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EDITORIAL

While the Council of our Institute was meeting in Munich, the new President of the Administrative Council Mr. Leberl and the President and Vice Presidents of the European Patent Office gave us informative accounts of their activities. These accounts were so interesting to Council members that we have asked the EPO to give us summaries for inclusion in this EPI Information bulletin.

Mr. Van Benthem also introduced Council members to Mr. Braendli of the Swiss Patent Office who will be succeeding him when he retires on 1st May 1985.

If this EPI Information bulletin reaches you via an address from which you have moved, please write to our Secretariat giving your correct, present address. In this connection please see item 7 of the List of Decisions of our Council meeting reported on page 19 (English), 24 (French) and 13 (German).

Jean Brullé . Ernst J. Schönhöfer . Ken Veryard

A MESSAGE FROM THE EUROPEAN PATENT OFFICE

Closely related applications are sometimes allotted to different examiners and therefore receive different treatment. This might be avoided if the applicant sends a covering letter to the European Patent Office drawing attention to the relationship.

The practice in DG 2 is to allot related cases to the same examiner whenever possible. However it sometimes occurs that the relationship between applications is not discovered until later. We therefore would very much welcome the suggestion that where an applicant files applications which are closely related to one another he informs the Office of this fact in a covering letter on each of the applications.

J.B. van Benthem, President of the European Patent Office.

TRAINING PROGRAMMES ON THE EUROPEAN PATENT

30 January - 1 February 1985
11 - 13 February 1985

The Training Programmes on European Patent Law and Practice are intensive 3-day courses designed for students who are preparing for the European Qualifying Examinations.

Treatment will be given to the four papers of the European Qualifying Examinations.

The courses are open to members of EPI and to other persons who wish to attend, particularly those who may be interested in an English language course.

For further information contact:

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VORBEREITUNG AUF DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 1986

In der Schweiz wird schon zum 4. Mal ein Vorbereitungsprogramm für die europäische Eignungsprüfung durch die nationalen Verbände der Industriepatentanwälte und der freiberuflichen Patentanwälte organisiert. Diese langfristige Vorbereitung auf die Prüfung 1986 besteht aus einer schriftlichen Phase mit bekannten Prüfungsunterlagen und aus einer simulierten Prüfung mit neuen Unterlagen. Das Programm wird in deutscher Sprache durchgeführt und beginnt mit einer Orientierungsversammlung, die voraussichtlich Anfang Februar 1985 in Basel stattfindet. Weitere Informationen können bei Herrn J. D'haemer (tel. CH/61/24 44 25) eingeholt werden. Anmeldungen sind an ihn an die Adresse Sandoz A.G.,

Patentabteilung
CH - 4002 Basel

zu richten.

LETTERS TO THE EDITOR

From: Mr. M.G. Harman, Member of the EPI from Great Britain

GRACE PERIOD

Dear Sirs,

I would like to congratulate you on the latest EPI Information (No. 3, 1984). The letters and general articles are making it increasingly interesting.

I would like to make a couple of comments on "Grace Periods".

First, on the details of the proposal, I am disturbed by the way that the US system is wholly ignored, on the ground that that system rests on a different basis. It seems to me that we have an important opportunity to bring about a convergence of the US and European systems. We could provide for a true priority period (not a mere grace period) of up to a full year, to be claimed at the applicant's choice, so that the claimed disclosure date would operate as the priority date for all purposes. The only restriction would be that the applicant would have to provide proof (similar in standard to the US proof of date of conception, etc) if challenged; priority would exist only for matter so proved. This would be easy in cases of disclosure by documentary publication; and such proof would minimise the chances of outright stealing of someone else's published invention or of trying to antedate a competitor in the event of parallel invention. This is not the US system; but it has significant similarities to the US system whereby a publication (by the inventor or by a

third party) within the 1st year preceding a US filing date can be overcome by proof of a date of conception, etc, before the date of publication.

Second, on the fundamental question of whether there should be some kind of grace period at all, by far the most important consideration to me is the case of the ignorant inventor. Every one of us who has had contact with small private inventors must have had someone come to them saying "I have this invention, which I have been selling for some little time now with great success; please get me a patent for it". Mr. Brullé says that ignorance is not an excuse. It is true that ignorance of the laws forming part of the system is not an excuse; but conversely, it must therefore be the duty of the system to ensure that everyone is aware of, or at least has been given a reasonable opportunity to make themselves aware of, the general nature of the system. The evidence is that the system has failed in its duty, and I see no reasonable prospect of it fulfilling that duty in the future. The system ought therefore to be changed so that it does act fairly towards the small private inventor, either by means of a grace period or by some far more radical change. Any change is bound to cause some degree of upheaval, but I do not believe that it is beyond our ingenuity to alter the system without causing intolerable problems. Until then, I shall continue to feel ashamed when inventors come to me and say "I have made this invention, which has sold so well in the last few months that I have realised it is genuinely significant, and I would like a patent ...".

Yours faithfully,
M.G. Harman

From: Mr. Richard Petersen, member of the EPI from Great Britain

Dear Sir,

GRACE PERIOD

The original proposal for the international acceptance of a grace period for public disclosure of an invention before filing a patent application, envisaged that this grace period would only be used on an exceptional basis, usually when an inventor had failed to file his/her application before publication through ignorance or inadvertence. Indeed the main arguments in favour are based upon this concept. No penalty for the granting of this privilege was suggested. I fear that the result of granting such an international grace period without penalty would be to make its use attractive on a general rather than an exceptional basis. Already the grace period is referred to in WIPO documents as a general grace period. Is such a development desirable?

Previous experience in such countries as have or had a similar grace period may appear to confirm that its use is exceptional, but the lack of any international recognition discouraged and still discourages its use generally. Once international recognition is achieved, the situation will be different and, for example, delayed filing could add six months to the life of any patent granted with a claim to grace, as well as postponing the payment of all fees. Are the supporters of this proposal prepared to accept such general delay? The six months could soon become twelve months following the WIPO model law for developing countries and the example of U.S.A. We could then be well

on the way to a first-to-invent system. Recently, a British inventor engineer suggested what amounted to a twenty year grace period, allowing an inventor to postpone filing his/her patent application until the invention had proved to be commercial, and had been copied!

Other failures to meet time limits are penalised financially, for example late payment of EPO search and examination fees, but clearly any financial penalty is inappropriate as many inventors are particularly short of funds when a patent application is to be filed after development of an invention. As the usual reason for the use of the grace period provisions will be ignorance or inadvertence, it would be appropriate if the penalty could be educative and have the effect of removing the ignorance or carelessness of the inventor.

One possible penalty could be included in a system in which the late filer has to declare his/her claim to the privilege of the grace period. Having done so once, the inventor could not validly invoke the same privilege again in any country recognising the grace period, except for applications filed within the six months following the first filing to claim the privilege. This would allow for any inventions in the pipeline suffering the same defect when the inventor learnt of the need for absolute novelty. Thereafter, he/she would be assumed to have sufficient knowledge of patent law to keep to the proper time limits.

Obvious variations are possible within this idea. Two or more such claims might be allowed to enlarge the educational process. The ban on claiming might lapse after a period of years to allow for the forgetfulness of inventors. There might even be a points system to cumulate the number of days privilege claimed for several applications, when the ban would operate upon an unreasonable total being reached.

Devious minds will doubtless think up ways of avoiding the penalty that I have suggested, but other penalties will occur to other minds and I do not consider that that detracts from the desirability of the principle of a non-financial, educative penalty.

Yours sincerely,
Richard C. Petersen

From: Mr. Hugh R. Wright, member of the EPI from Great Britain

Dear Sirs,

The European Qualifying Examination

I would like to write to support Mr. Hurst in the strongest possible terms. There appears to have been a definite shift away from a technical and legal basis for our profession to a linguistic basis. It seems to me that this is quite wrong.

Our clients ask us to represent them because we can understand the technicalities of their inventions which we describe in a Patent Specification, and also because we can understand the complexities of the European Patent Law so as to represent their case in the best possible terms. Our linguistic abilities are of much more minor importance since it is possible to have translated any relevant document.

Of course those supporting greater European linguistic ability will tell me that what is required in a European Patent Attorney is not only technical and legal ability, but also linguistic ability. I must tell you that in my experience it is extremely rare to find someone who is sufficiently competent in all three areas. Frankly, Patent Attorneys are already rare animals in that they combine an interest and ability in legal and technical matters.

Let us get back to the skills and abilities which our clients require.

Yours faithfully,
Hugh R. Wright

From: Mr. F. Antony, member of the EPI from Switzerland

European Qualifying Examination

Dear Sirs,

I refer to Mr. R.A.A. Hurst's letter to you, published in EPI Information 3-1984 and complaining about the use of "non-English language prior art", without translation, in connection with Papers A, B and C of the Examination.

I agree with Mr. Hurst to the extent that, for the examination, knowledge of European patent law and practice is more important than the linguistic abilities of a candidate. While I do believe that each candidate should have

sufficient knowledge of the three official languages for understanding prior art documents in his own technical area of competence (e.g. chemistry), I agree it does make a difference whether a document is in one's own language or in a language in which one is less than perfect. However I must strongly disagree with Mr. Hurst's reference to just "non-English language" prior art: does he realise

- (i) that the three official languages have equal standing, and
- (ii) that understanding of a "non-French language" or "non-German language" document (e.g. an English-language document) may be equally difficult to a candidate of French or German mother language, respectively, as is understanding of a non-English language document to an English-speaking candidate?

In my strong view, there are only two possibilities of fair treatment of the candidates: Either there is used an about equal mix of documents in the three official languages without translation (requiring all candidates to have an adequate knowledge of each of those languages); or a translation into the official language of each candidate's choice is provided for all documents which are in a different language. Anything else, such as providing English translation of non-English language documents, but no French or German translations, would be

- (a) a substantial handicap for the French- and German-language candidates, and
- (b) an insult to the English-language candidates (because it would imply that there are poor linguists only in the U.K. and Ireland).

Yours faithfully,
F. Antony

BERICHT DES RATES

Die 17. Sitzung des Institutsrates wurde in München am 22. und 23. Oktober 1984 abgehalten.

Die beiden Vize-Präsidenten, Herr D'haemer und Herr Schönöfer, berichteten über die im Juni abgehaltene Sitzung des Verwaltungsrates der Europäischen Patentorganisation sowie über die positive Atmosphäre, in der sie empfangen wurden. Der Präsident, Herr Bressand, berichtete über seine ermutigende Zusammenkunft mit Herrn Otto Leberl, dem neuen Präsidenten des Verwaltungsrates.

An einem WIPO-Programm über biotechnologische Erfindungen, das in Genf vom 5. bis zum 9. November stattfinden wird, werden die Herren Bressand und Gallochat im Namen des EPI teilnehmen. Herr Tasset wird als EPI-Delegierter an einem CEFIC-Programm über neue chemische Technologie teilnehmen, das in Brüssel am 22. und 23. November stattfinden wird.

Nach Durchführung einer Analyse des langfristigen Finanzhaushaltes des Instituts durch den Finanzausschuß empfahl dieser, daß das Vermögen die Größenordnung eines Jahresumsatzes haben sollte. Die durch den Umtauschkurs des US-Dollars hervorgerufene Erhöhung der Flugpreise zusammen mit den sinkenden Zinsraten in ganz Europa machen es wünschenswert, den Jahresbeitrag nun geringfügig (um DM 25,-) anzuheben, um drastische Erhöhungen in naher Zukunft zu vermeiden.

Bei der Überweisung des Jahresbeitrages werden alle Mitglieder gebeten, soweit möglich,

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um die Bankspesen, die das Institut bei Zahlungen per Scheck zu tragen hat, niedrig zu halten.

Aus dem 14. Bericht des EPPC nahm der Rat die Entscheidung des Verwaltungsrates betreffend die Erhöhung der EPA-Gebühren und die Reduktion des EPA-Anteils der Erneuerungsgebühren zur Kenntnis. Der Rat nahm ebenfalls die fortgesetzte Arbeit zur Frage 47, Entwurf der Richtlinien für Computer-Programme, zur Kenntnis.

Der Prüfungsausschuß berichtete, Kritik sei in Deutschland gegen die Anonymität der EPI-Prüfer für die Eignungsprüfung ausgeübt worden. Der Ausschuß sowie der Rat betrachteten die gegenwärtige Situation jedoch als zufriedenstellend.

Die fortgesetzte Arbeit der DATIMTEX-Arbeitsgruppe wurde dankend zur Kenntnis genommen.

Das EPA organisierte ein sehr geschätztes halbtägiges Informationsprogramm, das von Herrn van Benthem präsiert wurde, an dem die Herren Leberl, Braendli, Delorme, Wallace, Dornow und Zwartkruis und weitere Persönlichkeiten des EPA teilnahmen. (Berichte dieser Herren sind in einem anderen Teil dieser Ausgabe zu finden.)

Präsident Bressand, dessen Amtsdauer ablaufen wird, dankte allen Ratsmitgliedern für ihre tatkräftige Mitarbeit während der derzeitigen Amtsdauer des Rates, die nun zum Ende geht.

Die nächsten Ratssitzungen werden in

Cannes am 22. und 23. April 1985, in
München am 4. und 5. November 1985 und in
Wien im Frühling 1986

abgehalten.

Die nächste Vorstandssitzung wird in Wien am 15. März 1985 stattfinden.

BESCHLUSSLISTE

der 17. Sitzung des Rates des EPI
vom 22. und 23. Oktober 1984 in München

1. Die Herren Feldmann und Veit wurden als Stimmzähler gewählt.
2. Das Protokoll der vorherigen, in Cambridge abgehaltenen Ratssitzung wurde mit zwei Änderungen angenommen.
3. Der Rat setzte den Mitgliedsbeitrag für 1985 auf DM 125,- fest und nahm das vorgeschlagene Budget an.
4. Der Rat genehmigte nachträglich die Stellungnahme des EPI betreffend das Gemeinsame Berufungsgericht des Gemeinschaftspatentes, die vom EPPC erarbeitet, vom Vorstand genehmigt und dem Interimausschuß für das Gemeinschaftspatent vor dem Stichtag, dem 15. Oktober, unterbreitet worden war.

Der Rat beschloß, das Institut solle von dem Präsidenten des Institutes und dem Vorsitzenden des EPPC, Herrn Jenny, vertreten werden, wenn das EPI zu einer Anhörung vor dem Interimausschuß eingeladen wird.
5. Aufgrund einer von einem Mitglied des Institutes gestellten Frage beschloß der Rat, daß der Präsident auf Anfrage Schiedsrichter bei Streitigkeiten im Zusammenhang mit Angelegenheiten in Sachen gewerbliches Eigentum bestimmen darf.
6. Der Rat genehmigte einen Vorschlag des Ausschusses für Standesregeln, wonach es zu den Pflichten jedes Institutsmitgliedes gehört, dem Sekretariat jede Anschriftsänderung prompt mitzuteilen. Dies wurde in die Richtlinien für die Berufsausübung aufgenommen und tritt ab sofort in Kraft.

7. Die Herren Urbach (DE), Fritel (FR) und Van der Beek (NL) wurden als Mitglieder des Disziplinarausschusses, Herr Mohnhaupt (CH) als Mitglied des Ausschusses für die berufliche Haftung und Herr Wildi (LI) als Mitglied des Ausschusses für die Standesregeln gewählt.

8. Der Rat folgte den im 14. Bericht enthaltenen Empfehlungen des Ausschusses für die Europäische Patentpraxis und betrachtete die beiden Fragen als erledigt:

F 60 - Übersendung von Informationen bei Einspruchsverfahren, zum Beispiel von Einwänden gegen die Zulässigkeit;

F 65 - Benützen der Ankündigung der Mitteilung durch die Prüfer des EPA, um materielle Änderungen vorzuschlagen;

und beschloß, keine Schritte zu unternehmen im Hinblick auf:

F 62 - Qualität der europäischen Recherchen (Den Haag/Berlin);

F 66 - Änderung des Hauptanspruchs aufgrund von in der Originalanmeldung beschriebenen, aber ursprünglich in den Ansprüchen nicht enthaltenen Merkmalen;

und beschloß, in folgenden Angelegenheiten an das EPA heranzutreten:

F 30 - Verzeichnis und Veröffentlichung der Entscheidungen der Beschwerdekammern:
- Veröffentlichung des von der GD 5 (Dr. Gall) erstellten Stichwortverzeichnisses der publizierten Entscheidungen, wenn möglich kombi-

niert mit einem Verzeichnis der unpublizierten Entscheidungen und Verbesserung des Verzeichnisses z.B. durch spezifische Stichwörter;

F 68 - Doppelseitige Patentanmeldungen und Änderung der Regel 35(3):

- Antrag zur Schaffung der Möglichkeit der Benutzung der beiden Seiten der Blätter bei der Einreichung sowie der Numerierung der Seiten, wahlweise auch an deren unterem Rand und entsprechende Änderung der Regel 35(3);

F 69 - Einreichung von Dokumenten durch Telekopierer:

- Antrag, dieses neue Kommunikationsverfahren für die Einreichung von Schriftstücken nach der Einreichung der Anmeldung ebenfalls zuzulassen;

F 71 - Einreichung von bestimmten Dokumenten auf dem Postweg:

- Antrag zur Einführung eines Verfahrens, das das maßgebende Eingangsdatum beim EPA bei der gleichzeitigen Absendung eines Fernschreibens mindestens für Einsprüche gemäß Art 99(1) EPÜ und internationale Anmeldungsunterlagen gemäß Art. 22 und 39 PCT sichern soll.

9. Hinsichtlich Artikel 25 EPÜ genehmigte der Rat den Vorschlag des Ausschusses, das für die Sitzung in Cambridge vorbereitete Dokument an die zuständigen Stellen des EPA zu senden.

10. Der Rat lehnte einen Vorschlag des Ausschusses ab, eine Möglichkeit zur Einschränkung der beruflichen Haftung der Patentvertreter einzuführen, beschloß jedoch, daß der Ausschuß sich um eine günstige Versicherungsalternative für EPI-Mitglieder bemühen sollte.

11. Der Rat ernannte erneut die Herren Graf und Petersen zu Kandidaten zur Wahl des Prüfungsausschusses für die europäische Eignungsprüfung.
12. Der Rat genehmigte eine Resolution über die durch die Verzögerung des Inkrafttretens des PCT in Italien hervorgerufene unbefriedigende Situation; diese Resolution wird durch die zuständigen Stellen an die italienische Regierung weitergeleitet.
13. Die nächste Ratssitzung wird in Cannes am 22. und 23. April 1985 stattfinden.

REPORT FROM COUNCIL

The 17th meeting of the Institute Council was held in Munich on 22 and 23 October 1984.

The two Vice-Presidents, Mr. D'haemer and Mr. Schönhöfer, reported from the June meeting of the Administrative Council of the European Patent Organisation, and the positive atmosphere in which they had been received. The President, Mr. Bressand, gave a report from an encouraging meeting with Mr. Otto Leberl, the new Chairman of the Administrative Council.

A WIPO programme on Biotechnological inventions in Geneva, 5 to 9 November will be attended by Mr. Bressand and Mr. Gallochat on behalf of the EPI. A CEFIC programme in Brussels on 22 to 23 November about new chemical technology will be attended by Mr. Tasset as the EPI representative also.

The Finance Committee has made a long term analysis of the economy of the Institute and recommended that a financial reserve be kept on a level corresponding to one year's expenses. Increasing airline fares due to the exchange rate for the US dollar in combination with decreasing interest rates all over Europe make it desirable to increase the annual subscription slightly (DM 25) now in order to avoid drastic increases within the near future.

When paying the annual subscription all members are very much encouraged to

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account in order to reduce the bank charges that the Institute has to pay on cheques.

From the 14th report of the EPPC, Council noted the

decision of the Administrative Council to increase the EPO's fees and to reduce the EPO share of renewal fees. Council further noted the continued work on Question 47, Draft Guidelines for Computer Programs.

The Examination Committee reported that criticism had been raised in Germany against the anonymity of EPI examiners for the Qualifying Examination. The Committee, however, regards the present situation to be satisfactory and so does Council.

The continued work of the Datimtex working party was noted with thanks.

The EPO arranged a much appreciated half-day information programme chaired by Mr. van Benthem and attended by Mr. Leberl, Mr. Braendli, Mr. Delorme, Mr. Wallace, Mr. Dornow and Mr. Zwartkruis and assisted by other distinguished EPO officers. (Reports of which are contained in another part of this issue.)

President Bressand, whose term of office will expire, thanked all the Council members for their devoted and valuable contributions during this Council's term of office that is now coming to an end.

The next Council meetings will be held in

Cannes, 22-23 April 1985
Munich, 4-5 November 1985
Vienna, Spring 1986

The next Board meeting will be in Vienna on 15 March 1985.

LIST OF DECISIONS

of the 17th EPI Council meeting
on 22 and 23 October 1984 in Munich

1. Mr. Feldmann and Mr. Veit were appointed scrutineers.
2. The minutes of the previous Council meeting in Cambridge were approved with two corrections.
3. Council approved the proposed increase in the subscription which would be DM 125 for 1985, and it approved the proposed budget.
4. Council approved retroactively the opinion of the EPI on the Common Appeal Court of the Community Patent, that had been prepared by the EPPC, approved by the Board and submitted to the Interim Committee for the Community Patent before the 15 October deadline.

Council decided that the Institute be represented by the President of the Institute and the Chairman of the EPPC, Mr. Jenny, when the EPI is invited to a hearing before the Interim Committee.

5. On a question raised by a member of the Institute, Council decided that the President on request may appoint arbitrators in disputes related to industrial property matters.
6. Council approved a proposal from the Professional Conduct Committee to impose a duty on each Institute member to promptly notify the Secretariat of any change in the member's address. This has been incorporated into the code of Professional Conduct and becomes effective immediately.
7. Mr. Urbach (DE), Mr. Fritel (FR) and Mr. van der Beek

(NL) were elected to the Disciplinary Committee, Mr. Monhaupt (CH) to the Liability Committee and Mr. Wildi (LI) to the Professional Conduct Committee.

8. Council followed the recommendations of the European Patent Practice Committee in its 14th report and regarded these two questions as settled:

Q 60 - Communication of information in opposition procedures, for example of admissibility objections;

Q 65 - EPO Examiners using advance notices to propose substantive amendments;

decided not to take any action now in

Q 62 - Quality of European searches (The Hague/Berlin);

Q 66 - Amendment of the main claim to features described in the original application but not originally contained in the claims;

decided to approach the EPO in the following matters:

Q 30 - Publication and indexing of the decisions of the Boards of Appeal:

- Publication of the index of published decisions set up by DG 5 (Dr. Gall), if possible combined with an index of the unreported decisions and improving the index e.g. by more specific keywords;;

Q 68 - Double-sided patent specifications and amendment of Rule 35(3):

- A request that it shall be made permissible to use both sides of the paper when filing and to number a page at the top or alternatively at

the bottom and that Rule 35(3) be amended accordingly;

Q 69 - Filing of documents by telecopy:

- A request to accept this innovative method for communication also for the filing of documents after the filing of the patent application.

Q 71 - Postal filing of certain documents:

- A request to introduce a procedure to assure the date of reception by the EPO by using simultaneous telex messages, for at least opposition under EPC Art. 99(1) and international application documents under PCT Art. 22 and 39.

9. In the matter of EPC Art. 25, Council approved the Committee's forwarding the paper it had prepared for the Cambridge meeting to the appropriate channels of the EPO.

10. Council rejected a Committee proposal to introduce a possibility to limit a professional representative's liability, but decided that the Committee should strive to obtain a favourable insurance alternative for EPI members.

11. As candidates for appointment to the Examination Board for the European Qualifying Examination, Council nominated Mr. Graf and Mr. Petersen.

12. Council adopted a resolution pointing out the unsatisfactory situation arising from the delay in PCT's coming into force in Italy, and the resolution will be sent to the Italian government through appropriate channels.

13. Next Council meeting shall be held in Cannes on 22 to 23 April 1985.

RAPPORT DU CONSEIL

La 17ème réunion du Conseil de l'Institut s'est tenue à Munich les 22 et 23 octobre 1984.

Les deux vice-présidents, Messieurs D'haemer et Schönhöfer, présentent un rapport sur la session de juin du Conseil d'administration de l'Organisation européenne des brevets en mentionnant l'accueil positif qui leur a été réservé. Le Président, Monsieur Bressand, présente un rapport sur son encourageante entrevue avec Monsieur Otto Leberl, nouveau Président du Conseil d'administration.

Messieurs Bressand et Gallochat assisteront, au nom de l'EPI, au programme portant sur les inventions biotechnologiques qu'organise l'OMPI à Genève du 5 au 9 novembre. Monsieur Tasset participera, au titre de délégué de l'EPI, au programme organisé par la CEFIC les 22 et 23 novembre à Bruxelles qui portera sur la nouvelle technologie chimique.

Après avoir établi une analyse de la situation financière de l'Institut à long terme, la Commission Finances recommande que les fonds correspondent au chiffre d'affaires d'une année. L'augmentation des frais de transport aériens due au cours du dollar américain ainsi que la baisse des taux d'intérêt en Europe justifient une légère augmentation de la cotisation annuelle (de 25 DM) afin d'éviter prochainement de fortes augmentations.

Lors du paiement de la cotisation annuelle, tous les membres sont vivement priés, dans la mesure du possible,

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afin de réduire les frais bancaires que doit payer l'Institut sur tout chèque.

Le Conseil prend note, dans le 14ème rapport de l'EPPC, de la décision du Conseil d'administration concernant l'augmentation des taxes de l'OEB, la réduction de la part des taxes de renouvellement revenant à l'OEB. Le Conseil prend également connaissance du travail poursuivi sur la question 47, Projet de Directives pour Programmes d'Ordinateurs.

La Commission d'Examen rapporte que l'anonymat des examinateurs de l'EPI à l'Examen de Qualification a été critiqué en Allemagne. La Commission, cependant, considère la situation actuelle satisfaisante ; le Conseil de même.

Le Conseil prend connaissance du travail poursuivi par le groupe de travail DATIMTEX et le remercie.

L'OEB a organisé un programme d'information d'une demi-journée qui a été fortement apprécié ; à ce programme, qui a été présidé par Monsieur van Benthem, ont participé Messieurs Leberl, Braendli, Delorme, Wallace, Dornow et Zwartkruis ainsi que d'autres personnalités de l'OEB. (Les rapports de ces personnes figurent dans une autre partie de ce bulletin.)

Le Président, Monsieur Bressand, dont la période d'exercice va s'achever sous peu, a remercié tous les membres du Conseil de leur efficace collaboration durant le terme actuel du Conseil qui touche à présent à sa fin.

Les prochaines réunions du Conseil se tiendront à

Cannes les 22 et 23 avril 1985
Munich les 4 et 5 novembre 1985
Vienne au printemps 1986

La prochaine réunion du Bureau aura lieu à Vienne le 15 mars 1985.

LISTE DES DECISIONS

de la 17ème réunion du Conseil de l'EPI
tenue les 22 et 23 octobre 1984 à Munich

1. Messieurs Feldmann et Veit sont élus scrutateurs.
2. Le procès-verbal de la réunion du Conseil précédente tenue à Cambridge est approuvé avec deux corrections.
3. Le Conseil fixe la cotisation pour 1985 à 125 DM et approuve le budget proposé.
4. Le Conseil partage postérieurement l'opinion de l'EPI concernant la Cour d'Appel du Brevet Communautaire, telle que préparée par l'EPPC, approuvée par le Bureau et soumise au Comité Intérimaire pour le Brevet Communautaire avant l'échéance du 15 octobre.

Le Conseil décide que l'Institut sera représenté par le Président de l'Institut et le Président de l'EPPC, Monsieur Jenny, lorsque l'EPI sera invité à une audience devant le Comité Intérimaire.

5. Suite à une question posée par un membre de l'Institut, le Conseil décide que le Président pourra nommer, sur demande, des arbitres dans des litiges relatifs aux questions de propriété industrielle.
6. Le Conseil approuve une proposition de la Commission pour les Règles de Conduite Professionnelle consistant à exiger de tout membre de l'Institut qu'il informe le Secrétariat de tout changement d'adresse. Cette obligation est insérée dans le Code de Conduite Professionnelle et prend effet immédiatement.
7. Messieurs Urbach (DE), Fritel (FR) et Van der Beek (NL) sont élus membres de la Commission de Discipline, Mon-

sieur Mohnhaupt (CH) est élu membre de la Commission pour la Responsabilité Professionnelle et Monsieur Wildi (LI) membre de la Commission Conduite Professionnelle.

8. Le Conseil suit les recommandations contenues dans le 14ème rapport de la Commission pour la Pratique du Brevet Européen et considère les questions suivantes comme réglées :

Q 60 - Transmission d'informations au cours des procédures d'opposition, oppositions d'irrecevabilité par exemple ;

Q 65 - Utilisation de la note préalable par les examinateurs de l'OEB pour proposer des amendements importants;

et décide de n'entreprendre aucune action en ce qui concerne :

Q 62 - qualité des recherches européennes (La Haye/Berlin) ;

Q 66 - modification de la revendication principale en raison de caractéristiques décrites dans la demande d'origine mais ne figurant pas à l'origine dans les revendications ;

et décide de contacter l'OEB en ce qui concerne les questions suivantes :

- Q 30 - Indexation et publication des décisions des Chambres de Recours
- Publication de l'index des mots-clé des décisions publiées établi par la DG 5 (Dr. Gall), combiné, si possible, à un index des décisions non publiées et perfectionnement de

l'index au moyen de mots-clé spécifiques, par exemple.

Q 68 - demandes de brevet présentées Recto/Verso et modification de la Règle 35(3) :

- Motion demandant qu'il soit possible d'utiliser les deux pages des feuilles lors du dépôt, de numéroter facultativement les pages à leur bord supérieur ou inférieur, et de modifier la Règle 35(3) en conséquence ;

Q 69 - Dépôt de documents par télécopieur :

- Motion demandant que ce nouveau procédé de communication soit également autorisé pour le dépôt de documents après le dépôt de la demande.

Q 71 - Dépôt de certains documents par voie postale :

- Motion demandant d'introduire une procédure dans le but de garantir la date de réception décisive à l'OEB par l'envoi simultané d'un télex, ceci au moins pour les oppositions en vertu de l'art. 99(1) de la CBE et les documents de demandes internationales en vertu des art. 22 et 39 du PCT.

9. En ce qui concerne l'art. 25 de la CBE, le Conseil approuve la proposition de la Commission demandant d'envoyer aux autorités compétentes de l'OEB le document préparé pour la réunion de Cambridge.

10. Le Conseil rejette une proposition de la Commission demandant d'introduire la possibilité de limiter la responsabilité professionnelle d'un conseil en brevets, mais décide que la Commission doit s'efforcer d'obtenir une assurance avantageuse pour les membres de l'EPI.

11. Le Conseil nomme à nouveau Messieurs Graf et Petersen candidats aux élections du Jury d'Examen pour l'Examen Européen de Qualification.

12. Le Conseil adopte une résolution faisant apparaître la situation insatisfaisante résultant du retard de l'entrée en vigueur du PCT en Italie ; cette résolution sera envoyée au Gouvernement italien par les voies appropriées.

13. La prochaine réunion du Conseil se tiendra à Cannes les 22 et 23 avril 1985.

Report on the
EUROPEAN PATENT OFFICE SPECIAL PRESENTATION
to the EPI Council
22 October 1984

Introduction by J.B. van Benthem, President of the
European Patent Office

It is a pleasure for me to welcome you, the EPI Council, to the European Patent Office, and I would like to thank you for taking part in this special programme that we have arranged for you, the representatives of the Institute.

Before going any further, let me introduce to you Mr. Otto Leberl, the new chairman of the Administrative Council, and Mr. Paul Braendli, who will be succeeding me as President of the EPO in May 1985.

It is now over six years since the EPO opened on 1 June 1978 for the receipt of European applications. Since then the number of applications has been rising steadily - from approximately 4,000 in 1978 to an expected 35,000 this year. The original steady-state target of 30,000 applications per year has thus been exceeded. A steady-state figure of at least 40,000 now seems likely.

All stages of the European granting procedure have now been well established: search, examination, oppositions, appeals, although the opposition is still in its infancy. This record testifies to the success of the European patent system, a success which is attributable not only to the applicants, but also to you the Professional Representatives. Without your support this achievement would not have been possible.

Another area of co-operation is the regular dialogue between the Office and European interested circles within

the framework of SACEPO. The Committee has since its inception made many suggestions on examination of standards and practices (e.g. Guidelines for Examination), as well as other aspects of the Office's work. The Institute members, who make up half of SACEPO's members, have made a very valuable contribution.

Further successful co-operation between the Office and the Institute can be seen in the work of the several statutory bodies in which the Office and Institute are jointly represented, in particular the European Examination Board which is responsible for conducting the European qualifying examination.

This meeting gives us the opportunity of exchanging views with the European patent profession direct, through discussion and personal contact. The introductory talks have been kept short to allow enough time for discussions:

- Mr. Delorme, Vice-President, Directorate-General 1 will talk about the search work of the Office, in particular, the backlog problems, documentation and the use of automated search techniques.
- Mr. Wallace, Vice-President, Directorate-general 2, will speak on the examination and opposition procedure.
- Mr. Dornow, Vice-President, Directorate-General 4, will concentrate on the use of automation in the Office and our co-operation in this field with JPO and USPTO.
- Mr. Zwartkruis, Vice-President, Directorate-General 5, will deal with other aspects of the tripartite co-operation, in particular the dissemination of information.*

* This report will be published in the next issue of the EPI Information.

Grußworte des Präsidenten des Verwaltungsrates der Europäischen Patentorganisation, Otto Leberl, an den Rat des EPI.

Es gereicht mir zur Freude und Ehre, über Einladung von Präsident Van Benthem heute an der Sitzung des EPI teilnehmen zu können. Vor vier Tagen habe ich mein neues Amt als Präsident des Verwaltungsrates angetreten. Und so ist dies die erste Gelegenheit in meiner neuen Funktion, mit Ihnen offiziell Kontakt aufzunehmen und es ist somit auch das EPI die erste Organisation außerhalb des Europäischen Patentamtes, mit der ich auf diese Weise in Verbindung treten kann.

Ich glaube, daß dies ein ganz besonderes und gutes Omen ist:

Nicht nur im nationalen Bereich, sondern ganz besonders im internationalen Bereich ist der Kontakt zwischen dem Anmelder und dem Patentamt bisweilen von entscheidender Bedeutung für die Erlangung guter und haltbarer Schutzrechte. Im internationalen Bereich wird dies deshalb von ganz besonderer Wichtigkeit sein, weil die Verfahrensvorschriften schwieriger sind und weil der Wahl der Sprache ein besonderes Gewicht zukommt.

Wie ich weiß, hat das EPI mit seinen Vertretern in allen Mitgliedsländern des EPÜ in diesem Zusammenhang bereits hervorragende Dienste geleistet und insbesondere wurde der europäischen Anmelder, sei es ein Einzelanmelder, sei es ein Firmenanmelder, mit Hilfe des EPI besser an das EPÜ herangeführt und zur Inanspruchnahme des europäischen Verfahrens in immer stärkerem Ausmaß bewogen. Die steigenden Zahlen der Anmeldungen im letzten Jahr und in den letzten Monaten geben dafür ein eindrucksvolles Zeugnis.

Ihr Präsident, Herr Bressand, hat mich vor wenigen Tagen

in Wien besucht und wir haben bei diesem Gespräch die volle Übereinstimmung über die Zusammenarbeit zwischen dem EPA bzw. seinem Verwaltungsrat und dem EPI gefunden. Wir sind überzeugt, daß die gute Zusammenarbeit in der Vergangenheit nicht nur fortgesetzt werden soll, sondern daß sie sich in Zukunft noch intensiver gestalten möge. Ich habe die Absicht, Vertreter des EPI soweit wie möglich zu den Sitzungen des Verwaltungsrates heranzuziehen und sie vor allem zu jenen Fragen zu hören, die auch nur entfernt mit der Tätigkeit dieses Instituts zusammenhängen. Ich bin überzeugt, daß es uns gelingen wird, auf diese Weise das europäische Verfahren zur Erlangung von Patenten noch attraktiver zu gestalten.

Dabei wird uns die Tatsache von besonderer Hilfe sein, daß es Ihnen gelungen ist, die Vertreter der Industrie und die berufsmäßigen Vertreter im Patenterteilungsverfahren, also die Patentanwälte in engerem Sinn, an einen Tisch zu bringen, wobei ich mir im klaren bin, daß trotz vieler Vorbehalte, die im nationalen Bereich bestehen, im Bereich des Europäischen Patenterteilungsverfahrens dabei das Gemeinsame vor dem Trennenden gestanden ist, zum Nutzen und zum Wohl jener Anmelder, die im Verfahren zur Erlangung von Patenten gewillt sind, den europäischen Weg zu gehen.

Ich bin überzeugt, daß dem Verwaltungsrat der EPO und damit auch mir selbst eine große Verantwortung zukommt:

Eine Verantwortung, die, wenn auch auf einem speziellen Gebiet, so doch ident mit der Ihrigen auf die Verbreitung und die Festigung des Gedankens jenes einen Europa ausgerichtet sein soll, in dem wir leben, unabhängig von der politischen und wirtschaftspolitischen Situation unseres jeweiligen Heimatslandes.

So möchte ich mit Vertrauen an diese Aufgabe herangehen und versuchen, in meiner Funktion als Präsident des Ver-

waltungsrates dieser Idee zu dienen. Ich hoffe und vertraue auf eine gute Zusammenarbeit mit Ihnen und auf Ihre Mitarbeit bei der Verwirklichung dieses Zieles.

Report on the Activities in DG 2, by Norman Wallace, Vice President of DG 2

The substantive examination of European patent applications began in June 1979 so that we now have over 5 years experience behind us. It has been a period in which we have not only had to develop a new examining practice, but also had to cope with a rapid growth in examining staff from an initial figure of 46 to the present number of 334.

This rapid growth in a relatively short time has caused certain problems and I should like to refer to some of these and the measures we are taking to deal with them.

Firstly, there is the question of harmonisation and quality control. At the beginning the Office was fortunate in being able to recruit a large number of experienced examiners from national offices. We were therefore able to build up a nucleus of well-qualified and experienced staff who at least knew what patent examination was all about. Even so, since these examiners came from 10 different countries with different patent traditions a great deal needed to be done, and still needs to be done, by way of harmonisation. One very useful instrument for this purpose is the 3-member Examining Division, particularly since the Division is not a fixed administrative unit so that an examiner normally works together with not only 2 other colleagues but perhaps with 5 or 6. But other broader measures are also necessary in order to ensure that applicants receive uniform treatment regardless of the particular examiners dealing with the case. For this reason, we have established a harmonisation group which

looks independently at a sample of cases under examination in order to detect serious deviations in examination practice. I regard this harmonisation group as very important and am at present considering ways in which it can be made more effective.

Next I should like to mention the matter of recruitment and training. As I have said we now have 334 examiners and we probably need to recruit about 200 more over the next few years. But the recruitment pattern for DG 2 has changed. We can no longer obtain many examiners from national offices and depend largely on the scheme worked out in co-operation with DG 1 whereby young recruits without previous patent experience are first appointed to DG 1 (either in The Hague or Berlin) so that they gain experience of the search, and then later (say, after 3 to 5 years) are transferred to DG2. This scheme operates well and in this way we have been able to recruit many young examiners of high calibre. However, since we are recruiting less experienced people, this inevitably means a heavy training load both in DG 1 and later in DG 2. Furthermore the scheme cannot at present fulfill all the needs of DG 2 so that we need also to recruit some examiners directly from outside. We have therefore attempted to recruit some young European patent attorneys because we believe that such cross-fertilisation between the patent profession and the European Patent Office is beneficial to both sides. Unfortunately this attempt has had only limited success and I would therefore like to mention that, in most technical fields, we still have vacancies for young patent attorneys who are interested in switching over to the other side and working in the EPO.

This brings me to the problem of the backlog. When the EPO began we expressed the desire and intention of establishing a quick procedure under which an application would be brought to a final decision without undue delay.

Unfortunately, owing to recruitment and training problems, the continually rising input of European patent applications, and the unexpectedly high percentage (about 85%) of requests for examination, we are building up a large backlog. The present average delay between the request for examination and the issue of the first communication from the Examining Division is about 12 months and, according to current estimates, this delay is likely to rise to 16 to 17 months in the next few years and we will be in the 1990s before we can then get it down to 12 months again. However, once the first communication has been issued, the policy of reaching a final conclusion as soon as possible is put into practice and I am pleased to inform you that the average number of actions by the Examining Division before a final position (decision or withdrawal) is reached on an application is only about 1.20. I believe that this low figure has been achieved because of our policy of insisting that the first communication from the Examining Division should be a comprehensive one, raising all the objections which need to be raised and giving reasons for the objections. In return, we expect the professional representative to send us a comprehensive reply covering all the objections raised. In most cases this happens, hence the fact that a final conclusion is often reached after not more than one communication on each side.

Another thing which greatly facilitates the procedure in many cases is personal contact between the examiner and the professional representative. In this connection, it is interesting to note that last year the total number of informal interviews and telephone conversations between examiners and professional representatives was 4,960 whereas the number of formal oral proceedings before the Examining Division was only 77. This illustrates very clearly that most difficulties can be settled by informal contacts.

I turn now to opposition procedure. As with the examination procedure, I regret to say that we have not been successful in every case in our aim of establishing a speedy and streamlined procedure. In some cases there have been excessive delays, but we are trying to improve on this by giving priority to the examination of oppositions. Fortunately for everybody, the percentage of patents opposed has been lower than originally expected and has remained fairly stable at a figure between 10 and 11%, the percentage being however higher in chemistry and lower in electricity. From the small number of cases decided so far it seems that the pattern of decisions in DG 2 is approximately as follows:

Rejection of opposition	40%
Revocation of the patent	40%
Maintenance of patent in amended form	20%

However it is too early to draw any firm conclusions on this.

There are two further points I want to make regarding oppositions. The first concerns oral proceedings. In July 1982 our President wrote to the President of the Institute (at that time, Mr. Veryard) making a plea that where more than one language is involved the parties should try to come to an arrangement whereby the oral proceedings could be conducted without the use of interpreters. The reasons given for this plea were not merely cost (although this is an important factor) but also the practical difficulties of obtaining sufficiently qualified interpreters at short notice and also the desirability of encouraging direct communication between the professional representatives and the EPO officials concerned. I regret that the response to this plea has so far been minimal. In other words, in the vast majority of multi-language oral proceedings, interpreters have been requested. Fortunately the number of such cases has so far not been

very large (27 this year). Nevertheless I should like to repeat here the plea made by the President and would be interested to hear the views of the Council on this question.

The other point concerns the written procedure. In July 1983, the Institute wrote to the Office with certain requests concerning the communication of information in opposition procedure. We decided to comply with these requests and specifically, in a letter in November 1983, we stated inter alia that we would arrange for a copy of the observations of one party to be communicated immediately for information to the other party, the communication of the Opposition Division following later. We stated at that time that we hoped that the new procedure would not result in excessive "ping-pong" between the parties and said that we would review the matter after one year. From the experience so far we have found that the new procedure has, as we feared, resulted in a certain amount of unnecessary "ping-pong". But it has worked reasonably well on the whole and we will therefore probably continue with it at least for the near future.

I should like now briefly to put on another hat and speak, not as Vice-President of DG 2, but as Chairman of the Examination Board for the European Qualifying Examination for professional representatives before the EPO. This is a function which I have only taken over this year (the previous Chairman being my friend Jacques Delorme), but I have already become aware of the tremendous time and effort involved in running this Examination. I wish to pay particular tribute to the members of the Institute involved in this task. These are invariably busy people who are at the top of the profession, and I find it wholly admirable that such people are willing to devote so much unpaid time and trouble to something from which they obtain no personal advantage but which is of course vital to the future of the profession.

One matter that concerns me however regarding the Examination is that many candidates who sit for it are obviously ill-prepared. The examination standard is intentionally set high and rightly so, but if candidates were better prepared we would not have to fail nearly 50% as has occurred until now. I know that in four of the EPO member countries (France, Germany, Switzerland and the U.K.) there are excellent institutions which help to prepare candidates for the Examination but this in my view is not enough. Firstly I have the impression that there is insufficient co-ordination between these various bodies and secondly the present arrangements give an advantage to nationals of some countries compared with others. Regarding the second point, I do not suggest that one should necessarily set up training institutions for the European Qualifying Examination in all member countries. A different possibility, which I should like to put forward for consideration, is the organisation of a correspondence course - not as a substitute to the excellent training being given in the various institutions I have mentioned, but as a supplement to it. I see such a course as providing two important advantages. Firstly, since it could be organised centrally on a European level, it would provide a basic and uniform training for all interested candidates. Secondly since the course could be run in all the languages of our member countries, candidates from the Netherlands, Italy and Sweden would be at no disadvantage. This I believe is important if the profession is to remain fully European in the longer term.

Report on Activities in DG 1, by Jacques Delorme, Vice-President of DG 1

1) Capacity of DG 1

Until mid 1984, the total number of applications was expected to remain within the following limits:

	30,000 European applications
	3,000 PCT
	15,000 national applications
	<u>3,000 others</u>
Total of	<u>51,000</u>

The total examiner staff was foreseen to decrease in DG 1, whereas in DG 2 it has been increasing (because of the transfers).

A new situation will be created starting from the end of 1984, due to the increase of applications. We expect (for 1987-1988)

	35,000 European applications
	3,000 PCT
	20,000 national applications
	<u>3,000 others</u>
therefore a	
total of	<u>61,000.</u>

In order to be able to perform all these searches, an increase in the number of examiners will be necessary. This situation creates difficulties:

- the time required for completing searches in 1985 and 1986 will increase, because the output capacity is lower than the number of applications to be handled;
- the training of new staff creates and will create an acute problem; there are also the transfers to DG 2.

The recruiting and transfer policies should be consequently reexamined. But in DG 1, the prevailing situation for 1985 and 1986 will be characterised by an increase in the

backlog and time lag before search reports are issued.

II) The E.P.O. documentation

A) Composition

It covers the PCT minimal documentation and it amounts to 17,691,000 million documents including the classified non-patent literature.

According to the Protocol on Centralisation, Section VI, it is envisaged to add Italian and Swedish documents. In both cases, the applications to be added, are the national applications not extended outside the country, nor requested by non-nationals. As regards the Italians, we expect to begin in 1985, without any retroactivity. For the Swedish documents, some abstracts in English will be added. The documents will be included in the files, with their English abstracts.

B) Classification system

The number of sub-divisions keeps on increasing; from 77,057 in 1980, it has now reached 82,055.

As regards the 4th edition of the I.P.C., the concept of hybrid systems has been introduced in order to improve the effectiveness of the classification.

C) Search aids

- a) In 1978 DG 1 searched for the first time on an external on-line data base using a password for access to the E.S.A.-Information Retrieval service. Now DG 1 subscribes to the services offered by six hosts for an amount of 500,000 DM per year:

ESA European Space Agency in Frascati
(Italy),

- SDC System Development Corporation in Santa Monica, California (USA) and Woking (GB),
- T.SYS. Télésystèmes in Sofia Antipolis (France): particularly for chemical structure searching ("DARC"),
- I/P Pergamon-Infoline in London (GB): particularly for searching on the VIDEO-PATSEARCH system,
- CASOL CAS ONLINE in Ohio (USA): particularly for chemical structure searching (available only since November 1983),
- INKA Informationssystem Karlsruhe (DE), not used in 1983.

b) There are 13 different internal on-line systems in use (see annex). Most of them have existed since 1983. It is envisaged for 1985 that INVE and ECLA file will be on-line in Europe (FAMI file is already available).

D) Automated Search

In accordance with the trilateral co-operation agreement, we will receive English abstracts of Japanese documents on tapes; some tests are being made on the possibility of carrying out automated searches limited to Japanese abstracts. This, of course, could be quite useful to reduce the ever increasing amounts of paper.

E) Technical information group

In accordance with the trilateral co-operation agreement, the EPO is also involved in two major development

projects:

- a) DATIMTEX, that is the digitalisation of the incoming applications,
- b) Conversion of the backlog, that is the scanning of the whole backlog of documentation, in order to reduce it to an electronic condensed form, with a storage on magnetic discs.

Those two main projects are studied in conjunction with the Member States in a technical group called "Technical Information Group", which is a sub-group of the Administrative Council.

F) Internal "on-line" Services

Search Aids

- FAMI Family service
 INVE Search file interfaces (EPO)
 INVU Search file interfaces (USPTO)
 EPRV European patent register
 ECLA European classification system
 UCLA USPTO classification system
 REPA Class allocation list
 ("Répartition des classes")
 INCO Interface combination service
 ACFE Access file to the European Classification system
 ACFU Access file to the USPTO classification system
 REFI Reference file
 INSI Index for Search Instructions
 CABI Chemical Abstracts Bibliographic Information

Being developed

- BOCA Book catalogue

EPUS EPO - US classification concordance
ICO In computer only (indexing codes)

**Report on the activities in DG 4, by Hans-Peter Dornow,
President of DG 4**

Comments on the future development of the administrative services of the EPO, particularly with regard to the use of modern office technologies.

I. The actual extent of the EPO's present activities - which have not yet quite reached the steady state - can be illustrated by the following significant data:

- For 1985 the Office anticipates around 35,000 European applications including 2,800 PCT applications entering the regional phase.
- The 1985 draft budget provides for 1,998 posts to cope with the tasks of the Office, including around 1,050 posts for members of the examination and appeal directorates.
- The total expenditure of the Office in 1985 is estimated to be around DM 345 million; current staff expenditure accounts for 60.5% of this amount, arriving at 74.3%, if contributions to the pension fund are included.

These basic data newly approved by the Budget and Finance Committee - the year 1985 in freeze-frame as it were - also make clear the main elements in the administration of the Office, namely,

- staff
- finance
- organisation.

Let me first of all deal briefly with a few questions in the staff and finance fields, before addressing wider-ranging future organisational problems in the 2nd part of my talk, in particular the longer-term prospects for applying electronic office technology in the EPO.

1. Staff

Like all examining patent offices, the EPO is extremely labour-intensive. It will eventually have more than 2,000 staff, about half of whom or even more will have to have technical or scientific qualifications. In 1985 another 60 examiners are to be recruited. Taking into consideration the still increasing number of applications additional recruitment of examiners will prove to be necessary during the following years. You all know how difficult it is to recruit such a large number of qualified staff and keep them motivated for the very special tasks of patent examination.

A further factor is constituted by the special requirements arising from the international character of the EPO. If it is to be truly international in terms of both staff and the services it provides for you, its international clientele, it is essential that the examining staff in particular comprise a balance representing all the Contracting States. Right from the start, the Organisation has sought - successfully - to achieve this end.

For the more senior posts at least, recruitment is on the basis of a sort of quota system based

essentially on the financial contributions made by the Contracting States of the Organisation.

Examples of these quotas are as follows:

DE: 25%, GB: 22%, FR: 17%, CH: 9%, IT: 8%, NL: 6,5%, SE: 6%.

Attractive conditions, in particular appropriate salaries, are essential if we are to be able to recruit this staff in particular from abroad.

2. Finance

As you know, the European Patent Organisation is required to be self-supporting, which means that the Office must meet all its expenditure from its own fee income. Both we and the Contracting States are delighted that the Office is already paying its way, a situation which was not expected to arise until the 11th year of its life. It has been able to fund its running costs, at any rate, mainly from fee income. For this success the Office is particularly indebted to you and our applicants, who have made considerable use of the Office's services since it opened.

Like most all (West) European national patent offices, our fee income derives from the twin sources of procedural and renewal fees. At present, because of the as yet relatively small number of granted European patents, the Office's fee income is still predominantly from the procedural source, only about 5,5% expected from renewal fees in 1985.

However, our long-term fee policy objective is to cover the Office's expenditure by both types of fee in equal parts. This presupposes that the Contracting States continue to remit to the Office on a long-term basis a

rather high percentage of the income from granted European patents, a factor that would enable the Office - again in the long-term - to reduce somewhat the level of its procedural fees, which its management considers to be comparatively high.

As regards the structure of the Office's expenditure, the main component is clearly staff costs. According to our long-term financial planning calculations, serving staff costs alone will account for over 2/3 of all Office expenditure, and to this must also be added pensions, for which the Office is right now beginning to make provision for by setting up a sizable fund.

The figures clearly show that the main costs lie here, and here we must concentrate our efforts to keep the Office's costs within reasonable limits, not only in its own interest but also, in particular, in that of its customers.

- II. This brings me to problems of medium- and long-term developments in the Office's internal organisation of its work, and in particular the future use of modern office technology. The basic data I have referred to show that as a service organisation the EPO is extremely staff-intensive and its cost structures are determined to a decisive extent by this factor. It was therefore natural from the start of the build-up phase to attach special importance to the application and extensive use of modern office technologies, particularly data processing. The Office therefore introduced, virtually at the time of its opening, and has since developed the EPASYS system (European Patent Administrative System), an EDP system supporting the administrative formalities involved in the European patent grant procedure.

It is clear that the Office cannot stop at such ini-

tial projects.

After all, the Office's tasks place it in the category of information-processing and information-producing institutions. If only for this reason, it could not evade the rapid development in the field of information technology without thereby incurring serious damage, in that the quality of the services offered by the Office would no longer correspond to the state of the art.

You, our applicants and their representatives, customers and fee-payers, have the right to expect the Office to do all it can within the scope of its legal and factual possibilities to open up for you the style of access to and communication with the Office corresponding to the current norm of communications technology.

We know from numerous suggestions from the public how great the interest in these developments is among many applicants and their representatives and how much they look to the Office to meet this obvious need. An enquiry conducted by your Institute in 1983, for example, has revealed that more than one-third of our applicants already have text systems in their patent departments.

In this context we naturally also - and not least - proceed on the basis that the European Patent Office should not only register innovations and provide them with legal protection as early as possible, but should itself also make use of them unhesitatingly within its own range of activities in a rational and economical way, even if it occasionally means breaking new grounds.

A decisive impetus in all these activities, however, is the need for economy. The EPO management sees very

clearly that in the medium- and long-term a disproportionate increase in costs - and thus of course also in fees - can only be effectively avoided by the intensive use of suitable office, information and communication technology. This applies above all to the dominant area of staff costs, but also to other fields such as that of publications.

III. What concrete possibilities present themselves for the Office's administration in the medium- to long-term? We are rather sceptical about the catchword "paperless office" which is occasionally heard in this context. As regards the development and use of new technical possibilities, we are with our "Datimex"* project at the moment laying stress above all on three main areas:

- (a) To open up the possibility of accepting applications in digital or machine-readable form and storing their full text.
- (b) To use the information then available in digital form to improve the printing procedures and reduce their cost, both for the first publication and also for the patent specification.
- (c) In the longer term: for the examiners to process applications in the examination procedure making direct use of the appropriate technical possibilities - on key-board and screen -, eventually leading to paperless communication with the applicant or representative, at least to a certain extent.

Allow me to make some additional comments on these points of emphasis in the future use of data processing technologies.

* Data, image and text carriers

With regard to (a): Receipt of applications

The Office is working intensively on creating the technical preconditions for it to be possible as from July 1985 to accept applications in digital form (floppy disk) and in machine readable form (OCR-B).

The technical planning and preparations are being worked out by an internal EPO Working Party, in collaboration with experts nominated by the Institute of professional representatives. I should like to take this opportunity to thank in particular Mr. Duncan, Mr. Speiser and Mr. van der Auweraer for their most valuable contributions.

Preparations for operating the Datimtex-system are well advanced. Test results are encouraging and - we hope - will provide a reliable technical basis enabling us to offer, as from July 1985, to accept normal applications from our applicants in digital or machine-readable form. We assume that in the long run the majority of applications will be filed in this form. The existing paper form will naturally also remain in the long-term as a medium for those applicants who wish to continue with it; in this case, too, the Office will have to provide for conversion. We are expecting that in the medium-term as well new media such as teletex and screen-text will gain in importance.

With regard to (b): Printing procedures

With the introduction of this new application technology we hope to stabilise publication costs, particularly those for the patent specification. If the applications are available in digital form, extensive use can be made of economical printing procedures such as photosetting and, since just recently, laser

printers based on digital information.

But it is not only the financial aspect that is important here. This technology also permits, even for the A-document, a shift from the offset procedure - which has few advantages either in terms of quality or quantity - to printing, with the result that quality improves and the size of the document is considerably reduced as well. The B-document can then merely be regarded as the second publication, based on the printed A-document, which is brought up-to-date by text processing both during and after the examination procedure. We assume that this change will be of considerable interest to many of you and our applicants, particularly if it can be brought about without additional costs overall. A tender procedure for both printing and digitalisation has recently been carried out. The results will be available early next year.

With regard to (c): Screen search and examination

Whereas in the relatively short-term intensive practical use of the new communications technologies will be introduced to receive and store applications and to prepare the printing of EPO publications, the resulting gradual change in the working methods of EPO examiners will certainly take much longer to effect. On the search side the EPO has been endeavouring for a long time now to make EDP support available in the field of documentation. These efforts will have to be intensified, if only to keep abreast of the increasing flood of documents still appearing in paper form. The question as to whether some form of more or less automated search will ever be possible remains for the remote future. One thing is clear: paper documentation cannot be maintained in

the long run. Introduction of digitalised applications and their full-text storage in a data bank system will have to be recognised as a major element in solving this problem.

The working methods of those examiners engaged on substantive examination will also evolve, although this will take quite a long time. Where, for example, applications (and the search report) are available in digital form, there is no reason why the examiner should not also work on them at the screen. A further obvious step would be to have at least important parts of the communication between the Office and the applicant/representative during the examination procedure carried out not using paper but digital media (electronic mail). Consideration will also have to be given to the idea of having the examiner himself - working with key-board and screen - directly prepare the final version of the patent specification. In 10 years' time the examiner's job will thus perhaps have changed into a kind of electronic work-station with access to internal and external data banks, private files, and also other technical aids such as printers, because even by that time we shall not be able to manage without paper altogether.

IV. The opportunities for and effects of using modern communications and office technologies which I have only sketchily outlined here must not, of course, be thought of as being restricted to the EPO. It is obvious that close co-operation with the patent offices of the Contracting States is desirable, with the aim of developing in parallel.

The Office would like, however, to go still further. We know that Member States, the US Patent and Trademark Office and the Japanese Patent Office are con-

fronted with very similar problems and are looking intensively for similar solutions. Close co-operation appears to us to be urgently necessary firstly in order to ensure, in the interest of both patent offices and applicants, a minimum level - more if possible - of standardisation when using the new technologies; we feel that this is also in the interest of our applicants, since many of their inventions filed at the European level also lead to applications in the United States and in Japan.

Secondly, we see in this a chance at least to a certain extent to avoid costly duplicate development work - and hence duplicate costs - when introducing the new technologies.

The aim is a sensible assignment of development tasks among all those involved. Rather close contacts with the US and Japanese Patent Offices to this end are proving to be encouraging. The second Trilateral Conference has just taken place in Munich. Its conclusions on further co-operation are defined in a (second) Memorandum of Understanding, which will be presented to the December meeting of the Administrative Council.

V. Allow me in closing to make a final comment.

The aim of all our efforts to introduce intensive use of new technologies within our Office is to keep our services qualitatively and quantitatively permanently at the required standard and at acceptable prices. If this overriding aim did not exist those efforts would be more or less an end in themselves. The correct level to be reached by these services is in the final analysis determined not least by you, by our applicants and customers. So we especially depend on your participation, advice and help. The Office is confident that this support will continue to be forthcoming.

EINLADUNG DES EPA AN DEN EPI-RAT

DISKUSSIONSPUNKTE

1. Prüferrekrutierung

Das Amt berichtete über zunehmende Schwierigkeiten, qualifizierten Prüfernachwuchs zu finden. Auch von seiten des EPI wurde darauf hingewiesen, es sei zunehmend schwieriger, geeignete Kandidaten für den Beruf des zugelassenen Vertreters zu finden (hohe Anforderungen u.a. an die Sprachkenntnisse, Unsicherheit über die Entwicklung des Berufsstands infolge der Gründung des EPA etc.). Die Möglichkeit einer engeren Zusammenarbeit mit den zugelassenen Vertretern bei der Rekrutierung geeigneten Nachwuchses wurde diskutiert (Einbeziehung der Kanzleien und Industriepatentabteilungen in die Prüferausbildung).

2. Vereinheitlichung der Ausbildung zum zugelassenen Vertreter

Von seiten des Amtes wurde die Frage einer Vereinheitlichung der Ausbildung zum zugelassenen Vertreter angesprochen; so wäre es z.B. denkbar, daß das EPI einen vorbereitenden Korrespondenzkurs zur europäischen Eignungsprüfung einführt. Das EPI wird diese Problematik untersuchen.

In diesem Zusammenhang wurde von seiten des EPI die Frage nach der Zahl derjenigen zugelassenen Vertreter aufgeworfen, die wirklich aktiv vor dem EPA praktizieren. Es handelt sich hier mit Sicherheit um erheblich weniger als die rund 4.600 auf der Liste aufgeführten Vertreter, doch sind genaue Untersuchungen hierzu noch nicht durchgeführt worden. Es wäre sicher nützlich, in dieser Beziehung Klarheit zu haben, um in bezug auf den erforderlichen Nachwuchs und die damit zusam-

menhängenden Ausbildungskapazitäten konkretere Vorstellungen zu entwickeln.

3. Produktivität in der GD 1 und GD 2

Das Amt wies auf die große Zahl der außerhalb des europäischen Verfahrens in Den Haag zu erstellenden Recherchen hin, insbesondere die als Folge der Übernahme des IIB für die nationalen Ämter einiger Mitgliedstaaten durchzuführenden Arbeiten. Um die Bearbeitungszeit solcher nationaler Recherchen nicht auf über 18 Monate anwachsen zu lassen, ergab sich in der letzten Zeit eine gewisse Verlängerung der Verfahrensdauer bei europäischen Recherchen und demzufolge ein höherer Anteil von ohne Recherchenbericht veröffentlichten Anmeldungen. Das Amt hofft, den Anteil dieser ohne Recherchenbericht veröffentlichten Anmeldungen in Zukunft wieder senken zu können, doch handelt es sich bei der zeitlichen Behandlung von nationalen Recherchen einerseits und europäischer Recherchen andererseits um ein diffiziles politisches Problem.

Auf eine entsprechende Frage von seiten des EPI erläuterte das Amt die Methoden der im EPA üblichen Produktivitätskontrolle, insbesondere in der GD 2. Auf eine entsprechende Frage von seiten des EPI in diesem Zusammenhang nach den Auswirkungen der Dreierbesetzung der Prüfungsabteilungen auf die Produktivität erwiderte das Amt, daß diese Auswirkung schwierig zu beziffern, aber mit Sicherheit relativ gering sei (Benutzung der Prüfungsabteilung zu Ausbildungszwecken und zur Lösung des Sprachenproblems; relativ wenig Zeitaufwand des zweiten und dritten Mitglieds, wenn der Berichterstatte ein erfahrener Prüfer ist). Wegen der guten Erfahrungen mit der Prüfungsabteilung beabsichtigt das EPA bis auf weiteres nicht, auf das Prinzip des Einzelprüfers überzugehen.

4. Streichung zugelassener Vertreter von der Liste

Das Amt regte auf seiten des EPI eine Prüfung an, ob man über Regel 102 Absatz 2 hinaus in zwei weiteren Fällen eine Streichung zugelassener Vertreter auf der Liste von Amts wegen vorsehen solle, und zwar im Falle des Konkurses eines zugelassenen Vertreters oder in dem Falle, in dem dieser trotz mehrmaliger Aufforderung seinen Mitgliedsbeitrag an das EPI nicht zahle. Zur Zeit werden diese Fälle disziplinarrechtlich behandelt, was auf die Dauer nicht befriedigt.

Das EPI wird diese Anregung des Amtes prüfen und eventuell eine Regelergänzung vorschlagen, die dann vom Verwaltungsrat zu beschließen wäre.

5. Benutzung des Telekopierers und der juristischen Datenbank

Von seiten des EPI wurde die Frage nach dem Zugang zum Amt für die Anmelder via Telekopierer sowie nach dem Zugang zur amtsinternen Datenbank wichtiger EPA-Entscheidungen gestellt.

In bezug auf den Telekopierer führte das Amt aus, es bestehe hier noch ein technisches Problem, da der Kopierer zur Zeit noch zu langsam arbeite; hinzu komme die rechtliche Problematik der rechtsgültigen Einreichung von Unterlagen auf diesem Wege (zum letztgenannten Problem führte der Präsident des Verwaltungsrats aus, die Frage werde bei WIPO besprochen, und es zeichne sich dort eine Lösung ab, indem man die Einreichung via Telekopierer als "behebbarer Mangel" einstufe). Das Amt wird die Frage des Zugangs zum Telekopierer - ebenso wie die des Zugangs zur amtsinternen Datenbank der Rechtsabteilung - prüfen und das EPI über das Ergebnis unterrichten.

6. Inkrafttreten des Gemeinschaftspatentübereinkommens

Von seiten des EPI wurde die Frage nach der voraussichtlichen Entwicklung des Gemeinschaftspatentübereinkommens und insbesondere der Möglichkeit eines Inkrafttretens für eine begrenzte Zahl von EG-Staaten gestellt.

Das Amt führte aus, welche schwierigen Hindernisse vor dem Inkrafttreten dieses Übereinkommens noch zu überwinden sind: Schaffung eines neuen europäischen Gerichts, eventuelle Änderung des Artikels betreffend die zum Inkrafttreten erforderlichen Voraussetzungen (politisches Problem des "Europa der zwei Geschwindigkeiten") etc. Wenn im Zusammenhang mit den eventuell zu ändernden Vorschriften für das Inkrafttreten eine diplomatische Konferenz einggerufen werden müßte, so könnte das wohl frühestens in zwei Jahren in Betracht kommen.

7. Versetzung von Prüfern von der GD 1 zur GD 2

Auf eine entsprechende Frage von seiten des EPI führte das Amt aus, die "Regellaufbahn" - d.h. zunächst mehrjährige Erfahrung in der Recherchenprüfung in Den Haag, dann Wechsel nach München zur Sachprüfung - werde flexibel gehandhabt; Prüfer, die hervorragende Recherchenprüfer seien und unbedingt in Den Haag bleiben wollten, würden nicht gegen ihren Willen zur Sachprüfung nach München versetzt. Es werde damit auch der Tatsache Rechnung getragen, daß - worauf aus Kreisen des EPI hingewiesen wurde - manche Prüfer hervorragende Recherchen anfertigen, jedoch für die Sachprüfung weniger geeignet sind.

8. Nationalitätenverteilung bei den Prüfern

Ausgelöst durch eine entsprechende Frage des EPI ent-

spann sich eine Diskussion über die Nationalitätenverteilung bei den Prüfern, insbesondere die zahlenmäßig schwache Repräsentation bestimmter Vertragsstaaten. Hier wurde insbesondere die Schweiz genannt. In der Tat hatte - wohl ausgelöst durch das Wechselkursverhältnis Schweizer Franken - DM und die relativ hohen nationalen Gehälter in der Schweiz - das Amt von Anfang an Schwierigkeiten, genügend qualifiziertes Personal aus diesem Vertragsstaat zu gewinnen.