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Editorial

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

For many practitioners at the European Patent Office, the major pitfalls in the prosecution of European Patent Applications lie in the inconsistent interpretation of the European Patent Convention by the European Patent Office. Whilst the tests for novelty and inventive step are well understood both inside and outside the European Patent Office, many other objections raised by the European Patent Office under other areas of the European Patent Convention vary a great deal from Directorate to Directorate and, indeed, from Examiner to Examiner. This is far from surprising, given human individualism and the size of the office itself.

This does not make the job of a European representative any easier, however, when faced with differing interpretations of, for example, clarity under Article 84 EPC, lack of support under Article 84 EPC (and the increasing need for some Examiners to have experimental evidence in the Application, despite the lack of any requirement for such evidence in the Convention) and added subject matter under Article 123 (2) EPC.

What would undoubtedly assist the situation, not only for the representatives and the Applicants but also for the Examiners themselves, would be some clear public guidance as to how such objections should properly be applied. Given the limited influence of individual Technical Board of Appeal Decisions, this is becoming difficult and, increasingly, people are looking with expectancy to the Decisions of the Enlarged Board of Appeal to give guidance in these matters. The opportunity presented by such Decisions is not always grasped, however.

The recent Enlarged Board of Appeal Decision on disclaimers is a case in point. Although the Decision

was ostensibly directed towards disclaimers, the opportunity was available for the Enlarged Board of Appeal to review the whole issue of added subject matter, what constituted added subject matter and why subject matter should not be added to an Application after filing. As such, the Enlarged Board of Appeal had a chance to give advice, to all participants in the granting of European Patents, as to how objections of added subject matter should be raised and assessed.

Regrettably, however, added subject matter itself is hardly mentioned in the Decision and the Enlarged Board of Appeal have contented themselves to sticking specifically to the topic of disclaimers, whilst avoiding any apparent need to put their Decision in the context of a broader discussion of the exclusion of added subject matter under the EPC. This would appear to be an opportunity that has been allowed to go by ungrasped.

Unfortunately, there is little that individual representatives can do to influence the European Patent Office, and the Enlarged Boards of Appeal, to give more guidance to Examiners and representatives when dealing with such undecided areas of the law. We should be grateful that the *epi*, by its representation on SACEPO, is able to bring some pressure to bear and, indeed, does so whenever the opportunity arises.

Practitioners working in the medical and pharmaceutical fields are now waiting with interest for the Decision of the Enlarged Board of Appeal relating to disclaimers. Let us hope that this Enlarged Board of Appeal recognise the situation and address not only disclaimers but the issue of EPC exclusions and the extent to which they are to be applied.

Redaktionsschluss für epi Information 3/2004

Redaktionsschluss für die nächste Ausgabe der *epi Information* ist der **20. August 2004**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Deadline for *epi* Information 3/2004

Our deadline for the next issue of *epi Information* is **20 August 2004**. Documents for publication should have reached the Secretariat by this date.

Date limite pour *epi* Information 3/2004

La date limite de remise des documents pour le prochain numéro de *epi Information* est le **20 août 2004**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Bericht über die 56. Ratssitzung in Kopenhagen 17.–18. Mai 2004

Die Sitzung wurde von Präsident Holzer eröffnet, der die Vertreter von 26 Mitgliedsländern im Rat und die Beobachter anderer Länder begrüßte, die bald Mitglieder des Instituts sein werden. Dann begrüßte er den Generaldirektor des dänischen Patentamts, Herrn Kongstad, der eine kurze Präsentation über „Globalisierung und die Herausforderung für Patentämter“ gab.

Die Stimmenzähler wurden ernannt. Der überarbeitete Entwurf der Tagesordnung wurde mit kleineren Änderungen angenommen und das Protokoll der 55. Ratssitzung wurde angenommen. Der Präsident legte einen Bericht zu den einzelnen Punkten vor, was Änderungen betraf, die sich aus dem Protokoll der letzten Ratssitzung ergaben. Im Anschluss an eine kurze Übersicht der Empfehlungen, die der Vorstand seit der letzten Ratssitzung gemacht hatte, legte der Präsident seinen Bericht vor, der an anderer Stelle in dieser Ausgabe der epi-Information veröffentlicht ist. Nach dem Bericht des Präsidenten wurden dem Rat auch die Berichte des Generalsekretärs und des Schatzmeisters vorgelegt.

Die internen Rechnungsprüfer legten ihren Bericht vor. Der Bericht des Schatzmeisters einschließlich des Haushaltsplanes für 2003 wurde angenommen und der

Schatzmeister und die übrigen Vorstandsmitglieder wurden vom Rat entlastet.

Der folgende Tagesordnungspunkt behandelte erneut den Schutz des Titels „European Patent Attorney“. Gemäß dem auf der letzten Ratssitzung gefassten Beschluss war beim EPA ein Antrag auf Änderung der Vorschriften zur Errichtung des Instituts gestellt worden, um die folgenden Kurzbezeichnungen aufzunehmen: „European patent Attorney“, „zugelassener Vertreter vor dem EPA“ und „mandataire européen en brevets“. Das Papier wird auf der nächsten Sitzung des Verwaltungsrats beschlossen.

Im Hinblick auf die nächsten Wahlen zum Rat im Jahr 2005 wurden Herr Breiter (CH), Frau Avenhaus (DE) und Herr Palágyi (HU) zu Mitgliedern des Wahlausschusses ernannt.

Dann wurden die Berichte der Ausschüsse vorgelegt, beginnend mit dem Bericht des Disziplinarausschusses. Der Hauptpunkt war die in Arbeit befindliche Revision der Disziplinarvorschriften. Der Rat diskutierte über einen neuen Vorschlag von Herrn Leherste, dem Vorsitzenden des Disziplinarausschusses und Mitglied der EPA/epi-Arbeitsgruppe. Schließlich entschied der Rat,



Foto: E. Benatov

New Council members from Bulgaria, with epi President Holzer, at the Sunday outing preceding the Council meeting. Dr. Emil Benatov, Emilia Vinarova, Milena Tabakova, Walter Holzer

dass die Revision der Disziplinarvorschriften gemäß den im Basisvorschlag ausgearbeiteten Richtlinien erfolgen soll, auf die man sich auf der letzten Ratssitzung geeinigt hatte.

Dann wurden dem Rat die Berichte des Redaktionsausschusses und des Ausschusses für biotechnologische Erfindungen, des Ausschusses für EPA-Finzen, des OCC und des *epi*-Finanzausschusses vorgelegt. Eine Zusammenfassung der meisten Berichte stehen an anderer Stelle in dieser Ausgabe der *epi*-Information. Die überarbeiteten Zuständigkeitsbereiche der Ausschüsse, die der Geschäftsführungsausschuss vorlegte, wurden angenommen.

Dann besprach der Rat den Bericht des EPPC. Ein Positionspapier über die Revision des Europäischen Patentübereinkommens im Zusammenhang mit der Gemeinschaftspatentverordnung wurde dem Rat vorgelegt, der die vorgeschlagenen Änderungen annahm. Zu dem vom Europäischen Parlament erarbeiteten Entwurf einer Richtlinie über die Patentierbarkeit von computergestützten Erfindungen gab es viele Einwände seitens des *epi*, und der EPPC hatte daher ein weiteres Positionspapier ausgearbeitet. Auch dieses Papier wurde vom Rat genehmigt und beide Papiere werden den zuständigen Stellen übermittelt. Sie sind in dieser Ausgabe als Anlagen zum EPPC-Bericht veröffentlicht.

Danach wurde dem Rat der Bericht des Harmonisierungsausschusses vorgelegt. Betreffend den Punkt „Prior Art Effect on International Applications“ genehmigte der Rat, dass EPPC und Harmonisierungsausschuss ein gemeinsames Positionspapier vorbereiten sollen.

Dann legte der Ausschuss für berufliche Weiterbildung (PQC) seinen Bericht vor. Der Vorsitzende legte die Ergebnisse des Berichts über die Modernisierung der Europäischen Eignungsprüfung und die Empfehlungen

des PQC vor. Hauptaugenmerk wird auf die Weiterbildung gelegt. Es werden außerdem Vorschläge für Änderungen der Vorschriften für die Europäische Eignungsprüfung gemacht. Der Rat genehmigte, dass das Papier dem EPA übermittelt wird.

Dann wählte der Rat ein neues Vorstandsmitglied für Griechenland, Frau Papaconstantinou, und ein Vorstandsmitglied für Bulgarien, Frau Tabakova. Neue Mitglieder aus Bulgarien wurden für SACEPO und den Disziplinarausschuss gewählt. Neue Mitglieder aus Spanien, den Niederlanden und Luxemburg wurden für den PQC gewählt. Auch ein neues Mitglied aus Österreich wurde für den EPPC gewählt. Diese neuen Ernennungen sind auf den letzten Seiten dieser Ausgabe der *epi*-Information aufgelistet.

Auf diesen Punkt folgte ein kurzer Bericht über die Arbeitsgruppe Streitregelung und über den derzeitigen Stand des Gemeinschaftspatents.

Der Präsident berichtete über den CEIPI/*epi*-Kurs über Patentstreitigkeiten in Europa. Der erste Kurs war ein Erfolg und wird Anfang Juni mit einer Prüfung beendet. Das Vorhaben einer Europäischen Akademie für Geistiges Eigentum wurde angesichts einer vom EPA ausgearbeiteten Machbarkeitsstudie erörtert.

Dann wurde die Frage der Aufnahme neuer Länder besprochen, da Polen am 1. März 2004 der Europäischen Patentorganisation beigetreten ist und Litauen, Lettland, Malta und Island demnächst beitreten werden.

Die Termine der nächsten Ratssitzungen wurden bestätigt: Die 57. Ratssitzung soll am 25. und 26. Oktober 2004 in Lissabon und die 58. Ratssitzung am 9. und 10. Mai 2005 in Budapest stattfinden.

Der Präsident dankte der dänischen Abordnung herzlich für die sehr erfolgreiche Organisation der 56. Ratssitzung und schloss die Sitzung um 13.30 h.

Entwurf der Beschlussliste, 56. Ratssitzung, Kopenhagen 17.–18. Mai 2004

1. Der Haushalt 2003 wurde angenommen und der Schatzmeister entlastet.
2. Der Vorstand wurde entlastet (keine Gegenstimmen, eine Enthaltung).
3. Der Rat billigte den Haushaltsplan für das Jahr 2004.
4. Frau B. AVENHAUS (DE), Herr H. BREITER (CH) und Herr T. PALÁGYI (HU) wurden einstimmig für den Wahlausschuss für die nächsten Wahlen zum Rat im Jahr 2005 gewählt.
5. Es ist Sache der Kammer, welche sich mit einem Disziplinarfall befasst, zu beschließen, ob die Entscheidung in dem entsprechenden Fall veröffentlicht werden kann oder nicht.
6. Der Rat stimmte zu, dass die Revision des Disziplinarverfahrens weiter verfolgt werden soll.
7. Der Rat billigte den auf der letzten Ratssitzung in Cannes gefassten Beschluss (69 Ja-Stimmen, 2 Nein-Stimmen, 15 Enthaltungen), dass der Disziplinarrat in der *epi*/EPA-Arbeitsgruppe gemäß den Richtlinien im Vorschlagsentwurf für eine Revision der Disziplinarvorschriften weiter arbeiten soll.
8. Der überarbeitete erste Paragraph der Richtlinien des Harmonisierungsausschusses soll wie folgt lauten: „Der Harmonisierungsausschuss soll sich mit Fragen der weltweiten Harmonisierung des Patentrechts beschäftigen“.
9. Die überarbeiteten Richtlinien der Ausschüsse wurden mit einigen redaktionellen Änderungen angenommen.

10. Vom 1. Januar 2005 an gelten folgende Rückerstattungsbeträge: Hotel: 150 EUR pro Übernachtung; entstehende Unkosten: 50 EUR pro Sitzung; Verpflegungskosten: 40 EUR pro Tag.
11. Das *epi*-Positionspapier über die Revision des Europäischen Patentübereinkommens hinsichtlich der Gemeinschaftspatentverordnung wird dem EPA, der Europäischen Kommission und nationalen Organisationen übersandt werden.
12. Das *epi*-Positionspapier über die Patentierbarkeit von computergestützten Erfindungen wird dem Europäischen Parlament, der Europäischen Kommission, dem EPA und dem ICC übersandt werden.
13. Der EPPC und der Harmonisierungsausschuss sollen sich auf den Entwurf eines Positionspapiers über die Wirkung von internationalen Anmeldungen als Stand der Technik einigen.
14. Der Bericht über die Modernisierung der Europäischen Eignungsprüfung einschließlich der Kommentare und Empfehlungen des PQC wird dem EPA übersandt.

Report of the 56th Council Meeting, in Copenhagen 17–18 May 2004

The meeting was opened by the President, Mr. Holzer, who welcomed the representatives of 26 countries in the Council and the observers of other countries that would soon be joining the Institute. He then welcomed the General Director of the Danish Patent Office, Mr. Kongstad, who made a short presentation on „Globalisation and the challenge for Patent Offices“.

The scrutineers were appointed. The revised draft agenda was adopted with minor amendments, and the minutes of the 55th Council meeting were approved. With regard to matters arising from the minutes of the previous Council Meeting, there was a report from the President on the individual issues. Following a brief review of the recommendations made by the Board since the last Council meeting, the President gave his report, which is published elsewhere in this edition of *epi* Information. Subsequent to the President's Report, the Reports of the Secretary General and the Treasurer were also provided to the Council.

The Internal Auditors gave their report. The Treasurer's Report including the 2003 accounts was approved and the Treasurer and the other Board Members discharged.

The next item on the agenda updated the issue of the protection of the title „European Patent Attorney“. According to the decision taken at the last Council meeting, a proposal for amendment of the Regulation on the establishment of the Institute had been sent to the EPO, to introduce the short professional titles: „European patent attorney“, „zugelassener Vertreter vor dem EPA“ and „mandataire européen en brevets“. The paper should be taken up at the next Administrative Council Meeting.

In preparation for the next Council elections in 2005, Mr. Breiter (CH), Mrs. Avenhaus (DE) and Mr. Palágyi (HU) were elected members of the Electoral Committee.

The reports of the Committees were then considered, commencing with the report of the Disciplinary Committee. The main outstanding issue was the ongoing revision of the Regulation on discipline. The Council discussed a new proposal made by Mr. Leherte, Chairman of the Disciplinary Committee and member of the EPO/

epi Working Group. The Council finally decided that the revision of the Regulation on discipline should be pursued along the lines set out in the basic proposal which had been agreed upon at the last Council meeting.

The reports of the Editorial Board, the Committee on biotechnological inventions, the Committee on EPO Finances, the OCC and the *epi* Finance Committee were then submitted to Council. A summary of many of these reports may be found elsewhere in this edition of *epi* Information. The revised terms of reference of the Committees, presented by the By-Laws Committee, were adopted.

The Council subsequently considered the EPPC Report. A position paper on the revision of the European Patent Convention for the entry into force of the Community Patent Regulation was presented to Council who approved the proposed amendments. The latest Draft Directive, issued by the European Parliament, on the patentability of computer-implemented inventions, had not met with the approval of the *epi* on many aspects and the EPPC had therefore prepared a further position paper. This paper was also approved by Council, and both position papers, which are published in this edition as annexes to the EPPC report, will be sent to the relevant bodies.

After this, the report of the Harmonisation Committee was presented to Council. Concerning the issue „Prior Art Effect of International Applications“, Council approved of the EPPC and the Harmonisation Committee preparing a joint position paper.

The Professional Qualifications Committee then reported. The Chairman presented the results of the report on streamlining and modernising the EQE and the recommendations of the PQC. Emphasis is to be put on training, and proposals for amendments of the EQE Regulations were suggested. Council approved sending the paper to the EPO.

The Council then elected a new Board member for Greece, Mrs. Papaconstantinou, and a Board member for Bulgaria, who is Mrs. Tabakova. New members from

Bulgaria were elected to SACEPO and to the Disciplinary Committee. New members from Spain, The Netherlands and Luxembourg were elected to the PQC. A new EPPC member from Austria was also elected. These new appointments are reflected in the last pages of this edition of epi Information.

This topic was then followed by a brief report on the Working Party on Litigation and on the current status of the Community Patent.

The President reported on the CEIPI/*epi* Course on Patent Litigation in Europe. The 1st course has been a success, and it will be terminated with an Oral Examination at the beginning of June. The projected European

IP Academy was again discussed, in the light of a feasibility study carried out by the EPO.

The attention of Council turned to the question of accession of new countries, with Poland having entered the European Patent Organisation on 1 March 2004. Lithuania, Latvia, Malta and Iceland are due to join shortly.

The dates of the next Council meetings were confirmed, with the 57th Council meeting due to take place in Lisbon on 25-26 October 2004, and the 58th Council meeting in Budapest on 9-10 May 2005.

After having warmly thanked the Danish delegates for the very successful organisation of the 56th Council, the President closed the meeting at 13:30.

Draft List of Decisions, 56th Council Meeting, Copenhagen 17–18 May 2004

1. The 2003 accounts were approved, and the Treasurer was discharged from liability.
2. The Board was discharged from liability (no votes against, 1 abstention).
3. Council approved the Budget for the year 2004.
4. Mrs. B. AVENHAUS (DE), Mr. H. BREITER (CH), Mr. T. PALÁGYI (HU) were unanimously elected members of the Electoral Committee for the next 2005 Council election.
5. It will be left to the Chamber handling a disciplinary case to decide whether or not the decision in the relevant case can be published.
6. Council approved that the revision of the Regulation on Discipline should be pursued.
7. Council endorsed the decision taken at the last Council meeting in Cannes (69 votes in favour, 2 against, 15 abstentions), i.e. the Disciplinary Committee should carry on with the revision of the disciplinary rules through the *epi*/EPO working group, along the lines set out in the draft proposal.
8. The revised 1st paragraph of the terms of reference of the Harmonisation Committee should read as follows: „The Harmonisation Committee shall deal with questions concerning the world-wide Harmonisation of Patent Law“.
9. The revised terms of reference of the Committees were adopted with some editorial amendments.
10. With effect from 1 January 2005, the new rates for reimbursement of expenses will be as follows: Hotel: 150 EUR per night; Incidental expenses: 50 EUR per meeting; Meals: 40 EUR per day.
11. The *epi* position paper on the revision of the European Patent Convention for the entry in force of the Community Patent Regulation will be sent to the EPO, to the European Commission, and to national organisations.
12. The *epi* position paper on the patentability of computer-implemented inventions will be sent to the European Parliament, the European Commission, the EPO, and the ICC.
13. The EPPC and the Harmonisation Committee should come to a common view for drafting a position paper about the Prior Art Effect of International Applications.
14. The Report on streamlining and modernizing the EQE, including PQC comments and recommendations will be sent to the EPO.

Compte rendu de la 56ème réunion du Conseil à Copenhague, 17–18 mai 2004

Le Président ouvre la session de la 56ème réunion du Conseil et souhaite la bienvenue aux représentants des 26 pays composant le Conseil ainsi qu'aux observateurs

d'autres pays qui deviendront bientôt membres de l'Institut. Il souhaite ensuite la bienvenue au Directeur Général de l'Office des Brevets danois, M. Kongstad, lequel

présente une allocution sur la question „La Globalisation, un enjeu pour les Offices de brevets“.

A la suite de la désignation des scrutateurs, l'ordre du jour est adopté avec des amendements mineurs, ainsi que le procès-verbal de la 55^{ème} réunion du Conseil. Le rapport oral du Président sur les différentes questions relevant de la réunion précédente est suivi d'un bref compte rendu des recommandations faites par le Bureau depuis la dernière réunion du Conseil. Ensuite le Président présente son rapport, lequel est publié dans ce numéro de epi Information. Suivent ensuite les rapports respectifs du Secrétaire Général et du Trésorier.

La présentation du rapport des Commissaires aux comptes internes est suivie de l'approbation des comptes pour l'exercice 2003. Quitus est ensuite donné au Trésorier et aux autres membres du Bureau.

Le point suivant de l'ordre du jour traite à nouveau de la protection du titre „European Patent Attorney“. Conformément à la décision prise à la dernière réunion du Conseil, une proposition d'amendement au Règlement relatif à la création de l'Institut a été adressée à l'OEB, dans le but d'inscrire dans ledit règlement les titres abrégés suivants: „European patent Attorney“, „zugelassener Vertreter vor dem EPA“ et „mandataire européen en brevets“. Le document devrait être présenté à la prochaine réunion du Conseil d'Administration.

En vue de la prochaine élection au Conseil en 2005, M. Breiter (CH), Mme Avenhaus (DE) et M. Palágyi (HU) sont élus membres de la Commission pour les élections.

Les Commissions présentent ensuite leur rapport. Le rapport de la Commission de Discipline traite principalement de la révision du règlement en matière de discipline, actuellement en cours. Le Conseil débat d'une nouvelle proposition faite par M. Leherste, Président de la Commission et membre du groupe de travail epi/OEB. A l'issue de la discussion, le Conseil réaffirme sa volonté de poursuivre la révision du Règlement en matière de discipline, d'après les principes de base adoptés lors de la réunion précédente du Conseil.

Suivent ensuite les rapports du Comité de Rédaction, de la Commission des Inventions en Biotechnologie, de la Commission des Finances de l'OEB ainsi que ceux de la Commission des Finances de l'epi et de la Commission des Communications en ligne (OCC). Un résumé de la plupart de ces rapports est publié dans ce numéro de epi Information. Le Conseil approuve la version révisée des attributions des commissions, présentée par la Commission du Règlement Intérieur.

La Commission „Pratique du brevet Européen“ (EPPC) présente ensuite son rapport. Une prise de position sur la révision du Brevet Communautaire pour l'entrée en vigueur de la réglementation sur le Brevet Communautaire est présentée au Conseil qui approuve les amendements proposés. En ce qui concerne la récente proposition de Directive du Parlement européen sur la brevetabilité des inventions mises en œuvre par ordina-

teur, l'epi avait indiqué son désaccord au sujet de nombreuses questions. C'est pourquoi l'EPPC avait préparé une seconde prise de position qui est également approuvée par le Conseil. Les deux prises de position seront envoyées aux organismes concernés. Elles sont publiées dans cette édition en tant qu'annexes au rapport de l'EPPC.

Puis la Commission d'Harmonisation présente son rapport. En ce qui concerne la question de „l'effet de l'art antérieur sur les demandes de brevets internationales“, le Conseil approuve qu'une prise de position soit préparée conjointement par l'EPPC et la Commission d'Harmonisation.

Suit ensuite le compte rendu de la Commission de Qualification Professionnelle (PQC). Le Président de la commission présente les résultats de l'étude qui a été réalisée pour déterminer les possibilités de modernisation et de rationalisation de l'examen européen de qualification (EEQ), ainsi que les recommandations faites par le PQC. L'accent est mis particulièrement sur la formation, et des propositions d'amendement au Règlement relatif à l'EEQ sont suggérées. Le Conseil approuve que ce rapport soit envoyé à l'OEB.

Le Conseil élit ensuite deux nouveaux membres du Bureau, Mme Papaconstantinou pour la Grèce, et Mme Tabakova pour la Bulgarie. De nouveaux membres de Bulgarie sont élus au SACEPO et à la Commission de Discipline. Puis sont élus de nouveaux membres du PQC pour l'Espagne, les Pays-Bas et le Luxembourg. Un nouveau membre de l'EPPC est élu pour l'Autriche. Ces nouvelles nominations sont publiées dans les dernières pages de ce numéro de epi Information.

Vient ensuite un bref rapport sur le Groupe de travail „Contentieux“ ainsi que sur le statut actuel du Brevet Communautaire.

Le Président informe le Conseil que le 1^{er} cours CEIPI/epi sur les procédures judiciaires en Europe a été un véritable succès. Le cours se terminera par un examen oral au début du mois de juin. Le projet d'une Académie européenne de la propriété industrielle est de nouveau discuté, à la lumière d'une étude de faisabilité actuellement en cours à l'OEB.

La question de l'entrée des nouveaux pays est ensuite évoquée. La Pologne est devenue membre de l'Organisation européenne le 1^{er} mars 2004. La Lituanie, la Lettonie, Malte et l'Islande doivent suivre dans un avenir proche.

Les dates des prochaines réunions du Conseil sont confirmées. La prochaine réunion du Conseil se tiendra à Lisbonne les 25 et 26 octobre 2004. La réunion suivante aura lieu à Budapest les 9 et 10 mai 2005.

Après avoir remercié chaleureusement la délégation danoise pour l'organisation très réussie de la 56^{ème} réunion du Conseil, le Président clôt la séance à 13.30 heures.

Projet de Liste de décisions, 56ème réunion du Conseil Copenhague, 17–18 May 2004

1. Les comptes pour l'exercice 2003 sont approuvés et quitus est donné au Trésorier.
2. Le Bureau reçoit le quitus (aucun vote contre, une abstention).
3. Le Conseil approuve le budget pour l'année 2004.
4. Mme B. AVENHAUS (DE), M. H. BREITER (CH) et M. T. PALÁGYI (HU) sont élus à l'unanimité membres de la Commission pour les élections, en vue de la prochaine élection du Conseil en 2005.
5. Il revient à la Chambre statuant sur un cas disciplinaire de décider si la décision portant sur ledit cas peut être publiée ou non.
6. Le Conseil approuve que la commission de discipline poursuive la révision du Règlement en matière de discipline.
7. Le Conseil réaffirme son approbation de la décision prise à la dernière réunion du Conseil, par 69 votes en faveur, 2 contre, 15 abstentions, à savoir que la Commission de Discipline doit poursuivre la révision du Règlement en matière de discipline au sein du groupe de travail *epi*/OEB, selon les propositions faites dans son premier rapport.
8. La version révisée du 1er paragraphe des attributions de la Commission d'Harmonisation doit être modifiée comme suit: „La Commission d'Harmonisation est chargée des questions concernant l'harmonisation du Droit des brevets dans le monde“.
9. La version révisée des attributions des Commissions est adoptée avec quelques modifications mineures.
10. A partir du 1er janvier 2005, les nouveaux tarifs de remboursement de frais de séjour seront modifiés comme suit: Hôtel: 150 EUR par nuitée; Faux frais de déplacement: 50 EUR par réunion; Frais de repas: 40 EUR par jour.
11. La prise de position de l'*epi* sur la révision de la Convention sur le brevet européen pour l'entrée en vigueur de la Réglementation du Brevet Communautaire sera envoyée à l'OEB, à la Commission européenne et aux associations nationales.
12. La prise de position de l'*epi* sur la brevetabilité des inventions mises en œuvre par ordinateur sera adressée au Parlement européen, à la Commission européenne, à l'OEB et à la Chambre de Commerce Internationale.
13. La Commission EPPC et la Commission d'Harmonisation prépareront une prise de position commune sur „L'effet de l'art antérieur sur les demandes de brevets internationales“.
14. Le rapport concernant la modernisation et la rationalisation de l'examen européen de qualification, y compris les recommandations faites par la Commission de Qualification Professionnelle (PQC) sera envoyé à l'OEB.

President's Report (covering October 2003 to April 2004)

W. Holzer (AT)

The President reported that the Council meeting in Cannes was followed by a meeting between the labelled members of CIPA and the labelled members of the *epi* Board. The meeting comprised a working session on topics of mutual interest and a dinner hosted by the CIPA. A report is published in the CIPA Journal.

The Administrative Council meeting from October 27 to 30, 2003, was attended by Vice-President Macchetta and the President. Alain Pompidou and Alison Brimelow were elected Presidents, for a three year term each. The Rules relating to fees were adopted, in particular the international search fee was increased to EUR 1550.-, in spite of protests from *epi* and UNICE.

In November 2003, an „International FORUM on the PCT procedure: Recent changes“ took place in the EPO on

November 3 and 4, 2003 on the EPC and PCT developments, in which together with WIPO the *epi* again was a partner in the planning of the event. The FORUM was well attended by about 350 persons. A CD-ROM is available from the EPO International Academy.

The President represented the *epi* at a conference in London, convened by the CIPA and AIPLA in November 2003, on possible harmonisation steps to be taken in the context of the SPLT at WIPO.

Still in November, the EPO had arranged an EQE diploma award ceremony in Munich with 140 out of 340 successful candidates who had taken the EQE in 2003 and who had accepted the EPO's invitation.

Finally, in November the Working Party on Litigation had its meeting attended by the President and the Vice-

President Mercer. The Draft Agreement and the Draft Court Statute were finalised. The next meeting will be held in December 2004 only. In the meantime the remaining political problems should be clarified.

The Administrative Council meeting in December 2003 was covered by the Vice-Presidents and the President. The President of the EPO gave his report and also announced that due to dropping filing figures for biotech and telecommunications the limitation to certain numbers of US applications will be lifted in 2004, not however for computers. The Chairmen and members of the Boards of Appeal and of the Disciplinary Boards of Appeal were appointed/reappointed. A formal mandate was given to the Committee on Patent Law to draw up a basic proposal for revision of the EPC pertaining to the organisational autonomy of the Boards of Appeal.

The President further reported that he attended the CEIPI Board meeting and meetings of a working group on the European IP Academy feasibility study.

In February 2004, the President accepted an invitation from the German Ministry of Justice to participate in a round-table conference at the „Deutsche Richterakademie“ in Trier (DE) on the future developments of the European patent court systems.

Still in February, the Patent Office of the Republic of Poland had invited the President to a conference in Warsaw concerning „Poland and the European Patent Organisation“: he addressed the conference on the role of European patent attorneys before the European Patent Office. In March 2004, the President followed

an invitation from the Lithuanian Patent Office to attend a round-table conference in Vilnius at the occasion of the accession of Lithuania to the European Patent Convention.

In March 2004 a meeting between the *epi* labelled members as well as the chairman of the PQC and the EPO management took place in Munich. The following topics were discussed: Community Patent Regulation, European Patent Litigation, Agreement, European IP Academy, Representation pursuant to Art 163 EPC, Status of the Reform of *epi* Disciplinary Rules, Amendment of Art. 5 of the *epi* Founding Regulations, Independence of EPO Boards of Appeal, the new PCT procedures.

Also in March 2004 Vice-President Mercer and the President attended the Administrative Council meeting in Munich, followed by the Board meeting in Orta. The main issues in the Administrative Council meeting were the accession of Poland, the feasibility study which drew a great number of interventions, but at the end was noted, and the petition of Finland to conclude a partnership agreement with the EPO, in view of the upcoming qualification of Finland as an ISA.

At a seminar organised by the EPO in Malta in April 2004 in preparation of Malta's accession to the EPC, the President explained the *epi* and the principles of representation. Finally, the President attended the CEIPI Symposium „Les Rencontres européennes de la Propriété Industrielle“ in Strasbourg.

Treasurer's Report

P. Kelly (IE)

The auditors have completed their work on the 2003 accounts and have produced audited accounts to 31.12.2003. A copy of the audited accounts to December 31, 2003 is enclosed, together with the relevant 2003 + 2004 budgets.

Based on the annual accounts, the following comments are appropriate, namely;

- 1) The accounts to 31 December 2003 show a surplus of income over expenditure of € 119000.
The budget projected a deficit of € 35966, so that a balance of approximately € 155000 exists between actual and budget.
- 2) Income was € 81818 over budget. This income increase over budget is accounted for primarily by a higher net membership subscriptions income of € 47884, the inclusion of CEIPI registration of € 30548 and non-foreseeable income of € 37879

– less budget shortfalls on interest and educational projects.

- 3) Expenditure is under budget by € 73300. The savings on expenditure are accounted for primarily by Secretariat costs (€ 32761), PQC Project costs (€ 28628) and promotion activity costs (€ 10000).
- 4) Overall expenditure costs for 2003 were € 26450 lower than costs for 2002 – a reduction of 2.36%. Meeting costs as expected were higher in 2003 and while only marginally over budget (€ 5580) were 13.3% (€ 56400) higher than in 2002.
- 5) The balance held of the monies received for the CEIPI Course will be fully expended in 2004. The CEIPI Course will therefore be a break-even position: similarly, the remainder of the PQC Project cost will be payable in 2004.

epi Balance Statement on 31st December 2003

Assets

	€	<u>2002</u> T€
A. Fixed assets		
I. Intangible and tangible assets		
Office machines and equipment, Software	-,51	—
II. Financial assets		
Securities portfolio	<u>1.161.037,46</u>	<u>1.417</u>
	<u>1.161.037,97</u>	<u>1.417</u>
B. Receivables		
I. Others current assets	<u>67.002,00</u>	<u>118</u>
II. Bank & Cash (incl. money deposits)	<u>703.842,81</u>	<u>285</u>
	<u><u>1.931.882,78</u></u>	<u><u>1.820</u></u>

Liabilities

	€	<u>2002</u> T€
A. Net assets		
as of 01.01.2003	1.567.967,99	1.546
results for the year	<u>119.046,06</u>	<u>22</u>
	<u>1.687.014,05</u>	<u>1.568</u>
as of 31.12.2003	<u>1.687.014,05</u>	<u>1.568</u>
B. Debts		
I. Provisions	<u>44.400,00</u>	<u>38</u>
II. Liabilities		
1. Deliveries and services	1.590,18	18
2. Others	168.330,12	196
3. Prepaid fees	<u>30.548,43</u>	<u>—</u>
	<u><u>200.468,73</u></u>	<u><u>214</u></u>
	<u><u>1.931.882,78</u></u>	<u><u>1.820</u></u>

epi Expenses and Income 2003

	Budget 2002	Actual 2002	Budget 2003	Actual 2003	Shortfall in receipts Surplus of expenditure 2003	Surplus of receipts Shortfall in expenditure 2003
	€	€	€	€	€	€
I. Receipts/Income						
1. from Members						
a. Subscriptions (in 2002 incl. late payment increment)	937.500, –	1.032.700, –	1.016.500, –	1.108.950, –	–, –	92.450, –
b. Late payment increment	–, –	–, –	14.00, –	16.850, –	–, –	2.850, –
c. Abandonment of unpaid subscriptions (incl. subscriptions now recovered)	./.	./.	./.	./.	47.416,51	–, –
2. Interests	56.000, –	53.673,75	70.000, –	71.088,66	–, –	1.088,66
3. CPE-Seminars	31.000, –	33.754,02	30.000, –	7.046,42	22.953,58	–, –
4. CEIPI	–, –	–, –	–, –	30.548,43	–, –	30.548,43
5. Others	33.000, –	47.787,49	33.000, –	58.151,58	–, –	25.151,58
	<u>1.036.500, –</u>	<u>1.079.379,22</u>	<u>1.128.500, –</u>	<u>1.210.218,58</u>	<u>70.370,09</u>	<u>152.088,67</u>
II. Expenses						
1. Meetings						
Council	205.000, –	239.660,37	250.000, –	266.636,07	16.636,07	–, –
Board	43.000, –	38.241,23	48.000, –	49.525,12	1.525,12	–, –
Committees	146.000, –	112.731,43	135.000, –	131.237,87	–, –	3.762,13
Delegates & Others	43.500, –	33.534,72	42.000, –	33.180,38	–, –	8.819,62
2. Other performances						
epi Information	62.000, –	55.412,95	63.000, –	66.183,86	3.183,86	–, –
By-Laws & non-foreseeable	2.500, –	–, –	500, –	–, –	–, –	500, –
Promotional Activities (incl. epi-Brochure)	49.000, –	68.391,52	31.000, –	20.027,31	–, –	10.972,69
CPE-Seminars	33.000, –	7.664,25	30.000, –	17.584,37	–, –	12.415,63
CEIPI	–, –	–, –	–, –	13.908,93	–, –	–, –
Project PQC	–, –	–, –	40.000, –	11.371,52	13.908,93	28.628,48
Examination Committee Dinner	7.000, –	1.359,80	4.000, –	2.271,55	–, –	1.728,45
3. President (+ Vice President)	31.000, –	25.125,07	30.000, –	24.866,46	–, –	5.133,54
4. Treasurer and Treasury						
Treasurer and Deputy	6.700, –	7.043,35	7.000, –	4.560,01	–, –	2.439,99
Bookkeeping / Audit	12.700, –	15.843,65	12.000, –	13.945,33	1.945,33	–, –
Bank charges	8.100, –	8.019,54	9.000, –	9.668,10	668,10	–, –
5. Secretariat						
Expenditure on personnel	284.500, –	272.778,24	282.000, –	278.640,87	–, –	3.359,13
Expenditure on materials						
Rent	81.300, –	82.615,35	85.066, –	86.709,03	1.643,03	–, –
Phone, Fax, e-mail	7.700, –	8.539,72	10.000, –	6.126,51	–, –	3.873,49
Postage	33.000, –	26.464,46	30.000, –	20.808,59	–, –	9.191,41
Copy, print	20.000, –	10.380,21	15.000, –	7.383,21	–, –	7.616,79
Office supplies/Representation	10.000, –	12.067,26	15.000, –	12.155,11	–, –	2.844,89
Maintenance/Repair	3.000, –	6.725,18	6.000, –	3.798,69	–, –	2.201,31
Insurances	520, –	933, –	900, –	933, –	33, –	–, –
Secretary General and Deputy	2.600, –	1.352,04	4.000, –	1.968,70	–, –	2.031,30
Travel personnel	1.000, –	746,56	1.000, –	652,29	–, –	347,71
Training	1.000, –	410,80	1.000, –	–, –	–, –	1.000, –
Acquisitions						
Office machines						
incl. Soft-/Hardware	21.000, –	20.002,72	7.000, –	6.667,57	–, –	332,43
Office equipment	2.500, –	–, –	2.000, –	362,07	–, –	1.637,93
6. Extraordinary expenses	–, –	1.260,65	4.000, –	–, –	–, –	4.000, –
	<u>1.117.620, –</u>	<u>1.057.304,09</u>	<u>1.164.466, –</u>	<u>1.091.172,52</u>	<u>39.543,44</u>	<u>112.836,92</u>
III. Surplus of receipts/ expenses	./.	22.045,13	./.	119.046,06	Surplus:	155.0125,06

Report of the Disciplinary Committee

G. Leherste (BE)
Chairman

The revision of the *epi* disciplinary rules seems currently in dead-lock situation.

The comments / proposals for amendments, as raised / approved at the *epi* Council of 20-21 October in Cannes, have been communicated to Mrs Dybdahl on 5 November 2003¹.

These remarks / proposals for amendment are currently being considered within EPO.

A follow up meeting of the ad hoc working group, scheduled for 27 January 2004, was cancelled.

Pursuant to a decision of the *epi* Board to put the issue on the agenda of the Council meeting of 17 – 18 May, a further consultation of the members of the Disciplinary Committee has been organised and the outcome thereof, with further proposals, will be reported to the Council for discussion.

As to current matters of the committee, the following can be reported on the Disciplinary Cases initiated in 2003:

in a decision of 13.8.03 the complaint of case *CD 1/03* was *dismissed* (complaint concerning alleged improper conduct of colleague professional representatives in the course of court actions for unfair competition);

in case *CD 2/03* the complaint was *withdrawn* after a preliminary intervention of the Disciplinary Chamber;

in a decision of 22.10.03 the complaint of case *CD 3/03* was *referred to the Disciplinary Board* (complaint

concerning the non payment of invoices to a professional representative, wherein the person complained against denies the competence of the *epi* disciplinary instances);

in a decision of 27.8.03 the complaint of case *CD 4/03* was *dismissed* (complaint concerning alleged improper conduct of a professional representative in the course of actions before the EPO ; after preliminary intervention of the Disciplinary Chamber the person complained about presented his apologies and the complainant accepted these apologies);

in a decision of 9.12.03 the complaint of case *CD 5/03* was *dismissed* (complaint concerning alleged improper conduct of a professional representative, where the complainant subsequently failed to specify the grounds for the complaint to the Disciplinary Chamber);

in case *CD 6/03* the Disciplinary Chamber is currently still investigating the complaint;

in case *CD 7/03* the complaint was withdrawn after the Registrar of the Disciplinary Committee enquired about the name of the person complained about.

The members of the Committee have furthermore recommended that a summary of all cases decided upon (including decisions to dismiss a case) be published in *epi*-information.

¹ note from the chairman of the committee

actual wording of this communication:

the single first instance disciplinary board should involve more „alternate professional representative members“ so that a proper „rota“ can be organised to keep the burden on each individual professional representative member of the disciplinary board within acceptable limits;

the proposal is to have in total eight members (with adequate balance between private practice and industry), three being designated by „rota“ as „sitting“ members, and the five remaining constituting alternates in sequential rota order (also for the event of „conflict of interest situations“).

in the mandatory mediation stage of the new disciplinary board procedure, there shall (instead of may) be called in a member of the disciplinary committee representing the (each) nationality of the representative(s) involved in the complaint (plaintiff and/or defendants) to assist the mediation and preparation of the case.

there were objections (on legal grounds) against the principle that the members of the executive committee, as sitting members of the disciplinary board, would be involved in the mediation on a specific case and might subsequently have to „judge“ on the same case.

Report of the European Patent Practice Committee (EPPC)

A. Casalonga (FR)
Chairman

The EPPC met on 25 November 2003 in Munich and studied the following items.

I. Meeting of the SACEPO Working Party on EPO Guidelines of 29 September 2003 in Munich

A Standing Committee has been created for future changes in the Guidelines. Three members of the EPPC have been nominated to represent the *epi* within this Standing Committee.

The Guidelines soon will be available in electronic form.

Overlap between EPO and PCT Guidelines will be eliminated.

Regarding Rule 29(2), the comments in the Guidelines have been softened slightly but remain very stringent.

II. International Forum on the PCT procedure: Recent changes of 3-4 November 2003

The following points may be noted:

- The Search fee is increased,
- The refund of the PCT search fee (based on a FR or NL search) is no longer 100% because the EPO has to write an opinion,
- Although a large amount of work is now carried out before the EPO Regional Phase, the refund for the Examination fee is only 50%.

The Patent Offices in ES, SE and AT were carrying out searches for the EPO on applications filed with their respective Offices. From 1 January 2004, these Offices also prepare an International Opinion. It is not clear whether the EPO will accept these Opinions or will carry out a supplementary Opinion (with charge?).

The Finnish Patent Office will become a PCT Searching Authority on 1st July 2004 in all technologies.

It is forecasted that the limitation of searches in the IT and Biotech fields will be withdrawn in July 2004.

III. Question 160: Community Patent Regulation

There had been several changes recently and the EPPC discussed the following points:

- a) *Conversion of a Community Patent into a European Patent:* The period was proposed as 3,6,9,12 or 24 months and this had to be decided. One factor to consider was that the period for filing translations of European Patents was 3 months.
- b) *Double protection:* It was discussed whether a protection in an EPC country by a European patent could be maintained for the same invention when

said invention is already covered by a granted Community patent.

A vote was taken and a slight majority of the EPPC decided in favor of such a possibility of double protection.

- c) *Saisie-contrefaçon on the basis of a pending application:* Some EPPC Members were concerned that „saisie“ could be abused readily: unfettered saisie could lead to the filing of broad claims without merit as part of a hunting/fishing expedition. Those thoughts that the main philosophy of provisional protection was to warn third parties and not to be able to obtain excessive protective measures.

Other Members were more concerned with the problem of disappearing evidence and the need for surprise.

A vote was taken and a clear majority of the EPPC was against the possibility of obtaining an authorization for „saisie-contrefaçon“ on the basis of a pending application.

IV. Question 134 – Second revision of the EPC

Following the discussions of the EPPC, a summary comment paper has been prepared as an *epi* position paper (see annexed document 1).

V. Question 162 – Computer Implemented Inventions

The EPPC discussed the latest draft Directive as modified by the European Parliament and considered this totally unacceptable. It was agreed that comments should be made by *epi*, preferably along the lines of the previous deliberation of the Council of the EU (November 2002). It was agreed to start from the Council's views rather than rebutting each and every amendment from the European Parliament.

The EPPC prepared a position paper (see annexed document 2).

VI. Question 171 – Creation of a European Patent Court

The main purpose is to increase the Independence of the Boards of Appeal. The draft is shortly discussed by the EPPC.

An important aspect is that *epi* members can always retain their right to represent their clients before the new

European Patent Court as is now the case before the Boards of Appeal, for all matters relating to the EPC.

It was observed that the Disciplinary Board of Appeal could be regulated under Article 138(a) EPC 2000 in the future.

The question is to be further discussed at the next CPL meeting.

Annex 1

Revision of the European Patent Convention for the entry into force of the Community Patent Regulation

The *epi* has taken due note of the proposed amendments to the European Patent Convention (EPC) in order to accommodate the Community Patent as published on 25 September 2003 by the Working Party on Intellectual Property (Patents) of the Council of the European Union.

The *epi* welcomes the basic principle of the proposed amendments to the EPC allowing the European Patent Office to receive patent applications and grant Community patents. This will permit to benefit from the present existing European Patent Organization which gives full satisfaction to its users as far as European patents are concerned. This will therefore eliminate the need for creation of a new independent body for filing, examining and granting Community patents.

The *epi* would like to make the following comments on specific points of the proposed amendments.

Article 2 – European patent

The new proposed paragraph 3 states that a European patent granted for the European Community (a „Community patent“) shall within the territory of the European Community have the effect and be subject to the conditions laid down in the provisions adopted in application of the Treaty establishing the European Community („Community law“).

The *epi* considers that the expression „Community law“ used here as well as in several other amended Articles should be more clearly defined as the „Community patent regulation“.

The *epi* considers also that, similar to the situation of a European patent designating a Contracting State according to Article 2, paragraph 2, the „Community patent regulation“ contains provisions and conditions which only apply if no specific provision is contained in the EPC.

- The *epi* would therefore suggest that paragraph 3 be amended to state that the Community patent is subjected to the conditions laid down in the Community patent regulation, *unless otherwise provided in the European Patent Convention*.

VII. Question 170: Collection of chemical structure data in electronic form

A working group was formed with the On-line Communications Committee (OCC) and Members of the EPPC. This group met once and studied the proposal of the EPO.

Article 24a – Consistent interpretation

The *epi*, while recognizing the advantage of obliging the EPO to follow the decisions of the European Court of Justice, has some doubts that this could be adopted as a general principle in the European Patent Convention which would apply also to Contracting States which are not Member States of the European Union.

Article 34 – Voting rights

The *epi* feels somewhat uneasy with the proposed new paragraph 3 since the provisions appear to make the voting of the European Community depending from the situation where one Member State of the European Union expresses a vote or not.

The *epi* wonders whether more balanced voting conditions for each future Contracting Party could not be provided.

Article 39a (new) – Amounts retained by the Organization from renewal fees paid for Community patents

The *epi* considers that the amounts to be paid for renewal fees for Community patents is one of the essential conditions which will greatly influence the users in their choice between the new Community patent and the European patent. The level of renewal fees should be commensurate to the effective charges of the European Patent Office for searching, examining and granting Community patents. In deciding the level of renewal fees, care should be taken to similar situations in other parts of the world, for example before the US Patent Office, and to the size of population in the respective areas.

The *epi* urges therefore the Council to take a well balanced decision relating to the level of renewal fees for Community patents, taking into consideration the legitimate interests of the users and, in such a way, that the final amounts received by the European Patent Organization does not exceed a fair counterpart of the efforts of the EPO to grant Community patents.

Article 59 – Multiple applicants

The *epi* suggests to make clear in the proposed amendment that it is only for Community patents that joint

applicants are compulsory. Two or more applicants having designated different Contracting States which are also Member States of the European Union should clearly remain possible within the frame of the European patent system if said several applicants decide to opt for the European patent instead of the Community patent.

Article 64- Rights conferred by a European patent

The *epi* feels that the proposed amendment introducing the „Community law“ could be better understood if the „Community patent regulation“ would be mentioned instead of the „Community law“ as already suggested for Article 2, paragraph 3.

Article 65 – Translation of the European patent (New paragraph 1a)

The *epi* considers that the proposed amendments should make clear that the absence of requirements for translation by Member States of the European Community provided in the second sentence applies in the case of a double protection obtained for the same invention by the same applicant through both a European patent designating at least one Contracting State which is also a Member State of the European Union and a Community patent.

Concerning Article 65(2), the *epi* notes that all or part of the costs for publication of claims translation for the Community patent could be requested from the patent proprietor. The *epi* is not in favour of such supplemental costs.

Concerning Article 65(3), the *epi* fears that the provisions of Article 122 EPC relating to *restitutio in integrum* could not be applied in case of failure to file in time the requested translations for the Community patent. It is therefore suggested that Article 122 EPC be amended to make clear that it also applies to such a situation so that the Community patent would be in the same situation as the European patent for which national laws usually provide for possibilities of *restitutio in integrum* in case of failure to file in due time a required translation.

Article 65(1) (New) – Conversion of a Community patent into a European patent

The *epi* welcomes this possibility of conversion which is an important request of the users. However, the *epi* notes that specific procedural points have to be clarified particularly concerning possible required translations for the European patent and the deadline for filing such translations. If corresponding provisions cannot be introduced in the Implementing Regulation, they should be provided for example in Article 65(a).

Article 139 – Prior rights of earlier date or the same date (Amended paragraph 2)

This is of utmost importance.

The *epi* is strongly opposed to the provision proposed which would have the result that a Community patent could be declared void for the entire territory of the Community for the sole reason that a national patent application or a national patent with a prior date exists in only one Member State of the European Union. Such a situation would be extremely detrimental and would probably deter most of the users to choose the Community patent system.

The *epi* therefore strongly suggests that specific provisions be introduced to allow for conversion of the Community patent into a European patent designating certain Contracting States of the EPC in the case that such a prior national right is opposed to the validity of the Community patent either during an opposition procedure or before a Court.

Article 153 – The European Patent Office as designated Office or as elected Office

The *epi* considers that amended paragraph 1a should be clarified to state that any European patent application is deemed to automatically designate the European Community from its filing date so as to make it effectively possible within the PCT that the EPO becomes a designated Office for the European Community. Otherwise, the *epi* fears that the European Community not being a „State“, the European Patent Office could not become a designated Office for the European Community.

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The patentability of computer-implemented inventions

epi position on the proposal for a directive of the European Parliament and of the Council

Introduction

1. The *epi* considers that the question of patentability of computer-implemented inventions is particularly important in view of the increasing extent of the use of software in the development of new and innovative industrial activities.
2. The patent system widely used since more than 200 years has proven its usefulness. It relies namely on precisely defined patentability conditions and gives to inventors disclosing true inventions a reward for a limited (20 years) period of time. The long history of the patent system has clearly shown the link between protection of inventions and development of innovation and progress. The patent system is neutral and can be of advantage to small as well as to big enterprises. As a matter of fact, it is essential for all enterprises having a strong R&D organization. It is also one of the rare economic tools offered by the legal environment, which a small enterprise can use to penetrate a market through innovation. And the end-user can only benefit of this eventuality offered to challengers to dispute the position of old players with innovation.
3. The possibility of patent protection for computer-related inventions, which is provided in the present legal European frame is particularly important now that an ever greater number of inventions make use of computer programs in their implementation. This is namely the case not only for the computer and software industry but also for numerous industries such as for example telecommunications, consumer electronics, car industry, transportation industry, domestic appliances, medical instrumentation, machine tools, chemical process engineering, gene technology and proteomics.
4. Weakening patent protection and enforcement possibilities of computer-related inventions in Europe would therefore be highly detrimental for a very large sector of the industry. It would also be detrimental for the European software industry, including small software development companies, which is frequently unaware of the patent protection possibilities but can nonetheless be borrowed by attacks based on copyrights that are, contrary to patents, based on highly undefined, usually unpublished and secret source codes, protected for an extremely long duration (at least 70 years).
5. The *epi* considers that many of the amendments adopted by the European Parliament in September 2003 to the draft directive prepared by the Commission, would change on many aspects, the present legal situation of patent protection in Europe in the field of computer-related inventions, as defined particularly by the jurisprudence of the Boards of Appeal of the European patent office. This would be contrary to one of the aims of the directive, which is only to clarify the present situation along the lines of the present practice. Some of the proposed amendments would also be contrary to the provisions of the TRIPs agreement and would place the European Union in a completely awkward position toward the rest of the world.
6. Development of the European industrial innovation, including in the software field, requires more awareness of the patent system and not weakening provisions.
7. The *epi* welcomes the position taken by the Council Working Party on IP (patents) dated 29 January 2004 and further amended on 17 March 2004 which constitutes a step in the right direction but wishes nevertheless to make the following comments.

Specific comments on the amendments voted by the EU Parliament

8. *Definitions (Article 2)*

- 8.1 The amendments made in the definition of „computer-implemented inventions“ in Article 2, point (a) are confusing. This definition should not be mixed with questions of novelty. The *epi* suggests reverting to Article 2 (a) adopted in the common approach of the competitiveness Council dated 8 November 2002.
- 8.2 The statements in amended Article 2, point (b), concerning the „technical contribution“ according to which said technical contribution would be „one of the four requirements for patentability“, would be „the invention“ and would therefore have to be non obvious, are not in line with the long established practice and jurisprudence of the EPO as well as the national courts. The *epi* considers those amendments unacceptable.
- 8.3 A technical contribution should be understood as a novel technical effect not present in the prior

art. This concept can be used for assessing whether a claim defines an „invention“ according to Article 52 EPC. A technical contribution is not required to be non obvious.

- 8.4 The statements in Article 2, point (ba), according to which in a „technical field“ „controllable forces of nature“ would achieve „predictable results“, introduce unreliable concepts, which have been abandoned in the patent law since many years. The *epi* considers this as dangerous for legal certainty and therefore unacceptable.

- 8.5 The definition of „industry“ given in Article 2, point (bb) is not the correct definition usually adopted in the patent law. Industry cannot be limited to „automated production of material goods“. On the contrary, patents are granted for many other achievements, which are within industry, such as for example, manual tools or devices, agricultural products, cosmetic compositions and processes, medicaments, etc...

9. *Data processing (Article 3a)*

The *epi* considers that the term „data“ can cover many different aspects such as images (as stated in the decision T 208/84 Vicom), sounds, results of measurements, etc ...

Data processing could therefore control a technical process or be part of a technical process. In fact a „data processing“ is nothing else than a „computer program“. It should not be treated differently.

The *epi* suggests cancellation of Article 3a.

10. *Inventive step (Article 4)*

- 10.1 One of the basic principles of assessment of inventive step is that the claim must be considered „as a whole“. This means that all features recited in a claim, technical features as well as non-technical features, must all be taken into consideration for assessing inventive step.

- 10.2 The inventive step is defined in the EPC on the basis of non-obviousness and with regard to the skilled person. The „technical contribution“ is not a requirement for inventive step. The assessment of inventive step should not be mixed with the determination of whether a claim defines an invention or not.

- 10.3 The method proposed for assessing the „technical contribution“ is somewhat confusing. The *epi* suggests reverting to the wording of Article 2 (b) of the common approach.

- 10.4 The test proposed in Article 4 §3a is unclear and mixes novelty aspects with undefined „controllable forces of nature“. It should be cancelled.

11. *Exclusions from patentability (Articles 4a and 4b)*

The *epi* considers Article 4b unacceptable. Inventions „improving efficiency in the use of resources within a data processing system“ are in fact particularly important inventions, which the *epi* regards as clearly patentable inventions. This

could for example be the case with an invention making the operation of a computer faster. The means for obtaining such a result can constitute a patentable invention.

12. *Form of claims (Article 5, paragraphs 1 and 1a)*

If a computer-implemented invention is considered to be patentable, the form of the claims should be left to the applicant. There is no reason to forbid claims directed to a computer program on a carrier as long as the claims include the technical contribution and the patent makes clear that the computer program loaded and executed in a computer solves the technical problem disclosed in the patent.

The *epi* therefore suggests cancelling Article 5, paragraph 1a and reverting to Article 5-1 and 5-2 of the common approach.

13. *Infringement (Articles 5, paragraphs 1b, 1c and 1d)*

- 13.1 Article 5, paragraph 1b would render any patent in the field of television systems or telecommunications unenforceable even if it claims a patentable invention. This is completely unacceptable. The *epi* suggests cancelling Article 5, paragraph 1b entirely.

- 13.2 Article 5, paragraph 1c gives the false impression of defining an exceptional situation of exclusion from the scope of a patent. It should preferably be cancelled since it adds nothing to the usual patent scope interpretation.

- 13.3 Article 5, paragraph 1d introduces an unacceptable obligation to disclose source codes of a program without any licensing terms. The *epi* considers it not necessary to include in the description of a patent claiming a computer-implemented invention, a complete „documented reference implementation“ as well as a complete source code of a program used in the invention. This would lead to excessively long descriptions and is contrary to the relevant provisions of the PCT and the TRIPs agreement. The applicant should be left free to decide what to include in the description so that the invention can be carried out by the person skilled in the art.

14. *Use of patented techniques (Article 6a)*

The *epi* considers unacceptable to state that patent covering inventions „ensuring conversion of conventions used in two different computer systems or networks to communicate and exchange data“ would be definitely unenforceable.

The *epi* is of the opinion that the community competition law should rather be applied in such cases, for example in situations of abuse of a dominant position.

In specific cases, compulsory licenses could be provided along the provisions of the TRIPs agreement.

The *epi* suggests therefore cancelling entirely Article 6a.

15. *Reports on the effects of the Directive (Article 8)*
- 15.1 The *epi* is not in favor of a „grace period“ for filing patent applications in view of the numerous complications and legal uncertainty that this would imply. The *epi* suggests therefore cancelling Article 8, point (cb) since there is no sensible reason to treat the computer-implemented inventions in a different way than inventions belonging to other fields.
- 15.2 The provisions recited in Article 8, point (cc) relate to the Community patent and the consequent revision of the EPC. Such provisions do not belong to the concerned Directive. The *epi* suggests therefore cancelling Article 8, point (cc).
- 15.3 The provisions recited in Article 8, point (ce) relate to the organization of the EPO. Such provisions do not belong to the concerned Directive. The *epi* suggests therefore cancelling Article 8, point (ce).
- 15.4 The *epi* suggests therefore cancelling Article 8, point (cf) and Article 8, point (cg) since they relate mainly to provisions of Article 6a, which the *epi* has suggested to cancel.

Report of the Harmonisation Committee

F. Leyder (BE)
Chairman

1. The Harmonisation Committee follows the work of the Standing Committee on the Law of Patents (SCP) in the framework of WIPO.
2. There had been no meeting of SCP for about a year, whereas it used to meet twice a year. The one-year break was motivated by a relative blockage in the negotiations: it was felt that no significant progress could be made. Activity was intense outside SCP. *epi* was involved in the following events.
3. On 10-11 November 2003, the American Intellectual Property Law Association (AIPLA) and the Chartered Institute of Patent Agents (CIPA) organised a Roundtable of non-governmental organisations (NGOs) on Patent Law Harmonization in London. The President of *epi* attended the meeting. All documents may be found on the AIPLA website: http://www.aipla.org/Content/NavigationMenu/IP_Issues_and_Advocacy/NGO_Roundtable/Roundtable_of_NGOs-Nov_2003.htm
4. On 29-30 January 2004, I represented *epi* at a seminar organised by AIPPI to present their views on how to proceed with the discussions in WIPO (SCP), including what should be discussed first (the so-called „reduced package“) and what should be postponed. A delegation of many States and NGO's attended the seminar, organised in the WIPO building. The documents, including the conclusions of the seminar, are available on the AIPPI website: http://www.aippi.org/splt/splt_index.html.
5. In preparation for the session of the SCP, AIPPI in coordination and cooperation with AIPLA and FICPI had invited *epi* to an NGO Assembly that took place on 9 May 2004. The President of *epi* and John Brown attended the meeting.
6. During the past year, John Brown and/or I represented *epi* for those parts of three meetings of the Committee on Patent Law that dealt with harmonisation within the framework of WIPO. The last meeting was called to discuss the result of the trilateral (EP, US, JP) consultations on harmonisation. The joint proposal is posted on the WIPO website (document SCP/10/9).
7. On 26 February 2004, the Harmonisation Committee met in the *epi* Secretariat. I am pleased to report that all full members were present.
 - (i) The Committee reviewed the latest proposal for a SPLT, available from the WIPO website http://www.wipo.int/documents/en/document/scp_ce/index_10.html and advised the delegates nominated by the President for the 10th SCP meeting.
 - (ii) The Committee also reviewed the Terms of Reference as proposed, and noted that they still do not correspond to our mission: Council asked us e.g. to follow international harmonisation in the framework of WTO, and we accordingly suggested to remove the reference to WIPO in the first paragraph.
 - (iii) Finally, we unanimously adopted a text supporting our position regarding the desired prior art effect of PCT applications in the international phase within the context of worldwide harmonisation. This text was requested during the last Council meeting, and has been passed to the Council and to EPPC and the Biotech Committee.
8. The 10th session of the SCP was held in Geneva from 10 to 14 May 2004, after a break of about one year. John Brown and the undersigned represented *epi*. Day 1 was spent arguing about the scope of the discussions. At the end of the day, the Chairman

concluded that SCP was unlikely to reach a consensus on a reduced package, and whether or not traditional knowledge and genetic resources should be included in the discussions. He said that there is an impasse on these two issues, which would need to be decided by the WIPO Assembly because a vote in SCP could have a negative effect on cooperation. He then suggested reviewing the proposal, starting with Art. 8. Some countries immediately objected, asking whether and when traditional knowledge and genetic resources would be discussed. The Chairman finally suggested discussing these in the last half-day. During the next three days, SCP worked unusually slowly. In the end, only draft Art. 8 to 12 out of 16 were reviewed, together with the corresponding regulations. Just a few paragraphs were provisionally accepted. The last half-day was actually spent discussing future work in the SCP. Again, no consensus could be reached, even on the chairman's conclusion that there was no agreement. The matter will thus in principle be before

the WIPO Assembly in September, which will have to decide the future of SCP.

9. In view of the outcome of the SCP meeting, our draft position paper was not discussed during the Council meeting. From the report of EPPC, it appeared that there had been a vote in EPPC regarding the desired prior art effect of PCT applications in the international phase. The discussions in SCP on this point revealed continuing disagreement, with a tendency towards international applications being taken into account without the need to enter the national phase. EPPC and the Harmonisation Committee have been asked by Council to further consider the matter.
10. Council has amended the Terms of Reference of the Harmonisation Committee, in particular by deleting the limiting reference to WIPO. Indeed, the outcome of the SCP meeting of last week shows that negotiations (if any) towards international harmonisation could possibly move away from WIPO, at least for a while.

Report of the Online Communications Committee (OCC) (covering October 2003 – May 2004)

D. K. Speiser (DE)
Chairman

Since reporting to Council last October the Online Communications Committee and the EPPC were involved in the formation of a task group comprising members of the OCC and EPPC to discuss with the European Patent Office questions of the „collection of chemical structure data in electronic form“. The EPO was informed on 5 February 2004 of the names of nine epi members who are prepared to participate in the respective discussions with the EPO. On 13 April 2004 the task force met with members of the EPO in the Hague. A report is provided as annex 1 to this report.

Since the last Council meeting the members of the OCC started to look into the forthcoming new XML-format for application documents.

The new XML format was designed to allow automatic processing of documents containing text and other data. XML is short for **Extensible Markup Language**. In the patent profession forms and documents of any kind such as application forms, naming of inventor forms, patent descriptions and claims, selections of bibliographic data, office actions, submissions, fee sheets etc can be drawn up in the XML format and can subsequently be exchanged between applicants and patent offices with the advantage of allowing automated processing of such documents. When taking a complete patent application as an example being submitted online to a patent office

in the XML format every single element within this application such as each name or the title of the invention or the usual parts of the description or each designated country etc is machine readable and is entered into the computer system of the office automatically. Obviously, this is a cost saving approach but it also avoids errors because none of the elements of the patent application need to be entered into the computer manually.

The applicants also can benefit from the XML format when receiving online or as an email attachment an XML coded document from the patent office; if their patent management system is designed to deal with XML input, serial numbers and filing dates can be entered automatically into their system or terms for answering office actions (if such actions are received online in XML) or the bibliographic data of an application or patent obtained online from the register of the office.

Generating documents in the XML format is simple because this is done under the control of a program or even simpler by means of templates. However, before exchanging documents in the XML format the parties must agree on certain standards. Over the past few years standards for IP documents were developed by WIPO and are contained in „Annex F“ of the „Administrative Instructions under the PCT“. Details are available from

the WIPO website: www.wipo.int/pct/en/texts/pdf/ai_01_part7.pdf.

For the time being the use of the XML format for filing European and PCT-patent applications is optional. It is obligatory when online filing national German patent applications. WIPO as an incentive introduced a new schedule of fees providing for a reduction of the official filing fee for PCT-applications if such applications are filed using the XML-format. The savings vis-à-vis paper filing PCT-applications is EUR 193,- for XML-filings and EUR 129,- for PDF-filings. The EPO also intends to reduce its filing fee for online applications. Effective 1 April 2004 the fee for online applications was reduced by € 35. From 1 January 2005 the fee for paper filings will go up by € 35 so that the incentive for using the online filing system will be € 70.

For drafting and preparing descriptions and claims in the XML-format the European Patent Office offers a program named „PatXML“ which program is being tested by OCC members. It is not yet perfect but promising.

On 8 March 2004 the OCC had a further meeting in the Hague with EPO vice president Edfjäll and his collaborators from the *epoline* team.

XML was a major topic of the discussions. The EPO pointed out that presently there are two XML-variants in use of which one is Annex F compliant while the other variant in the name of Patras-XML is only similar to the Annex F standard. Patras XML is used by the German PTO and will be adapted to the full Annex F standard in the not too distant future. WIPO and EPO have agreed on the Annex F standard and the US PTO is likely to follow. It is not difficult to foresee that the Annex F standard in the end will be accepted worldwide. The result will be that an application prepared in the Annex F compliant XML-format can be used to file in all countries.

Regarding the *epoline* software of the European Patent Office and the relatively frequent updates the OCC addressed the problem that such updates might involve changes in the interface between the *epoline* software and the patent management systems of the users resulting in unforeseeable breakdown. The EPO, therefore, was requested to provide information when distributing updates on possible changes within the interface so that the software developers of the patent management systems can adjust their software in time. According to the EPO all updates are tested before they are released but the EPO cannot exempt the users and the software developers from performing their own tests.

The EPO is about to set up a forum for active test users which will be in addition to the existing *epoline* forum.

Test users who are willing to test alpha and beta versions of the software and are prepared to give feedback within a few days or weeks can be registered by the EPO. The office is looking for 10 – 30 persons. Volunteers are invited to join.

In contrast to the intended test user forum the *epoline* forum has some 160 participants. The forum contains interesting information on various *epoline* products such

as online filing or online file inspection etc. For further information see

www.epoline.org/epoline?language=EN&page=forum.

The number of users of the online filing system of the EPO is increasing steadily and one can expect that the reduced filing fee will result in a further increase of the numbers of filings. Online communications will be expanded in the next year to the sending of search reports to the applicants. These search reports are intended to be in the XML-format. A recent improvement is the availability of secret online file inspection requiring a smart card for identifying the person intending to inspect a file.

Another improvement will be the availability of data from the EPO register in the XML-format. While the German PTO was the first to provide for download the data from the German register in XML the EPO intends to follow before the end of the current year.

Another topic of the discussion of the OCC with the EPO was the availability of online fee payment which was opened a while ago and functions to the satisfaction of many users. The OCC suggested to display the users account with payments made for more than the last month and the EPO agreed to expand the time period displayed from 30 to 60 days. This change is intended to take effect in mid 2004.

Another proposal of the OCC was to make available on-screen all payments made with respect to an application over its entire lifetime. The EPO was not enthusiastic about this proposal but promised to look into it.

Presently, the user's accounts can only be viewed via the ONLINE FEE PAYMENT button of the *epoline* homepage. For identification purposes the users need a smart card for accessing their account. The OCC suggested to allow downloading of the deposit account preferably in XML-format so as to obtain the possibility of directly feeding the information about transactions into the user's accounting system. The EPO agreed to provide a downloading possibility so that we can look forward to it.

Prompted by some epi members the OCC addressed the question of availability of the *epoline* software for non-windows platforms such as Unix or Linux. According to the EPO less than 5% of the potential users of the online filing system use non-windows platforms. For this reason the EPO takes the position that most of its resources will have to go into the support of users with windows platforms but the EPO will provide „a limited support“ for the 5% of users with non-windows platforms. In practice this will mean that the EPO will provide documentation and source code for willing contributors under an open-source agreement. One difficulty in this context according to the EPO might be the question of the digital signature.

The next meeting between EPO and OCC was scheduled for 18 October 2004 and the epi membership is invited to contact the OCC with questions requiring a discussion with the office.

Report of the Task Force „Collection of Chemical Structure Data in Electronic Form“ (covering October 2003 – May 2004)

H. Sendrowski (DE)

The European Patent Office plans to implement means for standardisation of the presentation of organic chemical compound structure data filed in computer readable form. To discuss possible ways of implementation, the EPO invited the epi council last fall to participate in corresponding discussions. The epi Council requested the Online Communications Committee and the EPPC to form a task group comprising members of the OCC and EPPC. The EPO was informed on 5 February 2004 of the names of nine epi members who are prepared to participate in the respective discussions with the EPO. On 13 April 2004 the task force met with members of the EPO in the Hague.

The reason for the Office's move for standardisation is that search examiners frequently encounter patent applications comprising huge lists of chemical compounds, some of which falling under the scope of the claims. For a number of reasons it is cumbersome for a search examiner to search all of these compounds: Predominantly, chemical compounds are not always referenced exactly the same way. Even if a substance is not called by a trivial name or trade name, variations arise for example by different punctuation. The ambiguity of chemical compound names has so far also prevented the Office from automatically extracting compound names from application documents and from setting up a database of compound names to assist its search examiners. At present, a search examiner effectively cannot search for each compound cited in a patent application but has to pick some compounds based on his search expertise, until the application is indexed by chemical database providers which is well after 18 months after the respective first filing date.

To ameliorate these shortcomings and thus improve the quality of its searches, the EPO has been considering means for standardisation of the presentation of organic chemical compound structure data filed in computer readable form. Such standards, once implemented, would allow the Office to unambiguously identify a chemical compound, to obtain a graphic representation of the compound's structure and to perform an efficient and exhaustive search. The Office plans to establish a database of the standardised compound data for internal use, and also plans to provide the data free of charge to the general public and to chemical database providers. However, the Office will not establish a publicly searchable compounds database; the rationale being that this is neither the Office's statutory business nor a field in which the Office could excel compared to commercial database providers.

In a first step, the Office's efforts are exclusively focused on specifically disclosed organic compounds, these being only those substances of defined chemical structure comprising one or more carbon atoms and one or more hydrogen or halogen atoms, and wherein every atomic node corresponds to a single atom of the periodic table of elements and every bond between these nodes can be represented as being specifically either a single bond, a double bond or a triple bond. Furthermore, compounds comprising more than 300 non-carbon atoms are also excluded from the current efforts. Also excluded from the present efforts are nucleic acid and amino acid sequence listings under WIPO standard ST. 25.

It is to be noted that the Office in no way intends to limit applicants' right to claim non-well-defined chemical substances, e.g. polymers, Markush-type groups and substances comprising references to classes like alkyl, aryl etc. It is left to the applicant to decide whether or not to specifically disclose an organic compound, but once such compound is specifically disclosed the Office wants to be in a position to perform an efficient search on this substance.

The chemical compound structure data shall be represented in an XML format according the CML standard (<http://www.xml-cml.org>). The XML data of all respective compounds of a patent application shall be placed in a single chemical structure file (CSF) placed at the end of the application. The chemical structure file will form an integral part of the description if filed together with the other application documents. Handling and regulations applicable to the CSF shall parallel those pertaining to nucleic acid and amino acid sequence data files.

So far, the Office has developed two prototypes to assist applicants in creating chemical structure files. The prototypes have similar functionality; the first prototype is a standalone application comparable to the electronic tool for online filing of patent applications, the other prototype is a collection of Microsoft Word macros.

Use of the prototypes is rather straightforward. The program collects all relevant data concerning the applicant and application name. Chemical compound names can be cut-and-pasted directly into a patent application's compound list from a Microsoft Word or ASCII document, or they can be semi-automatically extracted from an application text. The prototypes come along with a small predefined database of IUPAC and trivial compound names, accompanied by the respective structure data. Users may add further names and structure data to their personal database. The prototypes come along with

import facilities for importing chemical structures from two frequently used drawing tools (ISISdraw, Chem-Draw). A further way of adding compound structures is via a small built-in structure editor. The editor also allows modifying chemical structures already entered into the application's compound list. The prototypes perform plausibility checks on each compound structure of the compound list and notify of any inconsistencies. If all tests are passed, the prototypes create the chemical structure file.

At present, only the standalone prototype is advanced enough for alpha testing. Volunteers who are willing to test this prototype and to give feedback within a couple of weeks' time can be registered at the EPO (for registration, please contact Mr. Geert Pauwels, gpauwels@epo.org, or Mr. Stefan Härtinger, shaertinger@epo.org).

A number of questions arising from the Office's standardisation efforts have been discussed at said meeting. The benefit for applicants had been under discussion, with particular consideration to the Office's intention to offer the compound data obtained from the work of applicants to commercial database providers. The EPO explained that applicants will benefit from the improved search quality. Furthermore, the electronic format will facilitate publishing chemical structure graphics and allow the exchange of compound structural data in electronic form. The Office emphasised that, since all data would be published electronically along with the other application contents, the data will be available as such to the general public free of charge (albeit not in a searchable form). Applicants and particularly volunteers are invited to submit further suggestions how filing of organic chemical compound structure data could benefit their work. For example, the structure files may be made to comprise an indication whether or not a compound falls under the scope of a claim. Applicants would then have an additional security feature of not overlooking an interesting compound at the stage of claim drafting, and general public would benefit from obtaining a clear indication of the claims' scope of protection.

Further questions related to the problem how differences between the description, examples and claims section of a patent application on the one hand and the chemical structure file on the other hand should be resolved. The EPO explained that it is for the time being intended to treat chemical structure files in a manner corresponding to sequence protocols; the chemical structure file shall not replace the written description.

Another topic of the discussion was that an applicant's competitors would considerably benefit by the enhanced public access possibilities, rendering any chemical patent more vulnerable to oppositions and unfair data extraction. The Office explained that at some time it could become obligatory for all applicants to submit chemical structure files, thereby levelling out any disadvantages encountered by applicants that voluntarily comply to the filing standard. All competitors would then have the same burden imposed and obtain the same benefits.

In this context it had been observed that voluntary filing of chemical structure files would only become widespread practice if there were a financial compensation for the additional work completed by the applicants and their representatives. However, the Office explained that the budget leaves no room whatsoever for a fee reduction.

It was also discussed if the extraction of compound structure data has to be performed by the applicants at all, or if the extraction could not be performed by a commercial database provider for the EPO. After all, the respective database provider would gain access to valuable data way ahead of their publication; this might be an incentive for a prospective database provider to offer his services to the Office at a nominal fee. However, the Office was not too optimistic to find a database provider who would guarantee such services at low costs.

The next meeting between the EPO and the task force was scheduled for 19 October 2004. The epi membership is invited to contact the task force with questions and suggestions for further discussion with the Office.

Report of the Professional Qualification Committee (PQC)

T. Onn (SE)
Chairman

1. Students of the epi

Today we have 355 students from 16 countries. 26 of the students have registered this year.

Further the Guidelines for training to the EQE have recently been revised by the PQC and will be distributed to the students.

2. epi Tutorials

7 June 2004 is the last date for enrolment to the summer Tutorials (comprising papers A & B of 2002 and 2003) and 11 October 2004 to the autumn Tutorials (comprising papers C & D of 2002 and 2003).

An invitation to the Tutorials has been published in *epi* Information 1/2004 and on the *epi* homepage.

3. Tutors' meeting

The annual tutors' meeting was held on 13 November 2003. Chairmen/secretaries from Examination committees I, II and III had accepted our invitation and so had a number of *epi* tutors. Representatives from CEIPI were also present.

As usual the meeting started with the presentation of the EQE statistics for 2003. The figures revealed a continued acceptable passing rate for papers A and B and an encouraging result for paper D. However paper C showed an all time low passing rate decreasing the total passing rate to about 30 %. Thus the hope nourished that the good result of paper C in 2002 should not result in more difficult papers in 2003 ended in a disappointment.

Thereafter all the individual papers were discussed. The tutors were well prepared for the discussions as they before the meeting had received the papers of 2003 together with the Examiner's report. This resulted in a most efficient and constructive meeting.

4. EQE 2004

This year 1821 candidates had enrolled to sit the EQE, which took place on 24-26 March.

The EQE 2004 papers as well as the Compendia from 1990-2003 are available on the web site <http://eqe.european-patent-office.org/site/compendium>

5. EQE 2005

EQE 2005 will take place on 8-10 March. EPO has informed about a change concerning the date for enrolment: Last date for enrolment for first sitters is 30 July 2004 and for re-sitters 15 November 2004.

6. Continuing Professional Education (CPE)

A CPE seminar on the topic Oral proceedings at the EPO was held in Stockholm on 5 April 2004. About 70 persons participated and the seminar was much appreciated by the audience.

Further seminars on Mock Oral Proceedings and on the Amendments of

7. Joint meeting PQC/Examination Board

The joint meeting took place in Madrid in the afternoon of 20 April 2004. In the morning that day PQC had a meeting with some tutors to discuss EQE 2004 and prepare for the joint meeting. Revised Training Guidelines for the students of *epi* were also finally adopted.

The present Examination Secretariat works very efficiently and distributed the EQE 2004 papers to the PQC on the first working day after the examination. This was much appreciated by the PQC members who got plenty

of time to study the papers before the joint meeting. During this meeting the EQE papers of this year were discussed and those of last year briefly commented. Feedback from candidates was also presented to the Board. The Examination Board then presented some ideas on how to change the EQE and we had a vivid discussion (see also the annex to this report about the Streamlining and modernizing the EQE).

8. Streamlining and modernizing the EQE

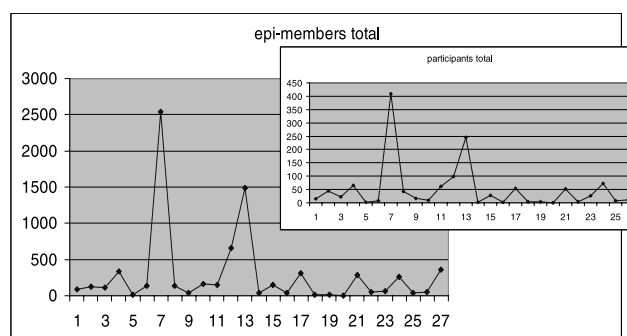
Sitting the EQE is quite a frustrating effort for the candidates. A further stress factor is the six months wait for the results. It is very desirable to diminish this stress as it obviously has a negative impact on the candidates' daily work as well as on their performance when sitting the EQE. PQC has for three consecutive years made a survey on the results of the EQE and their underlying causes. The PQC surveys were addressed to the candidates sitting the EQE. Two statistically relevant factors were found: ¹⁾the existence/absence of a national examination and ²⁾the language. Also time pressure is a stress factor to be mentioned.

The PQC has been given the task to present proposals on how to modernize the EQE. In addition to the earlier reports from PQC and in order to obtain an unbiased external view of the situation the *epi* Council in Ghent kindly approved our request to contact Professor Herrmann from the University of Ulm to make a survey on this matter.

In response to this request Professor Herrmann made a survey on this matter based on an inquiry addressed to the *epi* members. Thus the *epi* members with an e-mail address in the *epi*/EPO registers (about 3800) received an invitation to answer a website questionnaire. The answers to the questionnaire given by the *epi* members resulted in a voluminous amount of statistics.

When comparing the results of all these inquiries Professor Herrmann states that the PQC report in *epi* Information 2/2003 „has reached findings and conclusions analogous to those evident from the comments in the present survey“.

The country distribution of the respondents of his survey matches the country distribution of the total number of *epi* members quite well as is evident from the diagrams below.



The actual figures are as follows:

	EPI members		Participants	
	total	%	total	%
AT	88	1.15	14	0.92
BE	124	1.62	44	2.89
BG	113	1.48	23	1.51
CH	331	4.34	66	4.34
CY	15	0.2	1	0.07
CZ	136	1.78	8	0.53
DE	2545	33.33	409	26.87
DK	137	1.79	43	2.83
EE	32	0.42	16	1.05
ES	157	2.06	10	0.66
FI	153	2	61	4.01
FR	662	8.67	98	6.44
GB	1491	19.53	245	16.1
GR	33	0.43	2	0.13
HU	150	1.96	28	1.84
IE	34	0.45	1	0.07
IT	308	4.03	54	3.55
LI	10	0.13	4	0.26
LU	17	0.22	4	0.26
MC	3	0.04	0	0
NL	287	3.76	52	3.42
PT	46	0.6	4	0.26
RO	65	0.85	26	1.71
SE	257	3.37	73	4.8
SI	33	0.43	8	0.53
SK	51	0.61	12	0.79
TR	357	4.68	30	1.97
unknown			186	12.22
	7,635		1,522	

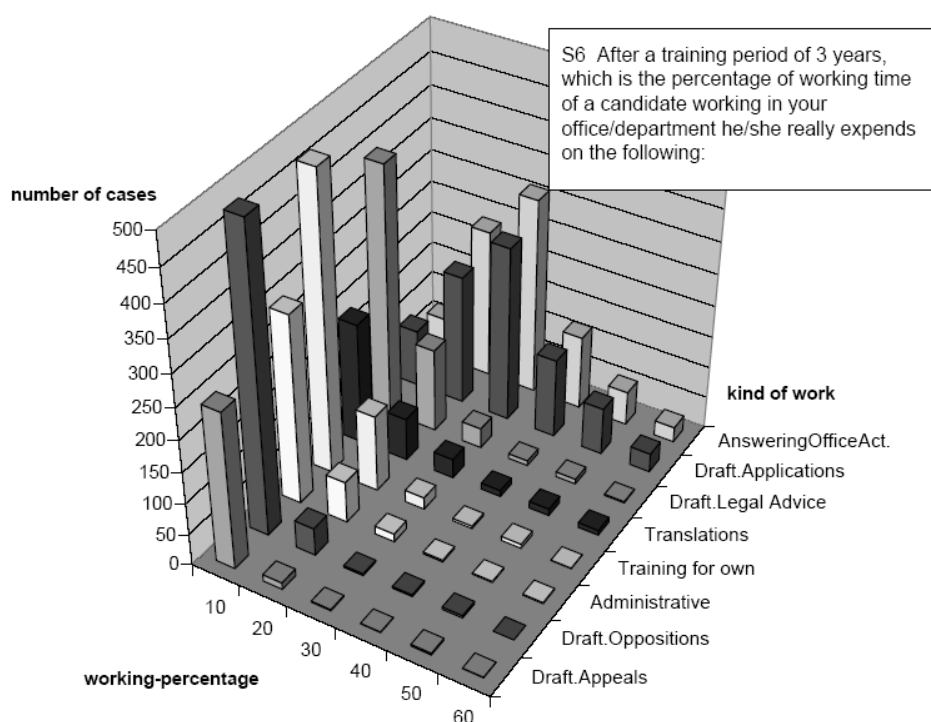
(Prof. Herrmann)

Another reason for doing all these inquiries is that a decade ago the EQE passing rate for first sitters was around 45-50 %. In 2003 it had dropped to about 30%. A look at the individual papers reveals that papers A and B have had acceptable average passing rates throughout the years. Papers C and D have been the difficult ones showing severely varying passing rates and in order to overcome this, more time has been given for papers C and D. In addition to this there has been a split of paper D into DI and DII. The latter change has led to an increased passing rate of paper D to an acceptable level.

The passing rates for the candidates exhibit important variations between the different member states. They show that candidates from the three big countries France, Germany and Great Britain have a higher passing rate than candidates from many other member states. This is probably due to several factors among which the language and the national training and examination systems can be mentioned. A number of new member states have joined the EPC system lately and they will probably have the same problem with training and education as the other member states. Therefore there is an urgent need to identify the factors which have an adverse effect on the passing rates and to find measures with which the passing rates may be improved. Possible measures are change and improvement in the training as well as the examination systems.

Candidates' background

Not surprisingly, Prof. Herrmann, when charting the general background of the candidates for the EQE from the answers of his survey, found that the main field of working is drafting and prosecuting patent applications in the national, PCT or EPC routes. The respondents have also indicated that opinions on patentability and



(Prof. Herrmann)

infringement, legal advice, drafting oppositions and appeals have high priority in their everyday work.

As to the above mentioned priorities, the answers from the respondents are contradictory as they indicate that after three years of training a candidate still works mostly in then field of drafting and prosecuting applications and spends very little time on oppositions, appeals and legal advice. However, it is interesting to see from the results of the survey that on the one hand it is deemed desirable by most of the *epi* members that candidates are competent to draft oppositions and appeals but that the percentage of work in this field is only in the lower range. This is consistent with the general workload of registered patent attorneys where far more working time is spent on drafting and prosecuting patent applications than oppositions lodged. Moreover, the number of oppositions seems to be highly dependant from the technical field.

Considering this it is understandable that papers C and D are stumbling-blocks to many candidates as there seems to be a shortage of in-the-job training possibilities concerning oppositions and legal advice. This becomes even more evident when looking at the answers from some countries not having one of the official languages as their mother tongue. From their answers it can be seen that more of the working time is spent on doing translations than on the basic work on drafting and prosecution. No or practically no time is spent on oppositions or legal advice (it is assumed that the respondents have interpreted the expression „legal advice“ in the sense of counseling work like that tested in paper DII).

In respect of the language question it has also been recognized that there is a need to improve the knowledge in language skills by more training. However it will take a long time before the training will yield desirable levels of skill in all member countries. Meanwhile the compromise presently existing on the examination regulations that a candidate may answer in his/her own mother tongue must be maintained.

Further, some of the countries not having any of the official languages of the EPO as a mother tongue have a low R&D activity. In these countries the input of patent applications is very small. As a consequence these candidates have very limited possibilities to practice everyday work in one of the official languages. This is another factor that adds to the language problem.

Training

CEIPI is today running basic training courses in quite a number of places around Europe. In addition to this CEIPI run special EQE prep courses for the individual papers. Specific prep courses are also run by a number of other organizers, of which *epi* is one (the *epi* Tutorials). In some countries there is a national system in addition to CEIPI, whereas that is not the fact in others.

Looking at the EQE results these training programs seem to work fairly well in some countries whereas the outcome is less favorable in others. The better results in some countries are probably due to the presence of national training systems that have been established for

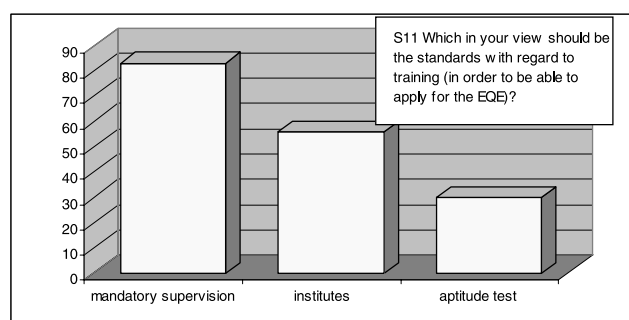
a long time and provide training for candidates by tutorials, special courses and by a structured learning schedule. Thus, in view of the above, an improved training especially for papers C and D is needed in most member states.

In Prof. Herrmann's survey a large majority of the respondents supports general European minimum standards for educational background and for training. CEIPI and CIPA are regarded as good standards for training. A standardization of the training and preparation for the EQE is regarded not only as possible but also as necessary.

As to the question of minimum standards of educational background a vast majority of the respondents answered that a candidate should have a university degree in a technical field. There are different opinions whether this should be a Bachelor or a Master degree, but the Master degree exhibits a clear majority. Quite naturally the British respondents find a Bachelor degree satisfactory.

A large majority of the respondents dislike the idea of an aptitude test in order to become a candidate to the EQE at such an early stage. „*Making access to the profession more difficult is rejected in countries where a national examination can be taken, where advantage can be taken of good training offers, and where access to the profession is supposed to be dealt with in a liberal way (even for the price of high failing rates in the EQE)*“. However in the new member states lacking experience of the EQE there is a majority approving an aptitude test to become a candidate. In this connection the question arises if a voluntary aptitude test could be offered.

The diagram below shows the preferences when it comes to standards for training:



(Prof. Herrmann)

When it comes to measures useful with regard to passing the EQE, 75% of all respondents are negative to the proposal of introduction of a mandatory admission examination (however from the new member states 60% are positive).

Possible solutions

One useful measure may be the introduction of training courses also for *epi* tutors and mentors who have the task of forming the candidates in their day-to-day job. In such courses experienced tutors transfer their skills to new tutors, preferably those just having passed the EQE.

In this way a continuous stream of up-to-date information could be maintained.

Tutorials under the supervision of experienced *epi* members, courses organized by the national institutes and lectured by experienced *epi* members could be helpful in many countries. Such a regimen could also

be implemented in the „new“ countries with the help of experienced *epi* members from the „old“ countries. This will at the same time lead to a more intense contact between „old“ and „new“ members.

As to the importance of accessibility of educational material the respondents' answers were as follows:

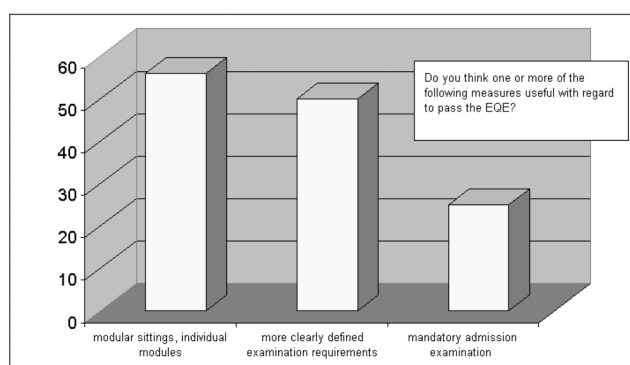
Gr. 1				Gr. 2				Gr. 3			
	low	med.	high		low	med.	high		low	med.	high
DE	43	46	61	AT	1	1	1	BG	0	3	1
GB	13	28	20	BE	1	4	7	CZ	0	3	2
FR	4	6	10	CH	3	9	13	EE	0	2	1
				CY	0	0	1	HU	0	5	4
				DK	1	5	7	RO	0	2	7
				ES	0	2	2	SI	0	0	2
				FI	3	4	6	SK	0	0	1
				GR	0	0	0				
				IE	0	0	1				
				IT	3	7	8				
				LI	0	2	1				
				LU	0	0	0				
				MC	0	0	0				
				NL	3	12	5				
				PT	0	0	1				
				SE	5	4	6				
				TR	1	1	3				
abs.											
.	60	80	91		21	51	62		0	15	18
%	25.97	34.63	39.39		15.67	38.06	46.27		0.00	45.45	54.55

(Prof. Herrmann)

There is a need to improve the accessibility of educational material to the candidates.

EQE

The diagram below shows the preferences as regards measures useful for improving the passing rate of the EQE:



(Prof. Herrmann)

The opinion on „More clearly defined examination requirements“ splits the respondents into two equal groups, one being of the opinion that there is a need for more clearly defined examination requirements and the other not recognizing that need. Here it can be noted that there is a difference between industry and private practice. In industry 44% are of the opinion that there is a need, whereas 56% see no need. The corresponding figures for private practice are almost the reverse, namely 55% and 45%, respectively.

As a result of his survey Prof. Herrmann comes to a number of conclusions:

- Time pressure must no doubt be eliminated from the exams. Neuropsychology has taught us that under a demand for performance under stress, only routine knowledge that is readily available can be reproduced, not however the branched knowledge required for problem solutions. On one hand, this serves to explain part of the high failure rates in EQE, on the other hand this serves to explain the obser-

vation that candidates who are successful in everyday job life encounter large difficulties in this exam.

- It is controversial whether the examination should rather be focussed on everyday job life or on more general proficiency.
A meaningful solution can only be found in the sense that the requirements should be limited to basic and core skills, and that exam performance should be demonstrated essentially without aids.
- The high failure rates have been the starting point for the survey and inquiry presented here. The dialogues and comments show that the level of failure rates is assessed in rather different ways.

Prof. Herrmann further points out that

- It is pointed out, on one hand, that a demanding examination is fitting for entry of a demanding profession. This belief presupposes a connection between exam proficiency and job proficiency, which as a rule does not exist, particularly so in cases where in an examination, not only knowledge is required but skills as well. As a rule, the examination then merely serves as a selection function in which success ratios can be lowered or raised in a relatively arbitrary fashion.
- It is pointed out, on the other hand, that an examination taken by candidates with several years of professional practice must not lead to these very low success ratios, since as a rule this is contradicted by job performance, and it also is irresponsible when seen in relation to the life situation of older candidates. This understanding does not imply pleading for an easier examination or lower rating criteria, but rather for prospects of success in the exams for candidates with appropriate aptitude and preparation. From this position, the optimum way of modernising the EQE is seen in a combination of qualified preparation, voluntary intermediate exams, and the elucidation of basic and core proficiencies in the exam itself.
- Thirdly, the belief is legitimate that in an examination without prior aptitude and admission tests, without controlled home study, and without mandatory preparation modalities, the failure rate will be at about the percentage level that is thought quite appropriate for instance in university exams of German universities in the natural and technical science courses where several intermediate tests are taken. Insofar it could be left to the national associations to worry about adequate preparation for the exams.

Computerization

Quite a number of respondents in all the surveys have asked for a computerization of the EQE. Today most of the candidates do their drafting work at the computer and not in handwriting. If the EQE is computerized there will be a number of advantages e.g. : ^{a)}papers in a digital form will be of a great help to the candidates when cutting and pasting in papers A and B and the ease of amending an answer in the computer relieves a part of the time stress for the candidates; ^{b)}the examination

secretariat can distribute the answers to the markers electronically and thus save the huge amount of work with copying of all answers and thus save a lot of time; ^{c)}the problem for the markers of reading bad handwriting disappears; ^{d)}it will also most probably be easier to mark the papers electronically and the markers can communicate with each other via e-mail, thus reducing the number of meetings needed.

Recommendations of the PQC

Training

- The development and production of educational material (available on a web site) which yields improved accessibility of educational material to candidates in all member states under the control of *epi*
- Special training for candidates from countries having a low R&D activity and a low number of national applications
- Language training with an emphasis on IP related language
- Improved educational material and training courses for papers C and D
- Introduction of training courses also for tutors and mentors
- Further improved transparency of the EQE e.g. by frequent meetings between the tutors and the members of the Examination Board discussing the standards required by the candidates
- Possibility of judging one's own training progress e.g. by taking non-mandatory intermediate examination(s) corresponding to the steps of knowledge leading to the EQE

EQE

Modernization of the system with List A and List B qualification (today there are several thousand diplomas that have to be checked) making it clear from the start whether or not a candidate will be admitted to sit the EQE

- Enrolment for sitting the EQE at the start of a candidate's training period (a contract for the candidate)
- Improving the modular system (a candidate should be able to sit each individual paper at his/her own choice).
- Reduce the time pressure in the examination by a restriction of material introduced
- Reduce the exhaustion by having rest days in between the various papers
- Maintain the possibility of answering in one's own mother tongue
- Prolong the time to make the examination papers for candidates not having an official language as their mother tongue
- Paper C should be at a more even level of difficulty from year to year
- Maintain *status quo* for paper D
- Computerization of the EQE
- Shorten the time period between the sitting and the presentation of the results.

Neue Telefon- und Faxnummern

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epi Excess Liability Insurance scheme

For the attention of epi members from countries which have recently joined the European Patent Organisation

epi members have the possibility to join an insurance scheme which aims to give better insurance coverage at a reasonable price.

The indemnity of basic professional liability insurance schemes is often limited to EUR 1.022.584. Therefore, the epi Excess Liability Insurance scheme indemnifies losses as far as they exceed DM 2million/EUR 1.022.584/equivalent. Its limit of indemnity is a further EUR 1.533.876 per loss so that – together with basic insurance – a total loss of EUR 2.556.400 is covered.

There is a collective indemnity limit to EUR 15.338.756 p.a. for all participating epi members which according to insurance calculations will hardly be reached. The premium for the epi Excess Liability Insurance scheme for the insurance year 2002/2003 amounts to EUR 383,47 plus legal insurance tax.

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epi invites each member to carefully consider joining the epi Excess Liability Insurance scheme since clients' claims may easily reach the sum of EUR 2.556.460. They may ruin your economic and professional situation if no adequate insurance cover is provided for. The epi Excess Liability Insurance scheme improves your insurance cover at a reasonable price and provides insurance cover for you as an epi member in all twenty-eight EPC contractual countries regardless of where you exercise your profession.

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International Symposium on Nanotechnology and Patenting

Venue: 9-10 November 2004 at the European Patent Office, The Hague

Leading economies have embarked on investing in R&D of Nanotechnology. For instance, the budget allocated by the European Union for Nanotechnology and Nanosciences is

€ 1 300 million for the period 2002 – 2006, whilst the Japanese government has quadrupled spending on nanotechnology, investing \$ 466 million in 2001 alone. The US passed a nanotech funding bill, allocating USD 2.36 billion for the next three years. As a result to these significant R&D funds spent on nanotechnology, the number of patent applications to protect new products in this technical field will grow. The European Patent Office (EPO) already experiences a significant increase in nanotechnology applications that is likely to persist.

Taking this trend into account, a European platform for the exchange of information regarding this emerging technology will be provided. The European Patent Institute (epi), the Technology Centre Physical Technologies of the German Association of Engineers

(VDI-TZ), the Licensing Executives Society (L.E.S.) and the European Patent Office (EPO) will jointly organise an *International Symposium on Nanotechnology and Patenting* with the aim to inform about the role of the European Patent System in protecting related IP and to share views on technical and ethical implications pertaining to Nanotechnology. On the occasion of this public event, European patent professionals will meet with leading European Nanotechnology experts – amongst them Nobel-Laureates.

The event will take place from 9 – 10 November 2004 at the European Patent Office in The Hague, Patenlaan 2, 2280 HV Rijswijk, The Netherlands. A registration fee will be levied. Online registration and a preliminary programme will be made available in due time on the EPO International Academy website at <http://academy.epo.org>.

For more information, contact the EPO International Academy at +49 (0)89 2399 5207 or via e-mail at internationalacademy@epo.org.

Keeping what's yours Does it still make sense to keep an invention secret?

B. Fabry¹ (DE)

One can argue whether non-disclosure of results of research is a strategy or not. At the end, however, it all comes down to developing innovations that are not protected because we fear that the competition would profit from a publication, without the inventors being able to prove an infringement later. These reservations are regularly uttered in connection with process patents.

Certainly such reservations cannot be denied, though advantages and disadvantages need to be carefully weighed against each other. Process patents whose infringement can be proved, e.g., by traces of catalyst in the product, etc., are uncritical and can be as valuable (or valueless) as patents for substances or use patents. But what happens to patents characterised by a feature that cannot be traced easily, e.g., a certain temperature or pH value? Would it in such cases not be sufficient to relinquish patent protection and rely on our own rights resulting from prior or continued use?

The opinion that our own non-public but documented prior use would secure continued use against a protected right of a third party that was granted later, is basically correct. The facts are, however, attached to a number of conditions:

- The right to continued use is territorially restricted, at least according to current judicature. Looking at the specific situation in Germany for example, prior use does not justify, e.g., a right to continued use in France. Thus the export to France of a product that has been legitimately produced in Germany, immediately becomes critical because of patent protection of the third party. Although there have been efforts to view the right to continued use in the European context – and the practice of judgment of the European Court of Justice known from other cases could support this – but all pending proceedings have been terminated out of court so that no decision can be found in this respect. Until now we will have to assume that prior use in Germany allows continued use in Germany only.
- The right to continued use cannot be easily exploited at any quantity. Prior use at laboratory scale will be difficult to evidence the right to continued use in a 10.000 ton production plant. Usually, factor 10 is acceptable in practice.
- The right to continued use requires „diligence“, i.e., the effort to put into practice the development through no fault of our own. If a non-disclosed invention has been hidden in the drawer for years and is produced only after the competitor had been successful, the right to continued use is forfeited.

Besides the uncertainties in connection with continued use, also legal regulations influence the decision to keep an invention secret or to apply for a patent.

For example, in the USA where the creation of monopolies is disreputable anyway, a person who keeps an invention to himself for his own benefit and for the harm of society, is expressly sentenced as he has to submit himself to the patent owner who applied later. So it can happen that a process that has been running without success for 20 years under the cover of secrecy, has to be stopped because in the meantime a relevant intellectual property right has been granted to a third party which cannot be destroyed.

Conversely, various legal systems grant the owners of process patents more rights than we would usually expect. So we can read, e.g., in § 139 (3) DPatG:

„Is the subject matter of a patent a process for production of a new product, the same product which has been produced by someone else is regarded as produced according to the patented process until the contrary is proved...“

In case that a substance can only be produced according to a – patented – process, German Patent Law provides that in case of alleged infringement of a process patent the potential infringer has to prove that the burden of proof is not with him.

In France even stronger measures may be taken against potential infringers. In case of a substantiated assumption of infringement, the patent owner may apply for a so-called „Saisie contrefaçon“ to the Regional Court, which usually is rarely refused.² Here we are dealing with the possibility of gathering evidence which is carried out by the bailiff accompanied by an expert at the premises of the potential infringer³. In this procedure it can be ascertained on the works site, e.g., in what temperatures or in what pH values a process is carried out. This way facts are examinable that could not be clarified from the product. The Saisie results in a report whose contents must lead the applicant to proceedings within 15 days of the seizure, otherwise the material may not be used any more. What also makes the Saisie interesting is that there is no chance for the affected person to reject it. Also direct appeal has no delaying effect. However, if the granting of Saisie proves to be unjustified in retrospect there exists a claim for damages. Additionally, it has been reported that the Saisie can be applied „cross-border“, i.e., the results from the French proceedings may find their way into a German infringement case. For the granting of a Saisie, incidentally, not even a French patent is required; it is usually sufficient if the applicant owns a protected right in a EU member

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² J.Lang, Mitt.d.Deutschen Patentanw., p319 (2000)

³ P.Veron, epi Information p82, (2003)

state and is able to explain why a Saisie needs to be carried out in France. There are similar regulations in Belgium and Italy, and in Britain exists a comparable Discovery procedure.

Finally it should be pointed out that patents also act as deterrents, regardless of proved infringement. Large companies in Europe, the USA, and Japan are expected to respect patents of third parties basically although this may not apply to smaller companies, particular in the Asian states. With the heavy fluctuation of employees we may assume that trade secrets are in principle protected for a short time, some even for a longer period, but it is unlikely that all trade secrets can be protected over an indefinite period of time.

So if it is considered that

- the right to prior use and, respectively, continued use does not exist in some countries, and if it does, is attached to various conditions,
- the legislature in the core countries of Europe provides the patent owner with tools like the reversal of the burden of proof or the direct gathering of evidence to discover infringements that are otherwise difficult to detect, and
- the probability to keep trade secrets safe over a long period of time is poor,

there are good reasons to see that non-disclosure is a big exception and should not be made a rule, regardless of the likely outflow of know-how.

Anwendung der Lehre über die erfinderische Tätigkeit in der technischen Praxis

S. V. Kulhavy¹ (CH)

Zusammenfassung

Die bisherigen Veröffentlichungen des Autors dieses Beitrages, welche im angeschlossenen Verzeichnis aufgelistet sind, hatten zum Ziel, die auf der Definition einer naheliegenden Lösung beruhende Lehre über die erfinderische Tätigkeit zu erläutern und zu begründen. Im vorliegenden Beitrag werden dagegen Möglichkeiten erläutert, wie die genannte Lehre in der Technik praktisch angewendet werden kann, nämlich beispielsweise zur Schaffung von Lösungen technischer Probleme mit Hilfe von Computern. Damit stößt dieser Beitrag das Tor unter anderem auch zu einem neuen und weiten Anwendungsgebiet von Computern auf. Die vorliegenden Ausführungen dürften Impulse nicht nur für die Patentrechtler sondern auch für jene liefern, welche beschließen, Computer bei der Suche auch nach erfinderischen Lösungen technischer Problem einzusetzen.

Die Entwicklung von Hardware bei Computern hat einen so hohen Entwicklungsstand erreicht, dass heutzutage enorm große Speicherkapazitäten zu vertretbaren Preisen zu haben sind, und dass die Computer heutzutage in der Lage sind, nützliche Informationen aus einer enorm großen Menge von gespeicherten Daten innerhalb kürzester Zeit zu gewinnen. Von dieser Seite her ist es daher keine Utopie mehr zu fragen, ob man Erfindungen mit Hilfe von Computern schaffen könnte. Diese Frage ist unter anderem auch deswegen sinnvoll, weil der Stand der Technik eine schier unendliche Menge von technischen Elementen bzw. Bausteine umfasst, welche zur Lösung von Problemen zur Verfügung ste-

hen. Der Mensch mit dem verhältnismässig beschränkten Umfang seines Gedächtnisses ist bei der Schaffung von Lösungen technischer Probleme nicht in der Lage, alles zu berücksichtigen, was der Stand der Technik zur Lösung von Problemen bietet.

Bei der Frage nach der Möglichkeit der Schaffung von Erfindungen mit Hilfe von Computern gab es seinerzeit ein prinzipielles Problem. Es ist allgemein bekannt, dass sich das Vorgehen auf dem betreffenden Sachgebiet in einzelne rationell erfassbare Schritte zerlegen lassen muss, damit ein Computerprogramm geschrieben werden kann. Lange Zeit wusste man nicht genau, was das Wesen einer Erfindung ausmacht. Somit konnte man nicht wissen, wie man zu einer Erfindung gelangen kann. Die damaligen Rechtsgelehrten sind nämlich zum Schluss gekommen, dass der Begriff Erfindung ein unbestimmter Rechtsbegriff sei. Dies bedeutet, dass man es rationell nicht entscheiden konnte, ob eine bestimmte Lösung eines technischen Problems eine Erfindung darstellt oder nicht. Die Rechtsgelehrten waren der Meinung, dass daher nur ein juristisch vorgebildeter Richter unter Anwendung subjektiver Urteile entscheiden kann, ob eine Erfindung vorliegt oder nicht. Dies ist ein Standpunkt, welchen neben anderen auch unsere Gerichte heutzutage immer noch vertreten. Der Autor dieses Beitrages hat in seinem Buch, welches bereits im Jahr 1978 erschienen ist, gezeigt, dass sich die Grenze zwischen Erfindungen und den nicht patentwürdigen naheliegenden Lösungen rationell erfassen und klar ziehen lässt. Die erwähnten, veralteten und zu einem Dogma gewordenen Ansichten über das Wesen einer Erfindung können die lebendige Technik jedoch nicht aufhalten. Irgendwie drängt sich hier eine Parallele zu einem berühmten Spruch auf, welchen sich ein Staats-

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(* Patentanwalt und früher Prüfer und Richter im Patentamt in Prag, 1958-1968)

mann aus der damaligen DDR kurz vor seinem Ende von einem Staatsmann aus der damaligen Sowjetunion anhören musste.

Die Grenze zwischen Erfindungen und den nicht patentwürdigen naheliegenden Lösungen bzw. Maßnahmen kann anhand der Definition einer naheliegenden Lösung werturteilsfrei gezogen werden. Diese Definition und ihre Anwendung bei der Prüfung von Erfindungen sind beispielsweise in *epi Information* 3/1998, S. 110 -114 publiziert worden. Eine gewerblich anwendbare und neue Lösung stellt eine Erfindung dar, wenn sie unter die Definition einer naheliegenden Lösung nicht fällt. Eine solche Lösung beruht auf erfinderischer Tätigkeit. Dies ist alles, was man wissen muss, damit man die im Patentwesen bisher schwierigste Art von Entscheid bei der Prüfung von Lösungen eines Problems treffen kann. Die genannte Definition ergab sich unter anderem auch aus der Analyse einer sehr großen Anzahl von fertigen Lösungen technischer Probleme. Diese Lösungen waren entweder in Patentschriften oder in den Unterlagen von Patentanmeldungen offenbart, zu welchen der Autor dieses Beitrages als Prüfer in einem Patentamt Zugang hatte. Die so offenbarten Lösungen von Problemen konnten analysiert sowie untereinander verglichen werden und aus den Resultaten dieser Überlegungen konnten Schlüsse gezogen werden, welche schlussendlich unter anderem auch zur Aufstellung der Definition einer naheliegenden Lösung geführt haben. Diese Definition kann als eine der Seiten einer Münze betrachtet werden. Die andere Seite dieser Münze stellen die Lösungen von Problemen dar, deren Analyse usw. zu der genannten Definition geführt hat. Diese Lösungen ergaben sich aus dem Stand der Technik mehr oder weniger intuitiv. Wir können uns jetzt den Lösungen von Problemen, d.h. dieser zweiten Seite unserer Münze zuwenden und prüfen, wie sich die Kenntnis der genannten Definition bei der Schaffung von Lösungen von Problemen in der Zukunft fruchtbar auswirken könnte.

Es dürfte allgemein bekannt sein, dass man zu einer nicht naheliegenden Lösung greifen muss, wenn es nicht gelingt, ein bestimmtes Problem mittels einer naheliegenden Lösung zu beseitigen. Vor dem Erscheinen der in der angeschlossenen Liste genannten Arbeiten war es möglich, nicht naheliegende Lösungen nur auf dem intuitiven Weg zu schaffen. Die werturteilsfrei anwendbare Definition einer naheliegenden Lösung ermöglicht es uns, den Weg zu einer Erfindung werturteilsfrei und daher rationell zu beschreiben. Da dieser Weg noch nie beschrieben worden ist und da manche erhebliche Zweifel daran haben, dass eine solche Beschreibung überhaupt möglich ist, wird dieser Weg, so weit dies der Umfang des vorliegenden Artikels erlaubt, möglichst genau nachstehend beschrieben. Das durch die genannte Definition vorgezeichnete rein rationelle Vorgehen kann die Grundlage für ein Computerprogramm darstellen, welches Lösungen von technischen Problemen hervorbringen kann. Damit die Lösung eines Problems das Problem wirklich lösen kann, muss die Lösung funktionstüchtig sein. Die Grundvoraussetzung hierfür ist,

dass sie den Gesetzen der Natur gehorcht. Diesen Aspekt dieser Angelegenheit hat die Rechtslehre, wie dies die Erfahrung des Autors zeigt, nie berücksichtigt. Folglich konnte die Rechtslehre auch keine klare Abgrenzung von Erfindungen gegenüber den naheliegenden Lösungen hervorbringen. In der Tat ist es auch nicht die Sache der Rechtslehre, sich mit Naturgesetzen und mit damit verbundenen Problemen auseinanderzusetzen. Dies bleibt den technisch Vorgebildeten vorbehalten. Um im Einzelnen zeigen zu können, wie es sich auf der „Lösungsseite unserer Münze“ verhält, wollen wir hier einen wahrlich winzigen Ausschnitt aus dem Bereich der Entstehung der Lösungen von technischen Problemen vorstellen. Die vorstehend erwähnten Analysen der bereits vorhandenen Lösungen haben unter anderem auch gezeigt, dass die nachstehenden Ausführungen für Erfindungen auf allen Gebieten der Technik zutreffen. Grundsätzlich gibt es nur zwei Wege zu einer Erfindung, nämlich die Kombination von Elementen des Standes der Technik und die Entdeckung einer Eigenschaft bei einem aus dem Stand der Technik bereits bekannten Element. Dieser zweite Weg setzt eine Wahrnehmung von Erscheinungen in der materiellen Welt durch einen Menschen sowie Überlegungen eines Menschen darüber voraus, zur Lösung welches Problems die entdeckte Eigenschaft genützt werden könnte. Dies sind zwei Denktätigkeiten, welche für den Menschen ziemlich typisch sind und bei welchen der Mensch, zumindest derzeit, durch einen Computer kaum zu ersetzen ist.

Daher ist für uns jetzt und hier nur der erste der genannten Wege interessant, nämlich die Kombination bekannter Elemente des Standes der Technik. Es ist allgemein bekannt, dass das jeweilige Element des Standes der Technik entsprechend seiner Ausbildung bzw. Struktur (Morphologie) bestimmte Naturkräfte in bestimmter Weise lenken kann. Man könnte auch von einer Transformation von Naturkräften durch das jeweilige Element des Standes der Technik, von Übertragung im Element usw. sprechen. Die Naturkräfte, welche das Element im Stand ist zu lenken bzw. zu transformieren, müssen dem Element an einer Stelle desselben zugeführt werden. Die Stelle am Element, wo auf dieses mit bestimmten Naturkräften eingewirkt werden kann, damit die Transformation in diesem erfolgt, wollen wir Eingang des Elements nennen. An einer bestimmten Stelle des jeweiligen Elements wirkt sich die durch dieses Element vollzogene Transformation der zugeführten Naturkräfte aus. Die Stelle am Element, wo sich die Transformation der Naturkräfte auswirkt, wollen wir Ausgang des Elementes nennen. Es gibt Elemente in der Technik, welche einen ausgeprägten bzw. typischen Eingang und Ausgang haben. Zu solchen Elementen gehören die meisten Elemente der Elektrotechnik, bei welchen der Eingang und der Ausgang meistens als im voraus gegeben gilt. Elemente der Mechanik haben ebenfalls Eingänge und Ausgänge, über welche sie untereinander kräftemäßig gekoppelt sind, aber zur Bestimmung der Eingänge und Ausgänge muss man sich in den meisten Fällen räumlicher und sonstiger Angaben bedienen. Wenn die vorliegende prinzipielle

Darlegung auf mechanischen Elementen aufbauen würde, könnte sie wegen den gerade genannten weiteren Angaben betreffend die Eingänge und Ausgänge möglicherweise unüberschaubar werden. Deswegen baut die vorliegende Erläuterung lieber auf elektrischen Elementen auf. Diese prinzipielle Darlegung ist jedoch dermaßen einfach, dass sie auch Leute verstehen dürften, welche keine tiefgehenden Kenntnisse der Elektrotechnik haben.

Es dürfte allgemein bekannt sein, dass die Elektrotechnik auf bestimmten einfachen Teilen aufbaut. Diese sind der Widerstand R , der Kondensator C , die Spule L , die Diode D , der Transistor T und noch einige jedoch weniger bekannte Teile. Hinsichtlich der Transformation ist es bei einem Widerstandselement R bekannt, dass dieses den Durchfluss von elektrischem Strom zwischen seiner Eingangsklemme und seiner Ausgangsklemme drosseln kann. Die Größe des durch einen Widerstand R fließenden Stromes ist von Zeit unabhängig, d.h. konstant. Bei einem Kondensatorelement C ist es bekannt, dass die Größe des durch den Kondensator fließenden elektrischen Stromes während dem Auf- und Entladen des Kondensators veränderlich ist, wobei diese Änderung einen exponentialen Verlauf hat. Dies ist die für einen Kondensator C typische Transformation, welche sich zwischen seiner Eingangs- und seiner Ausgangsklemme während dem Betrieb desselben abspielt. Bei einer Spule L gibt es je nach Umständen eine der beiden erläuterten Transformationen. Für die Bezeichnung der genannten elektrischen Teile sollen die dazu üblichen Buchstaben R , L und C beibehalten werden. Die in einem dieser Elemente stattfindende Transformation soll allgemein mit M bezeichnet werden. Die Transformation in einem Widerstand R ist daher mit M_r , in einem Kondensator C mit M_c und in einer Spule L mit M_l zu bezeichnen.

In der Praxis kann das Problem auftreten, dass der elektrische Strom, welcher durch eine Stelle eines elektrischen Schaltkreises fließt, zu groß ist. Diesen Schaltkreis wollen wir für unsere Zwecke als Objekt bezeichnen. Um das Problem zu beseitigen, sucht man im Stand der Technik nach einem Element X , welches in der Lage ist, den Durchfluss von elektrischem Strom zu drosseln. Die Person, welche das Problem zu lösen hat, erinnert sich daran, dass elektrische Widerstände R die Eigenschaft, nämlich die Fähigkeit M_r besitzen, den Durchfluss von elektrischem Strom zu drosseln. Man ordnet einen Widerstand R mit einem geeigneten ohmschen Wert an der betreffenden Stelle des elektrischen Schaltkreises an und das Problem kann dadurch als gelöst bzw. als beseitigt betrachtet werden. Es ist gerade erwähnt worden, dass sich auch der Computer „erinnern“ kann, dass elektrische Widerstände R die Fähigkeit M_r besitzen. Ein Computer, wenn er ein geeignetes Programm enthält, kann sich an ein Element des Standes der Technik und seine Transformationsfähigkeiten M deswegen „erinnern“, weil es ohne weiteres machbar ist, eine Datenbank anzulegen, in welcher die Elemente der Technik zusammen mit ihren Transformationsfähigkeiten M und noch einigen weiteren nützlichen Angaben

gespeichert sind. Es dürfte einleuchten, dass man bei Verwendung mechanischer Elemente zur Lösung von Problemen in gleicher Weise vorgehen kann, dass man jedoch die vorstehend genannten Angaben betreffend die Parameter der Eingänge und Ausgänge mitspeichern müsste. Aus diesen kurzen Erläuterungen dürfte schon die grundlegende Idee zur Lösung von Problemen unter Heranziehung von Computern ersichtlich sein.

In Verfolgung unseres Zieles können wir die Transformationsfähigkeit einer Kombination aus zwei elektrischen Elementen untersuchen. Wenn man beispielsweise einen Widerstand R und einen Kondensator C in Serie schaltet, dann wird die Ausgangsklemme des Widerstandes R an die Eingangsklemme des Kondensators C angeschlossen. Die andere freie Klemme des Widerstandes kann als der Eingang dieser RC -Kombination betrachtet werden. Die andere freie Klemme des Kondensators C kann als der Ausgang dieser RC -Kombination betrachtet werden. Wie erläutert, besitzt der Kondensator C die Transformationsfähigkeit M_c , wonach die Größe des durch den Kondensator C fließenden elektrischen Stromes einen zeitabhängigen, exponentialen Verlauf aufweist. Wie ebenfalls erläutert, besitzt der Widerstand R die Transformationsfähigkeit M_r , wonach die Größe des durch den Widerstand R fließenden elektrischen Stromes gedrosselt wird, und zwar auf einen konstanten Wert und dies zeitunabhängig. Wenn der Strom durch die hintereinander geschalteten Elemente R und C fließt, dann unterliegt dieser Strom den Einflüssen der körperlichen Gestaltungen und somit auch den Transformationsfähigkeiten M_r und M_c der beiden elektrischen Elemente R und C , woraus sich die resultierende Transformationsfähigkeit M_{rc} ergibt. Der durch den Kondensator C verursachte exponentiale Verlauf der Änderung der Größe des Stromes wird bei dieser seriellen RC -Kombination durch den Widerstand R „gebremst“. Die Folge davon ist, dass die daraus resultierende exponentiale Kurve, mit welcher der zeitliche Verlauf des durch diese serielle RC -Kombination fließenden Stromes darstellbar ist, zeitlich gestreckt wird. Technisch bzw. in der Praxis bedeutet dies, dass es bei der Verwendung einer solchen RC -Kombination länger dauert, bis sich der Kondensator C aufgeladen oder entladen hat.

Der durch die RC -Kombination fließende, resultierende Strom hat weder den Verlauf, welchen der Widerstand R allein verursachen würde, noch den Verlauf, welchen der Kondensator C allein verursachen würde. Der resultierende, d.h. durch die RC -Kombination fließende Strom hat einen neuen Verlauf, welcher sich aus der Zusammenlegung der Transformationsfähigkeit M_r des Widerstandes R mit der Transformationsfähigkeit M_c des Kondensators C ergibt. Die RC -Kombination besitzt daher eine resultierende Transformationsfähigkeit bzw. Gesamttransformationsfähigkeit M_{rc} . Der resultierende Stromverlauf durch die serielle RC -Kombination ist keine Summe der Ströme durch die einzelnen Elemente R und C , sondern der resultierende Stromverlauf ist das Resultat einer Zusammenlegung der Einwirkung der körperlichen Konstitution des Widerstandes R und der Einwir-

kung der körperlichen Konstitution des Kondensators C auf den durchfließenden elektrischen Strom. Wenn sich der resultierende Effekt aus dem Zusammenwirken von zwei oder mehreren Elementen von der Summe der Effekte der einzelnen Elemente unterscheidet, dann spricht man vom sogenannten Synergieeffekt, welcher eine echte Kombination von einer Aggregation unterscheidet. Man kann sich einen Fall vorstellen, in welchem bei einem herkömmlichen Schaltkreis ein zeitlich gestreckter exponentialer Verlauf der Größe des elektrischen Stromes zur Lösung eines das Objekt betreffenden Problems gewünscht wird. Man braucht somit ein Mittel X, welches eine resultierende Transformationsfähigkeit Mrc aufweist. Eine Person oder ein Computer kann sich daran „erinnern“, dass die Gesamt-Transformationsfähigkeit Mrc bei einer seriellen RC-Kombination vorhanden ist. Man ordnet diese serielle RC-Kombination an der betreffenden Stelle des Schaltkreises an und das Objektproblem gilt als gelöst. Obwohl dieses Beispiel keine Erfindung ist, stellt dieses Beispiel einen wichtigen Schritt in Richtung unseres wichtigsten Zieles dar, nämlich, im Einzelnen zu erläutern, wie Lösungen von Problemen entstehen.

Man kann sich in der Technik auch einen anderen Fall vorstellen, in welchem an einer bestimmten Stelle eines herkömmlichen Objektes, z. B. eines herkömmlichen Schaltkreises, eine bestimmte und im voraus vorgestellte Transformationsfähigkeit Mx als erforderlich erscheint, damit das Objektproblem als gelöst betrachtet werden kann. Man sucht im Stand der Technik, ob es dort ein technisches Element gibt, welches diese vorgestellte Transformationsfähigkeit Mx hat. Man findet kein solches Element im Stand der Technik. Das Problem erscheint daher zunächst als unlösbar. Wenn es jetzt jemandem gelingt, ein technisches Mittel aus den Elementen des Standes der Technik so zusammenzustellen bzw. zu kombinieren, dass dieses technische Mittel die vorgestellte Transformationsfähigkeit Mx besitzt, dann wird das zunächst als nicht lösbar angesehene Problem lösbar. Das Gelingen dieses Vorgehens hängt allerdings davon ab, ob es jemandem einfällt, bestimmte dazu geeignete Elemente des Standes der Technik zu diesem Zweck untereinander zu kombinieren. Da könnten Computer mit ihren riesigen Speicherkapazitäten und ihren riesigen Arbeitsgeschwindigkeiten gute Dienste leisten. Eine solche Lösung könnte man prüfen, ob sie eine Erfindung darstellt. Dies kann am einfachsten anhand eines Fragendiagramms durchführen, welches im Buch des Verfassers dieses Artikels als Anhang 1 wiedergegeben ist. Nach einem Durchlaufen dieses Fragendiagramms, das aus Platzgründen hier nicht im Einzelnen beschrieben werden kann, würde man feststellen, dass es sich um eine Kombinationserfindung handelt – siehe dazu auch die Beispiele D und F im genannten Buch.

Wenn ein geeignetes technisches Mittel durch einen Computer im Stand der Technik ermittelt oder durch einen Computer geschaffen werden soll, dann müssten unter anderem auch die Morphologie der einzelnen Elemente des Standes der Technik, ihre Transformationsfähigkeiten M derselben, die Angaben über ihre Ein-

gänge und Ausgänge usw. verschlüsselt und in einer Datenbank gespeichert werden. Ferner müsste ein Programm geschrieben werden, welches ermöglicht, die Elemente des Standes der Technik auf ihre Transformationsfähigkeiten abzusuchen bzw. zu prüfen und die Transformationsfähigkeiten der in Frage kommenden Elemente des Standes der Technik miteinander zu kombinieren. Ferner müsste das Programm auch so geschrieben sein, dass der Computer prüfen kann, welche der Transformationsfähigkeiten, die aus den einzelnen und durch den Computer probeweise geschaffenen Kombinationen von Transformationsfähigkeiten resultieren, mit der vorgestellten bzw. gewünschten Transformationsfähigkeit identisch sind oder dieser am meisten ähneln. Nachdem der Computer die gewünschte resultierende Transformationsfähigkeit so ermittelt hat, müsste das Programm noch anzeigen, welches jene Elemente des Standes der Technik sind, welche, wenn sie in gebührender Weise einander zugeordnet sind, das technische Mittel mit der gewünschten Transformationsfähigkeit ergeben. Das Programm müsste dieses Mittel dann an der betreffenden Stelle des mit dem Problem behafteten Objektes, z. B. eines elektrischen Schaltkreises, zur Lösung des Objektproblems einsetzen usw.

Man könnte einwenden, dass die Erläuterungen betreffend die Kombination aus einem Widerstandselement R und einem Kondensator C akzeptierbar sind. Aber wenn man sich beispielsweise eine der Platinen für einen bzw. in einem Computer, in einem Fernseher usw. anschaut, dann gibt es dort eine ganz große Anzahl von Widerstandselementen R und Kondensatoren C sowie von weiteren Bausteinen der Elektrotechnik. Wie könnte man diese riesige Menge an solchen Elementen der Technik im vorstehend genannten Programm zu dem hier vorgestellten und verfolgten Zweck verwalten? Diesbezüglich kommt uns eine der Eigenschaften unseres Denkens und unserer Sprache zur Hilfe. Die Widerstandselemente R, Kondensatoren C usw. befinden sich auf der Platine nicht nur so einfach nebeneinander liegend, sondern sie bilden Schaltkreise. Für die meisten solcher Schaltkreise hat unsere Sprache eine Bezeichnung. Diese Bezeichnung kann beispielsweise auf die Funktion des Schaltkreises hinweisen, wie z. B. Impuls-generator, Impulszähler usw., oder die Schaltkreise tragen manchmal sogar den Namen ihres Erschaffers, wie z. B. Schmidt-Trigger usw. Wenn wir uns mit jemandem beispielsweise über einen Impulszähler unterhalten, dann genügt es, wenn wir bloß das Wort Impulszähler benützen und der Gesprächspartner, wenn er von den Schaltkreisen etwas versteht, weiß schon im Einzelnen, wovon die Rede ist und welche Transformationsfähigkeit der betreffende Schaltkreis hat. Während einem Gespräch genügt es somit, wenn wir solche Bezeichnungen benützen und wir müssen während dem Gespräch daher nicht dem Gesprächspartner jedesmal die Morphologie des betreffenden Gegenstandes, beispielsweise des Impulszählers, im Einzelnen beschreiben. Dasselbe gilt nicht nur für die gesprochene, sondern natürlich auch für die geschriebene Sprache sowie für die vorstehend erwähnte Verschlüsselung. Diese Öko-

nomie unseres Denkens und unserer Sprache ermöglicht uns, auch in einer ganz komplizierten Anlage, wenn es für diese noch keine bereits allgemein bekannte Bezeichnung gibt, an sich bekannte Gruppen von Elementen zu finden, aus welchen diese Anlage besteht, wobei die Bezeichnungen dieser Gruppen ebenfalls bekannt sind. Den mentalen Vorgang, in welchem die Zerlegung einer komplizierten Anlage in bekannte Gruppen erfolgt, nennt man Analyse. Es hängt oft von den Fachkenntnissen des Analysierenden ab, welche Gruppen er in der komplizierten Anlage sieht. Die Bezeichnungen der gefundenen Gruppen ermöglichen uns, beliebig komplizierte Anlagen in einer überschaubaren Weise zum Ausdruck zu bringen, zu beschreiben usw. Wer über genügend Praxis in der Redaktion von Patentansprüchen für Patenanmeldungen hat, der kann diese bestätigen.

Bei Verschlüsselung von Elementen des Standes der Technik kann man in gleicher Weise vorgehen. Bei dieser Verschlüsselung könnte man dem Widerstandselement R beispielsweise die Nummer 0000001 zuteilen. Der Kondensator C könnte die Nummer 0000002 zugeteilt bekommen. Bei einem Transistor könnte man die Nummer 0000003 benützen usw. Ein Impulsgenerator könnte beispielsweise die Nummer 0000100 zugeteilt bekommen. In einem separaten Programmabschnitt könnte die Morphologie dieses Impulsgenerators Nr. 0000100, bestehend aus seinen Elementen 0000001, 0000002, 0000003 usw., gespeichert sein. Jedesmal, wenn man in den Computer 0000100 eingibt, zeigt der Computer die Morphologie dieses Impulszählers und gibt seine Transformationsfähigkeit an. Was hier gerade über die Verschlüsselung der Morphologie der Elemente des Standes der Technik ausgeführt wurde, trifft sinngemäß auch für die Verschlüsselung der Transformationsfähigkeiten der einzelnen Bausteine der Technik zu. Der Autor dieses Beitrages verfügt über diese Art von Verschlüsselung der Morphologie und der Transformationsfähigkeiten elektrischer Schaltkreise auf einem bestimmten Gebiet der Elektronik.

Durch Analyse beispielsweise bereits bestehender Lösungen von Problemen, am einfachsten lässt sich dies durch Analyse von Patentansprüchen zeigen, kann man sich davon überzeugen, dass die vorstehenden Ausführungen auch für Lösungen zutreffen, welche aus mechanischen Elementen zusammengesetzt sind. Im genannten Buch des Autors dieses Beitrages befindet sich das folgende Beispiel für eine naheliegende Lösung, welche aus mechanischen Elementen des Standes der Technik zusammengesetzt ist. Diese Lösung ist auf S. 53 des Buches als Beispiel I im folgenden Patentanspruch definiert:

„Aufbereitungsanlage für Baumaterial, insbesondere für Schuttmaterial, mit einem Brecher und einer Sortiervorrichtung für das durch den Brecher bearbeitete Material, dadurch gekennzeichnet, dass eine Entstaubungsvorrichtung zwischen dem Brecher und der Sortiervorrichtung angeordnet ist.“ Das Problem, welches sich damals ergab, betraf die Tatsache, dass Staub beim Brechen von Bauschutt frei geworden ist. Dieser Staub belastete die Umgebung. Dieses Problem sollte beseitigt

werden. Das Objekt des vorliegenden Beispiels ist im einleitenden Teil des wiedergegebenen Patentanspruchs angegeben. Die dieses Objekt darstellende Einrichtung umfasst die folgenden Elemente des Standes der Technik, einen Brecher und eine Sortiervorrichtung. Bei jedem dieser Elemente des Standes der Technik wird seine Transformationsfähigkeit im vorliegenden Fall ausgenützt. Beim Brecher ist dies die Fähigkeit desselben, Material zu brechen, d.h. zu zerkleinern. Bei der Sortiervorrichtung betrifft ihre Transformationsfähigkeit eine grössenabhängige Trennung angelieferter Gegenstände voneinander. Bei der Lösung des Objektproblems erinnerte man sich an die Transformationsfähigkeit eines Staubsaugers, ein Gemisch aus Luft und Staub aufzusaugen, den Staub zurückzuhalten und Luft durchzulassen. Man beschloss, den Staubsauger als Mittel zur Lösung des das Objekt betreffenden Problems einzusetzen. Dann musste man sich noch überlegen, an welchem Ort des Objektes, d.h. an welchem Ort der genannten Einrichtung, dieses technische Mittel anzuordnen ist. Man kam zum Schluss, dass das technische Mittel zwischen dem Brecher und der Sortiervorrichtung anzuordnen ist.

Weil es sich im vorliegenden Beispiel um eine naheliegende Lösung handelt, mag dieses Beispiel als trivial angesehen werden. Dennoch dürfte dieses Beispiel nützlich sein. Dies deswegen, weil die Gedankengänge, welche hier bei der Entstehung der Lösung gemäß diesem Beispiel wiedergegebene wurden, während der Entstehung von nicht naheliegenden Lösungen nur mehrmals wiederholt werden.

Eigentlich müssten sich jene lächerlich vorkommen, welche auch nach dem Durchlesen dieses Textes immer noch behaupten würden, dass der Begriff Erfindung ein unbestimmter Rechtsbegriff sei. Denn das Gebiet der Erfindungen stellt, wie man dies beispielsweise diesem Text entnehmen kann, in der Tat eine exakte Wissenschaft dar. Diese Feststellung und diese Tatsache werden in der Zukunft hoffentlich positive Resultate liefern.

Literaturverzeichnis:

- Buch: Materielle Prüfung von Erfindungen, 1978; ISBN 3-85732-100-8
- Artikel: „Zur Bemessung des technischen Fortschrittes von Maschinen“ in der Zeitschrift „Gewerblicher Rechtsschutz und Urheberrecht“ (GRUR), Internationaler Teil, 1967, Heft 2, S. 65 ff;
„Erfindungsbegriff und Prüfungsverfahren“ in GRUR, Inlandsteil, 1975, Heft 8, S. 401 ff;
„Konstrukteur und Patente“ in „Schweizer Maschinenmarkt“, 1979, Nr. 13, 15, und 17;
„Erfindungsbegriff werturteilsfrei“ in der Zeitschrift „Mitteilungen der deutschen Patentanwälte“ (Mitt.), 1979, Heft 7, S. 124 ff;
„Die Entwicklung der Erfindungslehre“ Mitt. 1980, Heft 4, S. 61 ff;
„Ein europäisches ‚kleines Patent‘?“, Mitt. 1980, Heft 11, S. 206 ff;

„Prüfung auf erfinderische Tätigkeit“, Mitt. 1981, Heft 3, S. 50ff;
 „Erfindung im Nichtigkeitsstreit“, Mitt. 1981, Heft 3, S. 193 ff;

„Erfinderische Tätigkeit und non obviousness“, EPI – Information des Institutes der beim Europäischen Patentamt zugelassenen Vertreter, 1998, Heft 3, S. 110 ff.

Methods of Diagnosis – Is there a case for review ?

R. S. Crespi (GB)

The legal protection of technological innovation through the patent system has been highly successful over many years, and the use made of it by private industry, public sector organisations, and academic institutions shows no sign of declining, especially for inventions in the Life Sciences. Nevertheless, patent law is not free from external criticism. Some critics are of the „armchair“ variety, working not as scientific researchers and inventors but in academic institutional departments of philosophy, ethics, and even law. The natural response of patent attorneys is to defend the system against misplaced attacks from these observers and to expose misunderstandings on which such criticism is often based.

That is not to say, however, that we should not be willing, from time to time, to re-visit the reasons for some of its provisions, including the basis for certain exclusions from patentability contained in the European Patent Convention. Although patent statutes are not obliged to contain explicit reasons for their particular provisions, it ought surely to be possible to discover them from preceding recitals or by other methods of enquiry, if only for the purposes of transparency towards those for whom the laws are intended and of course to the public at large.

For reasons of space, the present contribution will be restricted to the one indicated in the above title. By way of preamble, however, I consider it reasonable to question any exclusion which requires many years of deliberation by Courts and Appeal Boards, and the development of extensive case law, before it can be properly interpreted and applied by patent attorneys and Examiners in their daily work. For example, it has taken more than fifteen years to clarify the extent to which transgenic plants can be patented, in view of EPC Article 53 (b). And now that Directive 98/44 EC has been implemented for the EPC, the difficulties of applying Article 53 (a) to some types of biological invention have yet to be fully revealed and resolved. If these remarks are thought to exaggerate the problem, reference should be made to the recently issued „Examination Guidelines for Patent Applications relating to Medical Inventions in the UK Patent Office“. From these Guidelines, which review much EPC case law, one finds abundant evidence of the mental gymnastics the European patent authorities have been obliged to display in deciding cases put to them.

For my present purpose, it is not necessary to discuss this case law because I am questioning the very need for excluding certain kinds of diagnostic method from patentability. I will only remark, however, that from the viewpoint of inventors and those who fund research on new methods of diagnosis, it must seem surprising that it has been necessary, after so long, to request the Enlarged Board of Appeal to decide whether this exclusion applies only to methods which lead immediately to a diagnostic conclusion or to all methods which make some useful contribution toward this conclusion.

EPC Article 52(4)/53(c)

In dealing with inventors in the medical field, the patent attorney is often expected to have an explanation for the fact that European patents are refused for methods of treatment and diagnosis practised on the human and animal body. I will refer to the diagnostic part of this exclusion by the shorthand term „hands-on“ diagnostics as opposed to diagnosis resulting from tests on biological samples removed from the body e.g. blood or urine samples, which I will describe as „hands-off“ diagnosis. This exclusion was previously covered by Article 52 (4) but is now transplanted to form new Article 53 (c).

Many commentators explain this exclusion as deriving ultimately from ethical considerations or from some principle of public policy that patents should not inhibit humanitarian medical procedures of this kind. It has been said that the Diplomatic Conference establishing the EPC put forward some justification of this kind but I have found it difficult to trace chapter and verse for this assertion. However, this cannot be the real basis for it because the explicit wording of Article 52 (4) presented a quite different rationale for this exclusion, namely, that such methods are not susceptible of industrial application, a key requirement of Article 52 as a whole. Before examining this, the following observation must be made.

From the viewpoint of one skilled in the art of veterinary science and medicine, it might well be surprising that methods of treatment or diagnosis carried out on the *animal* body are also excluded from patentability. Ensuring the health of farm animals, whilst in itself commendable as a humane pursuit, is even more important for the proper conduct of agricultural practice in beef and dairy farming and in other sectors of this industry. Therefore to postulate that such methods are

not susceptible of industrial application seems at variance with real life. If one were to argue that domestic animals and pets are in a separate category from farm animals, and deserve separate consideration, it must at least be admitted that there is an industrial-type element in their breeding, nurturing, and sale to pet lovers.

What is Industrial Application?

In reverting to our main line of enquiry, we must first consider the meaning of the term „industrial application“. EPC Article 57 explains that an invention has this capability „if it can be made or used in *any kind of industry*, including agriculture.“ (italics added). The italicised words are therefore crucial to the interpretation we are seeking. It may seem absurd to question the meaning of such a common word as „industry“, but this cannot be avoided. Most English dictionaries are remarkably old-fashioned in the meanings they attach to this word in that they almost invariably rely on the terms „manufacture“, „goods“ and „factories“. This point should immediately resonate with mature British patent practitioners, who will recall that for more than three centuries leading up to 1977 British patent law defined a patentable invention as a „manner of new manufacture“, a term which meant something that could be carried out or made in a factory. An official ruling in 1942 had extended this by insisting that the outcome of the claimed process must be a „vendible product“. The law of some British Commonwealth countries had used the same definition and had adopted the same interpretation until 1960, when this was successfully challenged by a British Public Sector organisation (NRDC) in the Australian High Court. The Australian court then showed much broader vision and switched the emphasis from manufacture to the idea of the „useful arts“ and the field of „economic activity“, and this larger view was soon adopted also in New Zealand and in the UK itself.

Today the term ‚industry‘ has a broad meaning also embracing the „service industries“ where there may be no „vendible product“ in the tangible sense and perhaps only „information“ having a value of some kind. Even the term „tourist industry“ is now commonplace.

Are „Hands on“ Medical Procedures an Industrial Activity?

When the EPC was created, the notion that surgical and therapeutic treatments, as well as diagnostic procedures designed for and applied „hands on“ to human patients, ought not to be classed as industrial activities would not be difficult to accept. Many people would have thought these methods to be non-industrial in nature because they take place mainly in doctors' surgeries or hospital wards and operating theatres, which they were reluctant to think of in the same way as commercial activities. This feeling would be especially natural for the British attorneys in view of the UK national facility of State-funded medicine („free at the point of delivery“) which the vast bulk of the British public had enjoyed for so long.

But the climate has changed considerably over the last 30 years. Access to private medicine as an employment perk or through personal insurance schemes, and the

improved prosperity of many citizens, has become widespread. One particular branch of medicine relevant to this subject is that of the Fertility Clinics, many of which entail significant cost to the patient. The fertility experts might dislike the term „fertility industry“ but they can hardly deny that they operate not only philanthropically but also as a business enterprise. These observations are not meant in any way as criticism of these medical specialists; their situation has been highlighted only to show that the division between industrial and non-industrial (non-commercial) activities in the medical field is no longer clear-cut.

Diagnostic Methods using Samples taken from the Body

Methods of this kind are not embraced by the EPC Article under discussion here. Whatever may be the underlying reason for the exclusion of patents for ‚hands on‘ diagnostics, the distinction between this and the „hands-off“ methods (using samples removed) is also a somewhat weak basis for refusing one and allowing the other. In the „hands-off“ method, the consulted doctor rarely takes the sample or conducts the claimed method, having a nurse to do the first and the use of a technician elsewhere to do the second.

But here again a significant distinction is difficult to see. A hospital doctor often passes the sample to a routine test laboratory in the same hospital in which he works. Usually a family doctor will also pass the sample to this local hospital for the diagnostic test. A private hospital may well use the state-funded hospital or some commercial laboratory for these tests and, in either case, will be billed for this service. In each case, the doctor receives the test results and makes the diagnosis accordingly.

Again, in the hands-on method, the doctor commonly uses technicians in some other location. For example, an orthopaedic consultant may recommend an MRI scan on my lower back but he will usually not do this himself. His main role will be to interpret the pictures that he receives from the hospital and then perhaps tell me that my back is not so bad, considering my age.

Ancillary Claims to the Diagnostic Methodology

For present purposes I am leaving out of account the likelihood that claims of related types may also be possible in addition to the method claims. Even when the essence of the invention lies in the method, as such, ancillary claims to items of apparatus, diagnostic kits, combinations of reagents, and other claimable subject matter may also be permissible. Where these have been included, the refusal of method claims under the present law may not be disastrous to the prospects of effective commercial exploitation of the invention.

But it is not my present concern to question what exploitation value any diagnostic method patent (hands-on or hands-off) can have for its owner. I am restricting my remarks to the weak logic of allowing one type of diagnostic method patent and refusing the other. If the purpose of original Article 52(4) was that „a medical practitioner should not be hampered in the practice of medicine“ (quoted in one Technical Appeal

Board decision) why is this relevant only to hands-on diagnosis and not to hands-off diagnosis?. Both types of diagnosis involve technological procedures to produce results from which the diagnosis is finally made, and the presence or absence of the patient during these procedures seems irrelevant to any consideration of „hampering“ as far as the medical practitioner is concerned.

This kind of exclusion is not present in the patent law of some countries outside Europe. It would therefore be interesting to investigate to what extent the „hampering“ problem is a real one elsewhere. The US law has long allowed method claims of the kind considered here but now exempts certain kinds of medical practitioner from liability for infringement of such claims. This may detract from the value of such patents unless provisions in the law relating to inducing infringement or contributory infringement are relevant to the situation.

Conclusion

It is a basic assumption underlying the patent law that it is primarily designed to encourage the development of innovative technology across a wide waterfront. If, which I doubt, the legislators could provide a good and convincing reason for exempting diagnostic

methodology from patent protection, then the logic would be to deny patents for all such methods (as the Chinese law does). If not, there seems to be no reason for the discrimination of the kind we now have in the EPC. And as to who benefits from this selective exclusion, I am also in considerable doubt.

The removal of any reference to „industrial application“ in the new Article 53 (c) makes further discussion of this term redundant in the argument I am advancing, although it might be useful for future interpretation of Article 57 to have some clearer interpretation of what constitutes „industry“. Fortunately, all exclusions have to be interpreted narrowly, and the earlier EPC case law on methods of this kind was very helpful in applying this principle. It may be too much to hope for a removal of this exclusion in the foreseeable future but the justification for retaining it is unclear and unconvincing, in my view.

If the foregoing argument carries conviction, as applied to diagnostic methods, I do not overlook the possible implications it may have for a reconsideration of the whole of Article 53 (c); for the present, however, I must remain within the bounds of realism.

Allowability of Undisclosed Disclaimers: the latest from EPO

C. Germinario (IT)

The Enlarged Board of Appeal (hereinafter EBA) of the European Patent Office (EPO) issued on April 8, 2004 decision G0001/03 (and G0002/03), concerning the allowability of amendments made to a patent claim with a disclaimer that has no basis in the application as filed (hereinafter „undisclosed disclaimer“).

By stating that:

„An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed“ (Answer 1)

the EBA has legitimated a principle consistently applied in boards of appeal case law, with the sole exception of decision T 323/97 (OJ 2002, 476).

Additionally, the EBA has extended the field of applicability of an undisclosed disclaimer, allowing it to be used for excluding from the scope of protection anticipations under Article 54(3) and (4) EPC (conflicting applications) or subject-matter not eligible for patent protection (e.g. Articles 52 (2) (4) or 53 EPC). In particular, decision G0001/03 identifies three cases in which a disclaimer, undisclosed in the application as filed, can be added to a claim.

Article 54(2) EPC

First of all, a disclaimer may be used in order to restore novelty against an accidental anticipation. Since the need was felt in specialized circles¹ for a clear and stringent definition of the term „accidental“, the EBA has now delimited the concept more precisely. From a technical point of view, an accidental anticipation must be so unrelated to, and remote from, the invention, that the person skilled in the art would never have taken it into consideration when working on the invention. These circumstances apparently occur when the anticipation both belongs to a remote technical field and addresses a different technical problem. This principle should be considered in absolute, rather than relative, terms. That is, the accidental nature of an anticipation should be ascertained regardless of the existence and the relevance of any other available prior document. The fact that a document is not the closest prior art does not make it „accidental“.

Article 54(3) and (4) EPC:

A disclaimer may be used in order to restore novelty against an earlier EP (or PCT) conflicting application. This possibility is not subordinate to the „accidental“ nature

¹ C. Germinario, „Patent Word“ No. 142, May 2002

of the anticipation, that may well belong to the same technical field and solve the same problem as the subsequent application.

Subject-matter not eligible of patent protection (Articles 52(2), (4) and 53 EPC).

The EBA has extended the applicability of undisclosed disclaimers to subject-matter which is excluded *a priori* from patentability, either because of its non technical nature (Art. 52(2) EPC), or because it lacks industrial applicability (medical treatments), or even on moral or ethical grounds (Article 53 EPC).

However, I believe there to be a fundamental difference between a prior teaching, under Art. 54(2) or 54(3), and subject-matter excluded from patentability. Disclaiming the former is legitimated by the fact that the applicant, while filing the application, was obviously unaware of the existence of such an anticipation, either because it was unpublished or because it was so remote from the invention as to be „inexistent“. This criterion does not apparently apply to those „exclusions from patentability“ specifically provided for by the Law, of which the applicant or its representative are obliged to be aware. In other words, the rightful interest of the applicant in obtaining protection or priority rights also for those aspects of the invention that are excluded from patentability in some states, should not justify the absence, in the filed application, of embodiments of the invention that represent fall-back possibilities, allowing the scope of the claims to be limited without using undisclosed disclaimers. It seems therefore that this novel possibility envisaged by the EBA can be applied correctly only in those exceptional circumstances in which a change of substantive law or a change of the interpretation of existing provisions of law, during pendency of the application, would render unpatentable subject-matter considered patentable at the filing date. An example of this situation could be the protection of diagnostic technical methods, which are under consideration in Opinion G0001/04 now pending before the EBA.

The form of a disclaimer

The EBA has also confirmed that the recognized possibility of adding to a claim an undisclosed disclaimer is not an opportunity to reshape the claim arbitrarily, and contribute to its technical teaching. On the contrary, the disclaimer should remove from the scope of protection no more than the complete and precisely defined subject-matter either affecting the novelty of the claim, or not eligible of patent protection. In any case, the EBA makes it clear that the addition of a disclaimer cannot contravene the requirements of clarity provided by Article 84 EPC. For this reason, the disclaimer is not allowable if the necessary limitation can be expressed in simpler terms with positive originally disclosed features.

Admissibility of a disclaimer

Likely, the most helpful part of the decision is the identification of specific circumstances in which an undisclosed disclaimer would not be considered admissible, or circumstances in which an admissible disclaimer

would have to be considered *a posteriori* as inadmissible. In general terms, this may happen any time a limitation effected by an undisclosed disclaimer turns out, in a later phase of the proceedings, to be of technical relevance.

In particular, the EBA makes it clear that an undisclosed disclaimer is, first of all, inadmissible if it is *intended* to exclude embodiments of the invention not allowable for any reason other than those already discussed. For instance when the disclaimer is intended to exclude subject-matter that is not repeatable (Art. 83 EPC) or not inventive (Art. 56 EPC).

Beyond these circumstances, the EBA explains that an undisclosed disclaimer, though intended for an allowable purpose, such as that of excluding an anticipation under Art. 54(3) EPC, is nevertheless inadmissible when it automatically achieves an additional effect, technically contributing to the definition of the „amended“ claim.

This situation occurs for instance when the novelty of a claim is jeopardized by two anticipations: one under Article 54(2); another under Article 54(3) EPC.

The case is far from being only theoretical. It happens for example when an applicant files an EP application, and, shortly thereafter, publishes its invention as specialized literature. In this case, both the published piece of literature and the EP application may represent identical anticipations vis-à-vis a subsequent EP application: the former under Art. 54(2), the latter under Art. 54(3) EPC.

According to a general principle laid down by G0001/03, the subject matter of the conflicting application could be easily excluded from the subsequent EP application by way of an undisclosed disclaimer, even if the conflicting application belongs to the same technical field or solves the same problem, in other words it is no „accidental anticipation“. However, this disclaimer would automatically exclude from the scope of protection also the identical anticipation under Art. 54(2) EPC, i.e. the piece of literature, regardless of its non accidental nature. This means that the theoretically admissible disclaimer would assume technical relevance, which would make it inadmissible.

It is evident that this consideration equally applies to any situation in which an *a priori* admissible disclaimer would bring about the „side“ effect of excluding non workable or non inventive subject-matter.

The situation is complicated further by the fact that the conditions justifying the use of an undisclosed disclaimer may change during the proceedings, making the disclaimer inadmissible. For instance, the „accidental“ qualification of an anticipation, that had been disclaimed in a claim, may change because of novel facts or knowledge introduced during the proceedings. One example could be a novel prior document which reveals the existence of a technical relationship linking two technical fields, or two technical problems, previously considered very unrelated and remote.

A second case occurs when an Art 54(3) anticipation becomes an Art 54(2) anticipation, due to the loss of priority of the claim containing the disclaimer. If the disclaimed anticipation, represented by a conflicting prior application, was not an „accidental“ anticipation,

then the disclaimer would inevitably become inadmissible.

Also the above discussed situation of the two identical anticipations, under Art. 54(2) and 54(3) EPC, implies a considerable level of risk, if the prior art under Art. 54(2) is brought to the attention of the examiner only after the introduction in a claim of a disclaimer excluding the Art 54(3) anticipation. Also in this case, the disclaimer would become inadmissible.

An expert knows very well that all the illustrated cases are not merely academic or theoretical, but happen in the real life of a patent and sometimes can seriously endanger it. This is the case where the change of circumstances converting an admissible disclaimer into an inadmissible limitation occurs during an opposition proceeding. The patentee could run into the very uncom-

fortable situation in which the limitation cannot be maintained because it is against the requirements of Art. 123(2) EPC, but cannot be removed either, because that would result in extending the protection conferred by the granted patent, thus contravening the requirements of Art. 123(3) EPC (inescapable trap – G0001/93).

This shows that the use of undisclosed disclaimers, though now legitimated by a decision of the EBA, remains a tool not free of risks, and should therefore be regarded as the extreme, but not the preferred, solution in problematic situations.

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Gewerblicher Rechtsschutz in Japan¹ by Klaus Hinkelmann

A. Petersen-Padberg² (DE)

Der gewerbliche Rechtsschutz hat große Bedeutung in Japan. Mit der Pro-Patent Politik Ende der 1990er Jahre sind zahlreiche Gesetzesänderungen, insbesondere im Patentrecht erfolgt, um die Erlangung und Durchsetzung von gewerblichen Schutzrechten zu verbessern.

Mit dem Werk von Hinkelmann liegt erstmals in deutscher Sprache ein umfassendes Werk zum japanischen Patent-, Gebrauchs- und Geschmacksmuster, Markenrecht und dem Recht des unlauteren Wettbewerbs vor. Der Schwerpunkt liegt im Patentrecht, das über die Hälfte des Werkes einnimmt, breiten Raum erhält auch das Markenrecht. Das sorgfältig und kompetent verfasste Buch ist als praktischer Ratgeber konzipiert und profitiert von den Erfahrungen des Autors während seiner Tätigkeit in Japan. Das Werk beeindruckt durch die zahlreichen prägnant dargestellten Gerichtsentscheidungen und seine hohe Aktualität – die rasante Gesetzgebung der letzten Jahre wurde vollständig berücksichtigt.

Im patentrechtrechtlichen Teil wird zunächst die Patentierbarkeit mit Schwerpunkt auf den Gebieten der Medizin, Biotechnologie und Software, einschließlich Geschäftsmethoden erläutert. Praxisnah werden die Voraussetzungen für Neuheit, erfinderische Tätigkeit und Ausführbarkeit, die Abfassung von Patentanmeldungen und das in den letzten Jahren beschleunigte Patenterteilungsverfahren dargestellt.

Die Rechtsprechung zu den umstrittenen Themen wie die Zulässigkeit klinischer Versuche während der Patentlaufzeit, Parallelimport, Erschöpfung des Patentrechts, das gegenwärtig lebhaft diskutierte Arbeitnehmererfindungsrecht und die Weiterentwicklung der Äquivalenzdoktrin wird übersichtlich dargestellt. Ein ausführliches Kapitel ist dem Lizenzvertragsrecht gewidmet.

Der Leser erhält einen greifbaren Eindruck von der gegenwärtigen Praxis der Verletzungsverfahren, die in den letzten Jahren dank drastischer Verkürzung der Verfahrensdauer und der Gewährung erheblicher Schadensersatzsummen zunehmend in Anspruch genommen werden. Die jüngsten Gesetzesnovellen, die Abschaffung des Einspruchsverfahrens zugunsten eines einheitlichen Nichtigkeitsverfahrens, in Kraft ab 01.01.04, und das neue Gebührenrecht, in Kraft ab 01.04.04, fanden noch Berücksichtigung.

Das im zweiten Teil dargestellte Gebrauchsmusterrecht hat in Japan seit der Reform von 1994, mit der die Sachprüfung abgeschafft und die Laufzeit von 10 auf 6 Jahre reduziert wurde, an Bedeutung verloren (8.603 Anmeldungen in 2002). Doppelschutz durch Patente und Gebrauchsmuster kann nicht erlangt werden. Der Vorteil der schnellen Erlangung des Schutzrechts wird durch die verkürzte Patenterteilungszeit relativiert.

Dem 1999 grundlegend reformierten Geschmacksmusterrecht kommt in Japan eine große Bedeutung zu (2002 gab es 37.230 Registrierungen). Oft wird es sich empfehlen, sowohl Geschmacksmuster- als auch Markenschutz zu beanspruchen. Die Eintragbarkeit wird anhand zahlreicher Beispiele erläutert.

¹ Klaus Hinkelmann, Gewerblicher Rechtsschutz in Japan, Carl Heymanns Verlag KG, Köln, 1. Auflage 2003, 480 Seiten, ISBN 3-452-24622-1, 168,- Euro

² Dr. Anja Petersen-Padberg, Rechtsanwältin Kanzlei Hoffman & Eitle, München

Das Kapitel Markenrecht behandelt ausführlich die Besonderheiten der japanischen Sprache, die für ausländische Anmelder zu Schwierigkeiten bei der Eintragung von Wortmarken führt, insbesondere da das JPA von Amts wegen die Ähnlichkeit mit einer älteren Marke als Eintragungshindernis prüft. Zahlreiche Fallbeispiele illustrieren, wie (unklar) die Beurteilung der Ähnlichkeit insbesondere in Bezug auf die Aussprache ist. Die wichtige Rechtsprechung zum Schutz der berühmten Marke, die sich erst in den letzten Jahren stärker zugunsten des Markeninhabers entwickelt hat, wird ausführlich dargestellt.

Abgerundet wird das Werk durch eine übersichtliche Darstellung des Rechts des unlauteren Wettbewerbs, das

sich neben dem UWG auch auf Vorschriften des BGB, HGB und AMG stützt. Das japanische UWG enthält statt einer Generalklausel einen Katalog unlauterer Handlungen, zuletzt erweitert in Bezug auf cybersquatting. Ca. 150 anhängige Gerichtsverfahren pro Jahr zeigen eine andere Praxis als in Deutschland, doch die Gerichte haben seit kurzem die Schlagkraft des Rechts gegen den unlauteren Wettbewerb durch Beschleunigung der einstweiligen Verfügungsverfahren erhöht.

Das Werk ist eine lohnende Anschaffung für Praktiker und Wissenschaftler, die einen schnellen Zugriff auf den gewerblichen Rechtsschutz in Japan haben wollen. Es dürfte zu einem Standardwerk zum gewerblichen Rechtsschutz in Japan werden.

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- Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu den Prüfungsaufgaben des Jahres 2003, Versand erfolgt im Juni. Die eingegangenen Arbeiten werden schriftlich korrigiert, bewertet und den Kandidaten wieder zugestellt.
- **Anmeldeschluss:** **15.06.2004**
- **Kursgebühr Modul 1:** **CHF 450.-**

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- **Anmeldeschluss:** **01.09.2004**
- **Kursgebühr Modul 2 (inkl. Modul 3):** **CHF 600.-**

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- Ausführliche Besprechung der Prüfungsaufgaben 2004 und Fehleranalyse der Kandidatenarbeiten in Basel (Februar 2005). Auf Wunsch kommentieren wir schriftlich auch nicht bestandene Prüfungsarbeiten (2004).
- **Anmeldeschluss (nur für Modul 3):** **15.11.2004**
- **Kursgebühr Modul 3:** **CHF 300.-**

Auskunft / Anmeldung beim Kursleiter:

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2	BE	109	1,81
3	CH	284	4,71
4	CY	28	0,46
5	DE	2190	36,35
6	DK	112	1,86
7	ES	164	2,72
8	FI	155	2,57
9	FR	576	9,56
10	GB	1377	22,85
11	GR	39	0,65
12	IE	32	0,53
13	IT	287	4,76
14	LI	9	0,15
15	LU	13	0,22
16	MC	3	0,05
17	NL	264	4,38
18	PT	50	0,83
19	SE	249	4,13
Total		6025	100,00

LIST OF PROFESSIONAL REPRESENTATIVES AS OF **21.06.2004**

by their place of business or employment in the Contracting States and their entry according to A134 or A163

No.	Contr. State	A134	% A134	A163	% A163	Total Repr.	% of Tot/Repr.
1	AT	45	51	44	49	89	1,15
2	BE	78	62	48	38	126	1,63
3	BG		0	107	100	107	1,38
4	CH	173	53	152	47	325	4,20
5	CY		0	14	100	14	0,18
6	CZ		0	131	100	131	1,69
7	DE	1583	64	900	36	2483	32,11
8	DK	58	42	80	58	138	1,78
9	EE		0	32	100	32	0,41
10	ES	6	4	149	96	155	2,00
11	FI	8	5	144	95	152	1,97
12	FR	364	56	287	44	651	8,42
13	GB	941	63	563	37	1504	19,45
14	GR		0	33	100	33	0,43
15	HU		0	159	100	159	2,06
16	IE	7	20	28	80	35	0,45
17	IT	121	40	185	60	306	3,96
18	LI	5	50	5	50	10	0,13
19	LU	8	53	7	47	15	0,19
20	MC		0	3	100	3	0,04
21	NL	208	73	76	27	284	3,67
22	PL		0	252	100	252	3,26
23	PT		0	47	100	47	0,61
24	RO		0	132	100	132	1,71
25	SE	99	39	153	61	252	3,26
26	SI		0	33	100	33	0,43
27	SK		0	51	100	51	0,66
28	TR	1	0	212	100	213	2,75
Total		3705	48	4027	52	7732	100,00

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

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de discipline (epi)
AT – W. Katschinka AT – P. Révy von Belvard BE – G. Leherte* BE – T. Debled BG – E. Benatov CH – K. Schmauder CZ – V. Žak DE – W. Fröhling DE – G. Keller** DK – U. Nørgaard	ES – V. Gil Vega FI – P. C. Sundman FR – P. Monain FR – J.-P. Kedinger GB – S. Wright GB – G. Szabo GR – T. Kilimiris HU – I. Markó IE – G. Kinsella IT – G. Mannucci	IT – B. Muraca LI – P. Rosenich LU – J. Waxweiler NL – J. de Vries NL – A. Ferguson PT – A. J. Pissara Dias Machado RO – D. Tuluca SE – P. O. Rosenquist SK – M. Majlingová TR – T. Yurtseven
Disziplinarausschuss (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
DE – W. Dabringhaus DK – B. Hammer-Jensen	FR – M. Santarelli	GB – J. Boff
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
AT – W. Kovac DE – N. M. Lenz FR – P. Gendraud	GR – C. Kalonarou LI – K. Büchel	NL – A. V. Huygens SE – C. Onn
epi-Finanzen	epi Finances	Finances de l'epi
AT – P. Pawloy BE – P. Vandersteen CH – T. Ritscher	DE – M. Maikowski DK – K. Vingtoft FR – H. Dupont GB – T. Powell	IT – S. Bordonaro LU – J. P. Weyland* SE – B. Erixon
Geschäftsordnung	By-Laws	Règlement intérieur
CH – C. E. Eder* DE – L. Steiling**	FR – T. Schuffenecker	GB – T. L. Johnson
Standesregeln	Professional Conduct	Conduite professionnelle
AT – E. Kunz AT – E. Piso BE – P. Overath CH – U. Blum DE – H.-H. Wilhelm DE – K. Zimmermann DK – L. Roerboel ES – C. Polo Flores	FI – J. Kupiainen FR – J. Bauvir FR – P. Vidon GB – J. D. Brown* GB – J. Gowshall GR – A. Patrinos-Kilimiris IE – M. Walsh IT – A. Perani	LU – J. Bleyer NL – F. Barendregt NL – F. Dietz PT – N. Cruz PT – F. Magno (Subst.) SE – L. Stolt SE – M. Linderoth TR – K. Dündar TR – E. Dericioglu

Europäische Patentpraxis		European Patent Practice	Pratique du brevet européen
AT – H. Nemec		ES – E. Armijo	IT – A. Josif
AT – G. Widtmann		ES – L. A. Duran	LU – Bruce Dearling
BE – P. Jacques		FI – E. Grew	NL – W. Hoogstraten
BE – J. van Malderen		FI – A. Weckman	NL – L. J. Steenbeek
CH – W. Bernhardt		FR – A. Casalonga*	NL – R. Jorritsma (Substitute)
CH – E. Irniger		FR – J. Bauvir	PT – P. Alves Moreira
CY – C. Theodoulou		GB – P. Denerley**	PT – N. Cruz
DE – G. Schmitt-Nilson		GB – E. Lyndon-Stanford	SE – A. Bornegård
DE – F. Teufel		GR – D. Oekonomidis	SE – M. Holmberg
DK – P. J. Indahl		IE – P. Shortt	TR – A. Deris
DK – P. Stahr		IE – C. Lane (Substitute)	TR – O. Mutlu
		IT – E. de Carli	TR – S. Coral (Substitute)
Berufliche Qualifikation Ordentliche Mitglieder		Professional Qualification Full Members	Qualification professionnelle Membres titulaires
AT – F. Schweinzer		FI – B. Träskman	LI – S. Kaminski
BE – M. J. Luys		FR – L. Nuss	LU – C. Schroeder
CH – E. Klein		GB – J. Gowshall	NL – F. Smit
CY – C. Theodoulou		GR – T. Margellos	PT – I. Franco
DE – G. Leissler-Gerstl**		IE – L. Casey	SE – T. Onn*
DK – E. Christiansen		IT – F. Macchetta	TR – S. Arkan
ES – J. F. Ibanez Gonzalez			
Stellvertreter	Substitutes	Suppléants	
AT – P. Kliment		ES – A. Morgades	IT – P. Rambelli
BE – G. Voortmans		FI – J. Salomäki	NL – J. Grootsholten
CH – K. Schwander		FR – M. Le Pennec	PT – J. de Sampaio
DE – K. Zimmermann		GB – J. Laredo	SE – M. Linderöth
DK – A. Secher			TR – B. Kalenderli
(Examination Board Members on behalf of the epi)			
CH – M. Seehof		GB – I. Harris	IT – G. Checcacci
		GB – S. White	
Biotechnologische Erfindungen		Biotechnological Inventions	Inventions en biotechnologie
AT – A. Schwarz		FR – M. Le Pennec	NL – J. Kan
BE – A. De Clercq*		FR – J. Warcoin	PT – J. E. Dinis de Carvalho
CH – D. Wächter		GB – S. Wright	PT – A. Canelas (Substitute)
DE – G. Keller		GB – C. Mercer**	SE – L. Höglund
DK – B. Hammer Jensen		IE – C. Gates	TR – H. Cayli
ES – A. Ponti Sales		IT – G. Staub	TR – C. Özbay
FI – M. Lax		IT – D. Pieraccioli (Substitute)	
EPA-Finzen		EPO Finances	Finances OEB
DE – W. Dabringhaus		FR – S. Le Vaguerèse	GB – J. Boff*
ES – I. Elosegui de la Pena			
Harmonisierung		Harmonization	Harmonisation
BE – F. Leyder*		ES – J. Botella	GB – J. D. Brown**
DE – R. Einsele		FR – S. Le Vaguerèse	NL – L. Steenbeek
			SE – K. Norin

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DE – D. Speiser*	FI – J. Virkkala	IT – L. Bosotti
		NL – F. Dietz
Standing Advisory Committee before the EPO (SACEPO)		
epi-Delegierte	epi Delegates	Délégués de l'epi
AT – G. Widtmann	FI – P. Hjelt	LU – B. Dearling
BE – F. de Corte	FR – J. J. Martin	MC – G. Collins
BG – E. Vinarova	GB – C. Mercer	NL – A. Huygens
CH – A. Braun	GR – H. Papaconstantinou	PT – P. Alves Moreira
CY – C. Theodoulou	HU – I. Gödölle	RO – D. Nicolaescu
CZ – M. Guttman	IE – D. McCarthy	SE – L. Karlsson
DE – L. Steiling	IT – V. Faraggiana	SK – J. Gunis
DK – K. E. Vingtoft	LI – R. Wildi	TR – A. Ünal-Ersönmez
ES – M. Curell Suñol		
Wahlausschuss	Electoral Committee	Commission pour les élections
CH – H. Breiter	DE – B. Avenhaus	HU – T. Palágyi
Interne Rechnungsprüfer Ordentliche Mitglieder	Internal Auditors Full Members	Commissaires aux Comptes internes Membres titulaires
CH – A. Braun	DE – R. Zellentin	
Stellvertreter	Substitutes	Suppléants
DE – D. Laufhütte	DE – R. Keil	