

eipi **Information**

Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

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Table of Contents

| | | | |
|---|-----|---|-----|
| Editorial | 128 | Filing of Divisional Applications by F. A. Jenny (d, e, f) | 147 |
| Council Meeting | | »Prior art - Self collision« by J. C. H. Ellis | 147 |
| Bericht über die Ratssitzung in Funchal Beschlußliste | 129 | TRIPS and EPO proceedings: there is no problem by L. J. Steenbeek | 148 |
| Report from the Funchal Council Meeting List of decisions | 129 | European Qualifying Examination/Training | |
| Rapport de la réunion du Conseil à Funchal Liste des décisions | 129 | Rules of EPI Students and registration form (d, e, f) with introductory comment by K. Weatherald | 150 |
| President's Report (d,e,f) | 133 | Information from the Examination Board and the Examination Secretariat | |
| Secretary General's Report (d,e,f) | 133 | - Conduct of the 1995 examination (d,e,f) | 159 |
| Committee Reports | | - Compendium of the papers of the European Qualifying Examination (d,e,f) | 159 |
| Report of the Committee on Biotechnology Inventions by A. Huygens | 135 | EPI Tutorials · EPI Tutorium · Tutorat EPI | 161 |
| EPO Finances Committee Report by J. U. Neukom | 136 | University of London: Training Programme for the European Patent 1995 | 162 |
| Report of EPPC Meeting of 7th June 1994 by I. Muir | 137 | International Affairs | |
| Harmonisation Committee Report by R. C. Petersen | 138 | Industrial Property in Portugal by J. Cruz | 162 |
| Professional Qualification Committee Report by E. Thouret-Lemaître | 139 | Das neue österreichische Gebrauchsmustergesetz by G. Widtmann | 165 |
| EPI Membership Subscription | | Streit in den USA um »Schweizer Messer« by A. Braun | 166 |
| Rechnung 1995 · Invoice 1995 Appel de cotisation 1995 | 141 | USA database to be tested as vehicle useful for offering foreign rights to European technologies by J. L. White | 167 |
| Einzugsermächtigung · Direct debiting mandate Autorisation de prélèvement | 142 | Letters to the Editor | |
| Rules governing payment of the EPI Annual Membership Fee (d,e,f) | 144 | Taking of oral evidence at the EPO by C. P. Mercer | 169 |
| European Patent Convention | | Language problems by R. Chevallier | 170 |
| Changes in the application of the reservations on the protection of chemical and pharmaceutical products in Spain by M. Curell Suñol | 145 | De la difficulté de réussir l'examen de mandataire européen pour un Français par F. Benech | 170 |
| Extension of European Patents by E. Stohr | 146 | Information from the General Secretariat | |
| | | Deadline EPI Information 1/1995 | 172 |

Editorial

There is a report in this issue on the long-running saga of Patent Law Harmonisation. It seems to your Editorial Board that any and every effort in this direction is to be encouraged.

We have some pleasing harmonisation of a kind to report concerning our Institute, namely the setting up of a Studentship of the EPI. Members will find in this issue a note from Keith Weatherald of the PQC, and a sample of an application form for being registered as a Student of the EPI. As Students of the EPI will receive a copy of our Journal, your Board is looking forward to welcoming Students, new readers, and, we trust, new contributors (in any or all of the three official lan-

guages). We are confident that the possibility of Studentship will be beneficial to the Institute in providing a pool of people who will enhance the harmony that already exists among the 17 Nations making up the membership of the Institute.

It is to be hoped that the harmonisation will continue with the official side, to the benefit of all users of the patent system in Europe - which brings us back to patent law harmonisation in general, surely a benefit for users too.

It only remains for the Editorial Board to wish all our readers a very happy Christmas and Prosperous New Year, this being the last issue before 1995.

Jean Brullé · Joachim Herzog · Terry Johnson

Kurzbericht**37. Ratssitzung in Funchal
3. Oktober 1994**

Die 37. Ratssitzung des EPI fand in Funchal in Portugal, statt. Neben allgemeinen Verwaltungsangelegenheiten standen der Bericht des Präsidenten, Herrn David VOTIER, und des Generalsekretärs, Herrn Ton DRIES, auf der Tagesordnung. Zusammenfassungen beider Berichte sind nachstehend veröffentlicht.

Der Schatzmeister, Herr Kurt BÜCHEL, schlug für das laufende Jahr Änderungen des Budgets vor, die vom Rat gebilligt wurden. Dadurch schließt das Budget für 1994 mit einem leichten Defizit von 3.750 DM ab.

Der Rat beschloß, den Mitgliedsbeitrag für 1995 auf 300 DM festzusetzen und billigte das Budget für 1995 mit voraussichtlichen Einnahmen von 1.777.000 DM und voraussichtlichen Ausgaben von 1.693.000 DM.

Die Diskussion über die Möglichkeit einer Kostenreduzierung durch eine Reduzierung der Anzahl der Ausschußmitglieder führte zu keinem wesentlichen Ergebnis. Das Für und Wider reichte von der Befürwortung, Vertreter aller nationalen und berufsständischen Gruppen in zumindest einigen Ausschüssen zuzulassen, zu einer strikten Begrenzung der Ausschußmitgliedschaft. Ein Entwurf, den Herr JENNY zu diesem Thema ausgearbeitet hat, wird allen neugewählten Ratsmitgliedern im nächsten März mit der Bitte zugeschickt, die Nominierungen für Ausschüsse, die bei der Frühjahrs-Ratssitzung besetzt werden, gründlich abzuwägen.

Die Berichte der EPI-Ausschüsse wurden vom Rat zur Kenntnis genommen und diskutiert. Soweit vorhanden, sind Zusammenfassungen dieser Berichte in dieser Ausgabe veröffentlicht.

Die vom Rat gefaßten Beschlüsse sind in der nachstehenden »Beschlußliste« aufgelistet.

Der Präsident dankte allen Teilnehmern für ihre Unterstützung,

Short Report**37th Council Meeting
in Funchal
3 October 1994**

EPI's 37th Council meeting was held in Funchal, Portugal. Apart from general administrative items, matters on the agenda were the President's report by Mr. David VOTIER and the Secretary General's report by Mr. Ton DRIES. Summaries of both reports are published hereafter.

The Treasurer, Mr. Kurt BÜCHEL, proposed budget amendments for the current year which were accepted by Council. They will bring the 1994 budget to a slight deficit of 3,750 DM.

Council decided that the annual subscription for 1995 will amount to 300 DM and approved the budget for 1995 with an estimated income of 1,777,000 DM and estimated expenses of 1,693,000 DM.

The discussion on the possibility to reduce expenses in reducing the size of committees led to no decision in substance. The pros and cons ranged from favoring representation of all national and professional groups in at least some committees to a strict limitation of committee membership. A paper on this subject drafted by Mr. JENNY will be sent to the newly elected Council members next March urging them to carefully consider nominations for the committees which will be set up at the spring Council meeting.

Council discussed and noted the reports from EPI committees. As far as available, summaries of them are published in this edition.

The decisions made by Council are shown in the »List of Decisions« published hereafter.

The President thanked all participants for their efforts, our Portu-

Rapport succinct**37ème Réunion du Conseil
à Funchal
3 octobre 1994**

La 37ème réunion du Conseil de l'EPI s'est tenue à Funchal, au Portugal. Mises à part les questions administratives d'ordre général, le rapport du Président par M. David VOTIER et le rapport du Secrétaire Général par M. Ton DRIES étaient parmi les points à l'ordre du jour. Des résumés de ces rapports sont publiés ci-après.

Le Trésorier, M. Kurt BÜCHEL, propose des amendements au budget pour l'année en cours, qui sont acceptés par le Conseil. Il en résulte un léger déficit de 3.750 DM pour le budget 1994.

Le Conseil décide de porter la cotisation annuelle pour 1995 à 300 DM et approuve le budget 1995 dont les recettes sont évaluées à 1.777.000 DM et les dépenses à 1.693.000 DM.

La discussion relative à une éventuelle réduction des dépenses qui résulterait d'une réduction de la taille des commissions n'aboutit à aucune décision en substance. Les avis pour proposent une représentation de tous les groupes nationaux et professionnels, au moins dans quelques commissions, les avis contre recommandent une stricte limitation des membres des commissions. Un document sur cette question, préparé par M. JENNY, sera envoyé en mars à tous les membres du Conseil nouvellement élus afin qu'ils considèrent soigneusement les nominations aux commissions qui seront effectuées à la réunion du Conseil au printemps prochain.

Le Conseil discute et note les rapports des commissions de l'EPI. Des résumés de ces rapports sont publiés dans ce numéro, dans la mesure où ils étaient disponibles.

Les décisions prises par le Conseil sont indiquées dans la »Liste des Décisions« publiée ci-après.

Le Président remercie tous les participants de leurs efforts, nos

den portugiesischen Kollegen für ihre herzliche Aufnahme und den Organisatoren, insbesondere den Herren Jorge und Joao DA CRUZ, für ihre perfekte und wunderbare Vorbereitung.

guese colleagues for their warm welcome, and the organizers, in particular Messrs. Jorge and Joao DA CRUZ, for the perfect and wonderful job they had done.

collègues portugais de leur accueil chaleureux ainsi que les organisateurs, en particulier MM. Jorge et Joao DA CRUZ, de leur parfaite et remarquable préparation.

Beschlußliste
37. Ratssitzung in Funchal
3. Oktober 1994

List of decisions and actions
37th Council Meeting
in Funchal
3 Octobre 1994

Liste des Décisions
37ème Réunion du Conseil
à Funchal
3 Octobre 1994

1. EPA-Präsidentschaft

Der Rat beschloß, daß Präsident VOTIER einen Brief an den Präsidenten des Verwaltungsrates richten soll, in dem darauf hingewiesen wird, daß Kandidaten für die Präsidentschaft des EPA nur dann in Betracht gezogen werden sollen, wenn sie ein ausreichendes Verständnis für Patentangelegenheiten, Führungsqualitäten und den Willen haben, u.a. mit dem EPI zusammenzuarbeiten.

1. EPO presidency

Council decided that President VOTIER should write a letter to the Administrative Council Chairman that candidates for the EPO presidency should only be considered if they have adequate understanding of patents, management qualities and the willingness to cooperate a.o. with EPI.

1. Présidence de l'OEB

Le Conseil décide que le Président D. VOTIER écrira une lettre au Président du Conseil d'Administration pour demander que les candidats à la présidence de l'OEB ne soient retenus que s'ils offrent une connaissance adéquate des brevets ainsi que des compétences en management et le désir de coopérer entre autres avec l'EPI.

2. Generalsekretariat

Der Generalsekretär, Ton DRIES, schlug vor, die Bezeichnung »Generalsekretariat«, die seit Bestehen des EPI-Büros verwendet wird, in die Geschäftsordnung des EPI aufzunehmen. Sie soll die Bezeichnung »Sekretariat« ersetzen. Der Rat beschloß, daß der Geschäftsordnungsausschuß einen Vorschlag vorlegen solle.

2. General Secretariat

Secretary General, Ton DRIES, suggested that the name »General Secretariat« which has been used throughout the EPI office's existence, should be included in the EPI By-Laws to replace the term »Secretariat«. Council decided that the By-Laws Committee should make a proposal.

2. Secrétariat Général

Le Secrétaire Général, Ton DRIES, suggère que le nom de »Secrétariat Général« qui a été utilisé depuis la création du bureau de l'EPI, soit inclus dans le Règlement Intérieur de l'EPI pour remplacer le terme »Secretariat«. Le Conseil décide que la Commission du Règlement Intérieur devrait faire une proposition.

3. Budget 1994

Der Rat billigte das Ergänzungsbudget für 1994.

3. Budget 1994

Council approved the amended budget 1994.

3. Budget 1994

Le Conseil approuve le budget révisé 1994.

4. Größe der Ausschüsse

Die optimale Größe des Ausschusses für Biotechnologische Erfindungen wird zunächst auf 15 Mitglieder festgesetzt. Herr JENNY wird sein Papier über die zukünftige Größe der Ausschüsse entsprechend ändern.

4. Size of the committees

The optimum size of the Biotechnology Committee will be fixed at 15 members for the time being; Mr. JENNY will make the amendment in his paper on the future size of committees.

4. Taille des commissions

La taille maximale de la Commission de Biotechnologie sera fixée à 15 membres pour le moment; M. JENNY corrigera son document sur la taille future des commissions.

Der Rat bestätigte, daß die Entscheidung über die Berufung stellvertretender Mitglieder den Präsidenten der Ausschüsse überlassen bleibt. Der Rat stimmte nicht über den vorgeschlagenen Entwurf eines »Beschlusses für die Wahlen in die »Ausschüsse«, Papier 70/94, ab,

Council maintained that the decision on having or not having substitute members is left to the Presidents of Committees. Council did not vote on the proposed draft »Decision on the elections to the committees«, paper 70/94, but decided instead that paper 59/94,

Le Conseil maintient que la décision d'avoir ou de ne pas avoir de suppléants est laissée aux Présidents des Commissions. Le Conseil ne vote pas le projet proposé »décision sur les élections aux commissions«, document 70/94, mais décide à la place que le docu-

sondern beschloß statt dessen, daß das Papier 59/94, »Einige Gedanken über die Zukunft der EPI-Ausschüsse«, abgeändert werden und im März nächsten Jahres jedem neuen Ratsmitglied zum gründlichen Studium zugeschickt werden soll.

5. EPI-Mitgliedsbeitrag für 1995

Der jährliche Mitgliedsbeitrag für 1995 wurde auf 300 DM festgesetzt.

Das Budget für 1995 wurde entsprechend dem geänderten Papier 75/94 gebilligt.

6. Vorschlag für die Ernennung/Wiederernennung von Mitgliedern des Disziplinausschusses

Der Rat erneuerte die Nominierung von Herrn Michael RUFF als Mitglied des Disziplinausschusses und nominierte die Herren Marc SANTARELLI, Edward LYNDON-STANFORD, Claude Alain WAVRE.

7. Biotechnologie

Der Bericht der Arbeitsgruppe für Biotechnologische Erfindungen über Fragen des Umfangs der Ansprüche bei biotechnologischen Patenten, ferner ob der Artikel 84 EPÜ ein Grund zum Einspruch sei, wird zunächst dem EPPC vorgelegt, bevor er an den Rat geleitet wird, da er von allgemeinem Interesse ist.

Bezüglich der Freigabe von hinterlegten Mikroorganismen stimmte der Rat zu, daß der Briefentwurf, Annex 1 zum Biotechnologie-Bericht, mit geringfügigen Änderungen an den Präsidenten des Europäischen Patentamtes geschickt werden soll. Er wird vom Generalsekretär weitergeleitet.

Der Rat billigte eine geringfügig geänderte Fassung des vorgeschlagenen Briefentwurfs zum Entwurf der EG-Direktive über Rechtsschutz für biotechnologische Erfindungen. Er wird nach Überprüfung durch Herrn Bo HAMMER JENSEN vom EPI-Präsidenten dem Ministerrat und der Kommission der Europäischen Union zugeschickt.

»Some thoughts on the future of the EPI Committees«, be amended and sent to each new Council member next March for careful study.

5. EPI subscription fee 1995

The annual subscription for 1995 will amount to 300 DM.

The budget 1995 as presented in the amended paper 75/94 was approved.

6. Proposal for appointment/reappointment of Disciplinary Board members

Council renominated Mr. Michael RUFF as member of the Disciplinary Board and nominated Messrs. Marc SANTARELLI, Edward LYNDON-STANFORD, Claude Alain WAVRE.

7. Biotechnology

The report of the Biotechnology Working Group on the questions of the scope of claims in biotech patents and if article 84 EPC should be a ground of opposition will be given to the EPPC before being presented to Council since it is a question of general interest.

With respect to the release of deposited microorganisms Council approved that the draft letter, Annex 1 to the Biotechnology report, be sent to the President of the European Patent Office with minor amendments. It is to be forwarded by the Secretary General.

Council accepted a slightly amended version of the proposed draft letter concerning the EC draft directive on the legal protection of biotechnological inventions. It will be sent to the Council of Ministers and the Commission of the European Communities by the EPI President after revision by Mr. Bo HAMMER JENSEN.

ment 59/94, «Quelques réflexions sur l'avenir des Commissions de l'EPI», soit modifié et envoyé à chaque nouveau membre du Conseil au mois de mars prochain afin d'être soigneusement étudié.

5. Cotisation EPI 1995

La cotisation annuelle pour 1995 sera de 300 DM.

Le budget 1995 est approuvé avec les amendements proposés dans le document 75/94.

6. Proposition pour la nomination/renomination des membres de la Chambre de recours en matière disciplinaire

Le Conseil renomme M. Michael RUFF en tant que membre de la Chambre de recours en matière disciplinaire et nomme MM. Marc SANTARELLI, Edward LYNDON-STANFORD, Claude Alain WAVRE.

7. Biotechnologie

Le rapport du Groupe de Travail Biotechnologie concernant la portée des revendications dans les brevets de biotechnologie ainsi que la question de savoir si l'article 84 CBE doit être une raison d'opposition sera donné à l'EPPC avant d'être présenté au Conseil puisque qu'il s'agit d'une question d'intérêt général.

En ce qui concerne la publication de microorganismes déposés, le Conseil approuve que le projet de lettre, Annexe 1 du rapport de Biotechnologie, soit envoyé au Président de l'Office Européen des brevets avec des amendements mineurs. Il sera envoyé par le Secrétaire Général.

Le Conseil accepte une version légèrement modifiée du projet de lettre concernant le projet de directive de la Communauté Européenne sur la protection légale des inventions de biotechnologie. Après avoir été revu par M. Bo HAMMER JENSEN, celui-ci sera envoyé au Conseil des Ministres et à la Commission des Communautés Européennes par le Président de l'EPI.

8. Geschäftsordnung

Der Rat billigte den vom Geschäftsausschuß vorgeschlagenen Beschluß über die Veröffentlichung einer Zusammenfassung von EPI-Beschlüssen mit einigen Änderungen.

9. EPPC

Das EPI wird nur in sehr außergewöhnlichen Fällen und nur auf Beschluß des EPI-Vorstandes »amicus curiae briefs« in Verfahren vor der Großen Beschwerdekammer einreichen. Wenn solche Stellungnahmen die Frage der Vertetung betreffen, ist der EPI-Ausschuß für Standesregeln dafür zuständig.

Zum gegenwärtigen Zeitpunkt besteht keine Aussicht, in das EPÜ eine Bestimmung des Inhaltes aufzunehmen, daß eine Wiedereinsetzung in das Prioritätsrecht erfolgen kann, wenn trotz aller den Umständen entsprechenden Sorgfalt eine europäische Nach-Anmeldung nicht innerhalb der 12-Monatsfrist nach dem Einreichungsdatum der Erst-Anmeldung eingereicht werden konnte. Falls Änderungen des EPÜ in Betracht gezogen werden, sollten die Staatsangehörigen von BE, DK, ES, FR, GR, IE, IT, LI, LU, MC, NL und SE ihre staatlichen Vertreter darauf hinweisen, daß es sehr wünschenswert wäre, wenn die Möglichkeit der Wiedereinsetzung in ein Prioritätsrecht in das EPÜ aufgenommen würde.

10. Ausschuß für die Berufliche Qualifikation

Präsident David VOTIER wird bezüglich der Broschüre über den Berufsstand ein Schreiben an den Präsidenten des EPA richten.

Der Rat billigte die Regeln für eine EPI-Studentenschaft mit geringfügigen Änderungen.

A.J.M. Dries, Generalsekretär

8. By-Laws

Council accepted the resolution proposed by the By-laws Committee on the publication of an inventory of EPI decisions with some amendments.

9. EPPC

EPI will abstain from filing amicus curiae briefs in proceedings before the Enlarged Board of Appeal except in very exceptional circumstances and only if the EPI Board decides. If such statements are to be filed concerning questions of representation the Professional Conduct Committee will be the competent EPI Committee for preparing them.

For the time being there is no chance for an introduction in the EPC of a restoration of the rights to priority in case the subsequent patent application could not be filed within the twelve months period from the filing date of the earlier application in spite of all due care required by the circumstances. When amendments to EPC are considered, the nationals of BE, DK, ES, FR, GR, IE, IT, LI, LU, MC, NL and SE should advise their officials that the principle of restoration of the right to priority is very much worth being introduced into the EPC.

10. Professional Qualification Committee

President D. VOTIER will write a letter to the EPO President in respect of the brochure on the profession.

Council approved the Rules of EPI Studentship with minor amendments.

A.J.M. Dries, Secretary General

8. Règlement Intérieur

Le Conseil accepte la résolution proposée par la Commission du Règlement Intérieur en ce qui concerne la publication d'un inventaire des décisions de l'EPI, avec quelques amendements.

9. EPPC

L'EPI s'abstiendra de déposer des amicus curiae briefs dans les procédures devant la Grande Chambre de recours excepté dans des circonstances très exceptionnelles, et seulement si le Bureau de l'EPI le décide. Si de telles déclarations relatives à des problèmes de représentation doivent être faites, la Commission de Conduite Professionnelle sera la commission compétente pour leur préparation.

Il n'y a pour le moment aucune possibilité d'introduire dans la CBE un rétablissement des droits de priorité au cas où la demande de brevet ultérieure ne pourrait pas être déposée dans les douze mois qui suivent la date de la demande précédente, et cela en dépit de tous les soins requis par les circonstances. Quand des amendements à la CBE sont considérés, les ressortissants de BE, DK, ES, FR, GR, IE, IT, LI, LU, MC, NL et SE devraient informer leurs délégués que le principe du rétablissement du droit de priorité mérite d'être introduit dans la CBE.

10. Commission de Qualification Professionnelle

Le Président D. VOTIER écrira une lettre au Président de l'OEB concernant la brochure sur la profession.

Le Conseil approuve les Règles des «Etudiants de l'EPI» avec des amendements mineurs.

A.J.M. Dries, Secrétaire Général

**Bericht des Präsidenten
an den Rat
(Zusammenfassung)**

S.D. Votier, Präsident des EPI

Zum Bericht des Präsidenten gehörten

- (i) die Teilnahme des Präsidenten an der Tagung des Verwaltungsrates am 7./8. Juni 1994 in München;
- (ii) seine Teilnahme an einem Symposium in Slowenien, das vom slowenischen Amt für gewerblichen Rechtsschutz zusammen mit dem Europäischen Patentamt organisiert wurde. Es stand unter dem Thema »Unterstützung der Industrie in Patent- und Warenzeichenangelegenheiten«. Der Präsident erläuterte die Rolle des Patentvertreeters;
- (iii) die Gründung eines neuen Ausschusses für Harmonisierung, der das Wiederaufleben der internationalen Harmonisierungsaktivitäten verfolgen soll;
- (iv) diverse Korrespondenz zu den Tätigkeiten der Institutsmitglieder und ihrem Beitrag zum Funktionieren des europäischen Patentsystems.

**President's Report
to Council
(Summary)**

S.D. Votier, EPI President

When presenting his report, the President referred to a number of items, including

- (i) his attendance at the Administrative Council Meeting in Munich on June 7th and 8th 1994;
- (ii) his participation in a Symposium in Slovenia organised by a Slovenian Industrial Property Protection Office and the European Patent Office. The theme of the Symposium was »Patent and Trade Mark Services to Industry«, and the President explained the role of the Patent Attorney;
- (iii) the constituting of a new Harmonisation Committee, to review the resurgence of activity on the topic of International Harmonisation;
- (iv) sundry correspondence regarding the activities of members of the Institute and their contribution to the functioning of the European Patent System.

**Rapport du Président
au Conseil
(Résumé)**

S.D. Votier, Président de l'EPI

Parmi les différents points présentés dans son rapport, le Président rappelle entre autres:

- (i) qu'il a assisté au Conseil d'Administration à Munich les 7 et 8 juin 1994;
- (ii) qu'il a participé à un symposium en Slovénie, organisé par le bureau slovène de la Protection de la Propriété Industrielle. Le thème de ce symposium était «Les services de Brevets et Marques pour l'Industrie»; le Président y a expliqué le rôle du Conseil en Brevets;
- (iii) qu'une nouvelle commission d'Harmonisation a été créée afin d'étudier le regain d'activité dans le domaine de l'Harmonisation Internationale.
- (iv) qu'il a eu divers échanges de correspondance concernant les activités des membres de l'Institut et leur contribution au fonctionnement du Système de Brevet Européen.

**Bericht des Generalsekretärs
an den Rat
(Zusammenfassung)**

A.J.M. Dries, Generalsekretär

Die Abhängigkeit von Software-Firmen bleibt ein heikles Thema, nicht nur in unserem Büro. Wir hatten mit einer Software-Firma, die sehr gute Referenzen hat, zu kämpfen, die sich schließlich unfähig erwies, die Standard-Software an unsere Erfordernisse anzupassen. Damit hatte sie uns in große Schwierigkeiten mit der Buchhaltung für das Jahr 1993 gebracht.

Im Frühjahr fanden wir eine neue Firma, die die größten Probleme löste und es uns ermöglichte, die Buchhaltung für das Jahr 1993 abzuschließen und mit den Buchhaltungsarbeiten für 1994 zu beginnen. Trotzdem bleiben eine Reihe

**Secretary General's Report
to Council
(Summary)**

A.J.M. Dries, Secretary General

The dependance on software suppliers remains a delicate matter and not only in our office. We have been struggling with a supplier with very good references who finally was unable to adapt standard accounting software to our needs and thus put us in a difficult position with respect to the 1993 accounts.

This spring we found a new firm which solved the major problems and allowed us to do our 1993 accounting and to start with the 1994 accounts. Yet, a number of issues remain to be solved. Our difficulty now consists in obviously having a

**Rapport du Secrétaire Général
au Conseil
(Résumé)**

A.J.M. Dries, Secrétaire Général

La dépendance envers les programmeurs reste un sujet délicat, pas seulement pour notre bureau. Nous avons eu de grosses difficultés avec un programmeur ayant de bonnes références mais qui, finalement, s'est avéré incapable d'adapter le logiciel de comptabilité à nos besoins, nous mettant ainsi dans une position difficile en ce qui concerne l'exercice 1993.

Au printemps, nous avons trouvé une nouvelle firme qui a résolu les problèmes majeurs, nous permettant ainsi de faire notre comptabilité 1993 et de commencer la comptabilité de l'année 1994. Cependant, il reste encore un certain nombre de

von Problemen ungelöst. Unsere Schwierigkeit besteht nun darin, offensichtlich eine Software-Firma mit dem nötigen Know-how zu haben. Über diese Qualität sind aber auch andere informiert. Daher hat diese Firma viel zu viele Kunden. Diese Erfahrungen teilen wir sicher mit vielen unserer Mitglieder. Wir müssen weiterhin Druck machen um voranzukommen.

Um unsere Abhängigkeit von Firmen von außen zu verringern und um ein großes Vertragsvolumen im Rücken zu haben, erkunden wir zusammen mit dem EPA die Voraussetzungen für eine Einbindung in seine Wartungs- und Kundendienst-Verträge. Eine der Voraussetzungen dafür ist, daß wir unsere Hardware ersetzen, die veraltet ist und die sowieso in den nächsten zwei Jahren hätte ersetzt werden müssen, und leistungsfähigeres Material installieren. Dann können wir unsere Software so aufrüsten, daß sie dem EPA-System entspricht. Die Bereitschaft des EPA, uns in dieser Hinsicht zu unterstützen, schätzen wir sehr.

Die EPA/EPI Zusammenarbeit bei der Abbuchung von EPI-Mitgliedsbeiträgen funktioniert ebenfalls gut. Ca. 1.100 Personen haben dieses Jahr von dieser Möglichkeit Gebrauch gemacht, die abgebuchten Mitgliedsbeiträge belaufen sich auf rund 300.000 DM. Zieht man in Betracht, daß dies das erste Jahr dieser Abbuchungsmöglichkeit ist, so bedeutet dies eine enorme Akzeptanz. In diesen Zusammenhang möchten wir unsere Mitglieder erneut darauf hinweisen, daß die Abbuchung nur an zwei Terminen erfolgen kann; Das sind der 25. Februar und 25. Juni jeden Jahres. Unser Formular für den Abbuchungsauftrag ist in dieser EPI-Information veröffentlicht und muß an das EPI *und nicht* an das EPA geschickt werden. Es können nur Mitgliedsbeiträge und nichts anderes (Gebühren für das Tutorium, etc.) abgebucht werden. Kurz, es wäre hilfreich, wenn alle Beteiligten die Hinweise für den Abbuchungsauftrag lesen würden. Alle Ratsmitglieder werden gebeten, diese Mitteilung in ihren Ländern zu verbreiten.

software firm which has the necessary know-how, but which being known a such is asked for by too many clients. Thus, we certainly share the experience of a number of our members and have to keep pressing for progress.

In order to become less dependent on outside firms, and to have a big contract volume backing us, we are exploring with the EPO about the prerequisites for being included into their maintenance and helpdesk contracts. One of the requirements will be that we replace our hardware, which has become out of date and which was scheduled to be replaced within the next two years anyway, and install more powerful material for being able to upgrade our software so that it matches with the EPO scheme. EPO's readiness to support us in this respect is most appreciated.

EPO/EPI cooperation is also working well with respect to the direct debiting of EPI subscriptions. Some 1,100 persons have participated in this scheme this year amounting to some 300,000 DM of subscriptions. Taking into consideration that this is the first year the scheme is in operation, this is a tremendous acceptance rate. In this context it should again be pointed out to our members that we only have two dates at which the direct debiting may take place. They are 25 February and 25 June of each year. Our form for the debiting mandate as published in this issue of EPI Information is to be sent to EPI *and not* to EPO. Only annual subscriptions may be debited but nothing else (tutorial fees etc.). In short: It would be helpful if all participants read the instructions for the debiting mandate and Council Members are invited to spread this message in their countries.

questions à résoudre. Notre difficulté réside maintenant dans le fait d'avoir un programmeur qui a le savoir-faire nécessaire mais, connu en tant que tel, est sollicité par trop de clients. Nous devons constamment faire pression sur lui pour progresser et partageons certainement dans ce domaine l'expérience de beaucoup de nos membres.

Afin d'être moins dépendants de firmes de l'extérieur et de pouvoir nous appuyer sur un gros volume contractuel, nous étudions auprès de l'OEB les conditions requises pour être inclus dans leurs contrats de maintenance et d'assistance informatique. L'une des conditions préalables est que nous remplacions notre équipement qui est vieux et qu'il a été prévu de remplacer de toute façon dans les deux prochaines années pour installer un équipement plus puissant qui nous permettrait d'améliorer notre logiciel et d'être ainsi compatible avec le système de l'OEB. La bonne volonté de l'OEB à nous aider dans ce domaine est très appréciée.

La coopération EPI/OEB fonctionne bien en ce qui concerne l'autorisation de prélèvement des cotisations EPI. Environ 1.100 personnes ont participé cette année à ce projet; le montant de leurs cotisations s'est élevé à 300.000 DM. Si l'on considère que c'est la première année que ce projet fonctionne, le taux d'acceptation est énorme. Dans ce contexte, il semble important de préciser de nouveau à nos membres que nous disposons seulement de deux dates auxquelles ce prélèvement peut être effectué. Ce sont les 25 février et 25 juin de chaque année. Le formulaire pour l'autorisation de prélèvement publié dans ce numéro de EPI Information doit être envoyé à l'EPI, et *non pas* à l'OEB. Seule la cotisation annuelle peut être prélevée, et rien d'autre (frais d'inscription au tutorat etc). En résumé, il serait utile que tous les participants lisent les instructions concernant l'autorisation de prélèvement, et les membres du Conseil sont invités à faire passer le message dans leurs pays respectifs.

Report of the Committee on Biotechnology Inventions (Summary)

A.V. Huygens (NL), Chairman

A. Language Aspects of Sequence Listing

At the last meeting of the Committee on 28 June 1994 in Munich, Dr Kolle had been invited *inter alia* to introduce and discuss an EPO initiative relating to the language aspects of sequence listing. The EPO proposal was discussed at a Trilateral Meeting in Japan. WIPO has now taken the matter up and presented a proposal to the Meeting of International Authorities under the PCT held between 27th June and 1st July 1994.

The basic idea is that Applicants using the PCT or EPC would have the option of filing a Sequence Listing in English, even if the language of the application is not English. There would be a requirement for providing a glossary of the language-dependent terms and their equivalents in the language of the application. Although the filing of all Sequence Listings in English would effect a cost saving, it is not proposed that it should at present be mandatory.

The EPO is in favour of WIPO's proposal. It foresees that it may need to amend the Rules in the EPC to allow for a derogation from the strict language requirement in the EPC. The Committee also welcomed the proposal and supported the views given by Dr Kolle.

B. Sequence Listing/PatentIn Software Program

The Committee discussed the PatentIn software matter in the light of the version 1.30 beta test report. It was generally felt that there were problems with PatentIn which need to be solved. However, it appeared to be difficult to have these problems addressed unless they are relevant to the US situation.

The main problems were that it was necessary to put in some non-mandatory features in order to complete the program and that it appears to be necessary, at least for

the USA, to put in a separate sequence listing for all features which might be claimed, even if they are all present in a single segment. It was felt that a complete rewrite of the software may eventually become necessary.

EPI members who are using the PatentIn software are encouraged to report their experiences to the Committee so that the Committee gets a clear and complete picture of the problems and will be able to discuss them with the EPO.

C. Scope of Claims in Biotech Patents

The Committee was contacted by the CIPA Biotechnology Committee about the question of breadth of claims in biotech patents. The CIPA Biotech Committee had expressed serious concern about the EPO practice concerning allowable scope of claiming in biotech cases. It was felt that in too many cases the scope of the allowed claims is far too wide having regard to the support in the specification.

At its meeting last June the EPI Biotech Committee discussed this matter in detail with a representative of the CIPA Biotech Committee (who is also a member of EPI). It was questioned whether Article 84 EPC is a substantive part of the law or merely a formal requirement. It was also discussed whether failure to meet the requirements of Article 84 should be made a ground of opposition *ab initio*.

It was argued that Article 84 is only a formal requirement and should therefore not be a ground of opposition. The question of the scope of a claim might be dealt with under Article 56, as suggested even by the EPO itself. However, this had been tried in many cases but was generally unsuccessful.

It was also argued that Article 84 is a substantive requirement, that it should be used more carefully by Examining Divisions and that it

should be a ground of opposition. According to this view Article 84 should be used, both before and after grant, to ensure that the scope of the claims is commensurate with the contribution to the art made by the applicants.

The Committee agreed that, whatever view is taken of Article 84, there is still a problem that claims in biotechnology patents are granted with unduly broad scope. It was decided that further consideration of this point is required and so the Committee appointed a Working Group to consider the matter further and report.

D. Release of deposited micro-organisms

A new case was reported to the Committee where the «expert solution» under Rule 28(4) EPC had been requested but had not been put into effect.

Similar situations have been reported to the Committee previously and the question has been dealt with more generally in 1992 and reported to the Council at its meeting in Luxembourg in September 1992. At this meeting Council agreed with the proposal to send a letter to Dr Brändli in which it was urged that the procedure in connection with the administration of Rule 28 EPC in general should be emphasized to the administration of the EPO and to the National Offices who incorrectly may receive requests for samples of micro-organisms deposited in connection with European patent applications.

The present case is slightly different from the cases reported previously to the Committee in that it relates to a PCT application. The request for furnishing a sample was filed with the EPO very soon after the publication of the PCT application, but prior to the application entering the regional phase. It appeared that the relevant EPO

authority did not receive copies of the PCT Request thereby making it impossible to avoid such errors without the office by itself obtaining such a copy upon receipt of a request for the furnishing of a sample.

Although this situation will probably be exceptional, it was felt appropriate to urge the EPO to take measures to avoid such situations in the future. A draft letter to the President of the EPO was approved by the Council.

E. EC Draft Directive on the legal protection of biotechnological inventions

The Committee noted the latest developments with regard to the draft Directive. It was reported that the present status of the Draft was unclear. The Draft had been presented to the European Parliament, where a large number of amendments had been proposed, but only three had been voted on before the Parliament became inquorate. It is now up to the Commission to determine which of a number of options it will pursue in order to progress the matter. It may be difficult for the Commission to pursue that matter because the Rapporteur dealing with the Draft had resigned.

It was indicated that the EPO's position is one of waiting. The EPO will only take any action, for instance to amend Rule 28 or Article

53(b) EPC, once the Directive is agreed.

The Committee agreed with the view that the three amendments made by the Parliament were generally unacceptable and in particular that the amendment to Recital 10 should be resisted strongly. This made the Recital inconsistent with the Articles of the Directive. This would lead to different member states adopting different views of what the Directive meant.

The Committee felt that it was appropriate to make its views - through EPI - known to the Commission since the amendments could have a direct effect on the EPC. It was agreed that making its views known might not have any effect on the political situation but that it would create a history of opposition which would prevent anyone from saying at a later date that the amendments were unopposed. A draft letter which may still be slightly amended in the light of the latest developments was approved by the Council.

It was agreed that a letter should be sent by the President of the EPI to the Council of Ministers, the European Commission and the European Parliament. The letter should concentrate on the objections in principle to the amendment to Recital 10 and the adverse effect that this would have on the objectives of the Directive.

F. »Patents and Ethics« in the context of modern technology

It was reported that the EPI Position Paper on Art. 53(a) EPC (»Patents and Ethics«) which was prepared by the Committee had generally been well received, as appeared from various letters, e.g. from the President of the EPO and the Biotechnology Committee of CIPA, and oral notifications of adhesion.

The Committee discussed the possible effect of Article 27, paragraph 2 of the GATT Agreement on TRIPS as to whether »publication« would have to be removed from Article 53(a) EPC. It was decided that this question will be further investigated by the Committee.

H. Size of EPI Committees

The Committee discussed the question of the size of EPI Committees which had been raised by Council. The Chairman indicated that he had informed Dr Jenny, who had been appointed by the President of the Institute to investigate the question that, in his view, the predominant factor of this Committee should be expertise in the biotechnology field and that the present size of the Committee is right. In any event the Committee should consist of no more than about 15 members. It was agreed that the members of this Committee should continue to think about the problem.

EPO Finances Committee Report (Summary)

J. U. Neukom (GB), Chairman

General

1. Flowing from the Committee's recommendation at the last Council meeting, our President wrote in May to the Administrative Council Chairman, Mr. Thoft, on the subject of EPO procedural fees (the text is at page 92 of EPI-Info 3/1994). It is gratifying to learn that this letter was copied to member delegations, that it was considered at the Administrative Council meeting in June,

and that our President was invited to speak on it at that meeting.

2. The question of surpluses remains critical. In particular, should surpluses be generated to repay loans ahead of schedule (unscheduled loan repayments)?

3. Less than two years ago, the Administrative Council in adopting the 1993 Budget was content - at least by implication - that loan capital, as a percentage of total assets,

should be over 60% at that time and should reduce into the future at roughly 1% each year.

4. Against this background, the massive operating surplus of nearly DEM 125M. in 1993 - continuing as it does this year - can be seen as proof that current levels yield too much and are therefore excessive. However, instead of an acknowledgement that fee levels are in fact excessive, and instead of a reducti-

on of fee levels, a change is apparently preferred in the rate of loan repayments. A comparison of the 1994 Budget with that of 1993 reveals the magnitude of the change: It is now estimated, for example, that the loan capital percentage is reducible to nearly 40% in 1997 when hitherto the figure was only a few points short of 60%. Why this newly found haste - a mad rush, perhaps - to repay loans at the expense of more favourable fee levels?

Financing fee reforms

5. There are signs of continuing enthusiasm in the Office for the scheme of deferment of designation fee payments outlined to SACEPO earlier this year. In view of the previous paragraphs in this paper, the Committee believes that the least that should be done by our Institute is to use all suitable opportunities for insisting that the transitional

cost of such a scheme (said to be around DEM 100M.) should be met from internal resources, and therefore *not* from any increases in fee levels.¹

European Patent Extensions

6. Extension requests are already possible for Slovenia and Lithuania; also soon for Latvia. Having regard to widespread interest elsewhere, the number of countries offering the extension possibility could eventually run into double figures.

7. At the time when the agreement with Slovenia was signed, it was said that the extension fee (currently DEM 200) would, after deduction of a proportion to cover EPO costs, leave a balance to be remitted to the Slovenian office for »promoting innovation in industrial property in Slovenia«.

8. Whilst accepting that extensions benefit European industry by providing a simple and cheap tool for gi-

ving access to patent protection in central and eastern Europe, the Committee takes the view that it is not a proper function of the EPO to collect money on behalf of third parties. The Resolution concerning developing countries appended to the Convention cannot be relevant since it is confined to *technical assistance*. If the income represented by the balance of extension fees is important to the country concerned, there is opportunity to gain that income through the publication fees payable on filing the claims translations and/or through the national renewal fees, no part of which is remitted to the EPO.

¹ Since this paper was written, it has been learned that the EPO is for the present no longer pursuing the scheme of deferment of designation fee payments.

Report of EPPC Meeting of 7th June 1994

I.R. Muir (GB), Rapporteur

Patentability of Computer-Related Inventions

The present guidelines for computer-related inventions were signed and issued by Mr. van Benthem on 6th March 1985 following work by an EPO Working Group and an EPPC subcommittee. The guidelines have had broad support but some members felt that the position should now be reviewed in the light of experience and recent Appeal Board decisions. A small subcommittee of the EPPC has been set up with the job of making suggestions as to what, if anything, is necessary in this area.

Restoration of the Right to Priority

The EPPC was asked to study the feasibility of introducing into the EPC the possibility of restoration of the right to priority in the situation where a patent application could

not be filed within the twelve-month period from the filing of an earlier application, despite the exercise of all due care required by the circumstances. It was noted, however, that the question, of making of such a restoration possibility mandatory on the Contracting States, was discussed during the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention in the Hague in June 1991. At that time, only four of the existing EPC Contracting States (AT, CH, DE and GB) spoke in favour of such a restoration possibility

It seems likely that this situation prevails today and that a Diplomatic Conference of the EPC Contracting States would be unlikely to be in favour of such a restoration possibility. It, therefore, does not seem possible for anything to be done by the EPPC for the time being and it

was agreed that the matter should be held in abeyance until there is an opportunity to amend Articles 122 EPC. It was proposed that those in favour of the provision (in Contracting States other than the four already in favour) should first try to convince their governments that such a restoration possibility should be introduced into the EPC. Within the EPPC itself there was a minority opposed to the possibility of restoration, even if the loss results, for example, from a breakdown of the postal services.

Statements by Third parties in Proceedings Before the Enlarged Board of Appeal

On the 11th March 1994 the Enlarged Board of Appeal amended its rules of procedure inter alia by inserting the following new Article 11b into its rules of procedure:

»Statements by Third Parties

- (1) In the course of proceedings before the Board, any written statement concerning the points of law raised in such proceedings which is sent to this Board by a third party may be dealt with as the Board thinks fit.
- (2) The Board may announce further provisions concerning such statements in the Official Journal of the European Patent Office if it seems appropriate.«

In June 1994, the Administrative Council of the EPO approved the above-mentioned amendment and the amendment entered into force on the 8th June 1994. The EPPC discussed whether or not the EPI, and especially the EPPC, should play any part in such proceedings and particularly whether the EPI or the EPPC should file third party statements whenever they thought it appropriate so to do.

The members of the EPPC clearly felt it was not the task of a professional body such as the EPI to file statements in proceedings before the Enlarged Board, except where questions of representation are

concerned. It was particularly noted that there could be conflicts of interest since both parties to the case before the Enlarged Board will normally be represented by EPI members. The EPPC were of the view therefore that the EPI as well as the EPPC should abstain from filing third party statements in proceedings before the Enlarged Board of Appeal except in very exceptional circumstances and only if the EPI Board so directs.

Legal Documentation

The EPPC sub-committee on legal documentation has prepared a table containing a survey of existing sources of access to the EPO decisions, including so-called unpublished decisions. This table was published in EPI Information 3/1994, page 112.

Relationship between Articles 123(2) and 123(3) EPC

There was discussion of the conflict between these two paragraphs of Article 123 EPC, particularly in relation to the »Catch 22« situation where a feature has been added to the application before grant and

which is then considered an inadmissible extension in opposition proceedings. In that case Article 123(2) would require deletion of such a feature whereas Article 123(3) would not allow deletion because the protection conferred by the patent as granted would be extended. The Enlarged Board of Appeal decision G1/93 deals with this matter and has made it clear that the two paragraphs are mutually independent of each other and of equal importance. It was noted that the internal Patent Practice Committee of the EPO was studying the impact of the decision and will decide whether guidelines will have to be issued to the Examiners and, if so, what form they will take.

Meeting with DG3

The fourth meeting between members of EPI, UNICE, IFIA and the Boards of Appeal will take place in Munich on 7th November 1994. Members of the EPPC will take part in the meeting and a report will appear in a subsequent issue of EPI Information.

Harmonisation - again?

Richard C. Petersen (GB)

Readers will recall that the second part of the Diplomatic Conference scheduled for May 1993 was postponed (EPI Information 2/1993, page 99). This arose from the announcement by the newly appointed Commissioner of Patents in USA that the first-to-file system would be retained there. Subsequently, agreement was reached on GATT and the associated TRIPS articles, so that the decision of the Paris Union Assembly to remove the provisions of Article 10 (Fields of Technology), Article 19 (Rights Conferred by the Patent), Article 22(1) (Term of Patents), Article 24 (Reversal of the Burden of Proof), Article 25 (Obligations of the Right Holder) and Article 26 (Remedial Measures Under National Legisla-

tion) in September 1992 because these matters were covered by TRIPS, seems to have been justified and reduces the areas of disharmony.

In order to get things moving again, WIPO proposed in May 1994 that the second part of the Diplomatic Conference should be held in May 1995 with a text to be discussed based upon the original Basic Text without the articles listed above and without certain other controversial articles. There were offered by WIPO three alternatives, with increasing numbers of articles omitted. The first, A, lacked Article 9(2) (First-to-File), Article 12 (Grace Period), Article 16 (Time Limits for Search and Substantive Examination), and Article 20 (Prior Use). In

the second, B, Articles 11, 13, 14, 17, 18 and 23 would be added to the list of removals. The third, C, would be limited to Articles 2, 3, 4, 5, 6, 7, 8 and 9(1).

The general response from European governments was generally negative to the removals, although positive to the idea of progress in the field. AIPPI came up with the proposal that the four controversial articles should be put into a »Chapter II« part which would not become operative until all had accepted and ratified, thus effectively leaving the first-to-invent system operative in USA but equally the grace period inoperative in other countries until a change in U.S. law.

Other bodies offered support, although the EPI Harmonisation

Committee was unable to reach unanimous agreement for the inclusion of the four controversial articles in this way. At the following Paris Union meeting in September 1994, the negative attitude of USA was confirmed and an indication given that TRIPS and the 20 year term were in trouble. After a firm lead from the United Kingdom delegation in favour of further discussion of the whole matter, supported by other, particularly European, countries, Dr. Bogsch offered a proposal that:

1. There should be a Consultative Committee in the first half of 1995 to recommend solutions to the principal issues so that the second part of the Diplomatic Conference can be convened.
2. The Consultative Committee should be open to all members of WIPO, UN and WTO, representatives of GATT and the interested circles attending as observers.
3. The results of the Consultative Committee should be considered at the next Paris Union Governing Bodies Meeting in September 1995.

This proposal was unanimously adopted, even USA accepting it.

The Harmonisation Committee will now be working on any pre-

liminary documents for the Consultative Committee meeting, bearing in mind that general agreement has already been reached upon most of the articles. The opportunity to improve Article 12 (Grace Period) seems to be the most important. The matters which the writer of this article thinks should be considered are as follows and it is to be hoped that members will make their views known to the Committee as soon as possible.

The Treaty should have as object a pure first-to-file system and not a hybrid one involving the possible first-to-publish advantage. Thus the grace period would only provide the inventor/publisher with protection against the usual consequences of publication, i.e. lack of novelty and inventive step.

Where a third party uses an invention following publication, it should not be a legal presumption that the invention was obtained from the inventor, who should have the burden of proving that there was actual knowledge of the publication and obtaining of the invention by the third party.

The duration of the grace period should be reviewed. Twelve months seems over long to enable a publishing inventor's patent attorney to discover what was published and to file an appropriate patent applica-

tion. If provision is made for filing without the need for claims, a grace period of six months ought to be adequate.

If an inventor or his patent attorney is aware of a publication before filing, attention should be drawn to this for good faith's sake. Thus, an inventor should not publish in a deliberately obscure manner in order to anticipate a rival's later application, and then fail to disclose that the grace period is to be invoked in support of his own application.

There are thus several matters still to be discussed and argued before any final agreement can be reached. Practitioners will point, for example, to the earlier Article 7(2) which allowed for priority to be retained even beyond the twelve months from first filing in the case of force majeure, which was turned down at the first part of the Diplomatic Conference and regrettably stands little chance of being restored.

Much time and effort have already been expended upon harmonisation and the prospect of progress towards it, rather than continued hibernation and estivation, is to be welcomed.

Professional Qualification Committee Report (Summary)

E. Thouret-Lemaître (FR), Chairwoman

1. EPI tutorial 1994-1995

51 candidates (AT 2, BE 1, CH 3, DK 1, DE 24, GB 11, NL 4, NO 3, SE 2) and 18 tutors are involved in the tutorial.

The tutors' meeting will take place on November 8, 1994 in Munich.

As last year Chairmen and secretaries of the 3 Examination Committees are invited for exchanging views on the EQE papers.

2. EQE 1994 - EQE 1995

The first comments are coming from candidates and the Examination Committee's members. It is clear to everybody that the NCR paper (on which the answers had to be written this year) was a bad experience and that it should be excluded for the following years. Normal photocopier paper seems the only solution. Proposals will be made to the Examination Secretariat.

EQE 1995 will take place from 29 to 31 March 1995. Information relating to the EQE has been published in OJ 6/1994 and OJ 8/1994.

3. Joint meeting 18 May 1994

As usual this meeting was very useful; information and remarks given by the EPI tutors to the Examination Board were well received and in principle the Examination Board takes them into account.

It has been proposed by the Examination Secretariat to modify pa-

pers A and B but these proposals have been refused unanimously by the EPI members.

The Implementing Provisions were distributed to the EPI members. They have now been published in OJ 8/1994.

PQC made many remarks and comments on the document relating to the qualifications required for enrolment for the EQE. The final document has been published in OJ 8/1994. Moreover a list of landmark decisions has also been published in OJ 8/1994.

During the joint meeting it was decided to set up an EPO/EPI Working Group for discussing the time-lag between the holding of the examination and the candidates being given their results. The Working Group had its first meeting on September 28.

The composition of the Working Group is the following :

- L. Bleukx
Ex. Committee I EPI
- M. Jones
Ex. Committee II EPO

- E. Christiansen
Ex. Committee III EPI
- J-J. Joly
PQC EPI
- C. Neidl-Stippler
EPI Tutor EPI
- L. Dybdahl Österborg
EQE Secretariat EPO
- R. Cramer
EQE Secretariat EPO

4. EPI Students

The EPI Council approved in Maastricht the proposal of creating a studentship category for the future candidates to the EQE.

The rules have been proposed to the Council. PQC has taken into account the decisions of the EPI Council voted in Maastricht in writing the rules.

The final text of the Rules adopted by the Council is contained in the present EPI Information; the Application Form is also reproduced.

5. EPO/EPI Working Group on training

In Maastricht, the Council decided to appoint 5 EPI members to this

Working Group which had its first meeting on September 13. The composition of the Working Group is the following :

- EPO L. Dybdahl-Österborg
- R. Cramer
- D. Stauder
- C. Guggerell
- EPI E. Vinazzer
- L. Duran-Moya
- J. Gowshall
- F. Macchetta
- E. Thouret-Lemaître

A final document will be presented to the Administrative Council Meeting in June 1995. EPI insisted on the fact that PQC, the EPI Board and Council must be, this time, in a position to read and comment on the Administrative Council document in advance, before the final version is submitted to the Administrative Council. The Secretariat of the Working Group is on the side of the EPI.

In due time, the Council and EPI members will have information about the work of the Working Group.



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- votre numéro d'affiliation (inscrit à côté de votre nom sur l'étiquette).

Si votre compte-cotisation accuse déjà un solde débiteur, vous trouverez une feuille en annexe. Dans ce cas veuillez aussi verser la somme manquante.

Le Trésorier
Dr. Kurt Büchel

fil\invoice.95

Generalsekretariat · General Secretariat · Secrétariat Général

Erhardtstraße 27 · D-8000 München 2
Tel. (0 89) 201 70 90
Fax (0 89) 202 15 48

Bitte kopieren und einreichen an:

Please copy and return to:

Copiez et retournez s.v.p. à:

EPI-Generalsekretariat
Postfach 26 01 12

D-80058 München

Telefax 089 - 202 15 48**Einzugsermächtigung****Direct debiting mandate****Autorisation de prélèvement**Eingangsfrist im
EPI-Generalsekretariat:Deadline for receipt by the
EPI General Secretariat:Date limite de réception au
Secrétariat Général de l'EPI:

15. Februar

15 February

15 février

Bitte senden Sie diese Einzugsermächtigung oder eine Kopie hiervon **nur an das EPI-Generalsekretariat**, nicht an das EPA.

Please, send this debiting mandate or a copy thereof **to the EPI General Secretariat only**, not to the EPO.

Veillez envoyer cette autorisation de prélèvement ou une copie de celle-ci **uniquement au Secrétariat Général de l'EPI**, pas à l'OEB.

Bitte verwenden Sie **nur dieses Formular**, gegebenenfalls mit einem gesonderten Blatt für die Namen mehrerer EPI-Mitglieder. **Verwenden Sie keine Einzugsermächtigungen des EPA.**

Please use only this form, if necessary with a separate sheet for the names of several EPI members. **Do not use EPO mandate forms.**

Veillez n'utiliser que ce formulaire; ajoutez si nécessaire une feuille séparée pour les noms de plusieurs membres de l'EPI. **N'utilisez pas les formulaires d'autorisation de prélèvement de l'OEB.**

| | |
|---|--|
| Name/Vorname des EPI-Mitglieds: EPI member's surname/first name: Nom/prénom du membre de l'EPI | |
| EPI-Mitgliedsnummer: EPI membership number: Numéro d'affiliation à l'EPI: | |
| Die Einzugsermächtigung gilt für mehrere EPI-Mitglieder Falls "ja", bitte ein gesondertes Blatt mit den Namen und Mitgliedsnummern beifügen. | |
| This direct debiting mandate applies to more than one EPI member If "yes", please list names and membership numbers on a separate sheet. | nein ja <input type="checkbox"/> no <input type="checkbox"/> yes non oui |
| L'autorisation de prélèvement s'applique à plusieurs membres de l'EPI : Dans l'affirmative, prière de joindre au présent formulaire une feuille séparée portant le nom et le numéro de ces membres. | |
| Name des Kontoinhabers: Account holder's name: Nom du titulaire du compte: | |
| Kontonummer beim EPA: EPO account number: Numéro de compte auprès de l'OEB: | |
| | |
| Datum · Date | Unterschrift des Kontoinhabers · Account holder's signature Signature du titulaire du compte |

Einzugsermächtigung

**Eingangsfrist im
EPI-Generalsekretariat:**

15. Februar

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (EPI) wird hiermit ermächtigt, den EPI-Jahresbeitrag für das unten angegebene EPI-Mitglied in der jeweils gültigen Höhe von dem nachstehend genannten und beim Europäischen Patentamt (EPA) geführten laufenden Konto einzuziehen. Die Einzugsermächtigung gilt für den nächstfälligen und künftig fällige Beiträge bis auf schriftlichen Widerruf. Sie gilt ebenso für offene Beiträge vergangener Jahre. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem EPI getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABI. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABI. EPA 1993, 366).

Der Einzug des Beitrags erfolgt mit Wirkung vom **25. Februar** des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des EPI-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, faßt das EPI zu einem Gesamtbetrag zusammen. Demgemäß erteilt das EPI dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben nach Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des EPI nicht aus oder trifft die vorliegende Einzugsermächtigung beim EPI nach dem **15. Februar** ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das EPI-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das EPI spesenfrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des **erhöhten Jahresbeitrags** am **25. Juni**. Schlägt auch dieser Versuch fehl, muß der erhöhte Beitrag im normalen Bankverkehr beglichen werden.

Mit Wirkung vom **25. Juni** kann der Beitrag auch für EPI-Mitglieder, die zum vorausgegangenen Abbuchungstag noch keine Einzugsermächtigung vorgelegt hatten, eingezogen werden. Eingangsfrist für die Einzugsermächtigung im EPI ist hierfür der **15. Juni**.

Falls ein gesondertes Blatt mit den Namen mehrerer EPI-Mitglieder beigelegt wird, braucht es nicht gesondert unterschrieben zu werden.

Direct debiting mandate

**Deadline for receipt by the
EPI General Secretariat:**

15 February

The Institute of Professional Representatives before the European Patent Office (EPI) is hereby authorised to debit from the deposit account held with the European Patent Office (EPO) as specified below the EPI annual subscription for the EPI member named below at the appropriate rate. This direct debiting mandate applies to the forthcoming and all subsequent subscriptions until it is revoked in writing. It also applies to outstanding subscriptions from previous years. Debiting will be on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the EPI (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

Subscriptions are debited with effect from **25 February** of each year. All fees and costs payable to the EPO on the debiting date have priority over the EPI subscription. The EPI will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority payment of EPO fees and costs, the credit balance is not sufficient to carry out the EPI debit order, or if the direct debiting mandate is received by the EPI after **15 February**, the debit order is not carried out. The EPI member will be informed. Then, if the annual subscription has not been credited to the EPI account through the standard banking procedure and at no expense to the EPI by 30 April (reception on EPI account), an attempt will be made to debit the **higher annual subscription** on **25 June**. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the EPI through the standard banking procedure.

Subscriptions of EPI members who had not issued a direct debiting mandate by the previous debiting date may also be debited with effect from **25 June**. The deadline for receipt of the direct debiting mandate by the EPI is then **15 June**.

If a separate sheet with the names of several EPI members is enclosed, it does not need a separate signature.

Autorisation de prélèvement

**Date limite de réception au
Secrétariat Général de l'EPI:**

15 février

L'Institut des mandataires agréés près l'Office européen des brevets (EPI) est autorisé par la présente à prélever, sur le compte courant ouvert à l'Office européen des brevets (OEB) dont le numéro est mentionné ci-après, le montant en vigueur de la cotisation annuelle du membre de l'EPI dont le nom figure ci-dessous. La présente autorisation de prélèvement est valable pour la prochaine cotisation venant à échéance ainsi que pour les cotisations suivantes, jusqu'à révocation par écrit. Elle vaut également pour les cotisations des années précédentes non encore acquittées. Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'EPI (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Le prélèvement de la cotisation prend effet le **25 février** de l'année en cours. Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l'EPI. L'EPI regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. A cette fin, l'EPI donne à l'OEB un ordre de débit pour le montant total. Si, après règlement prioritaire des taxes et des frais dus à l'OEB, la provision du compte ne suffit pas pleinement pour exécuter l'ordre de débit de l'EPI ou si la présente autorisation parvient à l'EPI après le **15 février**, l'ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte de l'EPI), par une opération bancaire normale et sans frais pour l'EPI, il sera procédé, le **25 juin**, au prélèvement du **montant majoré de la cotisation annuelle**. Au cas où ce prélèvement non plus ne peut être effectué, le montant majoré de la cotisation doit être acquitté par une opération bancaire normale.

Avec effet au **25 juin**, il est également possible de prélever le montant de la cotisation annuelle des membres de l'EPI n'ayant pas produit d'autorisation de prélèvement à la date de débit précédente. A cette fin, la date limite de réception des autorisations de prélèvement par l'EPI est le **15 juin**.

S'il est joint une feuille séparée portant le nom de plusieurs membres de l'EPI, il n'est pas nécessaire de la signer.

Regeln für die Zahlung der EPI Mitgliedsbeiträge

Beschluß des EPI Rates auf seiner Sitzung in Kopenhagen am 11./12. Mai 1992

1) Der jährliche EPI Mitgliedsbeitrag ist innerhalb von zwei Monaten nach Fälligkeit zu zahlen.

2) Für Mitglieder, die bereits zu Anfang eines Jahres in die Liste der zugelassenen Vertreter eingeschrieben sind, ist das *Fälligkeitsdatum* der 1. Januar.

3) Für Mitglieder, die erst im Verlauf eines Jahres in die Liste der zugelassenen Vertreter aufgenommen werden, ist das *Fälligkeitsdatum* der Tag der Eintragung in die Liste.

4) Der jährliche Mitgliedsbeitrag wird *erlassen, wenn*

- der schriftliche Antrag des Mitgliedes auf *Löschung* von der Liste der zugelassenen Vertreter vor dem 1. April beim Europäischen Patentamt eingeht;
- eine Person nach dem 30. September in die Liste der zugelassenen Vertreter aufgenommen wird.

5) In allen anderen Fällen muß der volle jährliche Mitgliedsbeitrag bezahlt werden. Ratenzahlungen, Stundungen oder Beitragsreduzierungen können nicht gewährt werden.

6) Zahlt ein Mitglied, das bereits zu Anfang des Jahres auf der Liste der zugelassenen Vertreter stand, seinen Beitrag *nicht vor dem 1. Mai* (Eingang auf dem EPI Konto), erhöht sich sein Beitrag um DM 50.-.

Gleiches gilt für Mitglieder, die erst im Verlauf des Jahres in die Liste der zugelassenen Vertreter aufgenommen worden sind, falls sie ihren Mitgliedsbeitrag nicht innerhalb von vier Monaten nachdem sie durch »EPI-Information« oder einen Brief über seine Höhe informiert worden sind, zahlen.

7) Zahlungen müssen mittels Banküberweisungen, in Deutsche Mark

Rules Governing Payment of the EPI Annual Membership Fee

Decision taken by the EPI Council at its meeting in Copenhagen on 11/12 May 1992

1) The EPI annual membership fee has to be paid within two months after its due date.

2) *The due date* for members being on the list of professional representatives at the beginning of the year is 1 January.

3) *The due date* for members entering the list of professional representatives in the course of the year is the moment of entry on this list.

4) The annual membership fee is *waived if*

- a member's written *demand for deletion* from the list of professional representatives arrives at the European Patent Office prior to 1 April;
- a person is *registered* on the list of professional representatives after 30 September.

5) In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.

6) Members on the list of professional representatives on 1 January who *fail to pay* their membership fee prior to 1 May (reception on EPI account) will have to pay a *surcharge of DM 50.-*.

The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being notified of its amount through »EPI-Information« or by letter.

7) Payments have to be made by money transfers, in German Marks,

Règles relatives au paiement de la cotisation annuelle EPI

Décision prise par le Conseil de l'EPI à la réunion de Copenhague les 11 et 12 mai 1992

1) Le paiement de la cotisation annuelle EPI est dû dans les deux mois qui suivent la date d'exigibilité.

2) La date d'exigibilité pour les personnes inscrites sur la liste des mandataires agréés au début de l'année est le 1er janvier.

3) La date d'exigibilité pour les personnes admises sur la liste des mandataires agréés en cours d'année est la date d'admission sur cette liste.

4) N'est pas redevable de la cotisation de l'année en cours:

- un membre qui demande par écrit à l'OEB sa *radiation* de la liste des mandataires agréés avant le 1er avril;
- toute personne *inscrite* sur la liste des mandataires agréés après le 30 septembre.

5) La cotisation annuelle doit être payée dans son intégralité dans tous les autres cas. Aucun versement partiel, report d'échéance ou réduction du montant ne peut être accepté.

6) Toute personne inscrite sur la liste des mandataires agréés au 1er janvier et dont la cotisation n'est pas payée avant le 1er mai (date de réception sur le compte de l'EPI) doit payer un supplément de 50,- DM.

Ceci s'applique également à toutes les personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans »EPI-Information« ou par lettre.

7) Le paiement doit être fait par virement, en Deutsche Marks, sans

und frei von Bankspesen für EPI erfolgen. Dabei sind der Name und die Mitgliedsnummer jedes einzelnen Mitglieds, für das die Zahlung erfolgt, anzugeben.

8) Wegen der beachtlichen Bankgebühren und darüber hinaus wegen des großen zusätzlichen Verwaltungsaufwand werden keine Schecks, Bankschecks, kein Bargeld oder ähnliches angenommen.

9) Der EPI Rat beschließt Änderungen des Mitgliedsbeitrages vor Anfang des Folgejahres. Er informiert alle Mitglieder durch »EPI Information« über den neuen Beitragsbetrag und die Zahlungsmodalitäten. Alle Mitglieder, von denen angenommen werden kann, daß sie die entsprechende »EPI Information« erhalten haben, müssen Zahlungsvorkehrungen innerhalb der oben genannten Zeitspanne treffen, ohne daß eine zusätzliche Aufforderung hierzu erfolgt. Der Schatzmeister wird jedoch zu Beginn eines Jahres bzw. bei neuen Mitgliedern nach Eintragung in die Liste zusätzlich Rechnungen an alle Mitglieder verschicken. Verspätete Zahler, von denen angenommen werden kann, daß sie die oben genannte »EPI-Information« erhalten haben, können sich aber nicht darauf berufen, diese Rechnung nicht erhalten zu haben.

and free of bank charges for EPI. They must indicate the name and registration number of each member for whom the fee is paid.

8) Due to the substantial bank charges and furthermore to the enormous additional administrative requirements no checks, bankers drafts, cash, or the like will be accepted.

9) The EPI Council decides on modifications of the amount of the annual membership fee before the beginning of a year. It informs all members through »EPI-Information« of the new amount of the fee and the conditions for payment. All members deemed to have received the respective »EPI-Information« will have to make provisions for payment within the above mentioned time-limit without further request. The Treasurer will, however, also send out fee invoices to all members at the beginning of the year or to new members after their registration. Late payers deemed to have received the before mentioned »EPI-Information« may not plead not having received this invoice.

frais bancaires pour l'EPI. Le nom et le numéro d'affiliation de la/les personne(s) pour qui la cotisation est destinée doivent être indiqués clairement sur le virement.

8) Les chèques, les chèques bancaires, les règlements en espèces ou autres ne sont pas acceptés en raison des frais bancaires importants et de l'énorme supplément de travail que leur traitement nécessite.

9) Le Conseil de l'EPI décide des modifications du montant de la cotisation annuelle avant le début de l'année. Tous les membres sont informés par »EPI-Information« du nouveau montant de la cotisation et des conditions de paiement. Toute personne qui, en tant que membre, reçoit »EPI-Information« devra s'assurer que sa cotisation est payée dans le délai imparti, ci-dessus mentionné, sans autre notification. Le Trésorier enverra toutefois aussi un appel de cotisation à tous les membres au début de l'année, de même qu'aux nouveaux membres après leur inscription. Toute personne recevant en tant que membre »EPI-Information«, mentionné plus haut, et n'ayant pas payé sa cotisation à temps ne pourra pas alléguer qu'elle n'a pas reçu l'appel de cotisation.

Changes in the application of the reservations on the protection of chemical and pharmaceutical products in Spain

M. Curell Suñol (ES)

Changes affecting Spanish patents and European patents in Spain have recently occurred in the way the Patent Office applies the reservations on the protection of chemical and pharmaceutical products.

The grant of European patents designating Spain with the subsequent national validation was subject to the reservations made by Spain on its adherence to the European Patent Convention (EPC), in the sense that the patent would be ineffective to the extent that it con-

ferred protection on chemical and pharmaceutical products as such. These reservations expired on 7 October 1992. As is known, the question of the official view on the reservations held by the Spanish Patent Office (SPO) has caused certain controversies.¹

¹ See EPI-Information 3/1993, pp 177-186 (Marcelino Curell Suñol, European Patents in Spain: Reservations on chemical and pharmaceutical products and problems concerning priority claims).

Furthermore, controversies were also caused by the question of knowing whether said expiry date of the reservations should be considered with reference to the date of the priority claimed in the application (priority date approach) or with reference to the filing date of the application (filing date approach).

Recently, as a result of several cases submitted to the Appeal Division of the SPO, the first question has been reconsidered by the SPO

and is now being handled in a new way, very favourable for the patentees.

New official view on the reservations

Until recently, a practice of the SPO in its way of handling of the reservations was to publish the validation of the corresponding European patents with an individualized mention of the claims possibly affected by the reservations.

Now, this practice has been declared as not conforming to law, on the consideration that the SPO is not competent to open a post-grant national procedural stage and cannot refuse to admit or publish the translation of the printed European patent specification because it considers that the patent includes claims covered by the reservations, nor can it require any amendment thereof.²

2 Statements in this sense have been made in Resolutions of the Appeals Division of the SPO on reconsideration appeals filed against the former official view of the SPO. As examples, see: Resolutions of 25.01.93 and 28.01.93 (2), allowing reconsideration appeals concerning the validation of European patents 0 220 103, 0 253 412 and 0 292 348.

In this context, it has further been considered that the European Patent Office is exclusively competent to amend the claims and the Courts of Justice are exclusively competent to deprive a European patent of its effectiveness.

The consequence of all this is that the new official view of the SPO consists of refraining from making any reference to the reservations in specific claims, both in the publication of the validation in the Official Industrial Property Gazette and in the Spanish printed specification of the patents possibly affected by the reservations.

Nevertheless, as a reminder of the reservations made by Spain when adhering to the EPC, the SPO includes at the end of each Spanish printed specification, whatever the technical field of the invention, the following Informative note:

«In conformity with the reservation of Section 167.2 of the EPC and the Transitional Provision of the RD 2424/1986, of 20 October, relating to the application of the EPC, European patents designating Spain and applied for prior to 7.10.1992, shall be ineffective in Spain to the extent that they confer protection to chemical and pharmaceutical products as such. This information does not prejudice that the patent is included or not under the said reservation.»

Priority date/filing date approaches

European patent (or Spanish national patent) applications relating to the protection of chemical or pharmaceutical products as such, filed after 7 October 1992 but claiming a priority before that date, have not yet matured sufficiently to receive an action from the SPO. Until a short time ago, the SPO had been expected to apply the priority date approach.

Now, as a result of what is explained above, it is expected that there will be a change of position of the SPO, in the sense that it will abstain from any action in favour of or against either of the two approaches in conflict.

This abstention of the SPO does not mean that the problem has disappeared. The question is removed from the action of the SPO, but still comes under the competence of the Courts of Justice.³

3 The literature on this problem (see EPI-Information 3/1993, note 1) has been enriched with estimable contributions by Prof. Alberto Bercovitz (*La patentabilidad en España, a partir de 7 de octubre de 1992, de las Inventiones Químicas y Farmacéuticas*, in «Nuevos Desarrollos en Propiedad Industrial», Spanish Group of the AIPPI, Barcelona 1993, pp 58-63) and by Dr Manuel Lobato (*El Nuevo Marco Legal de las Patentes Químicas y Farmacéuticas*, Ed. Civitas, Madrid 1993, pp. 79-94).

Extension of European Patents

E. Stohr (EPO)

1. The extension system has been in operation for Slovenia (cf. OJ EPO 1994, 75) since 1 March 1994 and for Lithuania (cf. OJ EPO 1994, 527) since 5 July 1994 and will become operational for Latvia (cf. OJ EPO 1994, 201) and Romania (cf. OJ EPO 1994, 746) next year. First experience shows that the new system has been widely accepted. Up to 1 November 1994 extension of about 800 European patent applications to Slovenia has been requested. Another 300 to 400 extensions to this country are to be expected

from Euro-PCT applications designating Slovenia and filed between March and October. With about 150 extensions to Lithuania, the system got off to a good start for this country as well.

2. The extension of European patent applications and patents offers users of the European patent system a simple and cost-effective way to patent protection in these countries (Extension States) which are not (yet) Contracting States to the EPC.

3. The extension system largely corresponds to the EPC system, except that it is based solely on national law, modelled on the EPC, of the country in question. From the user's perspective, the system is very much like the EPC route to patent protection in the Contracting States, with which applicants are familiar.

4. Extension is largely »automatic« (Section 34 of the EPO's revised Request for Grant form gives the essential information; cf. OJ EPO 1994, 75 and 91); it is deemed to be requested for any European pa-

tent application as well as for any Euro-PCT application designating both the EPO and an Extension State, filed after the coming into force of the Extension system with respect to that Extension State. This request is deemed withdrawn, however, if the extension fee of DEM 200 is not paid to the EPO within the prescribed time-limits, i.e. the time-limits provided for in the EPC for paying the designation fees.

5. The request for extension may be withdrawn at any time. It is deemed to be withdrawn if the European or Euro-PCT application is finally refused, withdrawn or deemed to be withdrawn.

Einreichung von Teilanmeldungen

F.A. Jenny (CH)

Anlässlich der letzten Sitzung des Liaison Committee des EPPC mit Vertretern des EPA hat das EPA uns gebeten, die folgenden Vorschriften in Erinnerung zu rufen:

- Die vorgeschriebene Recherchengebühr ist auch für Teilanmeldungen zu bezahlen [Regel 25, Abs. 2]. Im Falle von Art. 10, Abs. 3 der Gebührenordnung wird die Recherchengebühr später zurückerstattet. Es ist jedoch in einem solchen Fall nicht zulässig, die Recherchengebühr im voraus einzubehalten.
- Teilanmeldungen können nur von dem im europäischen Patentregister eingetragenen Anmelder der früheren Anmeldung eingereicht werden [Regel 25, Absatz 1]. Dies ist insbesondere zu beachten, wenn die frühere Anmeldung in Umschreibung auf einen anderen Anmelder begriffen ist.

6. An extended European patent has the same effects in the Extension State as a national patent, provided the applicant has paid the prescribed publication fee and filed the required translation with the competent authority of the Extension State. Slovenia, Lithuania and Latvia require translations of the claims only, whilst for Romania a translation of the entire specification must be filed when an extended European patent enters the national stage.

7. Scope of protection, infringement and revocation etc. of extended European patents are governed by the relevant national provisions of the Extension States which are

Filing of Divisional Applications

F.A. Jenny (CH)

At the last meeting of the Liaison Committee of the EPPC with officials of the EPO the EPO asked us to recall the following provisions:

- The prescribed search fee has to be paid also for divisional applications [Rule 25, paragraph 2]. In the case of Art. 10, paragraph 3, of the Rules relating to Fees the search fee will be refunded later. In such a case, however, the advance withholding of the search fee is not permitted.
- Only the applicant of the earlier application entered in the European Patent Register may file a divisional application [Rule 25, paragraph 1]. This must be observed especially when the earlier application is in the process of being transferred to another applicant.

largely in line with the European norms.

8. The public is informed of extensions through the EPO's EPIDOS information register and the national patent registers of the Extension States.

9. To sum up, extended European patents offer all the benefits of the European system:

- a single application filed with a single Office
- only one language of proceedings up to grant
- a simple and reliable procedure
- a fully examined patent valid in (currently) up to 17 Contracting States and 2 Extension States.

Dépôt de demandes divisionnaires

F.A. Jenny (CH)

Lors de la dernière séance du Comité de liaison de l'EPPC avec des représentants de l'OEB, l'OEB nous a demandé de rappeler les dispositions suivantes:

- La taxe de recherche prescrite doit être payée aussi pour les demandes divisionnaires [Règle 25, paragraphe 2]. Dans le cas de l'article 10, paragraphe 3 du règlement relatif aux taxes, la taxe de recherche sera remboursée plus tard. Dans un tel cas, il n'est pas permis de retenir la taxe de recherche.
- Seul le demandeur de la demande initiale inscrit au Registre européen des brevets peut déposer une demande divisionnaire [Règle 25, paragraphe 1]. Cela doit être observé notamment lorsque la demande initiale est en train d'être transférée à un autre demandeur.

Prior Art - Self Collision

J.C.H. Ellis (GB)

Ever since I started work in a patent agent's office more than 60 years ago it has been a facet of UK law that a patent applicant, once the

application is on file, is at liberty to publish the exact details of the invention there described without injuring his or her rights. This held

true whether or not obvious variations of the specific description were later thought of by the inventor and included in a later specification

claiming the date of the earlier one, even if the resulting widened claims did not get the priority of the earlier case.

This feature of the law enabled patent agents in suitable cases to advise impecunious inventors that they could with reasonable safety file their own patent applications in the first instance and only seek professional advice once a prospective licensee had been found.

Since Opinion G 3/93 of the Enlarged Board of Appeal this advice, favouring the inventor rather than the patent agent, can no longer be safely given.

As your readers all doubtless know by now the Enlarged Board in the case cited above reached the following conclusions given in the headnote:

1. A document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Article 54(2) EPC against a European patent application claiming that priority, to the extent such priority is not validly claimed.
2. This also applies if a claim to priority is invalid due to the fact that the priority document and the subsequent European application do not concern the same invention because the European application claims subject-matter not disclosed in the priority document.

In the opinion the Enlarged Board cites the case of the applicant who files a priority document for the invention A+B, publishes that invention and then claims the priority of

the original application for a later patent application with a broad claim for A+B and a subsidiary claim for A+B+C, where C is not a feature of the priority document. In such a case publication of A+B after filing the priority document but before the priority date of the subsidiary claim is available as prior art against that claim.

At least in the case outlined above the patentee is left with the main claim. A more difficult situation arises where a specific element forming part of the invention as it appears in the priority document becomes a generic term when framing a main claim in the European patent. Many examples will come to mind: a Bowden cable becomes »force transmitting means«; a leaf spring becomes a »resilient member«; fluorine becomes »halogen«; ethyl becomes »lower alkyl« and so on. It is a matter of considerable hardship if the patent applicant by publishing the priority document thereby invalidates the main claim of the European patent, even if there is a subsidiary claim for the specific element (as there should be). The applicant has invalidated his own claim by a species of self-collision, to use a phrase much in use in the 1970s.

Those of us who were concerned with the drafting of the Patents Act 1977 took great pains to try to ensure concordance with the EPC. In doing so we came to a conclusion, based on the EPC and the International Convention, which was incorporated as Section 6 of the Act (following a similar section in the previous Act) but which was

the opposite of that now found by the Enlarged Board of Appeal and must therefore be regarded as incorrect.

The Enlarged Board of Appeal were, of course, bound to reach their conclusion on the law irrespective of the effect that this might have. Let me suggest some of the repercussions of the decision

European patent attorneys will need to be more careful than ever to widen the scope of any priority document to cover all aspects which might conceivably be regarded as part of the invention, now or in the future. Any over-optimistic statements can always be disregarded in the European application. Patent draftsmen and women outside the member states of the EPC must also learn this lesson.

Patent applicants would be well advised to keep their inventions confidential until the filing of the European application. This cannot be a good thing for industry and is particularly unhelpful to individuals seeking a licensee.

Applicants who have invalidated their own patents by self-collision in the manner indicated above may, unless and until Section 6 of the UK Act is repealed by Act of Parliament, feel that it would be an added precaution to file a domestic UK patent application to obviate the risk of the European patent being revoked on opposition.

I have always been a believer in, and supporter of the European patent system but I must say that I am saddened by Opinion G 3/93.

TRIPS and EPO opposition proceedings: there is no problem.

L.J. Steenbeek (NL)

In EPI Information 3/1994, an article¹ was published in which it was

questioned whether a decision of an EPO Board of Appeal in which a decision of an Opposition Division maintaining an EP patent, is set aside and replaced by a decision revoking the EP patent, is really final and unappealable in view of Article 32

of the TRIPS Agreement.² It was further proposed to replace the cur-

1 The Power of the EPO Boards of Appeal to Revoke European Patents: Is the EPO's Practice Compatible with Provisions of the TRIPS Agreement?, by B. Cronin, EPI Information 3/1994, pp. 102-106.

2 For the English text of the TRIPS Agreement, see GRUR Int. 1994, Heft 2, pp. 128-140, »Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods«.

rent EPO practice by an alternative system in which such a decision of a Board of Appeal is not considered final, in order to create a situation in compliance with TRIPS Article 32.

In this contribution, it will be shown that the current EPO opposition practice is fine, that the TRIPS Agreement constitutes no bar to continuing that practice, and that the proposed alternative system is legally impossible in view of fundamental rules of international law also underlying the TRIPS Agreement.

Let's first reconsider the current opposition practice. An opposition is an *inter partes* procedure in which both parties have (and should have) equal procedural rights. Both parties enjoy an equal chance of winning the first instance proceedings before the Opposition Division, and both parties have to face an equal chance of losing these first instance proceedings. Any losing party has the right to appeal. In the appeal proceedings, again both parties have (and should have) equal procedural rights. Both parties enjoy an equal chance of winning the appeal proceedings before the Board of Appeal, and both parties have to face an equal chance of losing these appeal proceedings. The decision of the Board of Appeal is final to both parties. If the patentee loses his patent, there is no possibility of regaining it. If the opponent loses his opposition, the *res judicata* effect of the judicial proceedings before the Board of Appeal precludes that a subsequent national application for revocation of the patent is admissible. Thus, both parties have equal possibilities to defend their case in two instances. Also, both parties run the equal risk that they have to accept a »wrong« decision as final and binding. It has been shown that the procedure before the EPO Boards of Appeal fully complies with the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR).³⁻⁴

Let's now consider the TRIPS Agreement. As has been confirmed by the EPO Boards of Appeal,⁵ international treaties should be interpreted along the interpretation rules laid down in the Vienna Convention on the Law of Treaties, more specifically Articles 31-33. For the present discussion, Article 31(1, 3c) of the Vienna Convention is applicable:

- (1) *A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.* (emphasis added)
- (3) *There shall be taken into account, together with the context: ...*
- (c) *any relevant rules of international law applicable in the relation between the parties.*

Indeed, TRIPS Article 32 provides that:

Article 32: Revocation/Forfeiture

»An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available.«

However, TRIPS Articles 62(4,5) and 41(2,4) are relevant for determining the context and purpose of TRIPS Article 32.

Part IV: Acquisition and Maintenance of Intellectual Property Rights and Related Inter-Partes Procedures
Article 62:

- (4) *Procedures concerning the acquisition or maintenance of intellectual property rights and, where the national law provides for such procedures, administrative revocation and inter partes procedures such as opposition, revocation and cancellation, shall be governed by the general principles set out in paragraphs 2 and 3 of Article 41.*
- (5) *Final administrative decisions in any of the procedures referred to in paragraph 4 above shall be subject to review by a judicial or*

quasi-judicial authority. However, there shall be no obligation to provide an opportunity for such review in cases of unsuccessful opposition or administrative revocation, provided that the grounds for such procedures can be the subject of invalidation procedures.

Part III: Enforcement of Intellectual Property Rights

Section 1: General Obligations

Article 41

- (2) *Procedures concerning the enforcement to intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.*
- (4) *Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to the jurisdictional provisions in national laws concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. ...*

And finally, for determining the relevant rules of international law applicable in the relation between the parties, it is appropriate to refer to the International Covenant on Civil and Political Rights (CCPR), which is the international (UN) treaty on Human Rights much like the European ECRM.

Article 14(1) CCPR provides, *inter alia*:

- (1) *All persons shall be equal before the courts and tribunals. In the determination of any criminal charge against him, or of his rights and obligations in a suit of law, everyone shall be entitled to a fair and public hearing by a competent, independent and impartial tribunal established by law. ...*

Article 14 CCPR is based on Article 10 of the Universal Declaration of Human Rights:

Everyone is entitled in full equality to a fair and public hearing by an independent and impartial tribunal, in the determination of his rights and

4 On the relation between the European Patent Convention and the European Convention for the Protection of Human Rights and Fundamental Freedoms, by L.J. Steenbeek, LL.M. thesis, January 1994.

5 Europäisches Patentübereinkommen, by R. Singer and M. Singer, München 1989, Vor Präambel.

3 Die Entscheidungen des Europäischen Patentamtes sind nicht durch nationale Gerichte nachprüfbar, by L.J. Steenbeek, EPI Information 4/1992, pp. 56-61.

obligations and of any criminal charge against him.

Needless to say that a patent is a civil *right*, and that until and unless a patent is revoked, an opponent has an *obligation* to abstain from using the invention, so that Article 14 CCPR and Article 10 of the Universal Declaration can be invoked both by the patentee and by the opponent. The same holds for Article 6 ECHR, but in the framework of the international TRIPS Agreement, it is more appropriate to refer to the CCPR and the Universal Declaration to determine the relevant rules of international law applicable in the

relation between the parties to the TRIPS Agreement.

It thus appears that TRIPS Article 32 is fully embedded in a legal system which guarantees that all parties enjoy an equal treatment. The EPO opposition practice fully fulfils that requirement: both patentee and opponent equally have two instances to present and defend their respective cases. TRIPS Article 32 when appropriately read in its context, only relates to the first, administrative instance, before the Opposition Division. It is not allowed to read TRIPS Article 32 separately from its context such that it also

applies to the judicial review, before the Board of Appeal, of a first instance's decision to maintain the patent. It is thus not necessary to amend the current EPO opposition practice. On the contrary, it is not allowed under international law to provide a system, as proposed in the article referred to in the introductory paragraph, in which a patentee may appeal from a decision of the Board of Appeal, while the opponent is forced to accept a decision of the Board of Appeal as final when it is unfavourable to him.

Students of the EPI

K. Weatherald (GB)

At its recent meeting, the EPI Council, through the agency of the Professional Qualification Committee (PQC), approved the rules of the above scheme, which has therefore effectively started. The rules themselves accompany this introduction. This means that the experiment can now begin which will either be important to many would-be candidates for the EQE, or turn out to be a damp squib.

By applying to become a student, no one should be under the illusion that it is a form of membership of the EPI, or that it will make it easier to pass the EQE.

The scheme is experimental because no one knows how many will take it up, or what use will be made of it. If it is of no assistance to new entrants, then it will be under-used, and eventually scrapped. The *raison d'être* of the scheme is to encourage new entrants, whatever their

nationality or mother tongue, to take a large measure of responsibility for obtaining the training they need to pass the EQE quickly.

There are national training schemes in some countries, and fewer regional schemes, such as the two-years' scheme run by CEIPI/EPI. However, they still leave a lot of room for self-help. It is envisaged that Students will use the lists of registered Students published under Rule 5(b), to form groupings, hopefully across national boundaries. When a group is big enough, and sufficiently motivated, it could complement the formal training provisions by itself contacting Members on the list, or those in industry who act as representatives under Article 133-EPC, to arrange for lectures and tutorials. Such directed cohesiveness could be expected to lead to a wish for the group to interact socially. That

would bode nothing but good for the profession.

My (unsought) advice to would-be Students is to forget about the intranational implications, at least for now. Leave to others the convening of pan-European conferences. Concentrate on finding like-minded people at the same stage in the profession, with whom you can talk freely. Use the resources within the group to locate and use other »local« people in the profession who can be persuaded to put their experience and knowledge at your disposal. Remember also, in these days of tape- and video-recorders, that »local« means further than it once did.

All Students may take for granted the best wishes and wholehearted support and encouragement from those already on the list.

EPI-Studenten Regeln

1. Wer EPI-Student werden möchte, muß ein Antragsformular ausfüllen, das im EPI-Sekretariat erhältlich ist.
2. Das Antragsformular muß von einem Sponsor gegengezeichnet

Students of the EPI Rules

1. Each applicant to be registered as a student of the EPI must complete an application form to be obtained from the EPI Secretariat.
2. The application form must be counter-signed by a sponsor, in the

Etudiants de l'EPI Règlement

1. Le candidat à l'inscription en tant qu'étudiant de l'EPI doit remplir un formulaire d'inscription à demander au secrétariat de l'EPI.
2. Le formulaire d'inscription doit être contresigné par un parrain qui

sein, der in die Liste der Vertreter eingetragen ist oder gemäß Artikel 133.3 EPÜ als Vertreter handelt und am Tage des Antrages für die Ausbildung des Antragstellers zuständig ist.

3. Das ausgefüllte Formular muß von einer Zahlung von DEM 300.- begleitet sein, die bis zum Ende des Monats Dezember des 4ten Jahres nach dem Antragstag gilt.

4. Sollte ein eingetragener Student wünschen, seine Zugehörigkeit für ein fünftes oder weiteres Jahr zu verlängern, muß er einen Antrag für jedes dieser Jahre einreichen. Diese Verlängerungsanträge müssen jeweils von einer Zahlung von DEM 150.- begleitet sein und von dem gleichen oder einem anderen Sponsor gegengezeichnet sein.

5. Während der Dauer der Zugehörigkeit wird das EPI dem Studenten folgende Unterlagen zukommen lassen:

- a) jeweils nach Erscheinen sein eigenes Exemplar von »EPI Information«;
- b) eine Liste der eingetragenen Studenten, welche jedes Jahr am 1. März auf den letzten Stand gebracht wird;
- c) eine Liste von Fachbüchern und -abhandlungen usw., wie z.B. die »Richtlinien für die Prüfung im Europäischen Patentamt«; und
- d) Hinweise auf die Ausbildungs- und Tutormöglichkeiten im Land oder Gebiet des Studenten.

6. Die ausgefüllten Antrags- und Verlängerungsformulare müssen von einem hierzu bestimmten Mitglied des Ausschusses für berufliche Qualifikation (PQC) sorgfältig geprüft werden. Etwaige Zweifelsfälle sind dem Vorsitzenden des PQC weiterzuleiten.

7. Ein eingetragener Student kann jederzeit die Kündigung seiner Zugehörigkeit beim Sekretariat einreichen. Eine Rückzahlung für eine mögliche Restzeit der Zugehörigkeit wird nicht vorgenommen. Das Abonnement für EPI Information wird sobald als möglich vom Sekretariat gestrichen.

person of either a European Patent Attorney on the list or a person acting as a representative under the provisions of Article 133-EPC, who is responsible for the training of the applicant at the date of application.

3. The completed application form must be accompanied by a payment of DEM 300, which will be effective to the end of December of the fourth year after the date of application.

4. If a registered student wishes to continue his/her studentship for the fifth or any subsequent year, he/she has to submit another application form in respect of each such year. Such continuation application forms have to be accompanied by a payment of DEM 150 and to be counter-signed by the same or another sponsor.

5. During the currency of the studentship, the EPI undertakes to supply each student with:

- a) his/her own copy of »EPI Information« as published;
- b) a list, to be updated annually, of students registered as at 1 March of each year;
- c) a list of reference books and articles, etc., such as the »Guidelines for Examination«, and
- d) information about the training and tutorial facilities for the student's country or region.

6. The completed original and continuation application forms have to be vetted by a designated member of the Professional Qualification Committee (PQC), who has to refer any queries to the chairman of the Professional Qualification Committee.

7. A registered student may resign at any time by writing to the EPI Secretariat to that effect. There will be no refund of any subscription in respect of the remaining period of his/her registered studentship. His/her subscription to »EPI Information« will be cancelled by the EPI Secretariat when convenient to it.

doit être un mandataire agréé près l'OEB inscrit sur la liste ou une personne agissant comme représentant dans les conditions de l'article 133 CBE et qui, à la date de l'inscription, est en charge de la formation du candidat.

3. Le formulaire d'inscription rempli doit être accompagné du paiement de DEM 300, qui sera valable jusqu'à la fin décembre de la 4e année après la date d'inscription.

4. Si un étudiant inscrit souhaite demeurer étudiant une 5e année ou une année ultérieure, il/elle devra remplir un autre formulaire d'inscription chaque année. Le formulaire d'inscription ultérieure devra être accompagné d'un paiement de DEM 150, et être contresigné par le même ou un autre parrain.

5. Après l'inscription, l'EPI fournira à chaque étudiant:

- a) »EPI Information«,
- b) une liste, mise à jour annuellement, des étudiants inscrits au 1er mars de chaque année,
- c) une liste des ouvrages et articles de référence, etc, tels que »les directives pour l'examen«, et

d) l'information relative à la formation et aux tutorats qui existent dans le pays ou la région de l'étudiant.

6. Les formulaires de première inscription et d'inscriptions ultérieures remplis seront visés par un membre désigné de la Commission Qualification Professionnelle, qui devra en référer au Président de la Commission en cas de difficultés.

7. Un étudiant inscrit peut démissionner à tout moment en écrivant au secrétariat de l'EPI. Il n'y aura pas de remboursement des frais d'inscription pour le reste de la période à courir. L'abonnement à »EPI Information« sera alors suspendu par le secrétariat de l'EPI.

8. Anmeldungen als EPI-Student sind bis 31. Dezember 1997 möglich, es sei denn, der Rat verlängert auf Antrag des PQC diese Frist für eine bestimmte oder unbestimmte Dauer.

8. Applications for becoming an EPI Student will be accepted until 31 December 1997 unless Council extends this deadline at the instigation of PQC.

8. Les demandes d'inscription seront acceptées jusqu'au 31 décembre 1997 à moins que le Conseil, à la demande de la Commission de Qualification Professionnelle, ne prolonge ce délai.

ANTRAG ZUR AUFNAHME ALS EPI-STUDENT

Zu senden an: EPI Sekretariat
 Postfach 260112
 D-80058 MÜNCHEN
 Tel: ..49 89 201 7080
 Fax: ..49 89 202 1548

Bitte in Großdruckbuchstaben ausfüllen:

Dieses ist ein Erstantrag Verlängerungsantrag

Name:

Vorname(n):

Zustellanschrift:

.....

Geschäftsanschrift
 (falls verschieden)

.....

Telefon:

Telefax:

Arbeitssprachen:

Ausbildungszeit
 (in Monaten)

Ich beantrage meine Eintragung und bin, bei Genehmigung meines Antrags, damit einverstanden, mich an die Regeln der EPI-Studenten zu halten.

Unterschrift des Antragstellers:

Datum:

Ich bin mir bewußt, daß mein Antrag nur wirksam wird, nachdem dem EPI-Konto bei der
 Postbank München
 No. 703-802
 BLZ (Bankleitzahl) 700 100 80

ein Betrag von DEM 300.- für den Erstantrag (für die ersten vier Jahre) oder ein Betrag von DEM 150.- für jedes weitere Jahr gutgeschrieben worden ist.

Ich Unterzeichnete(r)

aus:

eingetragen in die Liste der europäischen Patentvertreter
oder

handelnd als Vertreter gemäß Artikel 133.3 EPÜ

stehe Pate bei:

.....,

der EPI-Student werden möchte, und bestätige, daß ich derzeit die Verantwortung für seine Berufsausbildung habe, welche nach bestandener Eignungsprüfung in die Aufnahme in die Liste der Vertreter führt.

Sollte die Geschäftsanschrift des Sponsors von der des Antragstellers verschieden sein, bitte hier den Grund dafür angeben und insbesondere vermerken, wie der Ausbildungsverantwortung nachgekommen wird.

.....
.....
.....
.....
.....
.....

Unterschrift des Sponsors:

Datum:

APPLICATION TO BE REGISTERED AS A STUDENT OF THE EPI

To be returned to: EPI Secretariat
Postfach 26 01 12
D-80058 MÜNCHEN
Tel: ..49 89 201 7080
Fax: ..49 89 202 1548

Please write in capital letters:

This is a first application continuation application

Surname:

Forename(s):

Address:
(for correspondence)

Professional
Address
(if different)

Telephone No.

Fax No.

Working languages:

Training period (months)

I hereby apply for registration and agree, if my application is accepted to abide by the governing studentship rules of the EPI.

Candidate's signature:

Date:

I am aware that my application only becomes effective when the EPI account

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No. 703-802
BLZ (Bank Sorting Code) 700 100 80

has been credited with 300 DM for the first application (for the first four year period) or 150 DM for each additional year.

I,

of

being a European Patent Attorney on the list,

or a person authorised under Article 133-3 EPC,

hereby sponsor:

.....

for studentship of the EPI, and confirm that I have responsibility for his/her professional training leading to entry on the list by examination.

If the sponsor's professional address is different from that of the applicant, please indicate below the reason for this, indicating in particular how the responsibility for training is being met.

.....
.....
.....
.....
.....
.....
.....

Sponsor's signature:

Date:

FORMULAIRE D'INSCRIPTION COMME ETUDIANT DE L'EPI

Doit être renvoyé à: EPI Secrétariat
 Postfach 260112
 D-80058 MÜNCHEN
 Tel: ..49 89 201 7080
 Fax: ..49 89 202 1548

Ecrire s.v.p. en lettres capitales:

Ceci est une première inscription inscription ultérieure

Nom :

Prénom(s) :

Adresse :
 (pour la correspondance)

Adresse professionnelle :
 (si différente)

Téléphone :

Fax :

Langue(s) de travail :

Temps de formation (mois) :

Je demande mon inscription et accepte, si je suis inscrit, le Règlement de l'EPI relatif aux étudiants de l'EPI.

Signature du candidat :

Date :

Je sais que mon inscription ne deviendra effective que lorsque le compte de l'EPI

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aura été crédité de 300 DEM pour la première inscription (pour les 4 premières années) ou de 150 DEM pour chaque année ultérieure.

Je soussigné(e) :

de

mandataire agréé près l'OEB inscrit sur la liste

ou

personne autorisée selon l'article 133-3 de la CBE

parraine l'inscription de :

.....

en tant qu'étudiant de l'EPI et confirme que j'ai la responsabilité de sa formation professionnelle en vue de son entrée sur la liste après l'examen européen de qualification.

Si l'adresse professionnelle du parrain est différente de celle du demandeur, s'il vous plaît en indiquer ci-dessous la raison, en particulier préciser comment la responsabilité de la formation est assumée.

.....

.....

.....

.....

.....

.....

Signature du parrain :

Date :

Mitteilung der Prüfungskommission und des Prüfungssekretariats

Information from the Examinati- on Board and the Examination Secretariat

Information du Jury d'examen et du Secrétariat d'examen

1. Ablauf der Prüfung 1995

In einer Sitzung am 12. Oktober 1994 hat die Prüfungskommission beschlossen, den Ablauf der Prüfung 1995 geringfügig zu verändern.

Im einzelnen betrifft dies folgende Punkte:

1.1 Für die vollständig zu beantwortenden Teile I und II der Prüfungsaufgabe D werden zwei getrennte Prüfungstermine angesetzt:

- Teil I (Dauer: 2 ¼ Stunden) wird am Vormittag des ersten Prüfungstags geprüft. Hierbei geht es um Fragen, die sich auf die Rechtskenntnisse des Bewerbers beziehen. Es werden maximal 45 Punkte vergeben.
- Teil II (Dauer: 3 Stunden) wird am Nachmittag des ersten Prüfungstags geprüft. Hierbei geht es um eine Anfrage eines Mandanten. Es werden maximal 55 Punkte vergeben.

1.2 Jedem Bewerber wird spätestens am ersten Prüfungstag eine Nummer zugeteilt, die er auf jeder Seite der Arbeit anzugeben hat.

1.3 Die Anweisungen an die Bewerber für den Ablauf der Prüfung (ABl. EPA 1994, 249) und die Anweisungen an die Bewerber für die Anfertigung ihrer Arbeiten (ABl. EPA 1994, 252) werden entsprechend geändert.

2. Compendium der Aufgaben für die europäische Eignungsprüfung

2.1 »Compendium« 1994

Das Europäische Patentamt veröffentlicht das Compendium für 1994. Es ist als Ausbildungsgrundlage für die Bewerber und ihre Tutoren gedacht und ab Mitte Dezember 1994 erhältlich.

1. Conduct of the 1995 examination

At its meeting on 12 October 1994, the Examination Board decided on a number of changes concerning the conduct of the 1995 examination.

The details are as follows:

1.1 The time given for preparing the answer to the prescribed part I and part II of paper D will be separated into two sessions:

- Part I, duration 2 ¼ hours, will be held on the first day in the morning. It will comprise questions directed to the candidate's legal knowledge. A maximum of 45 marks will be awarded.
- Part II, duration 3 hours, will be held on the first day in the afternoon. This part will comprise an enquiry from a client. A maximum of 55 marks will be awarded.

1.2 Each candidate will be given a number, at the latest on the first day of the examination, and is to enter that number on each page of his/her answers.

1.3 The Instructions to candidates concerning the conduct of the examination (OJ EPO 1994, 249) and the Instructions to candidates for preparing their answers (OJ EPO 1994, 252) will be adapted accordingly.

2. Compendium of the papers of the European qualifying examination

2.1 Compendium 1994

The European Patent Office is to publish the 1994 edition of the annual Compendium. It will be published with the aim of providing candidates and their tutors with a good basis for training. It will be available from mid-December 1994.

1. Déroulement de l'examen 1995

Lors de sa réunion du 12 octobre 1994, le jury d'examen a décidé d'apporter quelques modifications au déroulement de l'examen 1995.

Ces changements sont les suivants:

1.1 L'épreuve D, qui se compose des parties I et II, se déroulera en deux séances :

- la partie I, d'une durée de 2 h ¼, aura lieu le premier jour dans la matinée. Elle comprendra des questions visant les connaissances juridiques du candidat. Il pourra être attribué un nombre maximum de 45 points.
- la partie II, d'une durée de 3 h, aura lieu le premier jour dans l'après-midi. Elle comprendra une demande de renseignements d'un client. Il pourra être attribué un nombre maximum de 55 points.

1.2 Chaque candidat se verra attribuer, le premier jour de l'examen au plus tard, un numéro qu'il devra inscrire sur chaque page de sa/ses réponse(s).

1.3 Les instructions aux candidats pour le déroulement de l'examen (JO OEB 1994, 249) et les instructions aux candidats pour la rédaction de leurs réponses (JO OEB 1994, 252) seront adaptées en conséquence.

2. Compendium des épreuves de l'examen européen de qualification

2.1 Compendium 1994

L'Office européen des brevets va publier l'édition 1994 du compendium annuel destiné à donner aux candidats et à leurs tuteurs une bonne base pour la formation. Il sera disponible à partir de la mi-décembre 1994.

Das »Compendium« 1994 besteht - wie schon die Ausgabe des Vorjahres - aus vier Broschüren, die einzeln oder zusammen bestellt werden können:

- Aufgaben A & B Chemie
- Aufgaben A & B Elektrotechnik/
Mechanik
- Aufgabe C
- Aufgabe D

Darin sind die Prüfungsaufgaben der europäischen Eignungsprüfung 1994 in den drei Amtssprachen, die entsprechenden Prüferberichte in der Originalsprache sowie Antwortbeispiele von Bewerbern wiederum in den drei Amtssprachen enthalten.

Die Broschüren kosten innerhalb Europas je 22 DEM einschließlich Versandkosten und außerhalb Europas je 20 DEM zuzüglich Versandkosten.

2.2 »Compendium« 1993

Das »Compendium« 1993 ist weiterhin kostenlos erhältlich.

2.3 »Compendium« 1990 - 1992

Das Europäische Patentamt gibt außerdem ein Gesamtkompendium für die Jahre 1990 bis 1992 heraus.

Diese Sonderausgabe besteht aus sechs Bänden:

- Aufgaben A Chemie
- Aufgaben B Chemie
- Aufgaben A Elektrotechnik/
Mechanik
- Aufgaben B Elektrotechnik/
Mechanik
- Aufgaben C
- Aufgaben D

Jeder Band enthält die Prüfungsaufgaben der drei Jahrgänge in den drei Amtssprachen, die Prüferberichte und Antworten von Bewerbern. Die Bände können einzeln oder zusammen bestellt werden.

Diese Veröffentlichung wird ab Mitte Januar 1995 erhältlich sein.

Die Bände kosten innerhalb Europas je 45 DEM einschließlich Versandkosten und außerhalb Europas je 40 DEM zuzüglich Versandkosten.

Diese Publikationen können bei der Dienststelle Wien des Europäischen Patentamts, Postfach 82, Schottenfeldgasse 29, A-1072

The 1994 Compendium, like the 1993 edition, will consist of four booklets which may be ordered together or separately:

- Papers A & B Chemistry
- Papers A & B Electricity/
Mechanics
- Paper C
- Paper D

Each booklet contains the paper(s) from the 1994 European qualifying examination, the examiners' reports in the original language and examples of answers written by candidates, again in the three official languages.

The booklets cost DEM 22 each including postage and packing in Europe, or DEM 20 outside Europe excluding postage and packing.

2.2 Compendium 1993

The Compendium 1993 remains free of charge.

2.3 Compendium 1990-1992

The European Patent Office is also publishing a Compendium of the years 1990 to 1992.

This special edition will comprise six volumes:

- Papers A Chemistry
- Papers B Chemistry
- Papers A Electricity/
Mechanics
- Papers B Electricity/
Mechanics
- Papers C
- Papers D

Each volume will contain the papers for each of the three years in the three official languages, the examiners' reports and candidates' answers. They may be ordered together or separately.

This special edition will be available from mid-January 1995.

Each volume costs DEM 45 including postage and packing in Europe, or DEM 40 outside Europe excluding postage and packing.

All publications can be ordered from the European Patent Office's sub-office in Vienna, Postfach 82, Schottenfeldgasse 29, A-1072

Comme pour l'édition 1993, le Compendium 1994 se composera de quatre brochures qui pourront être commandées ensemble ou séparément :

- les épreuves A & B Chimie
- les épreuves A & B Electricité/
Mécanique
- l'épreuve C
- l'épreuve D

Chaque brochure comprend les textes des épreuves dans chacune des trois langues officielles, les rapports des correcteurs ainsi que des réponses de candidats, rédigées également dans les trois langues officielles.

Chaque brochure coûte 22 DEM, frais de port compris, pour l'Europe et 20 DEM, frais de port en sus, pour les commandes hors Europe.

2.2 Compendium 1993

Le Compendium 1993 reste gratuit.

2.3 Compendium 1990-1992

En outre, l'Office européen des brevets publiera un compendium couvrant les années 1990 à 1992.

Cette édition spéciale sera composée de six volumes:

- Epreuves A Chimie
- Epreuves B Chimie
- Epreuves A Electricité/
Mécanique
- Epreuves B Electricité/
Mécanique
- Epreuves C
- Epreuves D

Pour les trois années concernées chaque volume comprendra les textes des épreuves d'examen dans les trois langues officielles, les rapports des correcteurs et des réponses de candidats. Les six volumes peuvent être commandés ensemble ou séparément.

Cette publication sera disponible à partir de mi-janvier 1995.

Chaque brochure coûte 45 DEM, frais de port compris, pour l'Europe et 40 DEM, frais de port en sus, pour les commandes hors Europe.

Si vous souhaitez commander ces publications, veuillez vous adresser à l'Agence de Vienne de l'Office européen des brevets,

Wien, Tel: (+43-1) 52126-0, Fax: (+43-1) 52126-5491, angefordert werden.

2.4 Aufgaben früherer Jahre

Die Aufgaben der europäischen Eignungsprüfung aus den Jahren vor 1990 sind bei der Bibliothek des Europäischen Patentamts, Erhardtstraße 27, D-80331 München, erhältlich. Die Fotokopiergebühr beträgt pro Seite 1,30 DEM (bei Fertigung durch das EPA-Personal) bzw. 0,50 DEM (bei Selbstbedienung), Beilage zum ABl. EPA 9/1994, 10.

Europäische Eignungsprüfung

EPI-Tutorium 1995

E. Thouret-Lemaître (FR)
Vorsitzende des Ausschusses für die Europäische Eignungsprüfung

Das EPI bietet erneut ein Tutorium vorwiegend für diejenigen an, die die Eignungsprüfung 1996 ablegen werden. Es ist wichtig, daß Sie Ihre Kandidaten auf die Möglichkeit dieses Tutoriums aufmerksam machen, da diese die EPI Information nicht selbst erhalten.

Wir werden die Prüfungsunterlagen A, B, C und D des Jahres 1994 oder 1995 bearbeiten. Die Kosten hierfür betragen 350.-- DM für ein Tutorium mit nur den Unterlagen A und B oder aber C und D und 450.-- DM für alle vier Unterlagen eines Jahres. Die Kandidaten können selbst entscheiden, ob sie die Prüfungsaufgaben 1994 oder 1995 oder von beiden Jahren wählen.

Die Kandidaten werden wieder den nächstliegenden Tutoren zugeteilt, die, soweit möglich, auf dem gleichen technischen Gebiet tätig sind.

Die Kandidaten werden gebeten, ihre Antworten den Tutoren schriftlich bis zum *1. Oktober 1995* zuzusenden. Üblicherweise werden zwei Tutoren mit sechs bis acht

Wien, Tel: (+43-1) 52126-0, Fax: (+43-1) 52126-5491.

2.4 Papers from earlier years

Copies of pre-1990 European qualifying examination papers can be obtained from the European Patent Office's library, Erhardtstrasse 27, D-80331 Munich. The photocopying fees are DEM 1.30 per page (copied by EPO staff) or DEM 0.50 (self-service), see Supplement to OJ EPO 9/1994, 10.

European qualifying examination

EPI Tutorial 1995

E. Thouret-Lemaître (FR)
Chairwoman of the Professional Qualification Committee

The EPI will again offer tutorials, primarily for those who will be sitting the Qualifying Examination in 1996. It is important that all persons instructing candidates draw the attention of their candidates to these tutorials since they do not receive EPI Information themselves.

We shall be considering papers A, B, C and D of the year 1994 or 1995. The tuition fee will be 350.-- DM either for papers A and B, or for papers C and D, and 450.-- DM for the four papers of each year. The choice will be left to the candidates (Papers 1994 or 1995 or both years).

Candidates will again be allocated to the nearest available tutors who, whenever possible, work in the same technical field.

The candidates are asked to submit their solutions to these papers to the tutors by *1st October 1995*. In general two tutors will arrange for a joint meeting with six to

Postfach 82, Schottenfeldgasse 29, A-1072 Wien, Tel: (+43-1) 52126-0, Fax: (+43-1) 52126-5491.

2.4 Textes des épreuves des années antérieures à 1990

Le texte des épreuves de l'examen européen de qualification des années antérieures à 1990 est disponible à la bibliothèque de l'Office européen des brevets, Erhardtstraße 27, D-80331 Munich, moyennant paiement d'une taxe de photocopie de 1,30 DEM par page (délivrée par le personnel de l'OEB) ou de 0,50 DEM (en libre-service), voir supplément au JO OEB 9/1994, 10.

Examen européen de qualification

Tutorat EPI 1995

E. Thouret-Lemaître (FR)
Présidente de la Commission Qualification Professionnelle

L'EPI propose à nouveau un tutorat destiné principalement aux personnes qui se présenteront à l'Examen de Qualification en 1996. Il est important que vous attiriez l'attention de vos candidats sur l'existence de ce tutorat puisqu'ils ne reçoivent pas EPI Information eux-mêmes.

Nous traiterons les épreuves A, B, C, et D de l'année 1994 ou 1995. Le prix est de 350.-- DM pour la préparation aux épreuves A et B ou bien C et D, et de 450.-- DM pour la préparation aux quatre épreuves d'une année. Les candidats décident eux-mêmes s'ils choisissent les épreuves 1994 ou 1995 ou bien des deux années.

Deux tuteurs seront de nouveau attribués à chaque candidat. Ces tuteurs résident géographiquement le plus près possible de leurs candidats et travaillent, autant que possible, dans le même domaine technique.

Les candidats devront envoyer leurs réponses aux tuteurs avant le *1er octobre 1995*. Les deux tuteurs organisent généralement au moins une réunion réunissant six à huit

Kandidaten ein gemeinsames Treffen arrangieren, um die Antworten zu besprechen.

Das EPI-Tutorium soll, soweit möglich, unter Prüfungsbedingungen stattfinden (Prüfungsunterlagen, Zeitspanne ...).

1994 haben 51 Kandidaten und 18 Tutoren am Tutorium teilgenommen.

Es sei darauf hingewiesen, daß die den Kandidaten in Rechnung gestellte Gebühr ausschließlich zur Deckung der Verwaltungs- und Reisekosten bestimmt ist, die beim EPI entstehen. Die Tutoren werden für ihren Zeitaufwand und ihre Arbeit nicht entschädigt.

Kandidaten, die an dem Tutorium interessiert sind, werden gebeten, dies dem EPI-Sekretariat baldmöglichst, jedoch auf keinen Fall später als dem *1. Mai 1995* mitzuteilen. Sie werden einen Fragebogen erhalten, den sie ausgefüllt zusammen mit der Gebühr vor dem Einsendetermin zurücksenden müssen.

eight candidates to discuss the answers.

The tutorial is a trial examination. The candidates should work, under examination conditions (documents, time...) as far as possible.

In 1994, 18 tutors instructed 51 candidates.

The fee charged to the candidates exclusively covers the EPI administrative and travelling costs. The tutors are not paid for their time and work.

Candidates who wish to participate in these tutorials must notify the EPI Secretariat as soon as possible but not later than *1st May 1995*. They will be sent a questionnaire which they have to complete and return together with the tuition fee, before the deadline.

candidats afin de commenter les réponses aux épreuves.

Le tutorat EPI est un examen test. Les candidats doivent travailler autant que possible dans les conditions d'examen (temps, documents..).

En 1994, 18 tuteurs ont assuré la préparation de 51 candidats.

Le droit d'inscription demandé aux candidats sert exclusivement à couvrir les frais d'administration de l'EPI et les frais de déplacement des tuteurs. Ceux-ci ne sont pas rémunérés pour leur temps de travail.

Les candidats désirant participer à ce tutorat sont priés d'informer le Secrétariat de l'EPI le plus rapidement possible, au plus tard le *1er mai 1995*. Ils recevront ensuite un questionnaire qu'ils devront compléter et retourner au Secrétariat avec leur droit d'inscription avant la date indiquée.

University of London: Training Programme for the European Patent 1995

The 1995 Training Programme on the European Patent for students preparing for the European Qualifying Examinations will be held from Tuesday 28th February to Thursday 2nd March 1995. Cost: £450 inclusive of documentation, refreshments and lunches. As the

course is usually over subscribed, applicants are advised to book early to avoid disappointment. Please note that places are offered on return of application forms on a first come, first served basis.

For further details, please contact Swee Ng/Gina Hickey, Intellect-

tual Property Law Unit, Centre for Commercial Law Studies, Queen Mary and Westfield College, 339 Mile End Road, London E1 4NS.

Tel: (0171) 975 5126

Fax: (0181) 980 1079.

Industrial Property in Portugal

J. Cruz (PT)

I Introduction

1. Portuguese law dates back to 1940 (Decree No 30.629, of 24th August 1940) and was recently completed by five important decree laws:

a) *Decree-Law No. 176, of 30th May 1980*

- Adopted the international classification of products and services as established by the

Nice Agreement of 15th June 1957;

- Introduced services trademark into Portuguese law;
- Established the DIU - declaration of intention to use - which must be filed by trademark owners every 5 years (except when trademark renewal is due), but without any proof of use of the trademark;

b) *Decree-Law No. 27, of 18th January 1984*

- Made the filing of an abstract of the invention compulsory;
- Enables annuities and renewal fees to be paid within the 6 months following the normal payment date, in accordance with Article 5-bis of the Paris Convention;

- Adopted licences in respect of registered trademarks;
- c) *Decree-Law No. 40, of 27th January 1987*
 - Reintroduced into Portuguese law reversal of the burden of proof, with regard to process patents;
 - Authorized trademark licences before the respective registration has been granted;
 - Regulates the protection of trademarks in Macao;
 - Authorized the registration of trademarks by any person who has a legitimate interest (previously, this right was almost exclusively reserved for manufacturers and merchants);
 - Established the use of the symbol (R) to indicate registered trademarks.
- d) *Decree-Law No. 42, of 31st March 1992*
 - Established the rules for the application in Portugal of the European Patent Convention.
- e) *Decree-Law No. 107, of 7th April 1993*
 - Regulates the application in Portugal of the Patent Cooperation Treaty of 19th June 1970.

2. As it had been in force for more than half a century, a general revision of Portuguese law was necessary, as it had become outdated due to two fundamental events:

- a) The publication of the EC Directives of 21st December 1988, which had not yet officially been introduced into Portuguese law by the deadline of 31st December 1992; and
- b) Joining of the European Patent Convention.

3. The new industrial property law should finally come into force in June 1995 and the summary which will be made of the main industrial property rights provided for under this law already takes into consideration the main alterations which have been disclosed.

II Patents

1. Portugal joined the Munich Convention with effect from 1st January 1992, and the PCT on 7th April 1993.

2. The new patent law generally follows the European Patent Convention.

Therefore, patent duration is increased to 20 years from the date of application (it is currently 15 years from the date of grant) and protection of chemical and pharmaceutical products is also provided for.

3. However, in practice, the Portuguese Institute of Industrial Property is already following the provisions of the European Patent Convention and even accepts claims for chemical and pharmaceutical products. There are naturally doubts as to the validity of these patents if the problem is raised in Court at a later date. We can therefore consider that patentable inventions are those permitted under the European Patent Convention.

The same applies to unpatentable inventions.

4. Patent applications should be filed at the Portuguese Institute of Industrial Property, and the respective abstract is published in the Official Bulletin for the purpose of possible oppositions. Once the abstract has been published it reaches the publicity stage, making it possible to obtain a complete copy of the application (claims, specification and drawings).

The application is examined by the Institute of Industrial Property and the patent is granted or refused. It is always possible to file an appeal against this decision at the Court of Lisbon.

5. Any person may file a Court appeal, even if they have not filed an opposition at the Institute of Industrial Property.

The patent may be annulled at any time, provided it can be proved that it was wrongly granted.

Decisions concerning annulment can only be given by the Court and cases may go as far as the Supreme Court of Justice.

6. The patent confers upon its owner the exclusive right to work the invention and to prevent it being worked by third parties without his consent.

It is possible to grant licences and assign the patent, which should

be effected by means of a duly legalised document.

Compulsory licences can also be granted when the invention is not worked in Portuguese territory, in accordance with the provisions of Article 5 of the Paris Convention.

III Utility Models

In Portugal, the legal system governing utility models is exactly the same as for patents and they are subject to the same legal requirements in order to be granted (novelty, inventive step and industrial application).

Protection, however, is limited to three-dimensional objects and under the new law the duration will be limited to only 15 years (there is currently no limit to their duration).

IV Industrial Models and Designs

1. In Portugal industrial models and designs can be protected.

The fundamental requirement is novelty, which must be absolute, that is within and outside Portuguese territory.

Applications are filed at the Institute of Industrial Property and published in the Official Bulletin for opposition purposes. After they have been examined, the registration is granted or refused. It is always possible to appeal to the Court of Lisbon against the decision of the Institute of Industrial Property. The maximum duration of a registration will become 25 years (it is currently unlimited).

2. Only registered models and designs are legally protected. It is extremely difficult to defend an unregistered model or design and this can only be attempted by means of the provisions concerning unfair competition or copyright.

3. It is possible to grant licences by means of a contract between the holder of the registration and parties possibly interested in the licence. Likewise, assignment of registrations is also possible. Both licences and assignments should be recorded at the Portuguese Institute of Industrial Property, otherwise they will not take effect in respect of third parties.

Registrations can be annulled at any time by a Court decision, with no time limit, proving that it was wrongly granted.

V Trademarks

1. Portugal is a founder member of the 1891 Madrid Agreement concerning the international registration of trademarks.

Trademarks registered under the Madrid Agreement are subject to the same formalities as Portuguese national registrations and protection can be granted or refused in Portugal.

2. Marks can be registered for products and services.

Protection of the trademark is conferred by the registration and use only gives priority in respect of the registration for six months.

3. Trademark registrations can currently be applied for by whomsoever has a legitimate interest therein.

Trademark applications are filed at the Portuguese Institute of Industrial Property and are published in the Portuguese Official Industrial Property Bulletin for opposition purposes by parties who consider that they would be prejudiced by the registration. After the application has been examined, the registration can be granted or refused and it is always possible to appeal to the Court of Lisbon (Court of First Instance, Court of Appeal and Supreme Court of Justice).

4. The registration is valid for 10 years counted from the date of grant and can be renewed for identical periods. However, every five years (except when renewal is effected) a DIU (declaration of intention to use) should be filed, without which it is presumed that the trademark is not being used and the registration may be cancelled for this reason.

5. The right to a trademark is conferred by the registration. However, it is possible to annul any registration within the period of 10 years counted from the date of grant, if it was wrongly granted. After this period, it is only possible to annul the registration if bad faith is proven.

6. The trademark must be used. Non-use for 5 consecutive years

may lead to the cancellation of the registration.

Cancellation actions based on non-use are relatively simple. They are filed at the Portuguese Institute of Industrial Property and a Court appeal is possible. In these actions, there is a real inversion of the burden of proof, since in the final analysis it is the owner of the registration (or the licensee) who has to prove definitive use of the trademark. Annulment actions are filed directly in Court.

7. Licences and assignments should be recorded at the Portuguese Institute of Industrial Property.

Any licence (exclusive or non-exclusive) must be justified by a duly legalised contract between the licensor and the licensee.

Assignment is possible separately from the establishment and must be justified by a duly legalised document signed at least by the owner of the registration.

Legalisation may be affected by Apostille.

VI Infringement of Industrial property rights

a) Legislative provisions

The Portuguese Industrial Property Code stipulates and categorises the types of infringement of the various industrial property rights (*»Offences against Industrial Property«*), which are classified as criminal offences. As a general rule, it is established that *»industrial property has the guarantees established by law for property in general and shall be specially protected within the terms of this Code and other laws and conventions in force«*.

This part of the Industrial Property Code also stipulates the basic procedural provisions for urgent reliefs and ends with the provisions regarding seizure by Customs, during the act of importation or exportation, of goods infringing of any industrial property right.

Apart from the special provisions established in the Industrial Property Code, the general provisions of civil and criminal law are also subsidiarily applicable.

b) Judicial protection

Judicial protection is, in principle, only conferred upon the grant of the right. Such protection can be obtained through either civil jurisdiction or criminal jurisdiction.

In both types of jurisdiction, it is possible to obtain urgent remedies.

c) Initiation of civil and/or criminal proceedings

Civil proceedings are initiated by the filing of an action at the competent Civil or Judicial Court which, in principle, is the court of the district where the defendant is situated or has head office. These proceedings can also be started through a preliminary injunction, after which (within 30 days of the seizure of the counterfeit goods) the plaintiff should file a main action.

Criminal proceedings can be initiated by means of a criminal complaint made to competent Public Prosecutor or (more commonly) any Criminal Police body, notably the *»Inspeção Geral das Actividades Económicas«* (the *»Bureau of Trade Affairs Inspection«*) and, more specifically, its department called *»Serviço Especial de Inspeção«* (the Special Inspection Service), which acts quickly and efficiently and has become considerably specialised in the area of intellectual property rights infringement. Since the infringement of industrial property rights is classified as a *»public crime«*, criminal proceedings can also be instituted on the initiative of the actual Criminal Police bodies or the Public Prosecutor.

d) Whether protection is available under international conventions

The provisions of international conventions signed and/or ratified by Portugal are, in principle, included in Portuguese national legislation.

However, in the case of loopholes in the provisions of national law, the provisions of the international conventions are, in fact applicable, by virtue of article 8 of the Portuguese Constitution. The provisions of international conventions should even prevail over those of Portuguese national law in cases of possible conflict between the two sets of regulations.

Das neue österreichische Gebrauchsmustergesetz

G. Widtmann (AT)

Obwohl von den beteiligten Kreisen mit und vor Erlassung des ersten Patentgesetzes im Anschluß an die Privilegiengesetze im vorigen Jahrhundert die Entwicklung der gesetzlichen Bestimmungen in anderen Ländern zum Schutz kleiner Erfindungen aufmerksam beobachtet wurde, bestand in Österreich kein echtes Bedürfnis für ein derartiges Schutzrecht. Dies auch, nachdem für eine kurze Zeitspanne das deutsche Gebrauchsmustergesetz in Österreich Geltung hatte. Nach dem Beitritt Österreichs zum europäischen Patenterteilungsverfahren ist eine Änderung eingetreten, welcher nunmehr Rechnung getragen wurde.

Mit 1. April 1994 ist in Österreich erstmalig ein Gebrauchsmustergesetz erlassen worden, das, wie die rege Anmeldetätigkeit zeigt, den Bedürfnissen der Anmelder Rechnung trägt.

Das neue Gebrauchsmustergesetz ist zwar unter Berücksichtigung des österreichischen Patentgesetzes als auch unter Ansichtnahme ausländischer Gebrauchsmustergesetze erarbeitet worden, aber es stellt bereits als solches eine innovative Leistung gegenüber dem Bekannten dar. Im folgenden sollen die Gründe angeführt werden, warum ein derartiges Gebrauchsmuster von besonderem Interesse ist. Es besteht weiterhin die Möglichkeit, neben demselben ein österreichisches Patent bzw. den nationalen österreichischen Teil eines europäischen Patentes aufrechtzuerhalten, da Österreich das Verbot der Doppelpatentierung fremd ist.

Wohl eines der wichtigsten Argumente für den neuen Gebrauchsmusterschutz ist, daß ein Schutzrecht in einer relativ kurzen Zeitspanne, und zwar 8 bis 9 Monate nach dem Anmeldetag, erhalten werden kann. Dies, obwohl im Regelfall ein Recherchenbericht zum Stand der Technik vorliegen muß. Ein Verzicht auf einen Recherchenbericht, wie dies in anderen Staaten

vorgesehen ist, durch Nichtstellen eines entsprechenden Antrages ist ausgeschlossen, jedoch besteht die Möglichkeit, eine Registrierung vor der Erstellung des Recherchenberichtes zu beantragen, wobei dann das Schutzrecht bereits ca. 3 Monate nach Anmeldung vorliegen kann. Die Vorteile einer derartigen raschen Registrierung ist leicht einsehbar, da es gerade bei kurzlebigen Artikeln von besonderer Bedeutung ist, bereits innerhalb einer Frist von wenigen Monaten gegen nachahmende Wettbewerber vorzugehen. Bedenkt man, daß beim europäischen Patenterteilungsverfahren mit einer unteren Frist von ca. 3 Jahren bis zur Erteilung zu rechnen ist, erkennt man den Vorteil, welcher dieses neue Gesetz, insbesondere für den freien Erfinder sowie kleine und mittlere Produktionsbetriebe, darstellt.

Neben der Tatsache, daß die Erfindungshöhe bei einem Gebrauchsmuster geringer angesetzt werden kann als bei einem europäischen oder österreichischen Patent, bestehen noch weitere Hinweise für die Bedeutung dieses Gesetzes, die besonders im Unterschied des Neuheitsbegriffes gegenüber dem österreichischen Patentgesetz bzw. dem europäischen Patentübereinkommen besteht.

Ein wesentlicher Unterschied liegt in der Neuheitsschonfrist vor. Sieht sowohl das europäische Patentübereinkommen als auch das österreichische Patentgesetz eine Neuheitsschonfrist von 6 Monaten ab Einreichung der Anmeldung vor, wobei, wenn man von der »Massenpriorität« absieht, lediglich als offensichtlicher Mißbrauch Dritter innerhalb einer 6monatigen Frist nicht neuheitsschädlich wirken soll. Zum Unterschied dazu ist beim Gebrauchsmuster vorgesehen, daß zusätzlich alle Offenbarungen der Erfindung außer Betracht bleiben, die nicht früher als 6 Monate vor dem Anmeldetag erfolgt sind und unmittelbar oder mittelbar auf den An-

melder oder seinen Rechtsvorgänger zurückgehen. Mit dieser Bestimmung ist besonders dem Bedürfnis des auf dem gewerblichen Rechtsschutz Unerfahrenen Rechnung getragen, so daß eine »Reparatur« des neuheitsschädlichen Verhaltens für Patente durch ein Gebrauchsmuster durchführbar ist.

Jedoch nicht nur für die im Erfindungsschutz unerfahrenen, sondern auch für die mit dem gewerblichen Rechtsschutz vertrauten Personen, bietet das neue Gebrauchsmustergesetz besondere Möglichkeiten. Mit 19. August 1994 wurde eine Novellierung des österreichischen Patentgesetzes erlassen und teilweise rückwirkend in Kraft gesetzt, wobei weitere Unterschiede zwischen dem Gebrauchsmustergesetz und Patentgesetz festgeschrieben wurden. So besteht durch das Gebrauchsmustergesetz die Möglichkeit, Verfahren zur chirurgischen oder therapeutischen Behandlung von Tieren noch unter Schutz zu stellen, wohingegen die Patentgesetznovelle diese Möglichkeit künftighin ausschließt. Dem aufmerksamen Leser wird nicht entgangen sein, daß zum Unterschied von anderen Gebrauchsmustergesetzen in Österreich die Möglichkeit besteht, auch Verfahren - und dies gilt selbstverständlich nicht nur für die chirurgische und therapeutische Behandlung für Tiere - unter Schutz zu stellen.

Der Neuheitsbegriff wurde gegenüber dem bereits angeführten Unterschied zusätzlich geändert. Ist bei einem Patent der gesamte Inhalt einer prioritätsälteren Patentanmeldung oder Gebrauchsmusteranmeldung neuheitsschädlich, so ist bei einem Gebrauchsmuster lediglich eine Abgrenzung gegenüber den Ansprüchen des prioritätsälteren Rechtes erforderlich. Es sind somit Patentanmeldungen, die nie zur Erteilung gelangt sind, aber auch die Beschreibung einer Patentanmeldung nicht neuheitsschädlich, son-

dern es muß bei erteilten älteren Rechten lediglich eine Formalabgrenzung der Ansprüche erfolgen, um eine Unterschützstellung von identen Gegenständen und Verfahren mit unterschiedlicher Priorität zu verhindern.

Alleine diese aufgezeigten Unterschiede werden die Existenz eines weiteren Schutzrechtes für technische Neuentwicklungen in Österreich rechtfertigen.

Eine weitere Besonderheit ist, daß zwei verschiedene Möglichkeiten bestehen, die Erneuerungsgebühren zu bezahlen. Dies war der Wunsch, um den Personen, die auf dem gewerblichen Rechtsschutz unerfahren sind, die jährliche Entscheidung und Überwachung durch eine einmalige Frist nach 5 Jahren zu ersetzen. Die kumulierten Gebühren für das 2. bis 5. Jahr betragen S 4.200,--, wohingegen die einmalige Pauschalgebühr S 3.600,-- beträgt. Berücksichtigt man die Verzinsung eines Kapitals, so sieht man, daß die Ersparnis zwar gegeben, je-

doch nicht beachtlich ist und damit die wesentliche Erleichterung in der einmaligen Verlängerung besteht, da auch für das 6. bis 10. Jahr eine derartige Möglichkeit besteht, wobei anstelle von S 12.000,-- lediglich S 10.800,-- zu bezahlen sind.

Zur besseren Übersicht sind die Bestimmungen für das Gebrauchsmuster im folgenden kurz zusammengefaßt:

1. Schutz für technische Erfindungen einschließlich Verfahren sowie für die Programmlogik der Programme für Datenverarbeitungsanlagen. Weiterhin wird Schutz für Diagnostizier- und Heilverfahren für Tiere gewährt.
2. Neuheitsschonfrist auch für Handlungen des Anmelders oder des Rechtsvorgängers gegeben, sofern diese Handlungen innerhalb von 6 Monaten vor dem Anmeldetag in Österreich liegen.
3. Das Erteilungsverfahren schließt einen Recherchenbericht zwangsweise mit ein; eine Registrierung kann allenfalls bereits 2 bis 3 Mo-

nate nach Anmeldung erreicht werden, wobei ein Recherchenbericht erst später veröffentlicht wird. Ein weiteres Vorprüfungsverfahren, denn formaler Natur findet nicht statt, und es ist im Regelfall mit der Registrierung eines Gebrauchsmusters innerhalb von 8 bis 9 Monaten ab Anmeldung zu rechnen.

4. Für Dritte besteht die Möglichkeit, gegen ein Gebrauchsmuster mit einer Nichtigkeitsklage vorzugehen. Gegen die Entscheidung der Nichtigkeitsabteilung kann Beschwerde erhoben werden.
5. Die Schutzdauer endigt 10 Jahre nach dem Ende des Monats, in dem das Gebrauchsmuster angemeldet wurde, und beginnt mit dem Tag der amtlichen Veröffentlichung des Gebrauchsmusters.
6. Eine Gebrauchsmusteranmeldung kann in eine Patentanmeldung und umgekehrt umgewandelt werden.

Streit in den USA um »Schweizer Messer«

A. Braun (CH)

Solange es Schweizer Sackmesser gibt, werden Nachahmungen davon insbesondere aus der ehemaligen Tschechoslowakei, Spanien und Japan auf dem Weltmarkt angeboten. Doch seit kurzem werden die Schweizer Marktleader Victorinox und Wenger mit einer steigenden Anzahl von Billigstimporten aus der Volksrepublik China konfrontiert. Der amerikanische Markt ist für die Schweizer Sackmesserhersteller von eminenter Bedeutung. Etwa 7 Millionen Sackmesser werden dort pro Jahr abgesetzt. Die chinesischen Nachahmer verkaufen dort aber bereits 20 bis 23 Millionen Stück zu durchschnittlich einem Fünftel des Preises eines echten Schweizer Armeemessers.

Die Importeurin der Victorinox Sackmesser in den USA, die Firma Forschner, hat deswegen bei einem erstinstanzlichen Gericht in New York Klage gegen Arrow Trading

eingereicht, weil letztere chinesische Sackmesser unter der Bezeichnung »swiss army knife« in den USA anbietet. Das Gericht hieß die Klage gut und verbot die Verwendung der irreführenden Bezeichnung für chinesische Sackmesser.

Die Appellationsinstanz hob diesen Entscheid auf und wies den Fall zur weiteren Beurteilung wieder an die 1. Instanz zurück. Als Begründung gab sie an, daß »swiss army knife« einen Messertyp bezeichne und keine Herkunftsangabe enthalte. Obwohl dieser Entscheid einer Niederlage der Schweizer Sackmesserhersteller gleichkommt, können die chinesischen Billigmesser in Zukunft trotzdem nicht ohne weiteres auf dem US-Markt angeboten werden. Denn das erstinstanzliche Gericht muß nun darüber befinden, ob der Konsument durch die Verwendung der Bezeichnung »swiss army knife« nicht hinsichtlich der Qualität

der chinesischen Billigsackmesser irreführt wird, weil die echten Schweizer Armeemesser hohe Qualitätsanforderungen erfüllen.

Man könnte sich deshalb z.B. vorstellen, daß die Importeure chinesischer Sackmesser zur Unterscheidung zu den echten Schweizer Armeemessern ihre Produkte in Zukunft zusätzlich mit »made in China« oder als »swiss army knife type« kennzeichnen müßten.

Obiges ist beileibe kein Einzelfall. Die Bezeichnung »swiss cheese« ist z.B. in den USA bereits zum gemeinfreien Gattungsbegriff entartet, so daß sämtliche Anbieter von Hartkäsen mit großen Löchern diese Bezeichnung verwenden dürfen.

Als löbliche Ausnahme fällt die gesetzlich geregelte Verwendung der Bezeichnung »swiss made« in der Uhrenindustrie auf. Der Schweizerische Bundesrat hat für diesen Fall nämlich von seiner auf den all-

gemeinen Interessen der Uhrenbranche beruhenden Kompetenz gemäß Art. 50 Schweizerisches Markenschutzgesetz Gebrauch gemacht und durch einen Bundesbeschluß von 1971 verfügt, daß eine Uhr nur dann die Bezeichnung »swiss made« tragen darf, wenn

mindestens 50% ihrer Bestandteile aus der Schweiz stammen und die Uhr zusätzlich in der Schweiz montiert und reguliert wurde. Diese Erfordernisse können grundsätzlich auch international durchgesetzt werden.

Trotzdem bleibt zu hoffen, daß sich mit dem Abschluß der Uruguay-Runde des GATT die Situation hinsichtlich Billigstimitate aus Entwicklungsländern bessert, weil alle Teilnehmerstaaten gewisse Minimalbedingungen zum Schutz des gewerblichen Eigentums erfüllen müssen.

U.S.A. Database to be tested as vehicle useful for offering foreign rights to European Technologies

John L. White (USA)

Foreign rights to technologies developed in a European Patent Convention Country can become non-transferable in the United States (and other foreign countries) because only a domestic (or European Patent Office) patent application has been filed, usually because of the high cost of filing in foreign countries. What is needed is a vehicle which will enable an owner of the technology (TO = Technology owner) to timely and inexpensively offer the foreign rights to their technologies to foreign candidates (ACs = Acquiring companies) who might want to acquire those rights, while there is still time to initiate foreign patent activity.

The A/H-4 International Technology Transfer Vehicle Pilot Program Ad Hoc Committee of the Licensing Executive Society (U.S.A. & Canada), a professional association of individuals involved in licensing and related activities, will test such a vehicle in 1994-1995 in a one year Pilot Program. The vehicle is a computerized database, named International Technology Transfer Vehicle (ITTV), which will permit TOs in a European Patent Convention Country (and other countries of the world) to easily and inexpensively offer the foreign rights during the period after the filing of a first patent application when foreign patent activity is still possible. The offer will include an Abstract in English (non-enabling or non-confidential) which describes the technology, its area of use and its advantages. The ITTV will be accessible electronically (key

words search) in most, if not all, of the European Patent Convention Countries through CompuServe (an existing database in the United States) which will be computer-accessible through local telephone services by ACs who participate in the program (and also who also are a subscriber to CompuServe) either directly or through Internet.

In their ITTV participation agreement, the TOs agree to offer to an interested AC an exclusive option (or right of first refusal) to acquire the foreign rights (and domestic rights as well, if the TO wishes) to a technology for which only a domestic patent application has been filed by the TO. In their participation agreement, the ACs agree that, in consideration for an exclusive option, an AC preliminarily interested in a technology in the ITTV will reimburse the TO for the initial filing costs of a PCT international patent application (or a national patent application in countries of interest to the AC) filed by the TO. The AC will negotiate the terms of the option agreement directly with the TO. The option agreement will give an interested AC, at modest expense, additional time to evaluate the technology during the option period, before the major expense of foreign filing must be incurred. It will give the TO an opportunity to initiate foreign patent activity without incurring the initial patent filing expenses.

Unlike most databases, which essentially are passive information »Bulletin Boards«, the TOs and ACs

who enter the ITTV Pilot Program will have executed a participation agreement in which they agree to a certain course of conduct prior to actually negotiating the transfer of any rights, thereby reducing the time and expense required to arrive at a serious negotiating stage before the deadline for making a decision whether to initiate foreign patent activity. There will be no charge to the TOs who participate in the Pilot Program. The cost, if any, to the AC participants will be nominal.

Before the Pilot Program is started, the A/H-4 Committee will require »requests to participate« from enough TOs who would like to participate to justify initiating the pilot program. If you are or know of an owner of a technology for which a domestic patent application has recently been filed or will be filed in the 1994-1995 period who would like to participate in the Pilot Program or if you are or know of an AC who would like to participate as subscriber in the Pilot Program or if you would like more information on the ITTV Pilot Program, please write to:

John L. White, Chair
A/H-4 Ad Hoc Committee LES
(U.S.A. & Canada), Inc.

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.

2200 Clarendon Blvd.,
Suite 1400

Arlington, VA 22201 USA

FAX: 703-243-6410

For further details of the International Technology Transfer Vehicle see the following article:

International Technology Transfer Vehicle (ITTV)

LES (U.S.A. & Canada), Inc. Pilot Program

Foreign rights to technologies often become non-transferable because foreign patent protection was not sought by the owner thereof. The International Technology Transfer Vehicle (ITTV) is a technology transfer system which employs a computerized database to facilitate the offering for transfer of the foreign rights to technologies for which foreign patent protection is still possible but is not planned by the owner thereof. The A/H-4 ad hoc Committee of the Licensing Executive Society (U.S.A. & Canada), Inc. (LES) is sponsoring a pilot program, to determine the feasibility of the ITTV, which will be administered by a commercial database operator whose database is accessible in all industrial countries through »CompuServe« or »Internet«.

Purpose of the ITTV:

Provide a vehicle which will permit a technology owner (TO), who otherwise has no effective means to do so, to effectively and timely offer to companies interested in acquiring technologies (ACs), the foreign rights (and domestic rights, as well, if the TO wishes) to a technology for which a domestic patent application has been filed but, in the absence of the ITTV, no foreign filings are planned (usually because of the expense), thus substantially precluding (in the absence of the ITTV), the transfer of any foreign rights to the technology. The objective of ITTV is to (a) provide an AC, at a modest expense, additional time during which the AC is protected by an exclusive option agreement, to evaluate a technology before the major expense of foreign patent filings is incurred and (b) provide the TO with a foreign patent application (e.g., a PCT international patent application or an application in the foreign country of interest to the AC) which is owned by the TO and

thus is a basis for negotiating for the transfer of the foreign rights to the technology with the AC (or with a third party, if the AC elects during the option period not to acquire the foreign rights to the technology).

Purpose of the ITTV Pilot Study:

Determine the feasibility of a computerized database as a vehicle for facilitating the transfer of foreign rights to technologies. A one year period for entry of technologies into the ITTV is planned with the program continuing thereafter until the priority period for foreign filing of the latest filed domestic application in the program has expired.

Target TO's for the ITTV:

Small businesses, universities and individuals who lack one or more of the finances, manpower or expertise required to effectively offer foreign rights to an invention.

Target AC's for the ITTV:

(a) Foreign corporations seeking foreign rights to technologies originating from U.S. TO's and (b) U.S. companies seeking U.S. rights to technologies originating from foreign TO's. (The ITTV can also be used as a vehicle for the transfer of all rights, including domestic.)

TO's Requirements to Enter ITTV System:

(a) A domestic patent application, filed by the TO less than 12 months prior to entering the system; (b) an Abstract in English, submitted to the A/H-4 Committee, which is either non-enabling or is non-confidential, which describes the technology, its technological field and its intended end use(s) and advantage over the prior art; and (c) signing of a participation agreement (which will be part of the form requesting entry of a technology in the ITTV), signed by an authorized representative of the owner of the technology, in which the TO agrees to:

(1) promptly send to an AC (i) who has identified himself to the TO; (ii) who is acceptable to the TO as an AC; and (iii) who has agreed, as a condition to entering the ITTV, to execute a confidentiality agree-

ment with respect to any confidential information supplied to that AC by the TO, a copy of the domestic patent application and, if it is not in English, an enabling disclosure in English of the contents of the application, for review by the AC during a review period of not less than one month thereafter;

(2) not grant any foreign rights to the technology to another during the review period (during which the AC must decide whether or not to acquire provisional rights to the technology through an option agreement and promptly notify the TO of its decision);

(3) grant an exclusive option to acquire the foreign rights to the technology, for a period of not less than six months, to an AC who executes an exclusive Option Agreement and who has agreed to pay the initial foreign filing costs for filing a PCT patent application or an application in the foreign country(s) of interest to the AC; and

(4) file within the priority year, upon notification from the AC who has entered into an option agreement to acquire foreign rights to the technology and upon receipt of payment from the AC of a predetermined maximum sum (corresponding to the standard initial filing costs, including agent's fee, to cover the cost of filing a PCT international patent application in the TO's domestic patent office or a foreign country of interest to and designated by the AC);

(5) negotiate in good faith, upon request by the AC who has executed an Option Agreement, for the exclusive transfer to the AC of the foreign rights to the technology in the country(s) in which a patent application has been filed by the TO under the Option Agreement;

(6) not negotiate with another party with respect to those foreign rights during the option period; and

(7) inform the A/H-4 Committee at the end of the priority period of the number of requests from ACs received through the ITTV for a copy of TO's domestic patent application and whether a PCT or for-

eign application was filed pursuant to an agreement with an AC.

AC's Requirements to Enter the ITTV:

(a) Subscribe to »CompuServe« database; and (b) enter into a participation agreement in which the AC agrees to:

(1) enter into a standard confidentiality agreement, upon request by a TO whose technology the AC wishes to evaluate, covering any confidential information received from the TO;

(2) inform the TO, after receipt of a copy of a TO's domestic patent application, within the agreed upon review period, whether or not the AC wishes an exclusive period to evaluate the technology and, if it does,

(3) enter into an Option Agreement with the TO which includes pre-payment to the TO of a predetermined sum for filing a PCT or foreign patent application; and

(4) promptly negotiate in good faith with the TO during the option period to acquire exclusive foreign rights to a technology covered by an Option Agreement, if the AC desires to acquire those rights.

ITTV Pilot Program Parameters:

(1) The ITTV will be a custom database maintained and operated by the database operator on behalf of the A/H-4 Committee;

(2) The ITTV Pilot Study will be operated on a non-profit basis;

(3) The database will not be accessible to the TOs. (The offerings of the TO participants in the Pilot Program will be submitted to the A/H-4 committee for entry in the database and will include (a) a non-enabling or non-confidential enabling one sheet type-written Abstract in English which describes the technology, its preparation and its use(s) and advantages or on a Disclosure Form supplied by the database operator or on a compatible floppy disc (in accordance with instructions supplied by the database operator), (b) the expiration date of the priority period for foreign patent filings; and (c) a signed participation agreement as described above;

(4) The TO entries will be accessible to ACs who (a) register with the database operator; (b) sign a participation agreement as described above; and (c) agree to pay the small monthly charge to sub-

scribe to »CompuServe« and the standard computer on-line database charges of the database operator;

(5) The database will contain only ITTV entries;

(6) The database will be conducted for a test period of one year (plus the time required for the priority year to expire);

(7) To facilitate negotiations with respect to confidentiality and option agreements, the database will include a library of standard confidentiality and exclusive option agreements from which a TO can select and identify in its entry sheet as being acceptable.

(8) TOs and ACs who are not members of LES may participate in the Pilot Study but, if the ITTV becomes a permanent part of the LES (U.S.A. & Canada), ONLINE database, participation by ACs will be limited to LES members.

(9) At the end of the Pilot Study, the results thereof, including the names of the TOs and ACs participating in the program, will be reported to the LES membership.

Taking of oral evidence at the EPO

C. P. Mercer (GB)

I recently attended, as a member of the public, an Oral Proceedings before an Opposition Division at which Oral Evidence was taken from a witness. The procedure used was the one recommended in Guideline E-IV, 1.7, involving a member of the Opposition Division dictating summaries of the witness' answers. As on previous occasions when I have been involved in such proceedings, I was very dissatisfied with the procedure, as were most of the representatives of the parties.

I wrote to the EPO to set express my dissatisfaction. As a result of this, I had a meeting with Mr. Vivian and some of his senior staff to discuss the matter. It appeared from the meeting that there had been some other complaints about the procedure used for taking oral evidence, but not enough to persuade the EPO to change the procedure.

I would like to follow up on this matter with Mr. Vivian. I would therefore be grateful if members of EPI who have had Oral Proceedings at which Oral Evidence was taken to

write to me, or directly to Mr. Vivian with a copy to me, setting out their views on the procedure adopted. So far, the members with whom I have discussed this have only had negative views about the procedure. Does anyone have a positive view?

Mr. Vivian also indicated that DG2 is at present reviewing the training of Opposition Divisions in ways to handle Oral Proceedings. It may also be useful if members could indicate any ways in which they feel that the conduct of Oral Proceedings could be improved.

Language problems

R. Chevallier (FR)

L'article de L.J. Steenbeek et le «Kommentar» de F.A. Jenny publiés dans le fascicule 3 de septembre 1994 sont consacrés très judicieusement au retard que la traduction en trois langues impose à la délivrance des brevets.

Le retard n'est pas le seul ni le plus important inconvénient de l'usage de trois langues officielles: l'examen du budget de l'OEB montre qu'une fraction considérable des dépenses de fonctionnement provient des travaux de traduction et d'interprétation; ceci se reporte naturellement sur les taxes.

Je me permets de faire une suggestion qui, probablement, a déjà été faite et, certainement, n'a pas

été retenue. Il serait extrêmement avantageux que l'OEB adopte l'espéranto comme langue officielle supplémentaire avec l'intention de supprimer par la suite, progressivement, les autres langues officielles.

L'emploi de cette langue neutre serait étendu graduellement. Par exemple, actuellement, les revendications des brevets délivrés pourraient être publiées dans la langue officielle du dépôt et uniquement en espéranto: le délai et le coût seraient réduits rapidement. Par la suite les descriptions pourraient elles aussi être publiées dans la langue du dépôt et en espéranto. Plus tard l'espéranto pourrait devenir la seule langue officielle pour les dépôts et

pour les brevets délivrés, la procédure d'examen pouvant se faire dans une des langues officielles actuelles choisie par le déposant. Enfin, plus tard encore l'espéranto deviendrait la seule langue officielle pour toutes les relations avec l'OEB et les publications de celle-ci.

Je sais parfaitement que cette suggestion n'a aucune chance d'être adoptée; pourtant une langue neutre comme l'espéranto, facile à apprendre par tous les mandataires et tous les examinateurs, les mettrait tous dans une situation égale sans en avantager aucun et permettrait de réduire fortement le budget de l'OEB ainsi que les taxes.

De la difficulté de réussir l'examen de mandataire européen pour un Français

F. Benech (FR)

Le faible taux de réussite des Français à l'examen de mandataire européen ne date pas d'aujourd'hui. Il ne saurait donc trouver une justification dans l'augmentation des difficultés des épreuves C et D de l'examen de qualification, ce qui par contre semble être la raison majeure des échecs récents plus fréquents chez les candidats d'autres pays.

Les raisons des difficultés rencontrées par les candidats français sont en fait beaucoup plus structurelles que conjoncturelles.

1. Elles tiennent tout d'abord et comme le remarque F. Charpail (EPI Information 2/93) au nombre insuffisant en France de tuteurs compétents.

Cela ne signifie pas, bien entendu qu'il n'en existe pas, mais simplement qu'ils ne sont pas assez nombreux.

A cela deux raisons:

(i) La France n'étant pas un pays à examen sur le fond, cette com-

pétence n'a pu être développée en interne avec la même fréquence et la même solidité que chez nos confrères allemands ou anglais. Il faut se garder à ce sujet de croire que la compétence dans ce type de métier s'enseigne par l'intermédiaire de cours externes ou conférences, comme le souligne ici encore F. Charpail.

(ii) La plupart des dossiers européens d'Outre-mer (en provenance des U.S.A., du Japon, etc.) sont traités par des confrères anglais ou allemands pour des raisons qui tiennent notamment à la langue (pour les Anglais) et à l'emplacement géographique de l'Office Européen des Brevets (pour les Allemands).

Ils échappent de ce fait aux conseils français qui, traitant peu de brevets européens en dehors de ceux issus des demandeurs français, ont moins l'occasion de développer leurs compétences:

«On n'est en effet spécialiste que de ce que l'on pratique».

2. Les raisons des échecs des candidats français tiennent ensuite au peu de temps consacré par ces candidats à la préparation proprement dite de l'examen, pour trois raisons :

(i) La première raison est le sous-effectif quasi-permanent des Cabinets de Conseil Français ou des services de Propriété Industrielle des entreprises françaises, entraînant un manque de disponibilité des tuteurs et la nécessité pour les jeunes candidats à l'examen, de «produire» tout de suite : On est loin de la demi-journée de temps libre par semaine accordée aux futurs mandataires par certains Cabinets anglais.

Notons à ce sujet que la plupart des mandataires français qui n'ont pas eu, eux-mêmes, à passer l'examen de mandataire, me-

surent assez mal l'énergie et le temps nécessaire pour effectuer une préparation digne de ce nom.

- (ii) La seconde raison, d'ailleurs liée à la première, réside dans la nécessité de rentabiliser le personnel existant.

Le chiffre d'affaires des Cabinets français a sérieusement baissé depuis l'avènement du brevet européen, les étrangers hors-Europe confiant essentiellement, comme on l'a vu, leurs dossiers aux confrères anglais ou allemands. Or, ce sont en particulier les dossiers provenant de confrères étrangers qui génèrent sans trop d'effort des bénéfices permettant ainsi de consacrer l'argent et le temps nécessaires à la formation des jeunes. Ils s'agit donc d'un cercle vicieux.

- (iii) Enfin, les échecs des candidats français proviennent d'un manque de motivation de ces mêmes jeunes pour une profession de Conseil en Propriété Industrielle qu'ils ont certes adoptée mais qui, en France, est une crise.

Est à ce titre révélatrice la vision très monopolistique de leur profession par les Conseils français en place à l'égard des jeunes générations, comme le montre par exemple l'interprétation de la nouvelle loi de 1991 concernant les dispositions transitoires.

La volonté de former de nouveaux mandataires n'apparaît pas toujours réelle même si les actuels titulaires du titre en France expriment le contraire à qui veut les entendre.

En clair, il n'est pas évident que les détenteurs de ce titre notamment dans les Cabinets de brevet, souhaitent véritablement que les jeunes accèdent à ce titre par crainte peut être de l'autonomie qu'il entraîne.

Il s'agit là malheureusement d'une vue à court terme mais qui crée un climat psychologique difficile, peu propice à la sérénité nécessaire à la préparation et au passage de l'examen.

3. Au vu de ce qui vient d'être dit, que peut-on faire pour améliorer la situation?

Remarquons tout d'abord que la France possède au moins deux atouts qui lui permettraient de former et de conserver de bons Conseils mandataires européens :

- 1) Elle possède des ingénieurs et des techniciens de haut niveau qui constituent un réservoir de compétences techniques important.
- 2) Elle possède ensuite des industries solides dans les domaines de pointe comme les transports, les télécommunications, la biologie ou le nucléaire qui sont matières à innovation et à protection par brevet.

Ces deux atouts sont tout à fait fondamentaux.

En effet, la compétence d'un mandataire européen ne se trouve pas uniquement dans ses connaissances dans l'art de rédiger des revendications et de respecter les procédures devant l'Office Européen des Brevets, compétence qui est pourtant et bien entendu nécessaire, mais elle réside également dans ses connaissances techniques pures, le mandataire devant pouvoir maîtriser techniquement les sujets qu'il traite.

Cette compétence est souvent plus difficile à acquérir que celle nécessaire à la réussite de l'examen actuel qui n'en tient pas compte, comme le remarque d'ailleurs encore F. CHARPAIL.

Cette compétence technique est un atout insuffisamment valorisé au niveau international. Elle devrait pourtant permettre aux Conseils français d'obtenir plus de dossiers en provenance de leurs confrères d'outre-mer.

Ajoutons que contrairement à une idée faussement reçue, le mandataire français est réellement parfaitement bilingue français/anglais, ce qui n'est pas assez connu à l'étranger.

Par ailleurs, la présence d'industries innovantes en France engendre des dépôts initiaux qui, étendus à l'étranger, notamment aux U.S.A. et au Japon, génèrent chez nos confrères de ces pays un chiffre d'affaires qui devrait être un fait générateur de «réciprocité». Ce n'est malheureusement pas suffisamment le cas.

En résumé, il ne faut pas chercher d'excuses au manque de succès des Français à l'examen de mandataire européen en invoquant uniquement une difficulté d'examen qui est réelle, mais qui devrait pouvoir être minimisée dans les années à venir.

Le problème français est autre.

Il est clair que s'il n'est pas pris en main par les responsables de la profession en France, dont c'est le devoir de réussir à mieux former et mieux motiver les jeunes candidats, il faudra se résoudre à ce que de l'ordre de 90 % des mandataires européens soient allemands ou anglais au début du 21^{ème} siècle.

Mais il est aussi du devoir, d'une part, des jeunes mandataires et, d'autre part, des futurs mandataires français de se prendre en main eux-mêmes, en se mobilisant pour chercher et trouver des solutions.

Ce problème n'est pas uniquement français, mais touche également encore plus dramatiquement les autres pays comme la Belgique ou les pays latins comme l'Espagne, l'Italie, le Portugal ou la Grèce qui n'ont pas la chance de parler l'une des trois langues officielles de l'OEB.

Si donc vous vous sentez concerné et souhaitez vous mobiliser sur ce thème, n'hésitez pas à prendre contact avec le signataire du présent article.

Information from the General Secretariat

Redaktionsschluß für EPI Information 1/1995

Redaktionsschluß für die nächste EPI Information ist der **23. Januar 1995**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum in General Sekretariat eingegangen sein.

Deadline for EPI Information 1/1995

Our deadline for the next issue of EPI Information is **23 January 1995**. Documents for publication should have reached the General Secretariat by this date.

Date de Remise des Documents pour EPI Information 1/1995

La date limite de remise des documents pour le prochain numéro de EPI Information est le **23 janvier 1995**. Les textes destinés à la publication doivent être envoyés au Secrétariat Général avant cette date.

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Disciplinary and other Committees · Commission de Discipline et autres Commissions

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| AT - P. Révy von Belvard | FR - R. Harlé | AT - E. Piso |
| BE - G. Leherte | NL - L.W. Kooy | BE - F. de Kemmeter |
| CH - B. Dousse | | CH - M. Micheli |
| CH - J.J. Troesch | | DE - W. Baum |
| DE - W. Dabringhaus | Beschwerdekammer in | DE - H.-H. Wilhelm |
| DE - H.G. Urbach | Disziplinarangelegenheiten (EPA/EPI) | DK - L. Roerboel |
| DK - H. Lindgaard | Board of Appeal (EPO/EPI) | ES - C. Polo Flores |
| ES - V. Gil Vega | Chambre de recours | FR - M. Dalsace |
| FR - F. Charpail | en matière disciplinaire (OEB/EPI) | FR - J.J. Martin |
| FR - R. Lhuillier | | GB - J.D. Brown ** |
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