johnson (GB) – Membre de la Chambre de recours en matière disciplinaire

M. Peter Vermeij (NL) – Vice Président DG2 OEB.

Prochaines réunions du Conseil: 63^{ème} réunion: 22–23 octobre, 2007, Nuremberg; 64^{ème} réunion: 26–27 mai 2008, Vilnius; 65^{ème} réunion: 24–25 novembre 2008, Munich.

Le 30^{ème} anniversaire de l'*epi* constituera une partie de la 63^{ème} réunion du Conseil et se tiendra le lundi 22 octobre 2007, de 14 h. à 18 h., à Nuremberg.

Le programme préliminaire est le suivant:

- 14.00: „L'avenir des brevets en Europe“ avec des présentations de l'*epi*, de l'OEB, de la Commission européenne et du Parlement européen.
- Pause café
- 16.15: „La formation nécessaire pour assurer l'avenir des brevets en Europe“ avec des présentations de l'*epi*, du CEIPI, et de l'IEEPI.

Les intervenants disposeront de 10 minutes pour leur présentation. Il sera réservé suffisamment de temps pour la discussion.

- 18:00: Fin

Il convient de rappeler que la CBE en date du 5 octobre 1973 est entrée en vigueur le 7 octobre 1977. Le règlement de création de l'Institut des mandataires agréés près l'Office européen des brevets est entré en vigueur le 21 octobre 1977. L'OEB a ouvert le 2 novembre 1977.

Projet de liste de décisions

62^{ème} réunion du Conseil, Cracovie, 21-22 mai 2007

1. M. K. P. RAUNECKER est élu membre de la Commission pour les élections au Conseil.
2. M. K. NORIN est élu membre de la Commission des Finances de l'*epi* pour le reste de la période d'exercice de l'actuel Conseil.
3. L'effectif de la Commission pour les Communications en ligne (OCC) passe de sept à huit personnes.
4. Les personnes suivantes sont élues membres de l'OCC: R. Burt (GB), D. Smith (GB), K. Stocker (CH), L. Bosotti (IT), A. Virkkala (FI), J. Van der Veer (NL), J-R. Callon de Lamarck (FR), P. Indahl (DK).
5. Un petit groupe de travail sera mis en place, lequel aura pour tâche d'élaborer des propositions pour la nomination d'une personne responsable de la coordination dans les domaines de la formation. Ce groupe de travail est également chargé de faire des propositions en ce qui concerne la rémunération des personnes travaillant pour la formation.
6. Les questions relevant des attributions de la Commission OCC seront exclues des attributions actuelles de la Commission EPPC.
7. La lettre à l'OMPI concernant le projet d'amendement des directives PCT de l'Office récepteur est approuvée.
8. La prise de position de l'*epi* sur une évaluation commune de la procédure de recherche et d'examen sera envoyée à l'OEB.
9. La prise de position sur la proposition de directive concernant les mesures pénales visant à assurer le respect des droits de la Propriété Intellectuelle est approuvée avec l'insertion de la protection du know-how.
10. La réponse à la communication de la Commission européenne sur l'avenir des brevets en Europe sera présentée à nouveau au Conseil lors de sa prochaine réunion.
11. La prise de position sur le „Traitement par l'OEB de documents confidentiels“ est approuvée.
12. La prise de position sur „L'accès aux dossiers non publiés, cartes smart, administration“ sera adressée sous forme de lettre à l'OEB.
13. La prise de position sur la „Confidentialité du MSBA“ est approuvée.
14. La prise de position sur „Le compte rendu des procédures orales des Chambres de recours et leur enregistrement“ sera envoyée à l'OEB.
15. La 65^{ème} réunion du Conseil se tiendra à Munich les 24 et 25 novembre 2008.
16. Les quatre tuteurs, Mme HEGNER, M. LEYDER, Mme MODIANO et M. VISSER, ayant participé au séminaire „Training the Trainers“ du 2 au 4 mai 2007, seront rémunérés.
17. L'*epi* versera une rémunération aux tuteurs pour les interventions ayant lieu dans le cadre des séminaires CBE 2000. Les tuteurs seront remboursés de leurs frais selon le règlement de l'*epi* en vigueur.
18. L'indemnité forfaitaire pour les faux frais passe de 50€ à 60€.
19. Les coûts des réunions du Bureau et du Conseil devront être comptabilisés dans le détail afin de pouvoir être identifiés de manière précise dans les comptes de l'*epi*.
20. Les coûts du Secrétariat ne seront pas alloués aux séminaires et devront rester apparents dans les comptes du secrétariat.
21. Les comptes pour l'exercice 2006 sont approuvés et quitus et donné au trésorier.

CEIPI *epi* Course on Patent Litigation in Europe

The programme of the 2007/2008 CEIPI Course is available on the *epi* website www.patentepi.com as well as on the CEIPI website www.ceipi.edu

Any question should be put to the *epi* Secretariat.

President's and Vice Presidents' Report

C. P. Mercer
President

I have been to a large number of meetings and had a number of informal contacts with personnel in the EPO, the Commission, the European Parliament and various national Patent Offices. I list below the meetings which I have attended and a brief outline of the content, unless it is reported elsewhere.

Many of the following meetings were also attended by the Vice-Presidents. They have also been very active.

23rd October, 2006 – Coordination Meeting European Patent Academy – *epi* – CEIPI

This meeting was chaired by Mr Campling. The draft contract, only received some days before our last Istanbul Council Meeting, was long and complex and was not in keeping with the expectations of many of the group.

In essence, the following three main concerns were seen by all to be critical in reaching a mutually acceptable agreement:

- Any contract has to be built on the concept of co-operation between three parties and a fair balance between their respective interests;
- Co-operation in both directions has to be included; and
- The copyright and liability clauses must safeguard the interests of all parties and share the responsibilities rather than any one party carrying all the burden.

Finally, a proposal was made to provide one brief agreement defining the essential features of co-operation between the parties. This would then be complemented by a template contract for the conditions which the *epi* and CEIPI will apply in any agreement between themselves and their tutors for any specific activity in co-operation with the Academy.

It was agreed that the EPO would draft a new proposal of a Memorandum of Understanding (MoU) and a proposal for a template contract corresponding to the conditions between the partners and their tutors.

23rd October, 2006 – Meeting of the Working Group on the EQE

We discussed again possible changes to the EQE Regulation and the structure of the various bodies. The suggestion was that the present EQE Board and Secretariat should remain essentially as it is but that there should be an „Advisory Board“ (the name has not been agreed yet) to look at more strategic issues. The suggestion is that there should be equal numbers of EPO and *epi* members and that the chairmanship should rotate.

24th-26th October, 2006 – Administrative Council

This meeting was attended by Mr. Finnilä and myself and a report of it can be obtained from Mr. Finnilä.

25th-27th October, 2006 – Academy Event in Venice

The EPO Academy organised an event in Venice in co-operation with Venice University on the island of San Servolo and the numerous Venetian municipal authorities. The event was aimed at connecting the academic, business and patent worlds. Mr Macchetta and I were heavily involved in the preparation and presentation of the meeting on San Servolo. We both chaired sessions. The event concluded with the award of the Venetian prize for contribution to the world of patents. Previous winners were Prof. Pompidou and the Head of WIPO. The prize was awarded to the President of the Mexican Patent Office.

Although the meeting was mainly attended by Italians, there were also a large number of delegates from all over Europe, and beyond. It was therefore a very good opportunity to make *epi* better recognised.

2nd November, 2006 – Committee on Patent Law

This meeting was mainly concerned with the amendments to the Rules for EPC 2000. However, trilateral issues were also discussed. I did not attend this on behalf of *epi*. I attended it as part of the UK delegation. I was therefore in a position to observe how the *epi* delegation operated. The delegation comprised members from EPPC and they operated very effectively. Most of the effective contributions were made by *epi*. I believe that *epi* made a significant contribution to making the Rules a lot better than they were.

3rd November, 2006 – CIPA Congress

I attended the CIPA congress in two sessions. In the first session, which was a breakfast session before the main event, I and as many of the UK's *epi* Council members and substitutes as were available had a meeting to answer any questions the attendees had about *epi*. I gave a short presentation and then we answered questions for about an hour. This was very successful and I would suggest that similar events could be held elsewhere.

I also took part in a session about the operation of the EPO in general and in particular oppositions and appeals. There were well over 100 people actually in the meeting, including many non-UK *epi* members.

At lunch, there was a presentation by Mr. Gowers on the report on IP he was preparing for the UK Treasury. The report has now been published. It has some parts related to patents but most of it relates to other aspects of IP. In his recent budget statement, the Chancellor (now Prime Minister) announced some measures related to the Gowers Report. CIPA is keeping a close eye on this and I will report on any developments which are of interest to *epi* members.

3rd November, 2006 – EQE Awards Ceremony

In the same evening as the CIPA Congress, the awards ceremony took place. It was very well attended and we presented certificates to a large number of successful candidates. It was very good to see successful candidates from some of the States where there have been no or very few previous successful candidates.

9th November, 2006 – STOA Meeting

This meeting was organised by a committee of the European Parliament and took place in Brussels. It was basically a fact-finding mission for the MEPs. The STOA is an organisation outside the Parliament but employed by the committee to carry out some work relating to the patent system in Europe. They made a number of studies and then invited a number of people from all sides of the patent debate. Thus, we had „greens“, the free software movement, big pharma, big electronics, SMEs, academics, lawyers, economists and patent offices giving their views on the effects of the patent system. There were not many views expressed which would have surprised anyone. The nearest to a shock was when the spokesperson for the big electronics announced that they were encouraging the use of free software and were making much of their software available to the public, except when it relates to a really valuable product.

There was a debate on governance, the upshot of which was that most people attending thought that the governance of the EPO was wrong as it was not democratic. However, there was no agreement as to who should govern the EPO.

10th November, 2006 – Labelled Members Meeting

A report on this meeting is available from Mr. Finnilä.

13th-14th November, 2006 – Quality Task Group

A report on this meeting is available from Mr. Finnilä.

16th-17th November, 2006 – Turkish Patent Institute Seminar

This was supposed to take place only in Istanbul but, because of the availability of the Turkish minister in charge of the TPI, it took place in Ankara one day and Istanbul the next day. The idea was to celebrate the

130th anniversary of the TPI. On the first day, there was a seminar on patents in Turkey and covered many topics. I gave a presentation on lessons patent offices could learn from events which happened when the TPI was founded. The meeting was very useful for what took place outside the seminar. I was able to meet with a number of heads of delegation to the Admin Council and a number of EPO staff. The second day was more concerned with counterfeiting and smuggling. According to the speakers, including one from the Commission, Turkey is the biggest source of black market goods which reach the EU.

20th November, 2006 – EPLAW

I attended the annual EPLAW meeting in Brussels. EPLAW has been set up by a group of UK solicitors and continental lawyers involved in patent litigation to support the bringing into force of EPLA. At this meeting, the keynote speaker was Lord Justice Jacob, who appeared to be in favour of suitably qualified patent attorneys having rights of audience before the EPLA.

I took part in a panel discussion on conflict of interest. I am glad I do not practice in the USA. In some States, acting when there is a conflict of interest is a criminal offence.

25th November, 2006 – CNIPA

I was invited to attend this meeting of CNIPA (an association of national associations of patent attorneys) as an observer. There were a number of topics discussed but the main one was the question of criminal sanctions for IP infringement. A paper was drafted and sent to interested parties.

I think that this is a useful meeting to attend as it enables some co-ordination, where necessary, with national organisations.

29th November, 2006 – Academy Academic Advisory Board

A report on this meeting is available from Mr. Nuss.

5th-8th December, 2006 – Administrative Council

A report on this meeting is available from Mr. Finnilä.

15th December, 2006 – CEIPI Administrative Council

A report on this meeting is available from Mr. Nuss.

19th December, 2006 – EPO/European Parliament Joint Meeting on Pharmaceutical Patents

This was another meeting in Brussels to discuss the effect of patents on the pharmaceutical sector. I was invited to attend by the President of the EPO. There was not much new said as to granting of patents and the main focus was on the effects of patents after they are granted.

There was one view that patents should not be granted at all but that inventors should only receive prizes. The question of governance of the EPO was again raised.

At both of these meetings at the European Parliament, the two most active MEPs are Sharon Bowles (UK), who is an *epi* member, and Georgi Chatzimarkakis (DE).

8th-9th January, 2007 – By-Laws Committee

I attended a meeting of the By-Laws Committee in Basel as a substitute for the English-speaking member. It was a very hard meeting. I had not realised how hard it is to come up with wording which can be translated into three languages and still have roughly the same meaning. The work is still in progress and will be reported on later.

16th January, 2007 – Quality Task Group

A report on this meeting is available from Mr. Finnilä.

25th January, 2007 – Quality Lecture to Examiners at the Hague

I gave a lecture to and then answered questions from a large group of Examiners in the Hague. Most of these examiners were from the medical devices area. The topic was quality. They asked me to ensure that all patent applications, especially those coming in from the USA and Japan, are drafted properly.

12th February, 2007 – Lecture to AMBA (Association of Members of the Boards of Appeal)

I gave a talk entitled „Whatever Happened to Inventive Step“ which was designed to provoke a discussion as to whether the Boards are relying too much on Article 123 to reject patents and applications. If this is what occurs, there is often never a discussion on inventive step. I also wanted to get their views on the question which is often raised at the Admin Council as to whether the level of inventive step is too low. There were at least 40 AMBA members present.

22nd February, 2007 – Meeting of Labelled Members

A report on this meeting is available from Mr. Finnilä.

1st -2nd March, 2007 – Board of Administrative Council

This meeting was held as part of the follow-up from the Strategy Debate and is part of the project for assessing the future workload of the EPO. The exercise had previously been carried out by the Board together with the senior management staff from the EPO. It was carried out at this meeting by the same people plus a number of „users“, including big pharma, big electronics, the EU

Commission, the free software alliance, academics, WIPO and myself. When the exercise had first been carried out, the result had shown that the EPO thought that it should be doing everything for the applicant and that there was not much reason for anyone outside a patent office to exist. When it was carried out this time, the result was that the EPO was expected to stick to its core business and let outside agencies, such as EPAs, do what they now do, only better. This exercise has been repeated again with all the members of the Admin Council present.

6th-8th March, 2007 – Administrative Council

A report on this meeting is available from Mr. Finnilä.

As they say in politics, in the margins, I had some useful discussions with EPO staff.

Mr. Finnilä and I met Mr. Machwirth of the examination secretariat regarding early registration for EQE. He raised a number of problems, which we discussed at some length but came to no conclusion. He will go away and think about it and perhaps present us with a paper. I will raise this with the EQE WG and PQC.

I also met Mrs Dybdahl. She is in the process of revising the Rules of the Disciplinary Boards of Appeal and will be contacting Mr. Rosenich in due course. She also is in a hurry to re-appoint some *epi* members to the DBA. Finally, we had a discussion about a matter which has occupied the Disciplinary Committee and which has not yet been resolved.

Finally, I met Mr. Messerli to some Appeal Board matters. These will be raised again at such informal meetings and also at the MSBA meeting.

Mr. Finnilä has for some time been discussing the facilities for patent attorneys at the EPO (especially for oral proceedings) with David Ellis, who is Assistant to the Vice-President of DG 2. In connection with this, at the AC meeting Mr. Finnilä was advised that the attorney's rooms in the Isar Building (Room 115) and in the Pschorrhöfe (Room 3473) are provided with the following facilities: access to the Internet, support for USB device reading/writing data, MS Office components installed in PCs, and local printing facilities. According to later information also the visitors' e-mail rooms in the Conference Centre in The Hague are equipped with PCs delivering the same functionality. Berlin is still under development. It is not clear whether the Adobe Acrobat Reader functions properly. Mr. Finnilä will pursue the matter.

10th March, 2007 – CNIPA Meeting

Again, I was present as an observer. The main topics of discussion were internal organisation, the expected statement from the Commission and privilege.

29th-30th March, 2007 – EU Presidency Meeting on Patents

The title of this meeting was “A Europe of Innovation – Fit for the Future?”, with the emphasis on the question mark. The event was organised by the German Federal Ministry of Justice and the Federation of German Industries.

The first session featured a talk by the German Minister of Justice, who made it clear that Germany will be pushing for reforms of the patent system during the rest of its term of presidency.

There was then a talk by Mr. McGreevy, who really just announced that the long-awaited paper will be made public on Wednesday of the next week. It will concentrate on the litigation system but will have something about the Community Patent. Most of his talk was spent urging member states to drop petty national squabbling and come to a consensus view. It appeared that there is scope for everything being optional at least to begin with, but the talk was carefully worded to give as little as possible away.

In the afternoon of the first day, there were six panel discussions on harmonisation, IPR vs Innovation, IP in Asia, SMEs and Patents, IP for New Technologies and Legal in Patent Enforcement. The panels were well stocked with some notable figures. There were generally very good discussions.

I also had a number of good discussions with various EPO and *epi* members, members of various national patent offices and members of the EU Commission.

On the morning of the second day, I met with Mrs Bowles who is keen to come to the Council meeting in October, but may not be able to do so because her main committees meet on Mondays and Tuesdays.

The day began with a talk by the President of BusinessEurope (the new name for UNICE). This was much as was expected with a plea for the signing of the London Agreement and for the EPLA. There was then a talk by Prof. Pompidou.

Finally, there was a very interesting panel discussion involving two from the European parliament, including Sharon Bowles, Mrs Brimelow, and Mr. Langfinger from BASF. The topic was “European Patent Law – Fit for Global Competition?”. There was a lot of discussion on costs. There were many more interventions about the London Agreement and EPLA. There were a few interventions to the effect that the EPO produces, and I quote, “crap”, especially in the CII field. However, these were met with many more, and some vehement, contrary views. I intervened to point out that *epi* members provide a quality service because we are properly trained, especially in drafting patent applications, and that the sooner we get the message over to Japan and the US that we can save them money by doing proper drafts for them, the better it will be for the EPO.

In amongst all this, there were again calls for an investigation into the governance of the EPO.

Mrs Brimelow was asked to sum up the session. She pointed out that many people had asked for many things

and that it was clear that it was not possible to provide swift, quality products at a low price. Her final words were to the effect that you should beware of what you ask for as you may find that you do not want it when you get it.

In the margins, I had a talk with one of the German EU Presidency officials. He assured me that Germany has agreed with Portugal (the next Presidency) that the efforts on sorting out IP in the EU will be continued and that Germany will assist the next two states in doing this. We may therefore see many more activities of this type and EU action. We will need to keep our eyes open.

18th–19th April 2007 – European Patent Forum

The labelled members were invited to the first two-day European Patent Forum held in Munich at the EPO premises on 18th–19th April 2007. The event was jointly organised by the EPO and the EC.

The first day focused on four scenarios for the future: market rules, trees of knowledge, blue skies and whose game (geopolitical approach). The introduction of these scenarios was done by way of a futuristic dance and talk show. The rest of the time was spent on breakout sessions and their conclusions.

A noteworthy feature was a forty minutes speech given by German Chancellor Angela Merkel. She gave a focused and relaxed speech on IP and especially patents in Europe. The theme was anchored in the German national sphere, where a number of measures are planned for strengthening innovation. Chancellor Merkel is also promoting IP in the G8 context.

On Wednesday evening, 18th April 2007, an award ceremony “European Inventor of the Year” was arranged. This was the second of its kind. The first one was in Brussels on 4th May 2006. Awards were given in four categories: SMEs, Industry, Non-European Countries and Lifetime Achievement.

More detailed information may be found on the EPO homepage.

20th–21st April 2007 – The CEIPI 3^e Rencontres européennes de la propriété industrielle

The main theme of this third tri-annual CEIPI colloquium was the EPC 2000. The speakers comprised a legal team from the EPO; Gert Kolle, Ingwer Koch, Robert Cramer, Eugen Stohr, Ulrich Joos and Eskil Waage. Two sessions were chaired by *epi*, (Mr. Holzer and Mr. Finnilä).

The colloquium gathered about 300 participants, one third CEIPI students and two thirds patent professionals. There were intensive discussions e.g. on the liberalised filing requirements, limitation procedures, petition for review, transitional rules especially relating to further processing and re-establishment of rights, and the practical meaning of attorney-client privilege.

2nd–4th May 2007 – EPC 2000 – Train the trainers

This event was jointly organised by the **epi** and the European Patent Academy. There were about 130 participants comprising the national trainers, CEIPI tutors and the labelled members. EPO provided a large number of speakers which were accompanied by Anette Hegner, Micaela Modiano, Francis Leyder and Derk Visser from the *epi*.

Discussions (especially on the same topics as mentioned above in connection with CEIPI) were lively, and also from time to time very heated.

The EPO gave to each participant a CD containing all the presentations made during the seminar and promised to deliver further material from this event to the participants within a delay of a couple of weeks. A package for a one day seminar in the three official languages will also be produced. The EPA will also provide speakers for some national training events.

The material may be used and modified by the participants for public events. Copies of the materials may be made and distributed to participants at national training events. EPO and *epi* logos may be used as far the contents are not changed. Translations and modifi-

cations are at the national/CEIPI trainers own responsibility (logos have to be removed). In any case translated documents should always be distributed together with the original documents.

The EPA will help with and participate in organising regional events (about 8-10), with EPO speakers, in the autumn of 2007. This are intended as a complement to the national events. This will be discussed with the PQC.

Visit to Icelandic Profession

I visited the Icelandic profession and spent a day visiting an Icelandic Pharma company, the Icelandic Patent Office and the Icelandic profession. The Icelandic profession is very keen, especially on training, and I have undertaken to see what can be done in this connection.

AIPLA – Boston

I attended the AIPLA Spring Meeting in Boston and gave a presentation on Unity of Invention before the EPO. This was well received.

Treasurer's Report

C. Quintelier (BE)

A. 2006 Accounts

The 2006 accounts have been completed by the external auditors. The meeting with the external and internal auditors took place in Munich in the presence of the secretary general and the treasurer on March 19, 2007. The final report of the external auditors was mailed to the *epi* secretariat on March 21, 2007.

The 2006 account showed the following figures:

1) In 2006 the number of *epi* members increased by 214 to a total of 8350 members who had to pay their membership fee. The late payment increment reduced by 18 %, as more members paid on time.

2) The bank interest showed a 24 % decrease with respect to 2005, and was 5 % under budget as a consequence of the lower interest rates. As the interest rates for 2007 show some increasing tendency, an improvement for this year is expected.

3) The increase in the *epi* Studentship is the consequence of the policy adopted with CPE seminars, where EQE candidates, who attended the seminars, were encouraged to enroll as an *epi* Student. In 2006 the number of *epi* students raised from 228 to 378 (65 % increase). Actually there are 411 *epi* students.

4) The CPE seminars showed a deficit of 7 652€ because by December 31, 2006 there were still some of the participants who had not paid their participation fee. An amount of 13 000€ was still unpaid and the *epi* secretariat is taking care to follow up this. Since January of this year some late payments reached the secretariat. From the income of the CPE seminars an amount of 30 000€ was withhold and accounted as an income for the *epi* secretariat (deducted from 4.4). This amount covers the costs for the personnel at the secretariat who did all the work involved with this CPE seminars. The person at the *epi* secretariat mainly involved with this CPE seminars was requested to note the time spent thereon. Based on this data a 100 hours per seminars were counted on average and an hour rate of 50€ for the costs was applied.

5) For the CEIPI/*epi* seminars 5 000€ were retained for the work performed by the *epi* secretariat and 5 000€ was paid to CEIPI for their work involved with this course. The 5 000€ retained for the *epi* secretariat was accounted in the same manner as for CPE seminars.

6) The costs for Council meetings showed a decrease over 2005 and remained under budget. This is the result of on the one hand an efficient negotiation with the

hotels and on the other hand less reimbursement costs paid. The request to take care of costs when buying airplane tickets was generally well followed and we would like to thank the Council members therefor and encourage them to continue this policy.

7) The costs for Board meetings showed a 21 % increase over 2005 and were over budget. As in 2007 a third Board meeting is foreseen it is proposed to increase the Board meeting budget by 20 000€.

8) The Committee meetings remained well under budget despite the Sofia meeting of the Disciplinary Committee which showed high costs, in particular the travel and conference room costs for this meeting were high. It is proposed to reduce the Committees' meeting budget by 20 000€ as it appears from the 2006 figures that 160 000€ would be sufficient. This 20 000€ is then used for increasing the Board meeting costs so that the overall meeting budget remains unchanged.

9) The fact that the postage costs were much less than in 2005 is explained by the absence of elections.

10) The account of 2006 shows a surplus of 207 386€, which is due to the increased number of members and to less expenses, in particular within the epi secretariat.

B. Credit card payments

For 2007 the possibility to pay the membership contribution on-line by credit card was opened. The first results show a positive response of the members.

C. EPC 2000 Seminars

In view of the entering into force of EPC 2000, *epi* will organize, in cooperation with the European Patent Academy, a series of seminars in the different Contracting States.

Three different types of courses will be organised:

1) Basic Seminar: half day course, where the most important changes will be highlighted. The course will be presented by trained patent attorneys. The target

group is Patent attorneys willing to have a short overview of the most important changes.

2) Full Seminar: 1 day; this course will be presented by trained patent attorneys and, if available, EPO members. The target group is patent attorneys and trainee patent attorneys willing to have a detailed overview of EPC 2000.

3) Extended Seminar: one additional day to the „Full Seminar“; this course will be presented by trained patent attorneys and EPO members. The target group is patent attorneys and trainee patent attorneys who not only want to have a detailed overview, but want to discuss more in depth the consequences of the changes.

During the Amsterdam Board meeting the following fees were proposed:

	<u>Rate A</u>	<u>Rate B</u>
Basic seminar (½ day)	100 EUR	50 EUR
Full seminar (1 day):	150 EUR	75 EUR
Extended seminar (2 days)	200 EUR	100 EUR

Rate A should apply to AT, BE, CH, DE; DK, ES, FI, FR, GB, IE, IS, IT, LI, LU, MC, NL, SE (17 states) and rate B to BG, CY, CZ, EE, GR, HU, LT, LV, MT, PL, PT, RO, SL, SK and TR (15 states). For *epi* students 50 % of the rate should apply.

The trained patent attorneys presenting such an EPC 2000 seminar should be remunerated. The remuneration should also cover the preparation time. Expenses incurred by the trainers presenting an EPC 2000 seminar, such as for example for travelling, if any, should be reimbursed according to *epi* rules. The four *epi* members who participated as speakers at the train the trainers meeting will also be remunerated.

As the organisation of these seminars will affect the budget, the CPE seminar budget should be revised as well from the income as from the expense side. A revised budget is annexed. On the income side an income of 400 000€ is expected, whereas on the expense side 550 000€ are expected.

Survey on the status of the Patent Profession in the EPC Contracting States

The survey published in epi Information 1/2007 (page 13 et seq.) has been updated on the *epi* website. It includes a correction of the Swiss entry.

The survey may be found at: <http://216.92.57.242/patentepi/english/300/390/>.

epi Balance Statement on 31st December 2006

Assets

	€	2005 T€
A. Fixed assets		
I. Intangible and tangible assets		
Office machines and equipment, Software	1,-	—
II. Financial assets		
Securities portfolio	1.788.814,28	1.728
	<u>1.788.815,28</u>	<u>1.728</u>
B. Receivables		
I. Others current assets	80.234,65	69
II. Bank & Cash (incl. money deposits)	638.452,58	448
	<u>2.507.502,51</u>	<u>2.245</u>

Liabilities

	€	2004 T€
A. Net assets		
as of 01.01.2006	2.034.925,68	1.856
results for the year	207.386,32	179
	<u>2.242.312,00</u>	<u>2.035</u>
as of 31.12.2006		
B. Debts		
I. Provisions	33.900,00	28
II. Liabilities		
1. Deliveries and services	39.782,34	2
2. Others	191.508,17	179
	<u>231.290,51</u>	<u>182</u>
	<u>2.507.502,51</u>	<u>2.245</u>

Corrigendum

A further decision (No. 10) was added to the draft list of decisions of the minutes of the 61st Council meeting, published in *epi* Information 4/2006, pages 113-116. The following decisions have been renumbered accordingly. This additional decision was adopted by Council at its last meeting. It reads as follows:

Beschluss 10: Der Rat beschloss, dass Herr STAUDER, der bis Ende 2006 Interimsdirektor der Internationalen Abteilung des CEIPI bleiben soll, vom *epi* für die Zeit von September bis Dezember 2006 5000 € erhalten soll.

Decision 10: Council approved that Mr. STAUDER who will remain interim Director of the International section of the CEIPI until the end of 2006 receives 5000 € from the *epi* for the period September-December 2006“.

Décision 10: Council approved that Mr. STAUDER who will remain interim Director of the International section of the CEIPI until the end of 2006 receives 5000 € from the *epi* for the period September-December 2006.

epi Expenses and Income

	Budget 2005	Actual 2005	Budget 2006	Actual 2006	Shortfall in receipts Surplus of expenditure 2006	Surplus of receipts Shortfall in expenditure 2006
	€	€	€	€	€	€
I. Receipts/Income						
1. from Members						
a. Subscriptions	1.200.000, –	1.220.400, –	1.207.500, –	1.252.500, –	–, –	45.000, –
b. Late payment increment	20.000, –	10.700, –	20.000, –	8.775, –	11.225, –	–, –
c. Abandonment of unpaid subscriptions (incl. subscriptions now recovered)	./.	./.	./.	./.	–, –	6.531,50
2. Interests	75.000, –	68.820,30	55.607, –	53.325,06	2.281,94	–, –
3. CPE-Seminars	10.000, –	5.830, –	25.000, –	93.306,64	–, –	68.306,64
4. CEIPI	31.500, –	92.653,50	63.000, –	54.000, –	9.000, –	–, –
5. Others	27.500, –	34.050,12	25.050, –	37.018,92	–, –	11.968,92
	<u>1.272.000, –</u>	<u>1.396.128,93</u>	<u>1.352.157, –</u>	<u>1.461.457,12</u>	<u>22.506,94</u>	<u>131.807,06</u>
II. Expenses						
1. Meetings						
Council	290.000, –	300.317,35	300.000, –	290.954,59	–, –	9.045,41
Board	48.000, –	54.421,55	49.000, –	65.790,32	16.790,32	–, –
Committees	168.000, –	138.900,80	173.000, –	120.203,04	–, –	52.796,96
Delegates & Others	44.000, –	35.301,71	46.000, –	26.635,13	–, –	19.364,87
2. Other performances						
epi Information	76.000, –	71.466,95	76.000, –	73.917,57	–, –	2.082,43
By-Laws & non-foreseeable	1.000, –	–, –	1.000, –	–, –	–, –	1.000, –
Promotional Activities (incl. epi-Brochure)	27.000, –	12.345,93	22.000, –	16.003,60	–, –	5.996,40
CPE-Seminars	10.000, –	200, –	10.000, –	95.957,56	85.957,56	–, –
CEIPI	31.500, –	65.233,50	70.000, –	69.143,24	–, –	856,76
Examination Committee Dinner	3.000, –	3.845,95	5.000, –	1.618,28	–, –	3.381,72
3. President (+ Vice President)	27.000, –	25.243,53	28.000, –	17.389,29	–, –	10.610,71
4. Treasurer and Treasury						
Treasurer and Deputy	5.000, –	4.884,48	5.500, –	5.294,76	–, –	205,24
Bookkeeping / Audit	20.000, –	20.588,56	20.000, –	20.522,73	522,73	–, –
Bank charges	17.000, –	8.435,54	17.000, –	8.596,85	–, –	8.403,15
5. Secretariat						
Expenditure on personnel	306.000, –	296.061,62	326.000, –	293.405,10	–, –	32.594,90
Expenditure on materials						
Rent	86.710, –	87.599,89	88.880, –	86.265,24	–, –	2.614,76
Phone, Fax, e-mail	9.000, –	5.585,26	8.000, –	4.793,51	–, –	3.206,49
Postage	30.000, –	35.491,29	30.000, –	16.265,86	–, –	13.734,14
Office supplies/Representation	13.000, –	13.568,17	13.000, –	14.007,61	1.007,61	–, –
Maintenance/Repair (incl. Copy, print)	15.000, –	16.797,15	12.500, –	16.045,14	3.545,14	–, –
Insurances	1.000, –	529,30	1.000, –	1.043,72	43,72	–, –
Secretary General and Deputy	5.000, –	3.851,49	5.500, –	5.251,92	–, –	248,08
Travel personnel	1.000, –	540, –	1.100, –	542,50	–, –	557,50
Training	1.000, –	774,90	1.100, –	–, –	–, –	1.100, –
Acquisitions						
Office machines incl. Soft-/Hardware	6.000, –	3.923,07	6.000, –	819,15	–, –	25.180,85
Office equipment	25.000, –	10.569,38	25.000, –	–, –	–, –	25.000, –
6. Extraordinary expenses	–, –	179,61	–, –	3.604,09	3.604,09	–, –
	<u>1.266.210, –</u>	<u>1.216.656,98</u>	<u>1.340.580, –</u>	<u>1.254.070,80</u>	<u>111.471,17</u>	<u>197.980,37</u>
III. Surplus of receipts/ expenses	<u>5.790, –</u>	<u>179.471,95</u>	<u>11.577, –</u>	<u>207.386,32</u>	<u>Surplus:</u>	<u>195.809,32</u>

Report of the Committee on Biotechnological Inventions

A.De Clercq (BE)
Chairperson

1. Committee Meeting December 5th, 2006

The following matters were discussed at this meeting:

(i) EPC Revision

The committee was asked at a late stage to comment on new proposed Rule 30 under EPC 2000. Members' comments were passed on to the EPPC. The Administrative Council was thought unlikely to finalise all the Rules at their meeting (the week of committee meeting), and so will need yet another meeting, so perhaps there is a last opportunity for us (in fact, on the contrary, the Rules were finalized by the AC). An update will be sought from EPPC Liaison Officer (Mrs Leissler-Gerstl). (*Very recently EPPC has requested us to prepare a position paper on this issue. We are working further on this paper with EPPC.*)

(ii) Implementation of EU Directive on biotechnological inventions

The status of the implementation and more particularly the countries with deviations were discussed at the meeting. The FR and DE members were requested to provide a report on the implementation of EU Biotech Directive, and perhaps other countries with deviation (IT and CH?). A short paper on law, practice/advice, court cases, etc., that could be expanded to all countries, including a section where the Directive was implemented without changes is in preparation. For DE the national law implementing Directive only seems to apply to national, and not EP, patents. For DE the advice is do not file a national case! Law seems to require disclosure of function. This overview paper will be presented to EPPC and will eventually be presented to all *epi* members to inform them of the deviations in the implementation in some countries.

(iii) EPO practice

(iii-1) Function

An important issue when claiming a new gene or protein in biotech patents is plausible (rather than credible, as previously) function. Note the article on this issue by H-R Jaenichen in the *epi* Journal earlier this year. T1329/04 has been widely criticised by *epi* members working in the field of biotech. The decision disallowed post-filing evidence of function.

Other recent decisions on this issue included T293/04 and T1336/04, both by the board 3.3.8, which could be used to support plausibility (against T1329/04).

T669/04 (MIT) said post-filed evidence may be acceptable under Articles 83 and 84 EPC (see reasons, paragraph 15). T898/05 is encouraging as it also allowed post-filing evidence.

It was noted that different Boards can take different lines, and that even the same Board can seem to differ in their case law, and do not always follow precedents. So this issue may be becoming less predictable: it seems to be decided more on a case by case basis. There seem to be no general rules and it is difficult to advise clients.

The case law is of course still very much in development.

Developing case law now uses also Article 57. Practical exploitation must be profitable (T898/05), this Board giving „profit“ a very broad interpretation. The Boards seem to want applicants not to be too speculative.

A crucial issue here is under which Article the credible/plausible function is raised; perhaps there should be different standards for function under the different Articles?

(iii-2) Morality/Article 53a

Decision (T866/01) on euthanasia was allowed but questioned whether exceptions to patentability should still be construed narrowly; the claims were limited to 'lower mammals'.

(iii-3) Other case law

T189/01 (Yeda) concerned the meaning of 'specific' in relation to binding of antibodies, and suggested that 'specifically binding' is inherent in claims directed to antibodies. The issue was discussed before at the previous *epi*/DG2 meeting. The EPO will object under novelty if prior art antigens are similar to antigens of the invention and the only way to test if new antibody will bind to old antigen is to conduct a cross-reactivity test.

T1300/05 (Board 338) is a recent decision on Articles 83 and 84 relating to antibodies (inhibiting fusion of HIV to CD4 cells) where claims broader than the Abs themselves were allowed on appeal from Examining Division.

(iii-4) Diagnostic Methods

T1197/02 and T143/04 (3.2.02, both mechanical Boards) have now been decided since G1/04. The division of a claimed method into the 4 steps can be quite difficult, as is whether a particular step/feature is essential.

(iii-5) Moral Issues

Stem cell (WARF) case G2/06: 162 briefs were filed, including submissions from the President (on invitation from the Enlarged Board, under Article 11a of the Rules of Procedure). Cases will not now be stayed unless Applicant so requests. Apparently EPO now thinks that there is no legal basis for it staying cases on its own motion.

(iii-6) Essentially Biological Processes

T83/05 (Board 3.3.4) will refer a question to the Enlarged Board under Art. 53b, concerning „essentially biological processes“ (EP 99915886.8, Plant Bioscience Limited).

(iii-7) Sufficiency

Post-published evidence is usually acceptable (but note T609/02, with reach through-claims, which failed due to not defining medical condition properly and so the Board did not consider the inherent allowability of reach through-claims).

Other recent decisions are: T994/05, T957/03, T792/00 and T946/02.

In T58/05 (a product defined for use in organ therapy) the Board avoided construing a claim, and so whether its scope was restricted to the purpose given, but punished the applicant for speculating on the purpose as it was not plausible.

(iii-8) Divisionals

Amicus curiae briefs were discussed and awaiting the decision of the Enlarged Board.

(iv) Next Committee meeting

Is being scheduled for October 23, 2007 (just after the next Council meeting).

2. Meeting with EPO Biotech Directors on December 6th, 2006

The items on the agenda which were discussed are:

1. Stem cells – G2/06
2. Function of genes and proteins – including discussion on T 604/04, T 1329/04, T 898/05, etc.
3. Summons to Oral Proceedings
4. Diagnostic methods – G1/04
5. Divisional applications

6. Pathway claims – „Use of an antagonist to receptor X in the manufacture of a medicament for the treatment of disease Y.“
7. Three dimensional structure claims – „Use of a compound which binds to receptor X pocket Z defined by amino acids XaaXaaXaa ... in the manufacture of a medicament for treating disease Y“
8. Rule 51(4) Procedure: Amendments by Examiners and situations in which translations of claims need not be filed
9. Timeliness – point raised by EPO

Minutes of this meeting are presently being reviewed by the EPO and will be published together with the minutes of the previous meeting in epi information. Mrs. G. Leissler-Gerstl of the EPPC joined this meeting as our liaison person with EPPC.

The next meeting with the EPO directors has been suggested to be on October 24, 2007.

3. Additional discussion items of the Committee after the Committee meeting

Our Committee has been corresponding about the issues concerned with disclosed and undisclosed disclaimers. A position paper has been requested by EPPC.

Our Committee is also preparing a position paper for EPPC as mentioned under 1(i) on R. 30 EPC2000 and will send a report to EPPC summarizing the deviations in the implementation of the EU biotech Directive in certain countries as mentioned under 1(ii).

There is a new referral in T 992/03 – 3.4.01 (Methods for treatment by surgery) to the Enlarged Board of Appeal, pending under Ref. N° G 1/07. We expect that our Committee will also comment on this in the near future.

Report of the Editorial Committee

1. The Editorial Committee did not meet in person since the last Council meeting. The deliberations took place by email. The next annual meeting is scheduled for July 2007.

Any input from Council members as to the structure and contents of the epi Information and the website are welcome.

2. The Editorial Committee had extensive discussion with the Datenwerk group concerning the improvement of the epi website.

3. The website of the epi has been enlarged and amended, and appears to be in good shape.

The latest adaptation was the instalment of a search index. Documents can be searched as PDF documents and as to the content of the texts.

<http://216.92.57.242/patentepi/english/>

For example: Search for payment:

<http://216.92.57.242/patentepi/english/search/list.php?query=payment&submit=search>

Search only text-documents:

<http://216.92.57.242/patentepi/english/search/list.php?query=payment%20swishdocpath=>

The other language versions are analogous.

4. The publication of the status of the patent profession in the different Member States is not without complication, and it is due to the diligent work of Kim Finnillä who put the survey together. Although Mr. Finnillä

with the help of the Committee tried to bring it to the final status, it nevertheless turned out that the update was not complete, as for example the Swiss entry was not totally correct. This has now been corrected on the website, and a notice is published in this issue of *epi* Information to this effect. The Editorial Committee urges the Board and Council members to bring to the attention of the Committee any changes and amendments. These

can be readily included in the internet version of the survey.

5. Further attempts concerning a relaunch of the *epi* Information cover have not been made by the Committee so far. The Committee awaits an input from the Secretary General.

6. The Editorial Committee would be happy to receive more contributions for publication from the members, in particular for themed editions.

Report of the European Patent Practice Committee (EPPC)

E. Lyndon-Stanford (GB)
Chairperson

The Terms of Reference of the EPPC

Council has amended the terms of reference to exclude any questions which fall within the terms of reference of the On-line Communications Committee (the OCC). As in the field of biotechnology, the EPPC would still collaborate with and assist the OCC to whatever extent is required.

Council discussed whether there should be some change in the terms of reference of the EPPC and of the Harmonisation Committee. The tentative conclusion was that no change should be made to the Harmonisation Committee but that two committees could be divided out of the EPPC, namely a litigation committee and a documentation committee. This will be further discussed at the next Council meeting.

EPPC Meetings

There was a meeting on 19th April. All items of substance are referred to below. The next EPPC meeting will be on 9th October 2007.

The EPC 2000 Implementing Regulations

A Sub-Committee under Mr. Francis Leyder will be looking at the amended Implementing Regulations in order to advise which Rules should be considered for (further) amendment, including Rule 71 (old Rule 51, the grant procedure). It is proposed to defer requesting any amendments until the year 2008

The EPC 2000 Examination Guidelines

A Sub-Committee under Mrs. Anette Hegner reviewed the English version of the new Guidelines and proposed many amendments and discussed them with the EPO. The English version has now been published. The published English version has still to be reviewed in detail as must be the French and German versions when they are made available.

The EPO is proposing to review the Guidelines in the future on a continuous basis and is also proposing the

formation of a standing EPO/*epi* Guidelines Sub-Committee.

The Liaison Sub-Committee

The Liaison Sub-Committee is dealing with many issues raised by *epi* members and others. The issues include: summons to oral proceedings and setting and changing dates; cancellation of oral proceedings by the Examining Division at very short notice; premature summons to oral proceedings; inadequate facilities in the attorneys' rooms, used when attending oral proceedings; double patenting; maintaining the confidentiality of confidential documents filed at the EPO; new Rule 164 (having to file a divisional in order to obtain the search of a second set of claims); mail stamped with the wrong date when delivered to the night mailbox in The Hague; problems when down-loading from the EPO electronic register; not achieving the intended time frame when proceeding under PACE; differing quality of search reports; the Paris criteria (the intergovernmental agreement in June 1999 that European patent applications should be granted within three years of filing at the EPO); translations of cited Japanese documents; correcting deficiencies in drawings; level of inventive step; the British Intellectual Property Office Code of Conduct for applicants; the proposed EPO evaluation of the quality of examination for a sample of granted patents. Some of these issues were discussed at a meeting with the EPO Vice-President and others were discussed at the Partnership for Quality meetings; further issues will be discussed at the forthcoming MSBA and SACEPO meetings. The other issues below should also be noted.

The Paris Criteria

The EPPC presented a draft position paper to Council, discussing the three year grant period agreed by the inter-governmental conference and a flexible three to five year period, and also proposing measures which

could be adopted by the EPO to speed up grant. Regarding the period, there was no consensus in Council. Council instructed the EPPC to re-present the paper, merely as a proposal for the speeding up measures.

The Partnership for Quality

The second Partnership for Quality meeting was held on 12th October 2006 and the third on 30th March 2007. These are relatively informal meetings, concentrating on various aspects of quality such as for instance searching and Examiners' review of claims for added subject matter. Regarding a proposed EPO evaluation of the quality of examination for a sample of granted patents, Council agreed that *epi* members could participate under strict conditions, including confidentiality.

The UK PO (now UKIPO) consultation on the inventive step requirement in United Kingdom patent law and practice

The EPPC will up-date for Council the *epi* submission to the UK PO consultancy.

The Problem and Solution Approach

The EPPC will submit to Council a draft *epi* position paper on this subject. The EPPC also proposes to draft a letter (to those responsible for training the EPO examiners and those responsible for training EPA's) recommending a way of teaching how to judge inventive level.

Sleeping Patent Applications (patent applications on which there have been no Office communications for a long time) – note, these are not „sleeping patents“

The EPPC will agree a discussion paper for Council.

Sleeping Patents

A draft EPPC paper was presented to Council but Council did not see the strategic need for the paper at the present time. The draft paper concluded that existing compulsory licence provisions were sufficient to address any problems.

Disclosed and undisclosed disclaimers (adding disclaimers to claims)

The EPPC will agree a discussion paper for Council, in collaboration with the Biotech Committee.

Double patenting (claims having the same scope in two different applications)

The EPPC will review this question and report to Council.

Holding oral proceedings only in one place

The EPPC will agree a discussion paper for Council.

Recording and Minutes of Board of Appeal Oral Proceedings

An EPPC position paper was approved by Council, subject to a minor amendment. The paper suggests that minutes of such oral proceedings, including any procedural objections raised, should be drafted in an extensive and detailed manner. The paper also suggests that such oral proceedings should be recorded by electronic means or by transcript.

Late-Filed Documents and Auxiliary Requests in Proceedings before the Boards of Appeal

A personal paper in the name of Mrs. Leißler-Gerstl has been filed for discussion at the MSBA. The paper argues for consistent rules that provide a fair balance between the interests of the parties. The paper will later be debated by the EPPC.

Setting and Changing Dates for Oral Proceedings

A personal paper in the name of Mrs. Leißler-Gerstl has been filed for discussion at the MSBA. The paper argues for proposing a date at least six months ahead and giving all parties the opportunity to object, but once a date has been agreed it can then only be changed in exceptional circumstances like the serious illness or death of the representative. The paper will later be debated by the EPPC.

How Confidential Documents should be handled by the EPO

Council approved a draft EPPC paper. The paper notes that the state of the art cannot be confidential. However, it suggests that there should be some provision for an edited or amended version of a state of the art document to be placed on file, with appropriate provisions to prevent deception.

The EPLA

There have been no further meetings of the working party. In March 2007, the Commission published a Communication on the Future of Patents in Europe and gave the most recent Commission view on the EPLA, amongst other statements. Subject to amending some passages, Council indicated approval of an *epi* position paper giving general support to the Commission's compromise, namely combining features of both the EPLA and a Community jurisdiction. However, the paper states that there should be both legally qualified judges and technically qualified judges, and that there should be no obligation on states to adhere. The paper will be amended and brought back to Council for formal approval.

Representation before EPLA Courts

The EPPC will present to the next Council meeting a paper which will discuss four alternatives, namely that the *epi* should:

- not lobby at all so as not to disturb what has been achieved in the draft EPLA Court Statute; or
- lobby for full representation by all EPA's; or
- lobby for full representation by EPA's having an extra qualification; or
- lobby for the obligation of representation by an EPA in addition to the European patent counsel.

Draft EU Directive on Criminal Measures

Council adopted (with an amendment) a position paper drafted by the EPPC. The paper states that all IPRs other than copyright, trade marks and know-how should be removed from the ambit of the Directive. The European Parliament has formally voted to remove just patents.

PCT Electronic Document Exchange System

Defects noted in the proposed system have been drawn to the attention of the EPO.

Draft amended PCT Receiving Office Guidelines

The final version has been published. With certain receiving offices (not all), applicants may have problems that they would not have had had they filed the application direct with WIPO. There will be no obligation on the receiving office to transfer the application to WIPO.

PCT Reform meeting, Geneva, 23rd to 27th April 2007.

It is reported that little progress was made.

Supplementary International Searches

The proposal is to introduce a supplementary PCT search so that the first search and the supplementary search are both available before the end of the international phase. The EPPC has indicated its approval to WIPO.

The Trilateral (EP, US, JP) Proposals – Trilateral Standard Format Pilot Project (TSFPP)

This is at an investigatory stage. The idea is that EP, US and JP specifications should be written in the same format.

The Utilisation Pilot Project (UPP) (collaboration in searching and examination between various European national patent offices)

The intention is that the EPO should be able to use the results of any examination carried out by European national offices, where priority has been claimed from a national application. There is no action to be taken.

Translating Chinese Patent Documents

The EPO hopes to load a complete image collection of Chinese patent documents, with the corresponding bibliographic information. The EPO wishes to negotiate the use of a machine translation tool developed by the Chinese patent office. Meanwhile it is expected that manual translations of cited passages would be available.

A-Publications of Applications filed without claims

It was reported from the March 2007 SACEPO/PDI meeting that if necessary publication would be delayed until the claims could be included.

Epoline – Access to Unpublished Files, and Smart Cards

Council approved a letter requesting that applicants be given access to unpublished files, and that Smart Cards should be de-activated if not used for a period of six months. The letter will be sent by the Chairman of the OCC to the EPO online team.

Report of the On-line Communications Committee (OCC)

R. Burt (GB)
Chairperson

The On-line Communications Committee (OCC) has been reformed and includes the following members:

Roger Burt (GB) (Chairman)
Debra Smith (GB)
Kurt Stocker (DE)
Luciano Bosotti (IT)
Antero Virkkala (FI) (Secretary)
Johan van der Veer (NL)
Jean-Robert Callon de Lamark (FR)
Peter Indahl (DK) (EPPC Liaison member)

The members have been selected on the basis of their experience with using the EPO's on-line filing systems.

One teleconference has been held between the members of the Committee and one teleconference has been held with the EPO team lead by Mr Guillaume Minnoye.

At the conference call with the EPO on 11 April 2007, we were invited as a committee to a meeting with the EPO epoline group in The Hague on 6 September 2007.

The proposed timing for the meeting is to enable discussion when the EPO has completed more work on their end to end electronic processing project (see below).

Update on the EPO systems:

The PatXML system has not been taken up to a sufficient extent to warrant further investment by the EPO. The system will be continued in order to support those Applicants currently using it and corrective maintenance and support will continue for current users. The system has been used extensively by one of the OCC members and is recommended for use when drafting the application directly in PatXML; conversion from other word processing systems into PatXML cannot be recommended. The fee reduction for PatXML will continue.

The EPO would like to encourage 100 % usage of electronic patent application filing; currently 40 % of applications are filed electronically and the EPO hopes

this will increase to almost 60 % by the end of 2007. Most of the applications filed electronically are filed using the pdf system and few problems are now recorded. The EPO receives the pdf copies of the applications and has an OCR system which converts the filed documents to XML to facilitate processing within the EPO. XML is still the favoured standard for filings because it is a text based system and more useful to the EPO than the image based pdf system.

The EPO is currently working on a full end to end process for electronic communication with the Applicants and their attorneys. The intention is for full electronic communication within the EPO and two way communication with Applicants/attorneys. An update on the EPO's system will be given at the EPO/OCC

meeting in September as mentioned above. The existing „Mailbox“ is considered by the EPO to be an integral part of the two way communication project and will be a focus for further technical and legal analysis by the EPO.

The EPO wishes to encourage all Applicants to use the electronic filing system to file subsequently filed documents even for those applications which were originally filed by hand or by post. The use for subsequently filed documents is considered to be very safe and convenient and can be recommended.

The EPO advised that electronic filing of appeal and opposition documents is not currently possible and will probably not be available until mid-2008. Filing opposition or appeal documents electronically will lead to a loss of rights.

Report of the Professional Qualification Committee (PQC)

S. Kaminski (LI)
Chairperson

PQC meeting

Since the last Council meeting in Istanbul, PQC has met on January 22/23, and on May 11, 2007, in Munich. The first meeting was combined with the regular bi-annual Joint Meeting with the Examination Board.

Annual Tutors' Meeting 2006

It took place in London and was combined with the Award Ceremony. To overcome the problems which showed up in the Strasbourg meeting in 2005, a 2-day meeting was organized. Unfortunately, the number of tutors attending the meeting was significantly smaller than in Strasbourg. As the new organization of the Tutors' Meeting concerns CEIPI tutors as well as *epi* tutors, many of the attending tutors were also tutors of basic CEIPI courses. The consequence was that only a limited number of tutors had studied the EQE papers in detail. Even if sufficient time was given to discuss all papers in detail, some of the *epi* tutors would have preferred the „old system“ enabling them to exchange specific *epi* tutorial problems and to get advice from their colleagues (see under point „*epi* Tutorials“ below).

EPC 2000

As *epi* president Chris Mercer already presented in his report, the trainers' seminar took place in Munich on May 2-4, 2007. Delegates from the Member States (the so-called trainers) and *epi* tutors as well as CEIPI tutors (the latter invited by the Academy) attended this sem-

inar. The seminar was very successful and well received. However, it made clear that there are still many open questions and in daily use the changes to the EPC will have to be applied very carefully. The organization by the Academy was very efficient, the contributions from the side of the EPO were accepted differently as some of the participants felt that some/few of the speakers are not really familiar with daily patent work and therefore, did actually not realize the implication of the new EPC on it. The speakers from the *epi* did a very good job, not only in their presentation, but also in pointing out weak points. PQC sent a thank you letter to all *epi* speakers for their valuable contributions and to the Academy for the well-received organization. Also, thanks were expressed to Martina Fromm from the *epi* Secretariat for the excellent organization.

National follow-up seminars are already in preparation and several dates already fixed. The *epi* Secretariat should be informed as soon as possible of the dates of further national seminars in order to put them on the calendar on the *epi* website.

We were overwhelmed by the unexpected immediate reaction from our national members.

Teaching material was and will be distributed to all attendants of the Train the Trainers seminar. This material may only be used for seminars registered with the *epi* Secretariat and therefore known by the Academy. No use for personal teaching purposes is allowed.

For the planned regional seminars, the Academy requested PQC to propose possible combinations of countries. The Academy is willing to take part in those seminars if a break-even point of at least 100 participants

is reached. PQC discussed this matter and information letters are to be sent to the Board members to give them an idea of possible combinations and to put them in the position to discuss this with the respective Council members. The PQC proposal is, of course, only a preliminary approach to this matter. Other combinations are certainly possible. This has to be dealt with and decided as soon as possible. Please be aware that the Academy can and will only help in case of an *early* request for help. Also, in case the number of 100 participants cannot be reached, PQC/*epi* Secretariat will still try to get help from the Academy.

Information on the follow-up seminars is given on the *epi* home-page. If you need further information/help please contact Mrs. Martina Fromm from the *epi* secretariat.

CPE Seminars

There was only one seminar (apart from the seminars in connection with EPC 2000) given, namely on the PCT in Bratislava on April 19/20, 2007. Attendants from Slovakia, Hungary, the Czech Republic, Austria, Poland, Latvia and Rumania were present.

For the time being there seems to be no need for drawing up CPEs with new contents. We can now use the already well-introduced CPE-seminars, and may reconsider it next year.

epi Tutorials

When looking at the numbers of candidates and tutors over the last years, a tendency of stagnation and even decrease has to be noted. Furthermore, we would like to remind you of the initial intention to give especially candidates from new countries the opportunity to get help with their preparation for the EQE. It must be admitted that this goal is far from being achieved. Most of the candidates come from so-called „old“ member states. Over the years quite a lot of other opportunities for preparation were established. However, it is felt that none of them provides an individual training specific to an individual candidate's need. This is even less true for resitters.

As the time limit for enrolling for this year's summer tutorial will not expire until July, we thought it useful to immediately send a short e-mail letter to all *epi* members reminding them of the opportunity for candidates to make use of the *epi*-tutorials.

Academy/CEIPI/*epi*

The so-called Memorandum of Understanding regarding cooperation between these institutions is nearly ready for signature. The principles for activities initiated in the name of the Academy/CEIPI/*epi* were agreed on and – as far as common programs of the Academy/*epi* are concerned – new programs are being made following this agreement. A first plan for educational matters has been

drafted. It works quite well. The Academy, for instance, helped as a trouble-shooter with one of our CPE seminars, whereas we (PQC/*epi*) helped when we were requested to assist with the on-line EQE-forum and with drafting a new concept for a seminar on opposition and appeal proceedings. In this context the „Train the Trainers“ seminar is a good and successful example. Only one thing to be improved is to get good feedback from the Academy.

The establishment of a study-fund for young grandfathers from the new countries still has to be made. We do not know if the list containing names of young grandfathers willing to be educated to become national tutors and then acting as coordinators for the education in their countries was made by the national bodies and the industry as well as by the national patent office of certain countries.

Working Party on REE:

This party is rather sleepy or even dead; in any case it is not working. However, there is evidently a strong wish not to delay the efforts already made. For instance, early registration should be installed as soon as possible, this especially with regard to the possibility to contact candidates early to offer help and information right from the beginning.

Proposal to the Council for introduction of a new staff function

Education is becoming more and more manifold and has to cover a wide variety of topics and needs (*epi*-tutorials, CPE seminars, coordination with the Academy, old and young grandfather programs, integrating new countries and countries to become new member states in the educational system and encouraging them to take part in this system, creating a teaching pool, requesting feed-back and taking care of the result). The organisation – even if performed diligently by the *epi* Secretariat – is sometimes not manageable and needs to be reviewed or changed. We are of the opinion that someone should act as a kind of supervisor for education, being in contact with and reporting to PQC, the *epi*-president, the treasurer and the *epi* Secretariat. Such a person has to be an *epi*-member, well-informed in all fields of education, familiar in dealing with and solving organizational as well as objective problems. It was felt that a person entrusted with such a task would have to be free to work at least one day a week, he/she should be invited to all Board and Council meetings and even a possible remuneration could be considered. Please be aware that we want to keep the control on the education of our members (candidates, grandfathers and well-installed *epi*-members).

Council is requested to consider the above. In case of approval, PQC would work on a detailed list of tasks to enable to Council to make a decision at the next Council meeting.

Divisionals – a continuing problem

David Harrison (GB)

It has recently become quite a common practice for practitioners to file a precautionary divisional from an application which is getting into serious trouble, no doubt with the idea of having another attempt at successful prosecution. Such divisionals are usually an exact copy of the parent as that was filed; indeed such is the uncertainty regarding what is permissible in a divisional until the Enlarged Board has spoken on G1/05, 1/06 and 3/06, that many „ordinary“ divisionals are filed with subject-matter identical to that in the parent, though the order of claims in these may be different.

In a recent decision an Examining Division („ED“) of the EPO has refused a „precautionary“ divisional application 04 104 919.8 for, essentially, abuse of procedure.

The application in question („‘919“) had been filed three days before oral proceedings were due on its parent, the ED having signalled in an earlier communication their provisional opinion that the parent application would be refused for lack of invention. As filed ‘919 had additional claims but was otherwise identical to the parent as filed. The day after filing ‘919 the parent was withdrawn, so that there were no oral proceedings on it. After a first official action on ‘919 which outlined the objections that the ED had, the applicant filed new claims. Oral proceedings on ‘919 were appointed but were not attended by the applicant.

In its decision the ED appealed to the „generally recognized principle“ enunciated in T 720/02 (and its twin T 797/02) that as soon as possible the public should have a fair knowledge of the extent of the exclusive rights sought by the applicant. This statement of general principle has met with a degree of cynicism from practitioners accustomed to the delays of the EPO, but even taken at face value is not of great assistance because, as has been pointed out in T 1409/05, there are great uncertainties inherent in the whole of the application process. Third parties are at no greater disadvantage in assessing a divisional application than they are in assessing any other; their safeguard (in all applications) being that the scope of protection eventually achieved is no greater than that justified by the original disclosure. Decision T 720/02 was also dealing with a factual situation very different from the present one; there, the question was whether the applicant could in a second-generation divisional claim matter not claimed in its immediate parent.

Basing themselves on T 720/02 and on a remark in T 1409/05 at Reasons 3.1.9 that the filing of cascading divisionals might be an abuse of procedure, the ED found that the applicant’s motivation was to defer an unfavourable decision, this was abusive, ‘919 did not therefore have divisional status and was anticipated by the parent.

However much one may sympathise with the exasperation of the ED there is, to put it mildly, much to criticise in this decision. Most fundamental perhaps is the fact that

the purpose of examination in the EPO is to determine whether the application „meets the requirements of this Convention“, not whether the ED approves of the tactics adopted by the applicant. Furthermore, „abuse of procedure“ is not a ground of refusal and for it to be so would be to contravene A 52(1) EPC, as indeed the Board in T 1409/05 appeared to recognize later in 3.1.9, remarking that there was a clear legislative intention to allow filing from „any“ pending application. The question of „cascading“, of course, is not in issue here.

But there are somewhat larger issues, which can be better discussed with reference to another application in which the ED is taking a similar line. This is application 05 019 453.9 („‘453“).

It must be emphasized that no decision has been reached in this case, but the questions which may arise generally can be seen in a communication from the ED dated 10/08/06.

This also is a divisional application; again it was filed shortly before oral proceedings were to be held on its parent, and again the parent was immediately withdrawn so that those oral proceedings did not take place.

The communication does not this time allege abuse of procedure, at least not directly, although it refers to T 720/02. Rather, it makes the argument that „division“ in A 76 EPC inherently, as a word, requires that what is divided out is less than the whole. It would then follow that since ‘453 is identical with the parent as filed it cannot meet the requirement of A 76, is not a divisional, and is anticipated by the parent. The alleged vice is therefore clearly the act of filing something identical with the parent as that was filed, not the filing of something which is identical to the parent when abandoned, nor amending the divisional to become so identical. And note that ‘919 when filed was not identical to the parent but contained additional claims (no objection was raised that there was added subject-matter), and was further amended before the decision was taken.

Of course the practitioner immediately asks „Well, what if I omit one word, one sentence, one paragraph, one claim, one Figure ...?“ ; is that still „identical“? And a divisional which contains all the subject-matter of the parent and all its claims, but in a different order, is that „identical“?

But it is more interesting, and appears possible, to deal with the situation on its own terms.

In its communication in ‘453 the ED refers to A 4G of the Paris Convention („PC“), where the word used is „division“. In A 4G1 what results may be „a certain number of divisional applications“ (emphasis added). This would imply that each was in some way less than the whole (at least if the parent were counted as one of the divisionals), and that would be logical. But A 4G1 PC deals with an application which is found in examination

to be "*complexe*" – rendered inadequately in the English translation as „containing more than one invention" – and here we are dealing with a voluntary divisional, as provided for in A 4G2 PC. There is no such plural in A 4G2; also Bodenhausen in his commentary on the PC says, at e), second sentence, "*La disposition est large: elle comprend la division des demandes de brevet pour des raisons autre que la complexité ou l'absence d'unité d'invention.....*" with a footnote referring to the record of the Lisbon Conference (at which A 4G2 was introduced into the PC) pp 503/504. So the PC does not reinforce or clarify the word "division", in the present situation, in the way that the communication supposes. Anyway, the EPC is a self-contained document.

Perhaps surprisingly the issues appear never to have been fully dealt with by a Board of Appeal. In T 441/92 there was a refusal by an ED of an identical divisional on the ground of double-patenting. This was overturned almost without discussion by the Board; double patenting could not arise because the parent had been abandoned! In T 587/98 a divisional was not rejected for claiming more widely than its parent; by implication this would answer the ED's assertion in '919 that the divisional must relate to less than the parent.

Will we get any help from the Enlarged Board when it issues its opinion in the consolidated G 1/05, 1/06 and 3/06? Probably not, since the questions there are almost all concerned with allegedly added subject-matter, which is the opposite of what we have here. But one of the issues there is whether a divisional could be in some way invalid or void if it were to offend against the provisions of A 76(1) EPC, or be considered not to be a divisional, in the way the ED has done in '919 and is suggesting may be the case in '453.

It seems highly unlikely that the Enlarged Board will come to any such conclusion. As to the first part, once an application has satisfied the requirements of A 80 EPC it has a filing date even if no fees are paid and it never proceeds further. There is no obvious mechanism for declaring an application to be *ab initio* void. If such an action were nevertheless found to be possible (see below), a refund of all fees paid would be involved; a move unpopular with the EPO when in nearly all cases the issue will arise only in substantive examination or opposition – and to make matters worse the latter might

incur the refunding of opposition fees and of national renewal fees paid on a non-existent patent!

As to the second part, there seems equally no explicit provision in the EPC for a change of status of an application, nor is there any explicit provision (except in the special case of R 43 EPC) for post-dating, which is effectively what would be involved. Furthermore, the Request form at section 35 makes the statement „This is a divisional application" which is completed by the insertion of the parent number. It appears that at that stage the applicant is making a non-negotiable demand – a divisional or nothing. Presumably the applicant could subsequently alter his position and accept non-divisional status, but in many cases, as here, this would result in total anticipation. If he refused to do so there would appear to be an impasse unless the „or nothing" were taken to be an opportunity for voiding the application totally, with the interesting consequences outlined above.

In view of all this it appears that the word „division(al)" cannot be held necessarily to imply „separation into parts" or even „producing something less than the whole" (leaving aside how much less) but rather must be taken to be signalling an application which if filed fulfilling certain conditions has special priority provisions – A 4 PC is, after all, the Article dealing with priority.

What it amounts to, therefore, is a situation where the EPO has to tolerate something that at least some of its Examiners may feel to be abusive, simply because there appears to be no legal framework for preventing the filing of „precautionary" divisionals or of disposing of them summarily once filed. The ED decision, even if supported by a Board of Appeal, would still leave the question of identity up in the air, since '919 was not identical to its parent either when filed or at the time of the decision.

The precautionary applicant has the privilege of paying accumulated renewal fees as well as filing and examination fees and, in the first instance, the search fee. If he is prepared to pay, the EPO should be prepared to examine. If the parent had already nearly or actually reached a conclusion the (re)examination should not be too onerous; indeed attempting summary disposal may well be more labour-intensive than simply proceeding into examination with shortened periods for response. If a remedy is deemed to be essential the legislator must find it.

Chemical and Pharmaceutical Product Claims in Spain

E. Lyndon-Stanford
Chairman, EPPC

In the issue of March 2007, I published a notice about the reservation for Spain regarding chemical and pharmaceutical product claims. That notice was based on inaccurate information. The legal position in Spain is a question of national interpretation and is uncertain. In

the circumstances, the notice should be ignored. If specific advice is required, I recommend that you consult a Spanish practitioner.

Please see the notice from the EPO, dated 18 June 2007, at: <http://www.epo.org/patents/updates.html>

EPC2000 invalidates existing patents?

O. Griebeling (NL)

On 13 December 2007, EPC2000 will come into force. It may be argued that in many ways applicants and patentees will benefit from the changes in the provisions. However, there is one group of applicants and patentees who will not benefit, but who will lose their patents if the provisions of the EPC2000 are interpreted strictly.

For a European patent (and application), the state of the art is defined in Art. 54(2) and 54(3). Under Art. 54(2), everything that has been made public before the filing date of a European patent application is prior art for such application.

Under Art. 54(3), the content of another European patent application, filed before but published later than the European patent application (hereinafter indicated as „prior European right“), is also prior art for such application.

Under the EPC1973, the prior art effect of such prior European right is limited to the designated states both applications have in common. This is provided by Art. 54(4)EPC1973: *“Paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application was also designated in respect of the earlier application as published.”*

Thus, the later European patent application can only be granted in respect of Contracting States NOT designated in the earlier application as published.

Such patent, granted under the EPC1973 for non-common designations, will hereinafter be indicated as „collision patent“. Likewise, a European patent application filed under the EPC1973, for which a novelty-destroying prior European right exists and which is limited to non-common designations, will hereinafter be indicated as „collision application“.

Collision patents are in great danger of becoming invalidated by the EPC2000, as will be explained in the following.

Key words in Art. 54(4)EPC1973 are *“as published”*.

In the original version of the EPC1973, designation fees had to be paid within 12 months from filing (or priority), i.e. before the application would be published under Art. 93, so the application „as published“ would only specify (under R.49(2)) the Contracting States for which the designation fees had actually been paid. Since the amendment of Art. 79(2) in 1997, designation fees are only due six months from the publication of the search report, so an application „as published“ may (and usually will) contain more designated Contracting States than those for which the designation fees will finally be paid. This problem was overcome because, together with the 1997 amendment of Art. 79(2), a new Rule 23a was introduced: *„A European patent application shall be considered as comprised in the state of the art under Art. 54 paragraphs 3 and 4 only if the designation*

fees under Article 79(2) have been validly paid.” This implies, of course, that no longer is the situation at the date of the publication decisive, but the situation at the expiry of the time limit for paying designation fees (including any grace periods).

Under the EPC2000, the prior art effect of a prior European right is not limited any more to „common designations“: Art. 54(4) of EPC1973 has been removed.

For collision patents and collision applications, the good news is that Art. 54(4) of EPC1973 continues to apply for such pending applications or granted patents: see Art. 1(1) of the Decision of the Administrative Council dated 28 June 2001, which was taken under Art. 7 of the Act revising the EPC of 29 November 2000.

The bad news is, however, that there is no comparable transitional provision for R.23a.

Since there is no similar rule in the Implementing Regulations to the EPC2000 (hereinafter: IR2000), the restriction of „common designations“ is factually gone, because, as explained above, a European patent application „as published“ typically still designates all Contracting States.

I note that it does not seem possible to continue to apply R.23a in any way on the basis of the current provisions.

With the entry into force of the EPC2000, the IR2000 in accordance with the Decision of the Administrative Council dated 7 December 2006 will come into force, and the „old“ Implementing Regulations do no longer exist.

In this respect, I note that Art. 2 of the Decision of the Administrative Council dated 7 December 2006 amending the Implementing Regulations specifies that the IR2000 shall apply to all applications and patents in so far as they are subject to the provisions of the EPC2000. This wording (probably) means that it is possible that a certain rule of the IR2000 does NOT apply to a certain application or patent, but it can not mean that a certain rule of the IR1973 CONTINUES to apply.

One may simply argue that, if an article continues to apply, its implementing rules automatically continue to apply. However, it seems that this is not a correct view. On the one hand, it is not always clear which rules can be considered as „implementing“ a specific article. On the other hand, it becomes difficult to distinguish between rules that are deliberately deleted and rules that are deleted but intended to continue to apply. In any case, it is my opinion that a provision of a replaced law can only continue to apply if a transition law explicitly specifies this.

What are the consequences? Let me give an example.

You and I have invented the same invention more or less at the same time. You have filed a European patent application in August 2004; I have filed a European patent application one month earlier. No priority claims.

Both applications contain all designations, and are published under Art. 93 in January and February 2006, respectively. You pay designation fees for DE, FR, GB, while I pay designation fees for NL and BE, both in March 2006.

Both patents are granted, very quickly, in September 2006. There was no other prior art, and my application was not harmful to yours because there were no common designations.

In May 2007, I file an opposition against your patent, based on the ground of lack of novelty under Art. 54(3), using my own prior European right.

In September 2007, you file a response, based on Art. 54(4) and R.23a, pointing out that there are no common designations.

By the time the Opposition Division has to make a decision, the opposition is to be examined under the EPC2000, which does not contain a rule similar to R.23a of EPC1973. It is now only Art. 54(4)EPC1973 which applies, and, since my application validly contained all designations at the time of publication under Art. 93, you will lose your patent.

What happens if this plays earlier, and the Opposition Division has to apply EPC1973? Well, you win the opposition procedure, of course, but then I file an appeal. The Boards of Appeal have to apply the EPC in its then existing form, i. e. EPC2000, and they have to set the decision of the Opposition Division aside and revoke the patent, even if the decision of the Opposition Division was completely correct under the EPC1973.

I acknowledge that the Boards of Appeal have yet to decide, but I find it difficult to assume that a Board can come to any other decision.

The above doom scenario for you not only applies in opposition proceedings or opposition/appeal proceedings, but even if your patent is much older, albeit that I now have to use national proceedings.

It may be that I am overlooking something, and that EPO will come with a kind explanation showing that my interpretation and conclusions are wrong. Otherwise, I hope that the Administrative Council will introduce an amendment before 13 December 2007.

One possible way of amendment is to decide that, for all applications and patents for which Art. 54(4)EPC1973 continues to apply, R.23a also continues to apply.

Another possible way of amendment is to introduce into IR2000 an additional Rule equivalent to R.23a, applicable only for the applications and patents for which Art. 54(4)EPC1973 continues to apply.

However, in both of such cases the (in my view, unsatisfying) situation would be continued where a Rule limits the scope or effect of an Article, without the Articles giving any legal basis for such limitation.

In many cases, the Articles specifically refer to the Implementing Regulations where a provision of the

Articles is further elaborated, for instance with wording such as „in accordance with the Implementing Regulations“, or „unless otherwise provided in the Implementing Regulations“. If an Article does not contain such referral, there is a danger that the Rule may be found to be in conflict with the Article, such as the famous Art. 123/R.88 situation.

Art. 54(4) does not refer to R.23a. Clearly, *without* R.23a, the outcome of the above-mentioned conflict differs from the situation *with* the rule. In my opinion, this means per definition that the rule is in conflict with the article.

For such situation, Art. 164(2) provides that the article prevails.

In other words, it may be argued that a rule such as R.23a does not legally lead to the desired effect in view of Art. 164(2). I note that EPO has accepted the effect of R.23a irrespective of Art. 164(2) for 10 years, but as far as I am aware the question has never been put before a Board of Appeal.

Therefore, I would advocate a different solution.

Under Art. 33, as far as relevant here, the Administrative Council only has power to amend the Implementing Regulations. However, at present, the Administrative Council is in the unique position to have the power, under Art. 3(1) of the Revision Act, to amend the European Patent Convention, i. e. the Articles. Therefore, I suggest the Administrative Council avoids the above-mentioned danger of potential conflict by incorporating R.23a into the EPC2000.

This can for instance be done by adding a new Art. 54(6) as follows:

54(6) A European patent application shall be considered as comprised in the state of the art under Art. 54 paragraph 4 of EPC 1973 only if the designation fees under Article 79(2) have been validly paid.

However, I find it aesthetically more satisfying if Art. 54(4)EPC1973 plus R.23a are incorporated into the EPC2000 together, for instance as follows:

54(6) For a European patent application filed before 13 December 2007, and for a European patent granted on such application, paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application was also designated in respect of the earlier application as published.

54(7) A European patent application shall be considered as comprised in the state of the art under paragraph 6 only if the designation fees under Article 79(2) have been validly paid.

With an amendment as proposed, possible misunderstandings are avoided, and all patent owners can rest assured that their patent rights as obtained or requested under the EPC1973 are safeguarded by the EPC2000.

Arten der Beurteilung von Erfindungen

S. V. Kulhavy¹ (CH)

Einleitung

Mit der Frage, ob eine Erfindung vorliegt oder nicht, werden die PrüferInnen in den Patentämtern praktisch täglich konfrontiert. Die Patentanwälte bzw. Patentanwältinnen werden mit dieser Frage ebenfalls sehr oft konfrontiert. Deswegen ist es zweckmässig, wenn dieser Entscheid, welcher weitreichende Folgen haben kann, möglichst einfach, logisch und überschaubar und daher auch überzeugend gestaltet werden kann. Es gibt mehrere Möglichkeiten, wie man eine neue Lösung beurteilen kann, ob sie auf einer erfinderischen Tätigkeit beruht oder nicht. Im Nachstehenden wird auch erläutert, wie man bis zur Definition einer Erfindung gelangen kann, welche eine sogar scharfe Unterscheidung zwischen den Erfindungen und den naheliegenden Lösungen ermöglicht.

Die volkstümliche Beurteilungsweise

Die wohl am meisten verbreitete Möglichkeit der Beurteilung von Erfindungen wollen wir volkstümlich nennen. Man führt sich eine berühmte Erfindung vor die Augen, nehmen wir als Beispiel den Phonograf von Edison an, und man fragt sich, ob die gerade diskutierte Lösung auch so berühmt werden könnte wie der Phonograph. Wenn man zum Schluss kommt, dass die diskutierte Lösung keine Aussicht darauf hat, auch so berühmt zu werden, dann betrachtet man die diskutierte Lösung nicht als Erfindung. Eine solche Diskussion kann, beispielsweise während einem small talk, sehr unterhaltsam sein, insbesondere, wenn die Teilnehmer sich für Erfindungen in irgendwelcher Weise interessieren.

Die Beurteilungsweise des EPA

Die zweite Möglichkeit kann man als die Prüfungsweise des Europäischen Patentamtes nennen. In den „Richtlinien für die Prüfung im Europäischen Patentamt“, Teil C, sind zwei Gruppen von Beispielen für neue Lösungen wiedergegeben. Die Beispiele der ersten dieser Gruppen ergaben sich in naheliegender Weise aus dem Stand der Technik. Die Beispiele der zweiten Gruppe ergaben sich nicht in naheliegender Weise aus dem Stand der Technik. Bei der Prüfung einer neuen Lösung vergleicht man diese neue Lösung mit den einzelnen Beispielen in den zwei Gruppen. Nachdem man ein vergleichbares Beispiel in einer dieser zwei Gruppen gefunden hat, schaut man, zu welcher der zwei Gruppen dieses Beispiel gehört. Aufgrund der Zugehörigkeit des Beispiels zu einer der zwei Gruppen weiß man, ob sich die geprüfte neue Lösung aus dem Stand der Technik in naheliegender Weise ergab

oder nicht, usw. Dies ist eine verhältnismässig langwierige und unsichere Art der Entscheidung über eine neue Lösung. Die Beispiele in den Richtlinien sind nämlich zahlreich, manche der Beispiele der zwei genannten Gruppen ähneln einander, die geprüfte neue Lösung braucht nicht unbedingt zu einem der Beispiele so zu passen, dass man eindeutig sagen kann, dass die geprüfte Lösung diesem bestimmten Beispiel entspricht, usw.

Die Beurteilungsweise gemäß Art. 1 CH-PatG

Am einfachsten und am sichersten lassen sich Erfindungen gemäß den Bestimmungen des Schweizer Patentgesetzes beurteilen. Art. 1, Abs. 2 CH-PatG lautet wie folgt: „Was sich in naheliegender Weise aus dem Stand der Technik ergibt, ist keine patentfähige Erfindung.“ Bei dieser schweizerischen Betrachtungsweise benötigt man nur noch die Definition einer Lösung, die sich in naheliegender Weise aus dem Stand der Technik ergab, damit entschieden werden kann, ob eine neue Lösung auf einer erfinderischen Tätigkeit beruht oder nicht. Diese Definition ist beispielsweise in *epi* Information, 1/2006, S. 30, I.Sp. publiziert worden. Unter diese Definition fallen alle Beispiele, welche die erste der genannten Gruppen der Beispiele in den „Richtlinien“ bilden. Diese Definition ist daher für das Patentwesen nichts fremdes, sondern sie stellt eine Verallgemeinerung der genannten Beispiele dar. In diesem Sinne bildet die Definition einer neuen naheliegenden Lösung einen organischen Bestandteil der derzeitigen offiziellen Prüfungsweise von Erfindungen, welcher bisher bloß fehlte. Da die genannte Definition fehlte, sind die Patentgesetze bei Feststellungen der Art stehen geblieben, wonach naheliegende Lösungen keine patentfähigen Erfindungen darstellen.

Der Entscheid darüber, ob ein Fall unter eine Definition fällt, ist bekanntlich ein sicheres und ein verhältnismässig einfaches logisches Vorgehen. Auf jeden Fall ist dieses Vorgehen viel einfacher und zuverlässiger als die europäische Vergleichung einer neuen Lösung mit den einzelnen Beispielen der zwei genannten Gruppen in den „Richtlinien“. Die Handhabung der genannten Definition erfolgt in der folgenden Weise. Wenn die geprüfte neue Lösung unter die Definition einer naheliegenden Lösung fällt, dann ergab sich diese neue Lösung in naheliegender Weise aus dem Stand der Technik und sie ist keine patentfähige Erfindung. Falls die neue Lösung unter die Definition nicht fällt, dann ergab sich diese neue Lösung eben nicht in naheliegender Weise aus dem Stand der Technik, und sie ist eine patentfähige Erfindung.

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Die Beurteilungsweise gemäß Art. 103 US-PatG

Ähnlich einfach gestaltet sich die genannte Prüfung auf der Grundlage von Art. 103 US-PatG. Dieser Gesetzesartikel ist recht wortreich. Für unsere Zwecke genügt es, wenn wir nur die folgenden Worte aus Art. 103 US-PatG hier wiedergeben: „A patent may not be obtained....if the differences....as a whole would have been obvious ...“. Auch hier kommt es nur darauf an, ob sich die neue Lösung in naheliegender Weise (obvious) aus dem Stand der Technik ergab oder nicht. Und auch hier braucht es daher nur noch die Definition einer naheliegenden Lösung zu verwenden, um entscheiden zu können, ob eine patentfähige Erfindung vorliegt oder nicht. Die übrigen Gedankengänge dieser Prüfungsweise gleichen den vorstehend erläuterten schweizerischen Gedankengängen.

Aufgabe-Lösung-Ansatz

Wie man sieht, kann man über die Erfindungseigenschaft einer neuen Lösung auch in einer ganz einfachen und genauen Weise entscheiden. Der hier besprochene Entscheid steht allerdings erst am Ende einer Kette von Handlungen, wie z. B. die Durchführung einer Neuheitsrecherche, falls erforderlich, die Abgrenzung der Patentansprüche usw. Aber über diese Kette von Handlungen besteht in den betreffenden Kreisen weitestgehend Einigkeit. Eine solche Kette von Handlungen ist beispielsweise im sogenannten Aufgabe-Lösung-Ansatz zusammengefasst.

Art. 56 EPÜ

Im Art. 56 EPÜ befindet sich der folgende Passus: „nicht in naheliegender Weise“. Diesen Passus kann man in zwei Bestandteile zerlegen, nämlich in die Negation „nicht“ und den Ausdruck „in naheliegender Weise“. Diesen Ausdruck können wir als den Namen eines Begriffes betrachten. Zu einem Begriff kann eine Definition aufgestellt werden. Im vorliegenden Fall ist dies die bereits besprochene Definition einer naheliegenden Lösung. Bei der Verwendung dieser Definition kann man im Rahmen von

Art. 56 EPÜ im Wesentlichen gleich verfahren wie bei der schweizerischen Beurteilungsweise. Es gibt allerdings einen Unterschied. Diesen Unterschied machen jedoch nur die Wortlaute der zwei genannten Bestimmungen aus, während der Sinn dieser zwei Bestimmungen derselbe ist. Art. 1, Abs. 2 CH-PatG sagt aus, was keine patentfähige Erfindung ist. Art. 56 EPÜ sagt dagegen aus, was eine patentfähige Erfindung ist, dies natürlich im Zusammenhang mit Art. 52, Abs. 1 EPÜ. Wegen dem Unterschied in den genannten Wortlauten muss es irgendwo eine Negation geben, damit der Sinn dieser Bestimmungen derselbe ist. Dies ist die Negation im Art. 56 EPÜ.

Manche Fälle sind dermassen kompliziert, dass einem nur die Besinnung an diese einfachen Prinzipien der Beurteilungsweise von Erfindungen weiter helfen kann,

wie dies eine langjährige Erfahrung des Autors dieses Beitrags mit dieser auf der Definition einer naheliegenden Lösung beruhenden Prüfungsweise zeigt.

Die Definition des Begriffes Erfindung

Eine berechtigte Frage könnte lauten, wenn es eine Definition zum Begriff „in naheliegender Weise“ gibt, dann müsste es auch eine Definition zum Begriff „nicht in naheliegender Weise“ geben? Selbstverständlich ist eine solche Definition möglich. Sie ergibt sich auf einem logischen Weg durch Negation der Definition einer naheliegenden Lösung. Die Definition einer nicht naheliegenden Lösung lautet wie folgt:

„Eine gewerblich anwendbare und neue Lösung eines technischen Problems ergab sich nicht in einer naheliegenden Weise aus dem Stand der Technik, wenn lösungsgemäß ein neues technisches Mittel verwendet wurde oder wenn lösungsgemäß ein zwar bekanntes technisches Mittel jedoch aufgrund der Entdeckung einer bei diesem technischen Mittel noch nicht bekannten Wirkungsfähigkeit verwendet wurde.“

Dies ist die seit vielen Jahren gesuchte Definition des Begriffes Erfindung! Diese Definition ermöglicht eine sogar scharfe Unterscheidung zwischen den Erfindungen und den naheliegenden Lösungen. Dies deswegen, weil sich die Erfüllung aller Merkmale dieser Erfindungsdefinition bei einer beurteilten Lösung anhand des Resultates der betreffenden Recherche im Stand der Technik eindeutig belegen lässt. Anhand des Resultates einer Recherche im Stand der Technik lässt es sich nämlich zuverlässig entscheiden, ob das lösungsgemäß verwendete technische Mittel neu oder bereits bekannt war, und wenn bekannt, ob dieses bekannte technische Mittel aufgrund der Entdeckung einer bei diesem technischen Mittel noch nicht bekannten Wirkungsfähigkeit lösungsgemäß verwendet wurde oder nicht. So begründete Entscheide können auch die Anmelder und Patentinhaber verstehen und akzeptieren, weil sie den Inhalt der relevanten Dokumente des Standes der Technik verstehen können.

Wie bereits erwähnt, sagt Art. 56 EPÜ zusammen mit Art. 52, Abs. 1 EPÜ aus, was als eine patentfähige Erfindung betrachtet werden kann. Um bei einer geprüften Lösung den diesbezüglichen Entscheid anhand von Art. 56 EPÜ treffen zu können, bieten die „Richtlinien“ die bereits besprochenen zwei Gruppen von Beispielen an. Die Erfindungsdefinition ist den Beispielen jener Gruppe in den „Richtlinien“ übergeordnet, welche sich nicht in naheliegender Weise aus dem Stand der Technik ergaben. In diesem Sinne stellt die Erfindungsdefinition ebenfalls einen organischen Bestandteil der derzeitigen offiziellen Prüfungsweise von Erfindungen dar, welcher bisher bloß fehlte. Folglich kann man bei der Prüfung anhand von Art. 56 EPÜ auch untersuchen, ob die jeweils geprüfte Lösung unter die Erfindungsdefinition fällt oder nicht, anstatt die geprüften Lösungen mit den einzelnen Beispielen in den Gruppen gemäß den „Richtlinien“ zu vergleichen.

Der Fachmann

In den Bestimmungen mancher Patentgesetze, welche die erfinderische Tätigkeit betreffen, wird auf den Fachmann Bezug genommen. Dies ist allerdings nicht in jedem Patentgesetz der Fall. Beispielsweise im Art. 1 CH-PatG ist vom Fachmann keine Rede. Dies bedeutet, dass man auch ohne Bezug auf den Fachmann entscheiden kann, ob eine neue Lösung auf einer erfinderischen Tätigkeit beruht oder nicht. Aber für jene, welche wissen möchten, wie es gemäß der vorliegenden Lehre um den Fachmann bestellt ist, können wir hier das Wissen und das Können des Fachmanns ebenfalls beschreiben. Das Wissen des Fachmanns umfasst ohne Abstriche alles, was zum Stand der Technik gehörte, welcher am Prioritätstag der beurteilten Lösung bestand. Dies bedeutet, dass der Fachmann nicht nur die Ausbildung der zu diesem Stand der Technik gehörenden technischen Mittel, sondern auch jene Wirkungsfähigkeiten dieser kannte, welche bei diesen technischen Mitteln im genannten Zeitpunkt bereits bekannt waren. Dies lässt sich anhand des Resultates einer Recherche im Stand der Technik unter Beweis stellen. Damit werden Diskussionen über den Umfang des Wissens des Fachmanns überflüssig. Die Grenze zwischen den naheliegenden und den nicht naheliegenden Lösungen liegt ausschliesslich innerhalb des Könnens des Fachmanns. Folglich kann der Fachmann sowohl naheliegende als auch nicht naheliegende neue Lösungen schaffen. Dies ist in einer ausgezeichneten Übereinstimmung beispielsweise mit Art. 56 EPÜ, mit Art. 103 US-PatG usw. Es kommt bloß darauf an, ob die geprüfte Lösung unter die Definition einer naheliegenden Lösung bzw. unter die Erfindungsdefinition fällt oder nicht, je nach dem, welche dieser Definitionen man im geprüften Fall anwendet.

Schlussbetrachtungen

Sicherlich wird es viele Leser überraschen, wie logisch überschaubar die Zusammenhänge auf dem Gebiet der erfinderischen Tätigkeit sind. Wenn man diese Zusammenhänge kennt, dann ist die Situation auf diesem Wissensgebiet wirklich relativ einfach.

Die Prüfungsweisen von Erfindungen, welche auf den besprochenen Definitionen basieren, liegen, wie dargelegt, im Rahmen der geltenden Vorschriften, und zwar sogar von mehreren Staaten. Bei diesen Prüfungsweisen handelt es sich daher nicht um andere Prüfungsweisen als bisher, wie dies manche meinen. Diese Prüfungsweisen sind alternativ anwendbar, weil sich die Erfindungsdefinition durch Negation der Definition einer naheliegenden Lösung ergab. Für die Prüfer im Patentamt und für die Patentanwälte dürfte die auf der Definition einer naheliegenden Lösung basierende Prüfungsweise zweckmäßiger sein. Für Gerichtsfälle dagegen dürfte die auf der Erfindungsdefinition beruhende Prüfungsweise zweckmäßiger sein.

Wenn man den Inhalt der übrigen bereits publizierten Arbeiten des Autors dieses Beitrags mitberücksichtigt, dann kann man wohl mit Recht sagen, dass das Gebiet der erfinderischen Tätigkeit ein wissenschaftlich erschlossenes Wissensgebiet ist. In der Tat gibt es noch weitere Zusammenhänge innerhalb dieses sehr umfangreichen, neuen aber vor allem faszinierenden Wissensgebiets erfinderische Tätigkeit. Die bereits veröffentlichten Zusammenhänge dürften den Lesern ermöglichen, sich in der derzeitigen offiziellen Beurteilungsweise von Erfindungen besser zu orientieren. Durch diesen Vorsprung am Wissen und Können dürften sie auf diesem Gebiet erfolgreicher agieren können als jene, welche diese Lehre ignorieren.

EPO examination practice in relation to Computer-Implemented Inventions, in particular, Computer-Implemented Business Methods

D. Closa, P. Corcoran, J. Machek, C. Neppel¹ (EPO)

1. INTRODUCTION

This article presents the practice of the EPO, based on DG3 decisions like T641/00 (Comvik), T173/03 (Ricoh) and T258/03 (Hitachi) concerning business method applications.

We will consider four fictitious examples of an application with a single claim and a short description in order to explain how the technical content of the application as a whole may influence the prosecution of the examin-

ation. In the next section the four exemplary claims and the accompanying descriptions are presented. Then in the subsequent section the expected course of action of the EPO examiner is outlined and explained. For each claim, from example 2 onwards, the features that have been added or modified compared to the preceding version are underlined. The technical content of each example increases incrementally with respect to its predecessor.

¹ Joerg Machek is EPO Director, Daniel Closa, Patrick Corcoran Clara Neppel are EPO examiners

2. EXAMPLES

Example 1

Claim

A method of controlling access to content by a user, the method comprising:

the user requesting a content

accessing said requested content

accessing regulatory information defining at least one regulation that applies to the requested content and to geographical information relating to the user

determining whether said at least one regulation is fulfilled

if said at least one regulation is fulfilled, providing the requested content to the user.

Description

Providing access to information has become one of the major issues in our world.

It has generally been considered desirable that access to published sources of knowledge or information should not entail excessive costs. For example access to books in a library is normally given for free or in return for a small annual fee. These annual fees never cover the costs for buying new books and storing and managing the existing stock of books. A library or any comparable information keeping and sharing system needs the financial support of institutions or a sponsor or has to dramatically increase its fees with the risk of restricting the accessibility of information.

In summary, there is a conflict between the wish to voluntarily share knowledge and the need for funds in order to keep the knowledge up to date and publicly accessible. Resolving that conflict is a typical problem with which any manager of a shared information repository is confronted.

The present application solves that problem by means of regulatory information defining at least one regulation that applies to the requested content and to geographical information relating to the user.

According to the invention, the borrowing fee to access a book in a library depends in the first instance on the book itself but the total amount charged is determined by taking account of the nationality of the user. Thus, different fees apply to different users wanting to borrow the same book. If the user originates from one of the 30 poorest countries in the world, then he will be required to pay less than a user coming from one of the other countries, or he may even be allowed to borrow the book for free. If, on the other hand, he originates from one of the 10 richest countries, he will be required to pay more than average. In this way we ensure that access to information is enabled independent of the user's financial resources. By adapting the fee structure to the users, the information keeping and sharing system can also manage its revenue in an efficient way.

In practice this can be achieved by furnishing the personnel of a library with a list of countries indicating the tariff applicable for each country. The user just has to present his passport and the applicable fee will be

determined in accordance with the book requested and the nationality of the user.

Example 2

Claim

A computer implemented method of controlling access to content *in a computer* by a user, the method comprising:

the user requesting a content

accessing *in a first database* said requested content;

accessing *in a second database* regulatory information defining at least one regulation that applies to the requested content and to geographical information relating to the user; and

determining whether said at least one regulation is fulfilled

if said at least one regulation is fulfilled, providing the requested content to the user.

Description

Providing access to information has become one of the major issues in our world.

It has generally been considered desirable that access to published sources of knowledge or information should not entail excessive costs. For example access to books in a library is normally given for free or in return for a small annual fee.

The development of computer technology has nowadays made it possible to access books or newspapers article in libraries via a computer.

This new service has increased the costs of the library and requires financial support. Normally a fee is charged depending on the type of information and the amount of information seen by the user. In some cases, the fee may be expensive, for example if the type of information to be seen by the user is important, and this may inhibit access for users with limited financial resources.

Resolving the conflict between the desire to share knowledge voluntarily and the need to provide funds for equipping the libraries with this technological infrastructure, is the problem that has to be addressed.

The present application solves that problem by storing and accessing regulatory information in a database, said regulatory information describing at least one regulation that is related to the requested content and to geographical information related to the user.

According to the invention, the fee to access an article stored in a computer database depends in the first instance on the article itself but the total amount charged is determined by taking account of the nationality of the user. Thus, different fees apply to different users wanting to access the same article.

If the user originates from one of the 30 poorest countries in the world, then he will be required to pay less than a user coming from one of the other countries, or he may even be allowed to access the article for free. If, on the other hand, he originates from one of the 10 richest countries, he will be required to pay more than average.

In this way we ensure that access to information is enabled independent of the user's financial resources. By adapting the fee structure to the users, the information keeping and sharing system can also manage its revenue in an efficient way.

In practice this can be achieved by providing the computer with a second database including fee information depending on the article requested and the nationality of the user. The user has just to enter his passport data as proof of his nationality via a user interface into the computer.

This nationality information will be stored by the computer and the fee will then be automatically determined in accordance with the regulatory information stored in this second database.

Example 3

Claim

A method of controlling access to *requested* content by a user *that is available on a content server* comprising the steps of

- (a) *receiving a request* for content from a user
- (b) *accessing in a first database* said requested content;
- (c) *accessing in a second database* registration information relating to the geographical location of the user;
- (d) *accessing regulatory information* in a third database defining at least one regulation that applies to said requested content and to said geographical location of the user;
- (e) *determining whether said at least one regulation is fulfilled by the request*;
- (f) *if the request fulfilled said at least one regulation, retrieving the requested content from the content server and transmitting the requested content to the user*; or
- (g) *if the request is determined to not comply with the at least one regulation then not providing the requested content to the user*

Description

Providing access to information has become one of the major issues in our world.

The Internet has allowed the development of information keeping and sharing systems using world-wide accessible content servers. Such systems either rely on voluntary contributions and offer free access or else they are dependent on the contributions of highly specialised experts who expect to be paid for their knowledge in which case access to information resources is only permitted after payment of a fee depending on the quality of the information. A disadvantage of the first alternative may be the lack of quality of the freely available information, and a shortcoming of the second alternative is that the relevant information is only accessible to the users who are able to pay for it. In summary, there is a conflict between the desire to share knowledge in an open manner and the need for funds in order to keep the knowledge up to date and publicly accessible.

Resolving that conflict is a problem which confronts any manager of a shared information repository.

The present application solves that problem by using a plurality of databases for storing and accessing the requested content, the geographical location of the user and regulatory information.

According to the invention, the fee to access an article stored on a content server depends in the first instance on the article itself but the total amount charged is determined by taking account of the nationality of the user. Thus, different fees apply to different users wanting to access the same article.

If the user originates from one of the 30 poorest countries in the world, then he will be required to pay less than a user coming from one of the others countries, or he may even be allowed to access the content for free. If, on the other hand, he originates from one of the 10 richest countries, he will be required to pay more than average.

By doing so, we ensure that access to information is independent of the user's financial resources. By adapting the fee structure to the users, the information keeping and sharing system can also manage its revenue in an efficient way.

In practice, this can be achieved by asking the user to register and to enter his physical address in the system.

In addition to a first database for holding the requested content, a second database is used to store all addresses of the registered users.

A third database will include regulatory information, e.g. the fee to be paid by the user taking into account his location and the content he wants to access.

The content will be delivered if the regulation is complied with, e.g. if the corresponding fee is paid.

The content server will be adapted in order to include three databases, a registration unit and all other technical means necessary for the implementation of the present invention.

Example 4

Claim

A method of controlling access to requested content by a user that is available on a content server comprising the steps of

- (a) receiving a request for content from a user;
- (b) *accessing and comparing content ratings describing the requested content and regulatory information to determine whether the requested content complies with at least one applicable regulation*;
- (c) *if the requested content is determined to comply with the at least one applicable regulation, retrieving the requested content from the content server and transmitting the requested content to the client*; or
- (d) *if the requested content is determined to not comply with the at least one applicable regulation denying access to the requested content*; *wherein the method steps (a) to (d) are carried out on a proxy server and wherein the proxy server is also arranged to perform the additional step of:*

- (e) *determining a geographic location of the user and, wherein the regulatory information is accessed based on the geographic location of the client.*

Description 4

Providing access to information has become one of the major issues in our world.

The Internet has allowed the development of information keeping and sharing systems using world-wide accessible content servers.

Such systems either rely on voluntary contributions and offer free access, (e.g. Wikipedia) or else they are dependent on the contributions of highly specialised experts who expect to be paid for their knowledge in which case access to information resources is only permitted after payment of a fee depending on the quality of the information.

A disadvantage of the first alternative may be the lack of quality of the freely available information, and a shortcoming of the second alternative is that the relevant information is only accessible to the users who are able to pay for it.

In summary, there is a conflict between the desire to share knowledge in an open manner and the need for funds in order to keep the knowledge up to date and publicly accessible.

Resolving that conflict is a problem which confronts any manager of a shared information repository.

The present application solves that problem by storing and accessing the request content, the geographical location of the user and regulatory information in a plurality of databases.

The present application solves that problem by using a plurality of databases for storing and accessing the request content, the geographical location of the user and regulatory information.

Such systems are already known, see example 3. However, in the prior art system the location of the user was determined using address information entered by the user himself. It became apparent that certain users being aware of the fee charging schedule entered a false address in order to benefit from more favourable conditions.

A supplementary problem to be solved is therefore to provide a system capable of automatically detecting the geographical location of a user and of using this information to automatically determine the applicable fees without any human interaction.

Therefore in accordance with a further preferred embodiment of the present invention the proxy server is arranged to determine the geographic location of the user as detailed below.

[PREFERRED EMBODIMENT WITH PROXY SERVER]

3. EXPECTED COURSE OF ACTION OF THE EPO EXAMINER

Example 1

In this example, it is not possible to identify any technical features or a technical problem to be solved neither in

the claim nor in the description. This application should be refused because its subject-matter is excluded from patentability (Art. 52 (2)-(3) EPC).

According to EPO practice such a refusal does not require any comparison to a specific prior art document and it is therefore to be expected that no document will be cited with the search report.

Example 2

In this example, the claimed subject matter includes technical means. Indeed the technical architecture comprises a computer and two databases. Furthermore, data is entered into the computer and automatically processed. Hence, the claims comprise a mix of technical and non-technical subject-matter.

To carry out an objective and consistent examination of a computer-implemented invention, an assessment is required to determine which aspects of a subject-matter do and which aspects do not contribute to the technical character of the subject-matter as a whole (T0641/00, OJ EPO 2003,352, reasons 7).

In this case, the non-technical part relates to the abstract concept of controlling access to content which corresponds to that set out in example 1 above. Furthermore, the non-technical aspects do not cause a technical effect in their interaction with the clearly technical aspects. Indeed, the data to be processed neither constitute the operating parameters of the underlying computer system nor does they affect the physical/technical functioning of the system.

The closest prior art will be from a technical field and is established on the basis of the technical content identified in the claims and description. In this case, it corresponds to a general purpose computer system having two databases.

The distinguishing features are of a non-technical nature and do not solve any technical problem.

It is mentioned that the possibly innovative concept underlying the application, namely taking into account the nationality of the user for calculating the fee to be paid, is not taken into account for assessing an inventive step because it is not considered to be of a technical nature.

The claimed subject-matter is thus considered to relate to the direct implementation of a non-technical idea on a computer.

Hence, according to EPO practice, such an application should be refused for lack of inventive step (Art. 56 EPC).

Example 3

In this further example, the complexity of the employed technical architecture has increased.

It comprises a content server, three different databases, data entered in the system, registration of users, some checks and transmission of data.

However, from a technical point of view, this amounts to nothing more than an Internet-based system with means for receiving and storing registration data from a user (e.g. as known from Amazon or eBay).

On the other hand, the claim also incorporates non-technical aspects as set out in example 2.

Following the problem-solution approach, an Internet-based system with means for user registration would be considered as being the closest prior art.

According to EPO practice, the objective technical problem must be one which, in a realistic situation, the skilled person may be asked to solve. The skilled person should be presumed to be an ordinary practitioner in a field of technology (T00641/00, OJ 7/2003, 352, r8).

Furthermore, the objective technical problem must be formulated in such a way that there is no possibility of an inventive step arising from the purely non-technical aspects of the subject-matter (T1053/98, not published in OJ EPO).

In this respect, purely non-technical aspects which define an aim to be achieved in a non-technical field and thus not contributing to the technical character of a disclosed invention, may appear in the formulation of the technical problem in the form of a requirements specification provided to the person skilled in a technical field as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met (T0641/00 OJ EPO 2003, 352; T1053/98 not published in OJ EPO).

In this case, the requirements specification provided to the skilled person corresponds to the concept of controlling access to content set out in example 1.

Given the above, the distinguishing features insofar as they are of a technical nature (e.g. additional databases) are considered to follow directly from the non-technical specification requirements.

The claimed subject-matter essentially relates to the direct implementation of a non-technical scheme on an Internet-based system with means for user registration.

The potentially innovative aspect of the application is the same non-technical concept as in the case of example 2 and this is not taken into account for the purposes of assessing inventive step.

The implementation of this concept in an Internet system is not considered to require the exercise of inventive skill.

Hence, in this case the application will also be refused for lack of inventive step (Article 56 EPC).

Example 4

The result of the examination of this application will depend on the content of the description, in particular on the content of the section relating to the „further preferred embodiment“ which has not been elaborated in detail above.

The difference between this case and the preceding one lies in the formulation of an identifiable technical problem.

„A supplementary problem to be solved is therefore to provide a system capable of automatically detecting the geographical location of a user and of using this information to determine the applicable fees without any human interaction“.

The only feature of the current claim which addresses this technical problem is the specification that „the proxy server is also arranged to perform the additional step of determining a geographic location of the user“.

If the description is silent on how the proxy server capable of performing this additional step then the examiner will probably arrive at the opinion that the disclosure is insufficient to enable the person skilled in the art to put the claimed invention into practice and will consequently raise an objection of insufficiency of disclosure (Art. 83 EPC).

If the representative is able to convince the examiner that the skilled person would know how to implement that feature despite the apparent lack of disclosure in the application, then the examiner will probably respond by arguing that, if no specific technical teaching is required in order to implement the underlying non-technical idea (i.e. determining the location of a user), then the subject-matter of the claim does not involve an inventive step.

This effectively returns us to a situation comparable to that of example 3.

If, however, in the part of the description relating to the „further preferred embodiment“, the applicant does in fact disclose technical details of how the automatic determination of the user's location is carried out then, once he has introduced the relevant technical features into the claim, the inventive step will be assessed taking due account of the available prior art.

In such a case, the application is considered to disclose a technical solution to a technical problem and the examiner's findings in respect of inventive step will depend on the cited prior art documents.

In conclusion, if in the part of the description relating to the „further preferred embodiment“, the technical details of the claimed solution are not disclosed, then the application is likely to be refused either due to insufficiency of disclosure (Art. 83 EPC) or due to lack of inventive step (Art. 56 EPC).

4. CONCLUSION

The practice of the EPO is to grant patents for applications for inventions which provide a non-obvious technical solution to a technical problem. As a practitioner you should ensure that all relevant technical details relating to the claimed invention are present in the original filing, at least in the description.

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