

# 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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## Editorial

T. Johnson (GB)

With apologies to those of our readers who are not following a certain football tournament taking place in Germany as this is being written, the proceedings in various stadia around Germany provoke us to consider the score in what might be termed another „world cup“ more closely related to our field of activity, namely the tri-partite cooperation between the EPO, JPO and USPTO.

WIPO must not be excluded, so in footballing terms we could have the famous „diamond“ pattern in play, in which case, which is the „holding“ player and which the „attacking“ central attacker? The JPO has made a tactical strike with its new „Highway“, which, like the curate's egg, is good in parts. All the Offices are under pressure of one kind or another, the EPO, JPO and USPTO all having massive backlogs of unexamined applications. While we are sure they all have their eye on the ball, most of the players are massed in defence, and cannot seem to break out into a strong position to attack, and thus reduce, the backlog. This is no good for the patent system. We must, however, do our part too, when

dealing with the EPO, in being as constructive as possible in responding to Office initiatives, and in our daily practice in dealing with official Communications. We take the view that as part of the European Patent Organisation, the *epi* is part of a team with the EPO. However, as in any good team, there must be a balance. Applicants and their attorneys should not be criticised merely for using the system to protect what are valuable rights. We have in mind here the filing of divisional applications, which seem to be under attack, as is the right to argue for a properly defined invention in a patent claim, which after all is a definition, not a description. Also, as is evident from a document published on the EPO website, attorneys' fees (including those „in-house“) are mentioned in such a way that those fees are implied artificially to inflate the cost of obtaining a European patent. Your Council is questioning the basis on which the EPO figures are founded. Watch this space.

We wish you good World Cup watching, and a good summer!

### Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionsschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **18. August 2006**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

### Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of *epi* Information is **18 August 2006**. Documents for publication should have reached the Secretariat by this date.

### Prochaine date limite pour epi Information

Veillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de *epi* Information est le **18 août 2006**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## Bericht über die 60. Ratssitzung Salzburg, 15.-16. Mai 2006

Die Sitzung wurde von Präsident Chris Mercer eröffnet, der die Mitglieder und Stellvertreter und eine Delegation aus Lettland begrüßte, die zum ersten Mal an einer Ratssitzung teilnahm.

Die Stimmenzähler wurden ernannt und die Tagesordnung wurde mit einigen Änderungen angenommen.

Vize-Präsident Finnilä konnte wegen seines gebrochenen Arms nicht teilnehmen. Der Rat wünschte ihm alles Gute für eine schnelle Genesung.

Das Protokoll der 59. Ratssitzung in Bukarest sowie die auf der jüngsten Vorstandssitzung gefassten Beschlüsse wurden genehmigt.

Zu den Angelegenheiten, die sich aus dem Protokoll der letzten Sitzung ergaben, lag ein Bericht des Präsidenten vor, der auch seinen Tätigkeitsbericht darstellte. Die Berichte von Generalsekretär und Schatzmeister wurden vorgelegt. In letzterem wurde die Zahl der Mitglieder zum Zeitpunkt der Sitzung mit 8.136 angegeben. Der Haushalt wies gegenüber dem Vorjahr einen Überschuss auf. Daher kam der Rat überein, den Haushalt für 2006 zu reduzieren. Die Jahresgebühr des *epi* wurde für die nächsten Jahre bei 150 € belassen.

Es gab eine Diskussion über die Website des EPA, wo typische Kosten für das Erlangen eines Europäischen Patents angegeben wurden. Dieser Punkt war bereits im Vorstand besprochen worden. Es war nicht klar, auf welcher Grundlage die vom EPA angegebenen Zahlen, die der Rat als irreführend ansah, erstellt wurden. Es wurde beschlossen, dass der Präsident und Herr Boff dem EPA einen Brief schreiben sollten, in dem ausdrücklich um die Löschung dieses Teils der EPA-Webseite gebeten wird. Der Redaktionsausschuss des *epi* wurde mit der Erstellung einer Kostenanalyse des *epi* für das Erlangen eines Europäischen Patents beauftragt.

Es gab eine Diskussion über den Fragebogen der Europäischen Kommission über die Zukunft des Patentsystems in Europa. Eine öffentliche Anhörung in Brüssel war auf den 12. Juli verschoben worden. Zum Fragebogen waren über 2.000 Antworten eingegangen, 700 davon offensichtlich über das frei zugängliche Forum. Das *epi* wird bei der öffentlichen Anhörung anwesend sein.

Der vom Präsidenten eingesetzte Ad-Hoc-Ausschuss hatte seit der letzten Ratssitzung seine Arbeit fortgesetzt, und man dankte ihm für den Entwurf eines Schreibens, das an Präsident Pompidou und an den Verwaltungsrat gesandt wird. Der Tenor war, dass der Rat sich auf die *epi*-Strategie konzentriert und einige seiner Befugnisse dem Vorstand überträgt; dies würde Flexibilität und Kontinuität gewährleisten. Nach einiger Diskussion stimmte der Rat zu, dass der Ad-Hoc-Ausschuss zusammen mit dem Geschäftsausschuss die Geschäftsordnung dahingehend abändern

soll, dass durch Änderung der Geschäftsordnung nur die Delegation an den Vorstand gedeckt ist. Der Ad-Hoc-Ausschuss wird einige weitere Punkte bearbeiten. Weitere Berichte werden mit der weiteren Arbeit des Ausschusses folgen.

Es gab eine Diskussion über ein Positionspapier des Ausschusses für die Europäische Eignungsprüfung, das angenommen wurde. Eine Diskussion über die Dauer der Prüfung und darüber, ob eine Qualifizierung auf nationaler Ebene eine Qualifizierung auf europäischer Ebene zur Folge haben könnte, fand ebenfalls statt.

Der Vorschlag, das Prüfungspapier D1 in zwei Teile aufzuspalten, wurde nicht positiv beurteilt, da der Rat der Meinung ist, dass die Kandidaten dadurch stärker belastet werden. Der Vorschlag, das *epi* solle als Sekretariat für die Europäische Eignungsprüfung fungieren, wurde abgelehnt. Es gibt eine Arbeitsgruppe zur Europäischen Eignungsprüfung, in der das *epi* weiterhin mitarbeitet.

Über die EPA-Finzen fand eine Diskussion statt; die Strategiedebatte im EPA geht weiter. Verbindlichkeiten und Vermögen des EPA stehen in einem vernünftigen Verhältnis zueinander.

Ein Bericht über die letzte Sitzung des Verwaltungsrats wurde vorgelegt. Das *epi* ist gegen eine Dezentralisierung.

Der Ausschuss für Standesregeln brachte einen neuen Punkt vor, nämlich Geldwäsche, über den er bei einer späteren Sitzung berichten wird.

Der Bericht des EPPC wurde eingehend besprochen, insbesondere mit Bezug auf das EPÜ 2000 und Vorschläge vom japanischen Patentamt für eine „New route“ und einen „Patent Prosecution Highway“. Der Rat war gegen Erstere und für Letzteren. Verschiedene andere Punkte des EPPC wurden zur Diskussion auf der nächsten Ratssitzung in Istanbul verschoben.

Die Berichte der weiteren Ausschüsse wurden zur Kenntnis genommen. Herr Johnson vom Redaktionsausschuss legte einen Vorschlag zum Erneuern des Umschlags der *epi*-Information vor. Er sollte graublau sein, mit einer deutlichen Titelzeile, gedruckt auf Recyclingpapier, und die Farbe sollte für jede Ausgabe anders sein. Der Rat wurde von einem Vorstandsmitglied überzeugt, dass das nicht machbar ist, aber nach einiger Diskussion beauftragte der Rat den Redaktionsausschuss, seinen Vorschlag auf einer späteren Sitzung erneut vorzulegen.

Der Rat stimmte zu, dass jeder Vorschlag des Geschäftsausschusses zur Revision der Geschäftsordnung an den Ad-Hoc-Ausschuss geschickt werden soll.

Die nächste (61.) Ratssitzung findet vom 16.-17. Oktober 2006 in Istanbul statt. Es gab eine Diskussion

über die 62. Sitzung im Mai 2007 in Polen. Der Rat war mehrheitlich für Krakau, nicht für Warschau.

Der Präsident schloss die Sitzung nach einem herzlichen Dank an die österreichische Delegation für ihre sehr erfolgreiche Organisation der Sitzung.

## Entwurf der Beschlüsse

### 60. Ratssitzung, Salzburg, 15.-16. Mai 2006

1. Präsident MERCER wird bezüglich der Veröffentlichung eines Dokumentes auf der Website des EPA über die Kosten für ein europäisches Patent einen Brief an das EPA schicken. Der Redaktionsausschuss wird sich um die Erstellung einer korrekteren Fassung zur Veröffentlichung auf der *epi*-Website kümmern.
2. Der Ad-Hoc-Ausschuss für die Überarbeitung der Gründungsvorschriften des *epi* wird in Artikel 9(1) der Gründungsvorschriften den Zusatz aufnehmen, dass die Handlungsvollmacht nur dem Vorstand übertragen werden kann.
3. Der Vorschlag für Änderungen der Artikel 8, 9 und 10 der Gründungsvorschriften des *epi* wird dem Verwaltungsrat des EPA unterbreitet werden.
4. Der Rat war der Meinung, dass in der neuen Geschäftsordnung die Nutzung der elektronischen Abstimmung über Ratsbeschlüsse vorgesehen werden sollte.
5. Der Redaktionsausschuss wird in Zusammenarbeit mit dem Geschäftsordnungsausschuss den Ad-Hoc-Ausschuss durch Bereitstellung von Mitteln für die elektronische Beratung über die Revision der Gründungsvorschriften und durch Erarbeiten von Mitteln für die elektronische Abstimmung über Ratsbeschlüsse unterstützen.
6. Der Rat billigte, dass dem EPA ein Positionspapier zur Überarbeitung der Vorschriften für die Europäische Eignungsprüfung geschickt wird, sobald es gemäß den im Rat besprochenen Vorgaben fertig gestellt worden ist.
7. Der EPPC wurde mit der Aufgabe betraut, die Frage der Zentralisierung der *Opposition Divisions* des EPA zu untersuchen.
8. Das Positionspapier zur Konsultation des britischen Patentamts über die Anforderungen an eine Erfindung im britischen Patentgesetz und in der britischen Patentpraxis wird dem britischen Patentamt und dem EPA geschickt werden.
9. Die zweite Fassung des *epi*-Positionspapiers über die Renummerierung der Ausführungsvorschriften des EPÜ 2000 wird dem EPA geschickt werden.
10. Der Entwurf des *epi*-Positionspapiers über den Vorschlag des japanischen Patentamts für einen *Patent Prosecution Highway* wird zum gegenwärtigen Zeitpunkt nicht abgesandt.
11. Der Rat stimmte für eine Verlegung des Termins für die nächste Ratssitzung in Polen auf den 14./15. Mai 2007, wenn in Krakau ein angemessenes Hotel zur Verfügung steht.
12. Der abgeänderte Haushalt 2006 wurde angenommen.
13. Der Rat genehmigte die Änderung von § 4 der Regelung für die Zahlung des jährlichen Mitgliedsbeitrags mit „eine Person, die nach dem 30. September *zum ersten Mal* in der Liste der zugelassenen Vertreter registriert wird“.
14. Die vorgeschlagenen Änderungen des Formulars für die Einzugsermächtigung zur Zahlung des jährlichen Mitgliedsbeitrags wurden angenommen.
15. Der Haushalt 2005 wurde angenommen und der Schatzmeister entlastet.
16. Der Rat nahm den Entwurf einer neuen Umschlagseite der *epi*-Information nicht an.
17. Der Rat genehmigte, dass das *epi*-Positionspapier zu CA/PL 12/06 „SPLT-Blick auf weitere Arbeit“ an das EPA geschickt wird.

## Report of the 60<sup>th</sup> Council Meeting Salzburg, 15-16 May, 2006

The meeting was opened by the President, Chris Mercer, who welcomed the members and substitutes, and a delegation from Latvia, who were attending Council for the first time.

The scrutineers were appointed, and the Agenda adopted with a few modifications.

Vice-President Finnilä was not able to be present owing to having sustained a broken arm. Council sent best wishes for a speedy recovery.

The minutes of the 59<sup>th</sup> Council meeting in Bucharest were approved as were Decisions made there and at the most recent Board Meeting.

With regard to matters arising from the Minutes of the previous meeting, there was a report from the President, who also gave his report of activities. The reports of the Secretary General and Treasurer were given. The latter reported that there were 8136 members at the date of the meeting. The budget showed a surplus on that for the previous year. In view of this, Council agreed to reduce the budget for 2006. The annual subscription to *epi* would be maintained at €150 for the next few years.

There was a discussion on the EPO website, which sets out typical costs of obtaining a European patent. This topic had previously been discussed by the Board. It was not clear what formed the basis for the figures used by the EPO, which Council agreed were misleading. It was agreed that the President and Mr. Boff would write a letter to the EPO basically to ask for removal of this part of the EPO website. The Editorial Committee of the *epi* was asked to investigate providing an *epi* analysis of costs for obtaining an EPO patent.

There was a discussion on the European Commission's Questionnaire on the future of the Patent System in Europe. A scheduled public hearing in Brussels had been postponed to 12 July. Over 2000 responses to the Questionnaire had been sent in, 700 of which had it seems came from the Open Source Forum. The *epi* would be represented at the public hearing.

The Ad Hoc Committee set up previously by the President had continued its work since the last Council Meeting, and was thanked for its work in producing a draft paper for sending to President Pompidou and the Administrative Council. The basic tenet was that Council would concentrate on *epi* strategy, and would have power to delegate certain of its powers to the Board; this would provide flexibility and continuity. After some debate, Council voted that the Ad Hoc Committee would work on amending, with the By-laws Committee, the By-laws so that only delegation to the Board would be covered by any amendment of the By-laws. Various

other topics would be continued to be worked on by the Ad Hoc Committee. Further reports will appear as the Committee continues its deliberations.

There was a discussion on a position paper by the PQC, which was approved. There was a discussion too on the length of the qualifying examination, and whether a national qualification would lead to European qualification.

A proposal to split paper DI into two parts was not well received, as Council thought that this could impose an extra burden on candidates. A proposal that the *epi* should act as secretariat for the EQE was rejected. There was a working group on the EQE, the *epi* would continue to contribute.

There was a discussion on EPO Finances; the strategy debate in the EPO was ongoing. The liabilities and assets of the EPO are reasonably well matched.

There was a report on the last Administrative Council meeting attended. The *epi* is not in favour of decentralisation.

The Professional Conduct Committee had a new topic, namely money laundering, on which it would report at a later meeting.

The EPPC report was discussed at some length, particularly with reference to EPC 2000, and proposals from the JPO for a „New route“ and a „Patent Prosecution Highway“. The Council was against the former, and in favour of the latter. Various topics in hand on the EPPC were deferred for further discussion at the next Council Meeting in Istanbul.

Reports of other Committees were noted. Mr. Johnson of the Editorial Committee presented a proposal for a re-vamped cover for *epi* Information. This would be blue/grey, with a clear title line, would be printed on recycled paper, and the colour could be changed for each issue. Council was persuaded by a Board Member that the change could not be implemented, but after further discussion the Council instructed the Editorial Committee to re-present its proposal at a later meeting.

It was agreed that any proposal by the By-laws Committee for revision of the By-laws would be sent to the Ad Hoc Committee.

The next Council Meeting (the 61<sup>st</sup>) will be in Istanbul on 16-17 October, 2006. There was a discussion on the 62<sup>nd</sup> meeting in May 2007, in Poland. Council agreed on Krakow, rather than Warsaw.

The President closed the meeting after having warmly thanked the Austrian delegates for a very successful organisation and running of the meeting.

## Draft decisions

### 60<sup>th</sup> Council Meeting, Salzburg 15-16 May 2006

1. Concerning the document published on the EPO website about the costs of obtaining a European patent, a letter will be sent by President MERCER to the EPO. The Editorial Committee will look into the possibility of producing a version on a more accurate basis, for publication on the *epi* website.
2. The Ad-Hoc Committee on the revision of the *epi* Founding Regulation will include in the amendments to Article 9(1) of the Founding Regulation, a provision that powers can only be delegated to the Board.
3. The proposal for amendments to Articles 8, 9 and 10 of the Founding Regulation of the *epi* will be submitted to the Administrative Council of the EPO.
4. Council considered that the new by-laws should provide for the use of electronic voting for Council decisions.
5. The Editorial Committee, in collaboration with the By-Laws Committee, will assist the Ad-Hoc Committee in providing means for electronic consultation on the revision of the Founding Regulation and in investigating means for electronic voting for Council decisions.
6. Council approved sending the position paper on the Revision of the Regulation of the EQE to the EPO after it has been finalized along the lines discussed by Council.
7. The EPPC was entrusted with the task of dealing with the question of centralising of the Opposition Divisions of the EPO.
8. The *epi* position paper on the UK PO consultation on the inventive step requirement in the UK patent law and practice will be sent to the UK PO and to the EPO.
9. The second version of the *epi* position paper on renumbering the Implementing Regulations of the EPC 2000 will be sent to the EPO.
10. The draft *epi* position paper on the JPO proposal for a Patent Prosecution Highway will not be sent for the time being.
11. Council voted in favour of changing the date of the next Council meeting in Poland to 14-15 May 2007 if suitable hotel accommodation is available in Krakow.
12. The 2006 amended budget was adopted.
13. Council approved amending § 4 of the rules governing payment of the annual membership subscription by „a person is registered *for the first time* on the list of professional representatives after 30 September“.
14. The proposed modifications to the direct debiting mandate form for payment of the annual membership subscription were adopted.
15. The 2005 accounts were approved and the Treasurer was discharged of liability.
16. Council did not approve the draft for a new cover of *epi* Information.
17. Council approved sending the *epi* position paper on CA/PL 12/06 „SPLT- Views on further work“ to the EPO.

## Compte rendu de la 60ème réunion du Conseil

### Salzburg, 15-16 mai 2006

Le Président Mercer ouvre la séance. Il souhaite la bienvenue aux membres du Conseil et aux suppléants ainsi qu'aux représentants de Lettonie qui assistent pour la première fois à une réunion du Conseil en tant que membres titulaires.

Les scrutateurs sont désignés et l'ordre du jour est adopté avec des modifications mineures.

Le Vice-Président Finnilä était empêché d'assister à la réunion en raison d'une fracture au bras. Les membres du Conseil lui souhaitent une prompte convalescence.

Le compte rendu de la 59ème réunion du Conseil à Bucarest et les décisions prises lors de cette réunion de

même que les recommandations faites lors de la dernière réunion du Bureau sont approuvés.

A la suite de son rapport sur les différentes questions relevant de la précédente réunion du Conseil, le Président présente son rapport d'activités, lequel est suivi de ceux du Secrétaire Général et du Trésorier. Le rapport du Trésorier fait état, à la date de la réunion, de 8136 membres. Le budget indique un surplus par rapport à celui de l'année précédente. Le Conseil décide par conséquent de réduire le budget pour l'année 2006. La cotisation annuelle de l'*epi* devrait pouvoir être maintenue à €150 dans les prochaines années.



Une discussion s'engage au sujet de la publication sur le site Internet de l'OEB des coûts d'obtention d'un brevet européen. La question a déjà été discutée par le Bureau. Il ne ressort pas clairement des chiffres présentés par l'OEB sur quelle base les calculs ont été effectués. Le Conseil juge que cette information induit l'utilisateur en erreur et approuve qu'une lettre rédigée par le Président et M. Boff soit envoyée à l'OEB pour demander que cette information soit retirée du site. La Commission de Rédaction est invitée à proposer une analyse des coûts d'obtention d'un brevet européen, laquelle serait réalisée par l'*epi*.

Le débat s'ouvre ensuite sur le questionnaire portant sur l'avenir du système des brevets en Europe, lequel a été soumis par la Commission européenne. Plus de 2000 réponses à ce questionnaire ont été retournées, 700 d'entre elles provenant du Forum Open source. Le débat public prévu à Bruxelles est reporté au 12 juillet. L'*epi* y sera représenté.

La Commission Ad Hoc qui avait été mise en place par le Président a poursuivi son travail depuis la dernière réunion du Conseil et élaboré un projet de lettre à l'attention du Président Pompidou et du Conseil d'Administration. Le Président Mercer remercie les membres de la commission Ad Hoc pour leur travail. Le principe de base est que le Conseil se concentre sur la stratégie de l'*epi* et qu'il délègue certains de ses pouvoirs au Bureau, ce qui assurerait flexibilité et continuité. A la fin du débat, le Conseil approuve au vote que la Commission Ad Hoc, en collaboration avec la Commission du Règlement intérieur, modifie le Règlement intérieur pour assurer que lesdits pouvoirs ne puissent être délégués qu'au Bureau. La Commission Ad Hoc poursuivra son travail en ce qui concerne d'autres points de discussion. Des rapports seront présentés pendant que la Commission continuera ses délibérations.

Une prise de position présentée par la Commission de Qualification Professionnelle est approuvée après discussion. La durée des sessions de l'examen de qualification donne lieu à un débat, ainsi que l'éventualité d'accepter un diplôme national comme équivalent de l'examen européen de qualification.

La proposition de diviser en deux parties l'épreuve D1 n'est pas reçue favorablement car le Conseil pense que cette mesure serait une charge supplémentaire pour les

candidats. La proposition que l'*epi* prenne en charge le Secrétariat d'examen est rejetée. Un groupe de travail pour la révision du Règlement de l'examen de qualification a été formé; l'*epi* continuera à apporter sa contribution.

Le rapport de la commission des Finances de l'OEB est examiné. Le débat sur la stratégie à l'OEB est en cours. L'actif et le passif de l'OEB sont assez bien équilibrés.

Suit un rapport sur la dernière réunion du Conseil d'Administration. L'*epi* n'est pas en faveur de la décentralisation.

La Commission de Conduite Professionnelle évoque un nouveau sujet, à savoir le blanchiment d'argent. Un rapport sera présenté lors d'une réunion ultérieure.

Le Conseil discute longuement le rapport de la Commission EPPC, particulièrement la CBE 2000 et les propositions de l'Office des brevets japonais pour une „New Route“ et un „Patent Prosecution Highway“. Le Conseil est contre la première proposition mais en faveur de la seconde. D'autres sujets, remis à l'EPPC pour examen, sont reportés à la prochaine réunion du Conseil à Istanbul.

Les rapports des autres commissions sont notés. M. T. Johnson présente au nom de la Commission de rédaction une nouvelle maquette de couverture pour la revue *epi* Information. Le Conseil serait en faveur d'une couverture gris-bleu, imprimée sur papier recyclable dont la couleur serait différente à chaque numéro. Un membre du Bureau persuade le Conseil que ces changements ne sont pas réalisables. Le Conseil est d'accord pour qu'une nouvelle proposition soit présentée à une réunion ultérieure du Conseil.

Il est convenu que toute proposition d'amendement au Règlement intérieur, faite par la Commission du Règlement intérieur, sera envoyée à la Commission Ad Hoc.

La prochaine réunion du Conseil (61ème réunion) se tiendra à Istanbul les 16 et 17 octobre 2006. Le choix du lieu pour la 62ème réunion du Conseil en Pologne ne fait pas l'unanimité. Le Conseil donne la préférence à Cracovie plutôt qu'à Varsovie.

Le Président clôt la séance après avoir remercié chaleureusement la délégation autrichienne pour l'organisation et le déroulement très réussis de la réunion.

## Projet de liste de décisions, 60ème réunion du Conseil Salzburg, 15-16 mai 2006

1. Un courrier sera adressé par le Président Mercer à l'OEB au sujet de la publication sur le site de l'OEB d'une information relative aux coûts d'un brevet européen. La Commission de Rédaction envisagera de publier sur le site de l'*epi* une version plus exacte.
2. La Commission Ad-Hoc pour la révision du règlement de création de l'*epi* inclura dans les amendements proposés à l'Article 9(1) du règlement de création une disposition précisant que les pouvoirs ne peuvent être délégués qu'au Bureau.

3. La proposition d'amendement aux Articles 8, 9 et 10 du Règlement de création de l'*epi* sera soumise au Conseil d'Administration de l'OEB.
4. Le Conseil est d'avis que le nouveau règlement intérieur devra inclure une disposition autorisant l'usage du vote électronique pour les décisions du Conseil.
5. La Commission de Rédaction, en collaboration avec la Commission du Règlement intérieur, donnera à la Commission Ad-Hoc les moyens nécessaires permettant une consultation par voie électronique sur la Révision du Règlement de création et recherchera des moyens permettant de mettre en place un vote électronique pour les décisions du Conseil.
6. Le Conseil approuve que la position de l'*epi* sur la Révision du Règlement relatif à l'examen de qualification soit envoyée à l'OEB, après que celle-ci ait été finalisée en prenant en compte les opinions exprimées par le Conseil.
7. La Commission EPPC est chargée de discuter avec l'OEB d'une possibilité de centralisation des divisions d'opposition.
8. La prise de position de l'*epi* sur la consultation par l'Office des brevets britannique au sujet du niveau du degré d'inventivité dans le droit des brevets et la pratique du brevet au Royaume Uni sera envoyée à l'Office des brevets britannique ainsi qu'à l'OEB.
9. La deuxième version de la prise de position de l'*epi* concernant la nouvelle numérotation du Règlement d'exécution de la CBE 2000 sera envoyée à l'OEB.
10. Le projet de prise de position de l'*epi* sur la proposition de l'Office des brevets japonais en faveur du „Patent Prosecution Highway“ ne sera pas envoyée pour le moment.
11. Le Conseil approuve de changer la date de la réunion du Conseil à Cracovie au 14-15 mai 2007 si des chambres d'hôtel sont disponibles à cette date.
12. Le budget révisé pour l'année 2006 est adopté.
13. Le Conseil approuve que le point 4 des règles relatives au paiement de la cotisation annuelle soit modifié comme suit: „... toute personne inscrite pour la première fois sur la liste des mandataires agréés après le 30 septembre“.
14. Les modifications apportées au formulaire d'autorisation de prélèvement pour le paiement de la cotisation annuelle sont adoptées.
15. Les comptes pour l'exercice 2005 sont approuvés et quitus est donné au trésorier.
16. Le Conseil se prononce contre la proposition de nouvelle maquette de couverture pour la revue *epi* Information.
17. Le Conseil approuve que la prise de position de l'*epi* au sujet du document CA/PL 12/06 „SPL- Views on further work“ soit envoyée à l'OEB.

## President's and Vice-Presidents' Report

C. Mercer (GB)  
President

Since the last Council meeting, I have attended the following meetings. Some of them give rise to points which are reported elsewhere and so are not reported here in detail.

FICPI Exco, Lisbon. A very good meeting with many interesting debates. I gave a short report on the activities of *epi* and our agenda. I have been invited to attend the FICPI Congress and Exco being held in Paris in May.

Meeting with M. Giroud, DG5, EPO regarding the Regulation for the EQE.

Trilateral Meeting. This was a meeting of the JPO, EPO and USPTO to discuss co-operation. The main item to note was that the JPO seems to have abandoned its „new route“ but has actively taken up the Patent Prosecution Highway. I attended a VIP dinner after the seminar where I was able to discuss various matters with members of the EPO.

EPO Academy Seminar on Quality. I gave a speech at the seminar and then was a member of a panel dis-

cussion on general matters of quality before the EPO. There were some interesting discussions and a booklet has been produced.

Meeting with M. Zilliox and Mr. Torlot of the Academy to discuss co-operation between *epi* and the Academy. EQE Diploma Award Ceremony.

Meeting with UNICE. I went to Brussels to meet the General Secretary of UNICE and his staff members who deal with IP. We had an interesting conversation and discussed possible co-operation. We noted that there are some areas where we have no real disagreement, for instance on the need to improve quality and efficiency at the EPO, but that there are also areas where there is less agreement, such as translation issues. I indicated that we would be pleased to co-operate but only on areas where there is a clear *epi* policy.

EPLAW Congress. This was interesting for two reasons, first because EPLAW is very much in favour of EPLA (which is rather surprising as it could mean less work for

them) and second because the keynote lecturer was Alison Brimelow. She set out her thoughts on the patent system in Europe and made particular reference to the state of the EPO and the Strategy Debate.

EPO Academy Seminar in Prague. The Academy organised a seminar in Prague for *epi* members and Patent Office employees from the new member states. The idea of the seminar was to determine what were the training requirements in those member states. Both Kim Finnilä and myself gave presentations and then chaired working groups. I believe that the seminar was successful and identified some clear training needs. The next thing we need to do, with or without the Academy, is to meet the training needs of the *epi* members.

EPO Administrative Council Meeting of October 2005. This was attended by Kim Finnilä and myself.

Working Party on Litigation. This meeting was not very long as although it had some real business to conduct. The meeting approved, with minor amendments, a number of changes to the EPLA needed to bring it into line with European law. The EU delegation made it plain that they are, contrary to previous indications, still not convinced that EPLA can go ahead at all and perhaps not even with the EU involved. However, the EU delegation did announce the Consultation Process. In the meeting UNICE, and a number of delegations, gave very forthright opinion that the EU was obstructing a very good system.

Meetings of Working Group on EQE. Mrs Kaminski, Mrs Linderoth, Mr Boyce and I have had a series of meetings with M. Giroud, Herr Machwirth and M. Zilliox to discuss ideas for reform of the EQE Regulation. These have also been discussed with the *epi* members of the EQE Board and their input will be given to the Working Party.

Meeting with EPO (Colin Philpott's group) on Quality. Mrs Leissler-Gerstl, Mrs De Carli, Mr Hatzmann and myself had a meeting with Colin Philpott and a number of people from his Quality Control Directorate to set up further meetings to discuss quality at the EPO. This was a rather indeterminate meeting as Mr. Philpott tried to keep the discussion at a high level and we as *epi* tried to also include more detailed discussions. The meeting was very useful as it set up a line of communication for complaints and it was also agreed that there would be regular meetings. After the meeting, I received an email from Mr. Philpott saying that he had changed his mind and that the meetings should also consider detailed points. EPPC will lead in dealing further with these meetings.

AIPLA Lecture. I gave a lecture to AIPLA on the European concept of unity of invention. This was received well and we have been asked to continue our co-operation with AIPLA. At another session of the AIPLA meeting, the USPTO gave a presentation at which

they made it clear that the situation at the USPTO is even worse than that at the EPO and that it is getting worse. They want to adopt a number of EPO procedures and laws but may not be able to because of the US Constitution.

Committee on Patent Law.

Meeting with the Patentanwaltskammer and VPP. This meeting was attended by Mr. Baum, Mr. Quintelier and myself. We discussed a number of topics of mutual interest and a number of topics where *epi* as a whole may not be totally in line with the thoughts of the Patentanwaltskammer and VPP. However, the meeting was very useful as it ensures that we can find out what at least a quarter of *epi* members are thinking.

PQC Seminar on Dealing with EPO Examination Reports in Eindhoven. PQC organised a seminar in Eindhoven, kindly hosted by Philips. This was a very successful event and attracted over 150 delegates, including some who travelled from distant places. It was interesting to note that the seminar was felt to be too simple for some and too complex for others. However, the format was very good and can easily be adapted to different levels. If any country or group of countries would like to have a re-run of the seminar, please let Mrs Kaminski know.

Supervisory Board of the Academy. This meeting preceded the March Council meeting by one day. However, due to heavy snow and bilateral meetings about the Strategy Debate, it did not begin until 15:30 and then the Chairman had to leave before the end of the meeting. It was generally a good meeting and the Board made it clear that they are going to keep a close eye on the Academy to ensure that it does not go beyond the bounds of its founding regulation and budget. I insisted that any actions the Academy takes in respect of training *epi* members or EQE students needed to have *epi* involvement at the earliest possible stage.

EPO Administrative Council Meeting of March 2006.

CEIPI Administrative Council.

IEEPI Administrative Council.

SACEPO Nominations – After consultation, I nominated the following to Prof. Pompidou: Mr. Finnilä, Mr. Nuss, Mr. Lyndon-Stanford, Dr. Leyder, Mr. Hössle, Mrs Papaconstantinou, Mr. Török, Mr. Armijo, Mr. Huygens and myself.

JURI Public Hearing.

I agreed with Mr. Maué and Mr. Armijo *epi*'s reply to the EU consultation.

A meeting of the Academic Advisory Board of the EPO Academy. This was also attended by Laurent Nuss.

Another meeting of the EQE Working Group.

A meeting of PQC and a meeting of PQC with the EQE Board.

The EU Inventor of the Year awards ceremony.

A meeting of the Swiss patent attorneys' federations in Berne.

## Treasurer's Report

C. Quintelier (BE)

### A. 2005 Accounts

The external and internal auditors have completed the 2005 accounts' audit.

The 2005 accounts show the following figures:

- 1) The number of *epi* members increased in 2005 by 394 and 8 136 members have paid their membership fees.
- 2) The fixed bank interests were about 10,000 € under budget, which reflects the low interest rates in 2005. On the other hand the DWS Investment were somewhat over budget, which was mainly due to a favorable disposal.
- 3) On tutorials a surplus of 5,524 € was realized, which could be seen as a real need from candidates for having a tutor.
- 4) Although no CPE seminar took place in 2005, the income is due to late payments of the Paris 2004 seminar. The 200 € on the CPE seminar expenses are due to a reimbursement to a participant.
- 5) As the CEIPI/*epi* litigation course is now on „cruising speed“ a different approach for accounting this course was chosen. All income and expenses over a same calendar year are now considered instead of splitting them over the two half-years on which the course runs. This approach requested however that the 31,500€ income set aside on the 2004 account for the 2004-2005 course was added to the 2005 income, leading to a total income of 92,653€. In 2005 more costs relating to this course showed up and have consequently been taken into account. The operational work for the *epi* secretariat was estimated at 5,000 €. The latter amount was then deducted from the personnel expenses (4.4).  
 The course showed in 2005 an expense of 65,233 €. If the 31,500 € of the 2004-2005 course would not have been added to the 2005 income of this course, the latter would have had a deficit of 4,080 €. As this course should from a financial point of view be a „neutral operation“ for the *epi*, and as more costs are generated by this course, it is proposed to raise the registration fee for the 2006-2007 course from 1,800 € to 2,000 €. In view of the quality of this course and taking into account that this is a 120 hours course, the requested registration fee of 2,000 € has still to be considered as very good value for money.
- 6) Council meeting costs are 10,317 € over budget and show an increase of 14 % over the 2004 Council meeting costs.

Board meeting costs are 6,421 € over budget and show an increase of 7 % over the 2004 Board meeting costs.

In view of those increased costs in Council and Board meetings, a cost control strategy should be applied.

- 7) Although Committees expenses are within the budget, they show an increase of costs of 31.5 % over the year 2004. The actual figures for the first quarter of 2006 show an increase in the number of working groups and the like. Committee chairpersons are kindly requested to inform the *epi* secretariat beforehand where and when such working groups meetings will take place and to indicate the name of the participants. The *epi* secretariat actually has some problems in identifying which item on the budget those meetings should be booked.
- 8) A substantial saving (21 %) was realized on phone, fax and e-mail costs due to a new contract with „Deutsche Telekom“.
- 9) Postage costs are 5,491 € over budget, which is mainly due to elections.

### B. Rules governing payment

The rules governing payment of the *epi* annual membership fee enable a „smart“ interpretation, which is used by some members. It has been observed that some members request their deletion before April 1 and then after September 30 ask for registration. In such a manner they don't have to pay their membership fee. This „carousel practice“ causes quite a lot of work to the *epi* Secretariat. In order to stop this practice it is proposed to amend § 4 of the rules by „a person is registered *for the first time* on the list of professional representatives after 30 September“.

### C. Direct debiting mandate

The direct debiting mandate also causes problems not only to the Secretariat, but also to the EPO as quite a lot of members complain about erroneous debiting. It is therefore proposed to change the direct debiting mandate.

### D. Eindhoven Seminar

On February 24, 2006 a seminar on „amendments“ was organised in Eindhoven. 154 participants registered and paid their registration fee of 200 €, which provided an income of 30.800 €. The total costs of this seminar were

at this stage of 21,661 €. The surplus will be used as reserve for further planned CPE seminars in 2006.

### E. 2006 Budget

The provision for SACEPO in the 2006 budget could be too high in view of the actual reform of SACEPO. Nevertheless it is proposed to keep it as such and wait for the first figures.

The 2006 budget has been revised in order to take into account the different approach applied on the CEIPI/epi litigation course. The costs of this course are now

budgeted on 70,000 €. The income side of the CEIPI/epi litigation course does not yet reflect the requested increase of 200 €, as this has first to be approved.

The post 10 under income has been revised and indicates now an amount of 50,000 € instead of 105,000 €. The reason for this revision is that the amount of 50,000 € is, in view of the actual 2004 and 2005 figures, probably closer to reality.

*Note: With respect to point 5, it has been discussed during the meeting that other solutions than an increase will be envisaged.*

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## epi Balance Statement on 31st December 2005

|   | €                   | <u>2004</u><br>T€ |
|---|---------------------|-------------------|
| <b>A. Fixed assets</b>                  |                     |                   |
| I. Intangible and tangible assets       |                     |                   |
| Office machines and equipment, Software | 1,-                 | —                 |
| II. Financial assets                    |                     |                   |
| Securities portfolio                    | <u>1.727.545,94</u> | <u>1.348</u>      |
|   | <u>1.727.546,94</u> | <u>1.348</u>      |
| <b>B. Receivables</b>                   |                     |                   |
| I. Others current assets                | <u>69.147,34</u>    | <u>102</u>        |
| II. Bank & Cash (incl. money deposits)  | <u>448.356,03</u>   | <u>641</u>        |
|   | <u>2.245.050,31</u> | <u>2.091</u>      |

## Liabilities

|                            | €                   | <u>2004</u><br>T€ |
|----------------------------|---------------------|-------------------|
| <b>A. Net assets</b>       |                     |                   |
| as of 01. 01. 2005         | 1.855.453,73        | 1.687             |
| results for the year       | 179.471,95          | 168               |
|                            | <u>2.034.925,68</u> | <u>1.855</u>      |
| as of 31. 12. 2005         | <u>2.034.925,68</u> | <u>1.855</u>      |
| <b>B. Debts</b>            |                     |                   |
| I. Provisions              | <u>28.400,00</u>    | <u>30</u>         |
| II. Liabilities            |                     |                   |
| 1. Deliveries and services | 2.472,10            | 2                 |
| 2. Others                  | 179.252,53          | 172               |
| 3. Prepaid fees            | —                   | 32                |
|                            | <u>181.724,63</u>   | <u>206</u>        |
|                            | <u>2.245.050,31</u> | <u>2.091</u>      |

## epi Expenses and Income 2005

|   | Budget 2004         | Actual 2004         | Budget 2005         | Actual 2005         | Shortfall in receipts<br>Surplus of expenditure<br>2005 | Surplus of receipts<br>Shortfall in expenditure<br>2005 |
|---|---------------------|---------------------|---------------------|---------------------|---|---|
|   | €                   | €                   | €                   | €                   | €   | €   |
| <b>I. Receipts/Income</b>   |                     |                     |                     |                     |   |   |
| 1. from Members   |                     |                     |                     |                     |   |   |
| a. Subscriptions  | 1.120.500, -        | 1.156.350, -        | 1.200.000, -        | 1.220.400, -        | -,-   | 20.400, -   |
| b. Late payment increment   | 15.000, -           | 12.650, -           | 20.000, -           | 10.700, -           | 9.300, -  | -,-   |
| c. Abandonment of unpaid subscriptions<br>(incl. subscriptions now recovered) | ./.                 | ./.                 | ./.                 | ./.                 | -,-   | 55.675,01   |
| 2. Interests  | 55.000, -           | 60.328,16           | 75.000, -           | 68.820,30           | 6.179,70  | -,-   |
| 3. CPE-Seminars   | 20.000, -           | 30.794,50           | 10.000, -           | 5.830, -            | 4.170, -  | -,-   |
| 4. CEIPI  | 30.548, -           | 62.033,43           | 31.500, -           | 92.653,50           | -,-   | 61.153,50   |
| 5. Others   | 36.500, -           | 40.761,61           | 27.500, -           | 34.050,12           | -,-   | 6.550,12  |
|   | <u>1.202.548, -</u> | <u>1.316.000,51</u> | <u>1.272.000, -</u> | <u>1.396.128,93</u> | <u>19.649,70</u>  | <u>143.778,63</u>                                       |
| <b>II. Expenses</b>   |                     |                     |                     |                     |   |   |
| 1. Meetings   |                     |                     |                     |                     |   |   |
| Council   | 288.000, -          | 263.258,19          | 290.000, -          | 300.317,35          | 10.317,35   | -,-   |
| Board   | 46.000, -           | 50.697,07           | 48.000, -           | 54.421,55           | 6.421,55  | -,-   |
| Committees  | 148.000, -          | 109.629,20          | 168.000, -          | 138.900,80          | -,-   | 29.099,20   |
| Delegates & Others  | 39.000, -           | 33.537,97           | 44.000, -           | 35.301,71           | -,-   | 8.698,29  |
| 2. Other performances   |                     |                     |                     |                     |   |   |
| epi Information   | 60.000, -           | 71.419,32           | 76.000, -           | 71.466,95           | -,-   | 4.533,05  |
| By-Laws & non-foreseeable   | 2.500, -            | -,-                 | 1.000, -            | -,-                 | -,-   | 1.000, -  |
| Promotional Activities<br>(incl. epi-Brochure)                                | 30.000, -           | 19.970,65           | 27.000, -           | 12.345,93           | -,-   | 14.654,07   |
| CPE-Seminars  | 20.000, -           | 17.548,97           | 10.000, -           | 200, -              | -,-   | 9.800, -  |
| CEIPI   | 47.198, -           | 48.673,39           | 31.500, -           | 65.233,50           | 33.733,50   | -,-   |
| Project PQC   | 15.000, -           | 19.259,50           | -,-                 | -,-                 | -,-   | -,-   |
| Examination Committee Dinner  | 2.000, -            | 4.244,14            | 3.000, -            | 3.845,95            | 845,95  | -,-   |
| 3. President (+ Vice President)   | 27.000, -           | 18.635,23           | 27.000, -           | 25.243,53           | -,-   | 1.756,47  |
| 4. Treasurer and Treasury   |                     |                     |                     |                     |   |   |
| Treasurer and Deputy  | 7.000, -            | 4.367,01            | 5.000, -            | 4.884,48            | -,-   | 115,52  |
| Bookkeeping / Audit   | 17.000, -           | 27.919,36           | 20.000, -           | 20.588,56           | 588,56  | -,-   |
| Bank charges  | 9.000, -            | 6.310,93            | 17.000, -           | 8.435,54            | -,-   | 8.564,46  |
| 5. Secretariat  |                     |                     |                     |                     |   |   |
| Expenditure on personnel  | 296.000, -          | 288.241,99          | 306.000, -          | 296.061,62          | -,-   | 9.938,38  |
| Expenditure on materials  |                     |                     |                     |                     |   |   |
| Rent  | 85.066, -           | 84.661,36           | 86.710, -           | 87.599,89           | 889,89  | -,-   |
| Phone, Fax, e-mail  | 9.000, -            | 6.782,45            | 9.000, -            | 5.585,26            | -,-   | 3.414,74  |
| Postage   | 30.000, -           | 27.634,29           | 30.000, -           | 35.491,29           | 5.491,29  | -,-   |
| Office supplies/Representation  | 13.000, -           | 16.086,07           | 13.000, -           | 13.568,17           | 568,17  | -,-   |
| Maintenance/Repair<br>(incl. Copy, print)                                     | 12.000, -           | 16.154,16           | 15.000, -           | 16.797,15           | 1.797,15  | -,-   |
| Insurances  | 1.000, -            | 956,66              | 1.000, -            | 529,30              | -,-   | 470,70  |
| Secretary General and<br>Deputy   | 2.000, -            | 2.234,20            | 5.000, -            | 3.851,49            | -,-   | 1.148,51  |
| Travel personnel  | 1.000, -            | 893,30              | 1.000, -            | 540, -              | -,-   | 460, -  |
| Training  | 1.000, -            | 778,90              | 1.000, -            | 774,90              | -,-   | 225,10  |
| Acquisitions  |                     |                     |                     |                     |   |   |
| Office machines<br>incl. Soft-/Hardware                                       | 8.000, -            | 4.668,91            | 6.000, -            | 3.923,07            | -,-   | 2.076,93  |
| Office equipment  | 2.000, -            | 1.543,60            | 25.000, -           | 10.569,38           | -,-   | 14.430,62   |
| 6. Extraordinary expenses   | -,-                 | 1.454,01            | -,-                 | 179,61              | 179,61  | -,-   |
|   | <u>1.217.764, -</u> | <u>1.147.560,83</u> | <u>1.266.210, -</u> | <u>1.216.656,98</u> | <u>60.833,02</u>  | <u>110.386,04</u>                                       |
| <b>III. Surplus of receipts/<br/>expenses</b>                                 | ./.                 | ./.                 | ./.                 | ./.                 | Surplus:  | Surplus:  |
|   | <u>15.216, -</u>    | <u>168.439,68</u>   | <u>5.790, -</u>     | <u>179.471,95</u>   |   | <u>173.681,95</u>                                       |

# Report of the epi Finance Committee

P. Weyland (LU)  
Chairman

The Committee reviewed the audited accounts for 2005 in the context of the financial results of the previous financial years, both in absolute values and in relation to the number of members. The Committee noted with satisfaction that costs of the major expense accounts on a „per member“ basis remained substantially constant.

The Committee assembled and reviewed charts showing the actual number of members from 1978 to 2005 and showing the trends for the years 2006 to 2010 in the various member states. These trends are based on estimates given by the Board members for their respective member states. A cumulative chart is shown below.

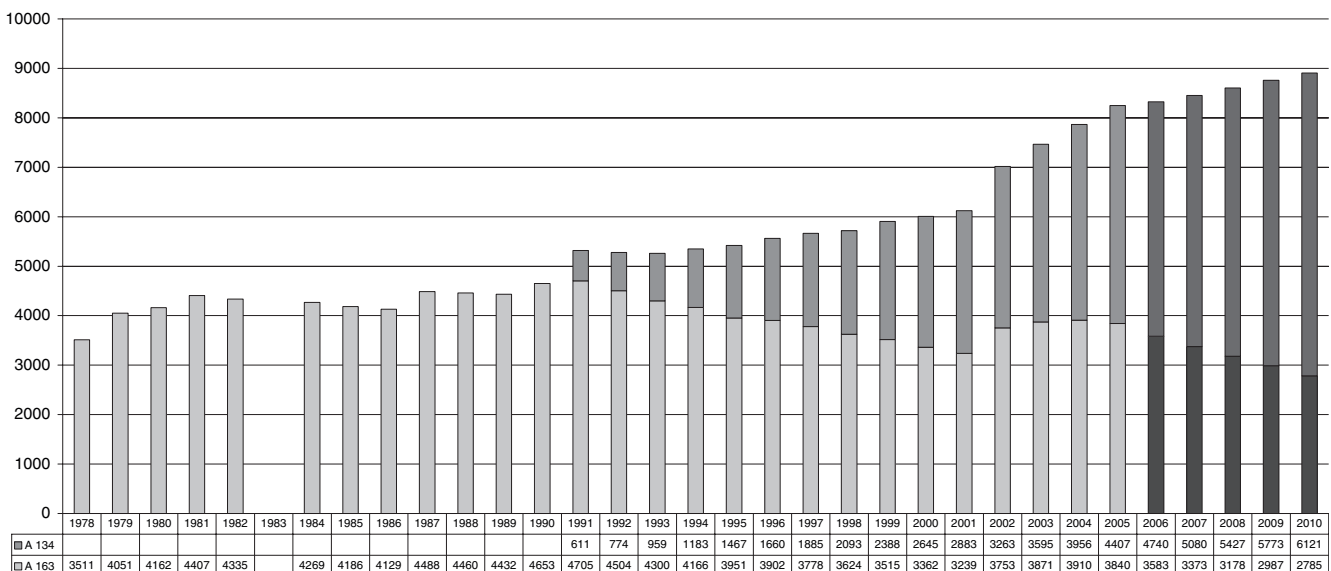
The Committee also drafted model budgets for the years 2006 to 2010. These are based, on the income side, on the estimates obtained for the number of members to be expected in the years 2006 to 2010, current return on investment and a subscription fee at current level. On the expense side, a moderate increase of expenses is assumed.

Given the fact that a Council decision requires that *epi's* assets amount to at least 1.5 times the annual expense, the Committee is of the opinion that *epi* is in a position to maintain, in the short term, the current membership fee at its present level.

## epi membership (all states) (as per 31 December)

1978–2005 actual; 2006–2010 estimated

N.B.: 1983 not available, split A134 / A163 available only as of 1991





## Report of the European Patent Practice Committee (EPPC)

E. Lyndon-Stanford (GB)  
Chairman

### 1. Draft Directive on Criminal Measures for Enforcement of IPR (COM(2006)168 final)

The EPPC will study and prepare a position paper for despatching to appropriate bodies.

### 2. Centrally-administered European Patents (part-harmonisation of European Patents)

Last year, during the UK presidency of the EU Council, it was suggested to the UK PO that the deadlock regarding the Community patent project could be resolved by an EU Regulation under Article 95 EC Treaty (so not requiring unanimity) to provide for a centralised administration of European patents granted for EU states, and that this should be supplemented by the EPLA to provide for a European patent litigation system. At the October 2005 Council meeting, Council voted against approval of the suggestion. It was reported to the UK PO that the *epi* did not support the suggestion.

The EPPC meeting of November 2005 decided that the EPPC should look into the merits of the suggestion, and a large ad-hoc sub-group was established for this purpose. During the debate in this ad-hoc sub-group, there was a considerable majority against a centralised administration of granted European patents, principally because this would reduce the importance of national patent offices in Europe. Council did not request the EPPC to further discuss the matter and it will be dropped.

### 3. The European Commission Consultation (Questionnaire) on future patent policy in Europe

The response was due by 31<sup>st</sup> March 2006. The EPPC prepared a draft response which was sent to the Board on 12<sup>th</sup> February 2006 and after the March 2006 Board meeting, revised by a small sub-group drawn from the Board and delivered to the Commission as the *epi* response. The *epi* response is set out below.

### 4. The UK PO Consultation on the inventive step requirement in United Kingdom patent law and practice

The response is due by 31<sup>st</sup> May 2006. A draft paper was presented and approved by Council. The paper will be reviewed by the EPPC and sent to the UK PO, with a copy for the EPO. At its next meeting, the EPPC will consider whether a deeper study should be made of inventive level requirements in EPO practice.

### 5. The coming into force of EPC 2000 on 13<sup>th</sup> December 2007 (or possibly earlier)

The first draft of the Amendments to the Implementing Regulations was issued as document CA/PL 11/06. This draft was discussed in the Committee on Patent Law on 2<sup>nd</sup> and 3<sup>rd</sup> May 2006 and will be considered by SACEPO on 22/23 June 2006. The draft will be further considered by the Committee on Patent Law in October 2006 and will then be submitted to the EPO Administrative Council meeting in December 2006 for approval and authorisation. The EPPC will study and advise on the amended Implementing Regulations and the EPPC will study and advise on the examination guidelines when the EPO communicates its detailed proposals on them. In association with the PQC, the EPPC will consider what can be done to up-date practising EPA's.

Though not fundamental, a controversial issue arose in connection with the Amendments to the Implementing Regulations. The EPO is proposing to renumber the Regulations so that there is a full sequence of numbers. Council was strongly against renumbering. As a result, a letter over the signature of the *epi* President is to be sent to the EPO. The text of the letter is set out below.

### 6. The Paris criteria (time taken to grant patents)

The Paris criteria include the aim of granting patents within three years of the effective filing date. This question has not been formally considered by the EPPC. There are very divergent opinions with the *epi*. At its next meeting, the EPPC will consider whether it is worthwhile ascertaining the EPPC or *epi* view on whether we should aim to have the EPO grant patents within three years of the effective filing date. However, the EPPC will in any case consider what measures that can be taken to shorten the period to grant.

### 7. The „Trilateral“ Prosecution Highway (the Japanese proposal)

Comments prepared by the EPPC PCT Sub-Group were submitted, saying that the *epi* welcomes the Japanese proposal but some refinements are required. However, a further Japanese proposal is to be taken into account and the EPPC will make a further study.

#### 8. *G01/05, G01/06 and G03/06 – Divisionals – Amicus Curiae brief*

A brief and a supplementary brief were filed in relation to G01/05. Since filing the *epi* briefs, cases G 01/06 and G03/06 have been consolidated with the first case. All the cases relate to the inclusion of extra subject matter in divisional applications. The *epi*-EPO Liaison Sub-Group is drafting a further *amicus curiae* brief. The main brief and the supplementary brief are set out below.

#### 9. *The EPLA, and the attitude of the EU Commission*

The United Kingdom, in its function as EU President, stated at the last meeting of the Working Group (14<sup>th</sup> December 2005) that it intended as soon as possible to reach a position where the EPLA was put to a diplomatic conference. The European Commission stated that it intended to launch wide consultations during which industry and member states would be consulted on how to improve patent litigation arrangements, and that after the summer break, it would submit proposals to the Council of Ministers and to the European Parliament. However, the Commission stated that it was unable to commit itself to any particular action until the completion of the consultation. The EPPC will continue to monitor developments.

#### 10. *Representation before the EPLA courts*

The draft EPLA is explicit that EPA's can speak in the courts when assisting the representative. The draft court rules of procedure have not yet been issued, but will specify who can represent. The EPPC will give consideration as to what other steps can be taken at the present time.

#### 11. *EPO-epi Partnership for Quality*

The Partnership for Quality is a new entity and should improve contacts with the EPO. A report on the first

meeting was given to Council. The entity will provide less formal meetings for discussion of problems arising in practice.

#### 12. *PCT Reform Working Group Meeting, 8<sup>th</sup> to 12<sup>th</sup> May 2006*

Mr. Paul Rosenich gave a brief report. Some of the items relate to apparently minor technical aspects such as the size of the type-face in published PCT specifications but can have significant consequences such as greatly increasing the number of pages in the published specifications, other items are more important for practice, such as the possibility of requesting the additional search only after the receipt of the standard search. The EPPC is making a further study with a view to providing comments to the International Bureau.

#### 13. *SACEPO/PDI Meeting 23rd March 2006, PDG Impact Meeting, 30<sup>th</sup> and 31<sup>st</sup> March 2006*

The meetings were attended on behalf of the *epi*, and reported on, by Mr. Indahl. The meetings were primarily concerned with technicalities of searching, but it was noted that the EPO is looking to introduce on-line filing of oppositions later in 2006 and on-line filing of appeals in 2007.

#### 14. *epi-EPO Liaison Meeting (Meeting with DG1 & DG2), 13<sup>th</sup> January 2006*

An oral report was given. Amongst the issues discussed were procedures under Rule 51/4, the scheduling of oral proceedings, the new qualitative management system for monitoring decisions of examiners, the Paris criteria (the time taken to grant patents, see above) and translation of cited Japanese documents, as well as some minor matters concerning the convenience of those attending oral proceedings.

## Response to Questionnaire on the patent system in Europe

This response is sent on behalf of the Institute of Professional Representatives before the European Patent Office, usually referred to as „*epi*“. All European Patent Attorneys who are entered on the List of Representatives maintained by the European Patent Office (EPO) are members of *epi*. Currently, *epi* has over 8,000 members from 31 countries, including all the member states of the

EU. Members of *epi* predominantly work either within industrial patent departments or within private practice. Almost all *epi* members are also members of professional organisations within their own countries and a large number of *epi* members are also members of international organisations. Thus, *epi* members have a very good overview of the patent system in Europe.

## Section 1 – Basic principles and features of the patent system

### 1.1 Do you agree that these are the basic features required of the patent system?

- The features mentioned in Section 1 of the Questionnaire are indeed relevant.

### 1.2 Are there other features that you consider important?

- EU legislation on IPRs should be fully compliant with the WTO TRIPs Agreement. It is observed that the WTO TRIPs Agreement is already based on the appropriate balance of interests of the right holders with the overall objectives of the patent system.

### 1.3 How can the Community better take into account the broader public interest in developing its policy on patents?

- It is clear that patent quality should be put high on the agenda. The Member States and the European Commission should work with the European Patent Office so as to ensure that the validity of granted national and European patents is as incontestable as practically possible. Only then will the patent system be credible with society. However, it is believed that no new EU legislation or other EU legal instruments are required for this purpose.
- The possibilities for SMEs to benefit from the patent system should be improved. They should be assisted as regards finding prior art to determine whether it makes sense to file patent applications for their own inventions, as regards entering the patent system, e.g. by means of subsidies for the first 10 patent applications they file, and as regards finding what has already been patented by their competitors. National patent offices should play an important role as regards such support for SMEs.
- Several currently available instruments already provide the basis for paying due regard for other public policy interests, such as competition (anti-trust), ethics, environment, healthcare, access to information, so as to be effective and credible within society. For example:
  - Articles 81 and 82 EC Treaty provide the tools to deal with anti-trust issues;
  - Article 53 European Patent Convention (EPC) outlaws patents in respect of inventions the publication or exploitation of which would be contrary to „ordre public“ or morality;
  - Article 31 WTO TRIPs Agreement provides for compulsory licences to ensure that patents essential for environment and healthcare can be used even if the patentee does not agree;
  - Article 93 EPC provides that all European patent applications are published 18 months from the priority date. These publications can be retrieved and searched by means of free and user-friendly web-access;

- Article 128 EPC provides that the file of a European patent application is accessible to the public via free and very user-friendly web-access as from this publication date;
- Article 115 EPC provides that any person may file observations with the European Patent Office (EPO) concerning patentability as from the publication date
- Article 99 EPC provides that all granted European patents may be revoked by the EPO as a result of an opposition filed by any person if the patent does not meet essential patentability criteria; and
- Article 138 EPC provides that all granted European patents may be revoked by national courts if the patent does not meet essential patentability criteria.

## Section 2 – The Community patent as a priority for the EU

### 2.1 By comparison with the common political approach, are there any alternative or additional features that you believe an effective Community patent system should offer?

*epi* considers that a common patent system for the common market, a greater legal certainty through a unified jurisdiction and a stronger link between the EU and the European Patent Organisation are strongly desired. Also, *epi* appreciates that any Community patent system must respect the basic principles of equal rights among all European citizens and of complementarity and subsidiarity. Further, *epi* is aware that a Community patent system will only be successful if applicants will regard the Community patent system as a cost-effective alternative to the present EPC and national patent systems.

However, *epi* believes that it makes no sense to put efforts in the Community patent project on the basis of the March 2003 political approach as it seems unlikely that this approach will allow unanimity, which is required to bring the Community Patent Regulation into effect.

If further efforts were to be put in to the Community patent project, *epi* is of the opinion that:

- There should be no need to await an EPC amendment;
- There should be no transfer of search activities to national patent offices, especially to those not meeting the minimum requirements of Rule 36 PCT; and
- As patents relate to technical subject matter and patent disputes relate mainly to deciding on technical questions, it should be required that at least one technically educated person should be a full judge in any court which deals with Community patents. Moreover, it should be required that any party to any such patent dispute should be represented by a technically qualified representative.

In view of the above, we call upon the EU to develop an alternative to the March 2003 political approach that would meet the above-mentioned requirements of legal

certainty and stronger links<sup>1</sup> between the EU and the European Patent Organisation.

### Section 3 – The European Patent System and in particular the European Patent Litigation Agreement

First, epi would like to make a general remark on the European Patent Litigation Agreement (EPLA). We are well aware that opinions are divided on this issue. Some believe that the EPLA is urgently needed so as to bring uniformity into the application of European patent law in an affordable and expedient manner that focuses on a high quality of decisions by selecting experienced judges, including at least one technically educated judge, for this specialized court system. Others believe that the EPLA does not match some of today's realities, such as the fact that national states are responsible for European patents once they are granted, and they feel that some measures included in the EPLA so as to ensure affordability and expedience would deviate from the diversity of today's Europe.

We believe that both views are accommodated by the fact that the EPLA is and should remain an optional agreement and that each EPC state should make its own assessment as to whether it would like to join this affordable, expedient and specialized court system (as a full member or just the Facultative Advisory Council part of it) or whether it feels that this system does not match its views as to how patent litigation should be organized in that particular state.

epi believes that no state should be obliged to join the EPLA while all states should be free to join the EPLA as it is currently proposed, with all characteristics that ensure affordability, expedience and quality, even if such characteristics do not match all aspects of the diversity of today's Europe.

Issues:

(1) *the text of the Agreement has to be brought into line with the Community legislation in this field.*

- It is noted that the draft EPLA is already being brought into line with existing Community legislation and that the Commission has been invited to participate as observer. Thus, the Commission already has had and will continue to have ample opportunity to make any and all necessary observations.

(2) *the relationship with the EC Court of Justice must be clarified.*

- Fully in line with ECJ decision C-337/95<sup>2</sup>, Article 40 of the present draft of the EPLA already provides

<sup>1</sup> These stronger links result from the fact that if the European Patent Office carries out activities for EU Member States as regards granted European patents, it will do so on the basis of Articles 142-149 European Patent Convention (EPC). Article 145 EPC provides for a Select Committee of the Administrative Council of the European Patent Organisation to supervise such activities. As a matter of course, the European Commission will be a full member of this Select Committee, which will further comprise representatives from the EU Member States. This was, for example, explicitly provided for in both the 1975 Community Patent Convention and the 1989 Agreement on Community Patents.

that EPLA Contracting States which are also Member States of the European Community designate the EPLA Court as their national court for the purposes of Article 234 of the Treaty establishing the European Community. This means that, just like the Benelux Court of Justice does as per C-337/95, the EPLA courts will refer questions on EU law to the ECJ. The preliminary rulings of the Court of Justice of the European Communities shall be binding on the EPLA Court in so far as the latter's decisions take effect in one or more of the Contracting States which are also Member States of the Community.

(3) *the question of the grant of a negotiating mandate to the Commission by the Council of the EU in order to take part in negotiations on the Agreement, with a view to its possible conclusion by the Community and its Member States, needs to be addressed.*

- What is needed is that the EPLA does not deviate from EU law. For that purpose, an observer role for the European Commission suffices.
- It is an essential feature of the EPLA that it is optional: those EPC states that do not wish to join are not obliged to join. This optional character makes it possible to obtain an agreement that makes sense, whereas compulsory participation by states that do not like the principles on which the current draft EPLA is based would easily result in negotiations ending up in an agreement that no longer is practical, as proven by the example of the March 2003 political approach on the Community patent.
- While it is desirable that as many states as possible join the EPLA, it is more important that the EPLA remains practical. Therefore, in further negotiations, no changes whatsoever should be made to the essential features of the current draft of the EPLA, such as a full participation of technically educated judges. It is better that states that do not like the EPLA's essential features do not join the EPLA than that the EPLA is modified by replacing the EPLA's essential features by more complicated features.
- In view of ECJ decisions C-22/70<sup>3</sup>, C-337/95<sup>4</sup> and Articles 38-40 of the present draft of EPLA, the EU

<sup>2</sup> ECJ decision C-337/95 deals with the Benelux Court of Justice, which supervises inter alia the Benelux trademark and design laws, which are subject to EU harmonizing directives. In that decision, the ECJ equated the Benelux court, which is a supranational court common to Belgium, Luxembourg and The Netherlands, to national courts for the purpose of applying Article 234 EC Treaty.

<sup>3</sup> In paragraph 81 of decision C-22/70, the ECJ decided that, if the Community only acquires competence when the negotiations about a treaty are already advanced, it does not make sense to shift competence from the Member States to the Community, so that in such a case, the Member States retain their competence. Therefore, even if the EPLA conflicts with Regulation 44/2001 (which does not apply in view of ECJ decision C-337/95 and Articles 38-40 EPLA), so that in principle competence to agree on the EPLA would indeed have shifted to the Community, this does not apply because the EPLA negotiations started in 1999 with the Paris ministerial conference of the EPC states, while Regulation 44/2001 was only adopted in 2001, and today the EPLA negotiations are about finished.

<sup>4</sup> In the same manner as in ECJ decision C-337/95, Articles 38-40 EPLA equate the EPLA courts to national courts of the EPLA states so as to enable undisturbed application of Regulation 44/2001 and Article 234 EC Treaty. Therefore, to the extent that Regulation 44/2001 accords jurisdiction to the courts of an EPLA state, the EPLA courts have jurisdiction, while to the extent

Member States have retained competence to negotiate on and conclude the EPLA without involvement from the European Commission.

### Questions

*3.1 What advantages and disadvantages do you think that pan-European litigation arrangements as set out in the draft EPLA would have for those who use and are affected by patents?*

Reference is made to the document „Assessment of the impact of the European patent litigation agreement (EPLA) on litigation of European patents“ drawn up by the Secretariat of the EPO Working Party on Litigation on 01.12.2005.

The main advantages seen by the states which would join the EPLA if it were to come into force are that:

- It will provide a single forum in which to settle patent disputes related to patents granted by the EPO. This will avoid the need for costly litigation in a number of countries where the same issues are at stake.
- For both plaintiffs and defendants, it is strongly desirable for patent litigation to be handled by experienced courts in an efficient manner. The EPLA provides for just that.
- Language issues will be simplified.

The main disadvantages seen by the states which would not join the EPLA are that:

- It may be necessary for the defendant (or, potentially, both the defendant and the plaintiff) to carry out litigation on a patent, and using a procedure, which is in a language which is not his native language and before a Court where the judges may not know that native language, thus putting the party at a disadvantage because he may not be able to understand the language of the proceedings.
- It may be necessary for the defendant (or, potentially, both the defendant and the plaintiff) to carry out such litigation outside their country of domicile, which may incur significant cost.

The majority of *epi* members are located in states which would join the EPLA if it were to come into force and are in favour of EPLA. However, *epi* also takes very seriously the views of its members from the states which would not join the EPLA and fully respects their right to opt out of the EPLA because they see that the disadvantages outweigh the advantages.

*3.2 Given the possible coexistence of three patent systems in Europe (the national, the Community and the European patent), what in your view would be the ideal patent litigation scheme in Europe?*

- National patents should remain subject to the jurisdiction of national courts. It is noted that the EPLA contains features allowing national judges to obtain more experience in handling patent matters by

participation as judges or assessors in the EPLA courts.

- In an ideal world, all patents granted by the EPO should be subject to a single jurisdiction so as to promote uniform application of the law throughout the member states of the EU and the member states of the EPC. However, it seems to *epi* that the ideal world is unlikely to come into existence soon. There seems little chance of a Community patent court coming into existence. Even if it did, there may be problems with non-EU member states agreeing to be bound by decisions of such a Community patent court. Moreover, any Community patent court would only have jurisdiction over Community patents and so would not address the problem in relation to the very large number of existing and future European patents. In light of this, *epi* suggests that the practical way forward is for the Commission to promote the EPLA, while stressing its optional nature.

As the EPC itself has grown from a very small initial number of 7 Contracting States to the current number of 31 Contracting States, and more states are expected to join the EPC in the future, it is not believed to be a problem that, initially, the EPLA may not cover all EU Member States.

Regulation 44/2001 and the Lugano Convention should govern the relations between the states that join the EPLA and the states that do not join the EPLA.

Introducing the EPLA would also result in that the EU fulfils its obligations under Article 41(2) TRIPs Agreement<sup>5</sup> regarding the way in which European patents are litigated. In view of this, *epi* considers that the EPLA should enter into force.

To accommodate those European companies whose language is not one of the three official languages of the EPC, provisions along the lines of Article 14 and Rules 1, 2, and 5-7 EPC should be included into the EPLA's Rules of Procedure. It is noted that these provisions have worked satisfactorily in the EPC context, so that they should work similarly satisfactorily in the EPLA context.

## Section 4 – Approximation and mutual recognition of national patents

*4.1 What aspects of patent law do you feel give rise to barriers to free movement or distortion of competition because of differences in law or its application in practice between Member States?*

- Although at the present time the national patent laws of all EU Member States have been harmonized with the EPC, the mere facts that European patents do not generally apply to all or most EU Member States, and that there is no European patent litigation system, result in distortions of the Internal Market that make intra-Community trade

that Regulation 44/2001 accords jurisdiction to the courts of a non-EPLA state, those national courts have jurisdiction.

<sup>5</sup> Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

more complicated. A European patent litigation system such as the EPLA or a future Community patent court would ensure that the harmonized aspects of European patent law are applied in a uniform way by judges responsible for deciding on both facts and law.

#### 4.2 To what extent is your business affected by such differences?

- The businesses represented by European Patent Attorneys are substantially affected by these differences.

#### 4.3 What are your views on the value-added and feasibility of the different options (1) – (3)?

*(1) Bringing the main patentability criteria of the European Patent Convention into Community law so that national courts can refer questions of interpretation to the European Court of Justice. This could include the general criteria of novelty, inventive step and industrial applicability, together with exceptions for particular subject matter and specific sectoral rules where these add value.*

- There is no need whatsoever for such measures. It is noted that the EPLA will already provide a unified litigation system for European patents in those states which join the EPLA, which will result in European case law for those states on all relevant patentability aspects.
- The EPLA also provides for a second-tier system for those EPC states that do not want to transfer jurisdiction to the EPLA courts but who nevertheless want to obtain advice from the EPLA appeal court.
- It is observed that the referral procedure of Article 234 EC Treaty only allows the ECJ to give rulings on the law, while the application of that abstract law to the facts of the case remains the responsibility of the national courts. In view thereof, a fuller degree of uniformity in those states which join the EPLA is achieved by allowing a single European Patent Judiciary as provided by the EPLA to rule on both facts and law.
- If a Community patent court were to come into existence, it would also have the effect of providing a fuller degree of uniformity on all relevant patentability aspects.
- If the EPLA courts need to refer questions on basic patentability matters like novelty and inventive step to the ECJ, all patent litigation will be extremely complicated, costly and lengthy.
- The EPLA is called into being in order to transfer jurisdiction in complicated patent matters to a specialized court experienced in such matters. It is submitted that the ECJ does not meet these requirements.

*(2) More limited harmonisation picking up issues which are not specifically covered by the European Patent Convention.*

- Again, there is no need whatsoever for new EU measures aiming at substantive patent law harmonization.
  - It is noted that already from 1963 a Council of Europe convention harmonizes substantive patent law in Europe.<sup>6</sup>
  - All 31 EPC states are party to the UN Patent Cooperation Treaty, of which Article 27 provides that the PCT criteria as to form and contents also apply in national phase.
  - The EPC provides that the post-grant revocation grounds for European patents are laid down in the EPC itself.
  - In the framework of signing the 1975 Community Patent Convention (CPC), there has been a joint resolution of then 9 EC Member States to adjust national patent laws so as to allow for ratification of the Strasbourg Convention and to adapt these national laws to the EPC, the CPC and the PCT. This resolution has been implemented.
  - In the framework of the signing of the 1989 Agreement on Community Patents (ACP), there has been a joint declaration of the then 12 EC Member States noting that, since the signing of the Community Patent Convention of 15 December 1975, legislative procedures have been completed in several Member States with a view to eliminating as far as possible the differences between national patent law and the common system of law for patents resulting from the said Convention.
  - Another joint declaration took note of the undertaking by the Government of each Member State in which these procedures have not been completed or are yet to be begin, to endeavour to adjust its law relating to national patents so as to bring it into conformity, as far as practicable, with corresponding provisions of the European Patent Convention, the Agreement relating to Community Patents and the Patent Cooperation Treaty. This declaration has been implemented.

In view of all these already existing harmonization measures in Europe, there is no need whatsoever for new legislative measures aiming at substantive patent law harmonization in Europe.

It is noted that the European Parliament has rejected the draft directive on the patentability

<sup>6</sup> 1963 Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention. This convention covers prior art, novelty, inventive step, industrial applicability, exceptions for public order, and plant or animal varieties and essentially biological processes, sufficiency of disclosure, and states that the extent of protection is determined by claims.

of computer-implemented inventions. It is not considered meaningful to restart that debate.

(3) *Mutual recognition by patent offices of patents granted by another EU Member State, possibly linked to an agreed quality standards framework, or „validation“ by the European Patent Office, and provided the patent document is available in the original language and another language commonly used in business.*

- As mentioned above, patent quality is of the utmost importance. In view thereof, it is simply not acceptable to transfer essential activities in the substantive examination process to national patent offices, especially those that do not meet the minimum requirements of Rule 36 Patent Cooperation Treaty. Without a good search for relevant prior art documents, it is simply not possible to obtain a high-quality patent.
- Moreover, several EU Member States have national patent offices that grant a patent without any substantive examination whatsoever, or where the results of a novelty search do not influence the possibility to obtain a patent based on the application as filed, even if the search results clearly show that essential patentability requirements have not been met. Clearly, such rubber-stamped applications cannot be recognized in other states, as this would seriously undermine the possibilities to do business in a normal way.
- There is no need whatsoever to reinvent the EPC. While there is a need to pay more attention to patent quality, it is essential to maintain the basic feature that a European patent is only granted after a uniform European substantive examination has shown that all patentability criteria have been met.

*4.4 Are there any alternative proposals that the Commission might consider?*

epi believes that no alternative proposals need to be considered.

## Section 5 – General

*We would appreciate your views on the general importance of the patent system to you.*

*On a scale of one to ten (10 is crucial, 1 is negligible):*

For those businesses represented by European Patent Attorneys, the following answers are in general indicative of the various importances:

*5.1 How important is the patent system in Europe compared to other areas of legislation affecting your business?*

– 9

*5.2 Compared to the other areas of intellectual property such as trade marks, designs, plant variety rights, copyright and related rights, how important is the patent system in Europe?*

– 9

*5.3 How important to you is the patent system in Europe compared to the patent system worldwide?*

– 9

Furthermore:

*5.4 If you are responding as an SME, how do you make use of patents now and how do you expect to use them in future? What problems have you encountered using the existing patent system?*

– N/A

*5.5 Are there other issues than those in this paper you feel the Commission should address in relation to the patent system?*

– No

*(1) If you would like the Commission to be able to contact you to clarify your comments, please enter your contact details.*

*(a) Are you replying as a citizen/individual or on behalf of an organisation?*

As an organisation

*(b) The name of your organisation/contact person:*

The Institute of Professional Representatives before the European Patent Office (epi)

Mr. Chris P. Mercer – President

*(c) Your email address:*

cpm@carpmaels.com

*(d) Your postal address:*

epi Secretariat, PO Box 26 01 12, D-80058, Munich, Germany

*(e) Your organisation's website (if available):*

**(2) Please help us understand the range of stakeholders by providing the following information:**

*(a) In which Member State do you reside/are your activities principally located?*

All member states

*(b) Are you involved in cross-border activity?*

Yes

*(c) If you are a company: how many employees do you have?*

Our organisation has over 8,000 members

*(d) What is your area of activity?*

Patent attorneys

*(e) Do you own any patents? If yes, how many? Are they national/European patents?*

*(f) Do you license your patents?*

*(g) Are you a patent licensee?*

N/A

(h) *Have you been involved in a patent dispute?*

*epi* members often advise on patent disputes.

(i) *Do you have any other experience with the patent system in Europe?*

Members of *epi* represent patent applicants, patentees and opponents in proceedings before the EPO. We also advise our clients on the prosecution of third party patent

applications, the scope of any claims which may be granted on such applications and the validity of any such claims. Members of *epi* also advise their clients on licensing and other exploitation strategies, and on all other matters relating to the protection and exploitation of IP rights.

## Renumbering the EPC Implementing Regulations

The *epi* at its Council meeting of 15-16 May 2006 considered the proposal to renumber the EPC Implementing Regulations made by the EPO in document CA/PL 11/06 dated 27 April 2006.

If the Implementing Regulations are not renumbered, the existence of nine blank numbers and the insertion of 59 provisions would not cause confusion, and the hypothetical situations suggested by the EPO are not realistic as the maximum number of inserted provisions at any location has not yet exceeded ten. From the point of view of the users of the system, no practical advantage is seen in renumbering.

On the contrary, the renumbering itself would be a source of confusion, particularly in connection with the case law but also initially in day-to-day practice, and the confusion cannot be prevented simply by providing a concordance table. The proposal to renumber is based on administrative convenience and has no regard to the problems presented to users of the system, particularly professional representatives of patent applicants and the patent applicants themselves. There will also be similar problems in the EPO itself. Most users of the system rely on memory to a greater or smaller extent when working in connection with patent applications. With renumbering, there would be an extended period of confusion when dealing with day-to-day practice, and confusion

would still exist even after this transition period when earlier case law etc. is studied.

Accordingly, the *epi* Council expresses its strong disapproval of the proposal to renumber the EPC Implementing Regulations.

Should the Administrative Council nevertheless proceed with the renumbering, the following would be essential and are presented as measures for avoiding to the greatest extent possible the problems that renumbering will give users of the system:

- the new numbering needs to be distinctive over the old one, i.e. it should be directly and unambiguously apparent whether a reference is to the old or the new numbering;
- a concordance table must be issued; it should be inserted in the „blue book“, which must show both numberings;
- the Guidelines must use both the new and the old numberings, without limitation in time;
- appropriate software must be provided, in particular by amending the relevant search tools provided by the EPO (Espace Legal, DG3 Case Law database, Online O.J., etc);
- one blank rule must be provided at least at the end of each Part of the Implementing Regulations.

## Amicus Curiae Brief in G01/05 (Divisional Application) on behalf of *epi*

The *epi*, highly concerned with the questions presented to the Enlarged Board of Appeal in the case of G 01/05, herewith presents its position in relation to „Divisional applications“

### I. Introduction

The submissions presented herein refer to the questions posed to the Enlarged Board of Appeal in case T0039/03 with regard to the validity of divisional application containing added subject matter.



The decision T0039/03 is concerned with an application that has been filed as divisional application to an earlier divisional application. Both applications were deemed not to comply with Art. 76(1) EPC because they were deemed to have been extended beyond the content of the earlier (parent) application as filed. With reference to the established practice of the EPO the Board held that the application could not be amended to meet the requirements of Art. 76(1) EPC because it was not deemed to be a valid divisional application.

The referring decision discusses the provisions of Art. 76(1) EPC and interprets its wording in the light of a decision issued by the UK Patents Court based on UK law of 1977. The reasoning was said to be based on recent case law and on the interpretation of Art. 76(1) EPC in the light of the Travaux Préparatoires. The Board was concerned on the following:

- The present practice were inconvenient in terms of legal certainty for the public
- An initially invalid divisional application could become valid as a result of the deletion of originally impermissible added subject matter
- A free selection of aspects disclosed in the earlier application were possible at a late stage.

Based on these concerns three questions have been referred to the Enlarged Board of Appeal.

## II. Factual Situation

According to general principles of interpretation the ordinary meaning to be given to the terms of a treaty in their context and in the light of its object and purpose should be found. Thus, also for the interpretation of article 76 the Legislator's intention and the aspect of historical interpretation of the wording shall be considered.

### 1. Historical Outline

The early drafts of the EPC already contained an Article<sup>1</sup> based on Art. 4G of the Paris Convention referring to the possibility of filing divisional applications (document IV/4860/61-D, page 56). As can be seen in the documentation of the Travaux Préparatoires, in several meetings of the working group (drafting the EPC) it was discussed in which time period divisional applications could be filed, if it was possible to amend the description or only the claims, if a second novelty search should be conducted and other questions. It was mentioned already in 1961 that the priority could be claimed only for those parts which are covered by the scope of the original application (see for example document IV/4860/61-D, page 59). A first version of the Article 76 (at that time Art. 68) in the conference of July 1961 read (in the German version): „Die Teilanmeldungen gelten als zu dem Zeitpunkt der ursprünglichen Anmeldung eingereicht und genießen ggf. das Prioritätsrecht, soweit der Gegenstand der Teilanmeldungen nicht über

das hinaus geht, was in der ursprünglichen Anmeldung beschrieben worden ist, jedoch unter dem Vorbehalt, dass die Teilanmeldung innerhalb einer Frist von 2 Monaten von der in Absatz 1 vorgesehenen Beschränkung eingereicht worden sind.“

This wording is very clear in that the application date or priority date respectively can be validly claimed only for those parts which are based on the original disclosure. This wording was maintained in the draft of 1969 and the second draft of April 1971 (Art. 81 at that time). During the conference of November 1971 the prohibition of introduction of new matter was discussed with regard to divisional applications (see document PR/135d/71e of 17 November 1971) (Art. 137a at that time). Under item 155 in PR/135d/71e it was found that a divisional application could have the same priority date as the original application only: „Soweit der Gegenstand der Teilanmeldung nicht über den Inhalt der ursprünglichen Anmeldung hinaus geht“. The fate of new matter introduced in a divisional application was mentioned under item 156 where it was discussed if new matter introduced in a divisional application should have a new application date or should be deleted. The working group came to the conclusion that in case a divisional application included new matter, the applicant should be informed and should delete the new matter. If the new matter was not deleted the divisional application should be rejected because it contradicted the then Art. 83a.

This above outlined discussion makes it evident that in the preparation of Art. 76 EPC the working group

- dealt with the problem that a divisional application included new matter and
- provided a solution – that the applicant should be given the opportunity to delete new matter.

This discussion and the conclusions written down in the preparatory documents prove the intention the Legislator had of what the wording of Art. 76 „soweit“ or „insofar as“ should mean, namely that a priority right or the right to have the same application date or priority date as the earlier application can be assigned only to those parts originally included in the earlier application. It was never discussed that an application not fulfilling this requirement should be deemed to not have been filed or to have lost the right to the application date or priority date completely. On the contrary, the intention of the Legislator was to give the applicant the opportunity to remove those parts contradicting the Convention.

Based on further discussions the wording of Art. 76 in the Draft Convention was changed: Instead of:

Divisional applications shall be deemed to be filed on the date of the original application and shall have the benefit of any right of priority insofar as their subject matter does not extend beyond what was disclosed in the original application ...

it now read:

A European divisional application ... shall not contain subject-matter which extends beyond the content of the earlier application as filed; insofar as this provision is complied with, the divisional application shall be deemed to have been filed on the date of

<sup>1</sup> In this text the Article referring to the filing of Divisional applications will be indicated generally as „Art. 76“, although the numbering differed in the course of discussions since 1961

filing of the earlier application and shall have the benefit of any right to priority.

By this amendment it should be avoided that applications to be kept secret were filed directly with the EPO which, owing to the nature of their subject matter, should not be communicated abroad without the prior authorization of the competent authorities of the respective state. A divisional application not containing new matter could not cause such problem (see Report of coordination committee, September 1972, Item 10).

During the Munich Diplomatic Conference of 1973 the addition to a divisional application of further examples or other parts that would not extend beyond the scope of the original application was discussed as a further option. It is this problem, paragraph 210 of document M/PR/I deals with and to which the Board of Appeal refers. This paragraph provides the conclusion that the introduction could be allowed. The added examples even if comprising new matter should be published and create prior art as from their publication rather than from the application date of the earlier application. However, in contrast to the view held by the referring Board this discussion did not refer to the assignment of the application date or priority date for the divisional application.

Summarizing, from the Travaux Préparatoires for the EPC it can be deduced that it was the clear intention of the Legislator to allow the filing of one or more divisional applications, which can claim the priority date or application date respectively of the original application only for those parts that were contained in the original application. It is this approach which found application at the EPO and is outlined in the Guidelines. It cannot be deduced from the Travaux Préparatoires that at any time it was held that a divisional application should be deemed invalid or to not have been filed in case it included new matter.

## 2. Established practice of the EPO

Based on Art. 76(1) (and in line with the interpretation of this Article in the Travaux Préparatoires) the European Patent Office has established a well performing practice for the treatment of divisional applications within the last decades. The Appeal Boards in their decisions have confirmed this practice over the last decades with very few exceptions mainly by the referring Board. This practice is also reflected in the Guidelines.

Patents are issued to provide a monopoly for a limited period in exchange for the publication of inventive ideas and to stimulate innovation. In order to provide for a fair balance of interests there are limits for Divisional applications. The bounds for Divisional applications are clearly set

They can be filed only within the time period given by Rule 25

They are limited to the disclosure in the first application

The duration is 20 years from the (first) filing date  
Divisional applications can be filed to divisional applications – A practice confirmed by the Administrative

Council when introducing new Rule 25. As for any other application deficiencies of a divisional application that are raised during examination can be remedied. Only if the deficiencies are not overcome the application has to be rejected.

The public is informed of the filing of divisional applications in the public register and is informed of the content of divisional application and the claims by file inspection.

Article 76 and Rule 25 EPC have been drafted to limit the advantages granted to the applicant but at the same time protect the applicant against the risk to lose part of the published disclosure because of lack of unity of an invention. Article 76 EPC is an implementation of Article 4G of the Paris Convention. If it turns out during the examining proceedings that the unifying concept of the set of claims in an application is not patentable it must be possible for the applicant to proceed with different inventions which are no longer covered by the concept without losing part thereof. On the other side it should be prevented that additions are made to improve the claimed subject matter in the course of the duration. The bounds are set on the one hand by the ultimate duration of 20 years which starts on the application date of the first application and on the other hand by the disclosure in the first application. Thus it is of public interest that these limits are not exceeded to balance the interests of both the applicant and the public.

## 3. Future development

In the Diplomatic Conference of 2000 for the Revision of the EPC Art. 76 has been slightly revised with the intention to increase flexibility for the applicant. By amending the English version it was also made clear that divisional applications of divisional applications are considered valid.

## 4. Decision of the referring Board

Under item 3.6 of their decision the Board referred to the historical documentation as indicating that the Convention was not meant to allow the deletion of subject matter extending beyond the content of the earlier application. The reasons for that are concerns about the legal certainty.

The reasoning is based on one paragraph of the Travaux Préparatoires referring to a different topic, i. e. pages 36 and 37, paragraph 210 of the minutes of the Munich Diplomatic Conference in 1973. However, when studying the Travaux Préparatoires and the minutes of discussions with regard to Art. 76 (formerly in different numberings Art. 74 and Art. 137) it can be seen that the implications meant by the Legislator were just the contrary as outlined above.

## III. Interpretation

The concerns of the referring Board are unfounded.

- The present practice were inconvenient in terms of legal certainty for the public

The applicant has the right to pursue any subject matter contained in the original application and in exchange for that the public is informed about the proceedings. The filing of any divisional application is published in the register and by inspecting the file the scope to be expected can be followed.

- An initially invalid divisional application could become valid as a result of the deletion of originally impermissible added subject matter

For the interpretation similar cases in the EPC shall be considered. There are other rules in the EPC where the applicant can lose rights. However, there is no rule or article in the EPC where there is risk to lose a right without a possibility for the applicant to provide for a remedy. If a divisional application were deemed invalid from the beginning for the only reason that it included new matter without any option to overcome this deficiency, this were against the Rules in the EPC.

Inter alia Art. 96 EPC regulates that the applicant has to be invited to correct deficiencies in an application. As one example of a remedy, there is a special rule for figures that were erroneously omitted, where the applicant has the choice either to keep the application date or to introduce the figures and lose the earlier date. If the claim to priority is incorrect it can be corrected within specific time ranges. If the application has been extended and contravenes article 123 the applicant can correct this deficiency by restricting the claims or by filing amended documents. Rule 38 is another example; therein it is stipulated that: *If the European patent application fails to meet the requirements laid down in Article 80, the Receiving Section shall communicate the disclosed deficiencies to the applicant and inform him that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within one month. If he does so, he shall be informed of the date of filing.* Of course, the date of remedy becomes the filing date, but this shows that there is not an automatic invalidation, without possibility of correction provides another remedy.

Whenever there is a risk to lose an application there is also a remedy for the deficiency. Thus, also from a systematic interpretation Article 76 can only mean that the priority or application date for those parts which were not part of the original application is lost but not the whole application. The applicant must have at least once the right to correct the error.

- A free selection of aspects disclosed in the earlier application were possible at a late stage.

It has to be emphasized that divisional applications are governed by two limits – the original disclosure and the 20 years duration. The applicant cannot get any right for something he did not disclose at an earlier stage. The applicant made the selection of what he offered the public before.

In the referring decision the Board seems to indicate that their concerns have been raised in a number of decisions terminated as „recent case law of the Boards of Appeal“. However, this recent case law are a few decisions issued mainly by only one technical Board of

Appeal, the same Board that has referred the questions to the Enlarged Board of Appeal.

The recent case law with the exception of these few cases is consistent in the last decades. The decisions of the other technical Boards of appeal continue with the practice to allow the removal of parts being deemed new matter or to contravene article 123 or article 76. There is also consistency with the interpretation as outlined in the historical documentation and with the practice of the EPO as explained in the Guidelines.

#### IV. Proposals for answers to questions before the Enlarged Board

- (1) Can a divisional application which does not meet the requirements of Art. 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?

The answer to this question is: Yes.

There are well-founded arguments for the answer. First, the EPC seems to give the answer to this question in Art. 96(2) wherein it is said that the applicant shall be invited to file observations and (as regulated in Rule 51 EPC) shall correct deficiencies noted and amend the description, claims and drawings. Art. 96 is applicable to any European patent application. It only were not applicable if the application filed was not deemed to be an application.

If a divisional application which does not meet the requirements of Art. 76(1) EPC at its actual filing date were not deemed to be a valid divisional application only two options can apply:

- either the application is treated as a European patent application having the filing date as application date or
- it is an application to which a date of filing cannot be accorded.

Both options have further consequences in the treatment of those applications.

In the first case, i.e. in case the application filed as divisional application does contain new matter and is deemed an invalid divisional application, it should be treated as a European application that could create a new priority right, and, for example, could be published only 18 months after the application date and had to be kept secret until then. (In case the application filed as divisional application does not include new matter, it enjoys the right to the application date or priority date of the earlier application, respectively).

If the second option is valid, according to Art. 90(2) EPC the Receiving Section has to inform the applicant accordingly and to invite the applicant to correct the deficiencies.

Thus, a divisional application, whether entitled or not to the date of the parent application, is anyway a patent application filed with the European Patent Office and therefore Art. 96 needs to be applicable thereto.”

In both cases it seems difficult to provide for such treatment and it introduces a high extent of legal uncertainty to all parties concerned..

In its referring decision the Board held that the historical documentation relating to the EPC gave indications that the Convention was not meant to allow the correction by deletion of parts deemed to be new matter. However, as outlined above, the contrary is true. In the discussions of the working groups treating Art. 76 it was expressly stated that in case a divisional application included new matter, the applicant should be invited to remove the extended matter. On the other hand, the part the Board refers to, does not deal with the problem of extended matter. Thus, the referred decision in this aspect is not properly based on the historical documentation.

(2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?

The answer is yes.

There is no provision in the EPC which requires a dependency between the divisional application and the parent application after the divisional application has been filed. On the contrary, it is established case law that a divisional application becomes independent as soon as it has been validly filed. There is no analogy in the EPC where actions in one application are dependent from the pendency of another application.

(3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by article 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

There are two subquestions A and B:

The answer to question (3)A is yes.

There are further limitations of substance to this possibility beyond those imposed by Art. 76(1) and 123(2) EPC: Rule 86(4) EPC has to be observed.

The answer to question (3)B:

The established practice does allow only to proceed with aspects that are disclosed in the one or more earlier applications the divisional application is based on. Otherwise, the content of the application is deemed to have been extended.

Amicus Curiae Brief in G01/05  
(Divisional Application)  
on behalf of epi  
Supplement

In supplementation to the arguments brought forward in our *Amicus curiae brief* of 7 March 2006 we would like to draw the attention to the following.

As outlined in the brief a divisional application which does not meet the requirements of Art. 76(1) EPC at its actual filing date and, therefore were deemed not to be a valid divisional application could either be

- an application to be treated as a „normal“ European patent application having the filing date as application date or
- an application, to which a date of filing cannot be accorded.

Both options have further consequences with regard to the payment or refund of fees.

It is established common law that fees that have been paid to the EPO but are lacking a legal basis must be refunded by the EPO. This is inter alia outlined in the Guidelines (Guidelines, Part A, Chapter XI, 10. refund of fees.)

If fee payment does not relate to a pending European patent application, e.g. it relates to a patent application already deemed to have been withdrawn, this fee is paid without a legal basis and the full amount paid must be refunded.

Applied to the above options this means that refund of fees is necessary in both cases. For the first option, if the application is deemed to be a normal European patent application only filing fee and search fee were due on the filing date, but not renewal fees due if it were a divisional application, i.e. renewal fees already due in respect of the earlier application thereof up to the date on which a European divisional application was filed. Thus, renewal fees paid for the first and second year after the filing date and for the years before the filing date of the European patent application which were due only in respect of an earlier application have no legal basis and have to be refunded.

If the second option applies, i.e. the application is deemed to never have been existent, there is no legal basis for payment at all, neither for renewal fees nor for a filing fee or search fee. In this case the whole amount of fees paid has to be refunded.

We respectfully ask the Board to consider also these arguments.

## Report of the Harmonisation Committee

F. Leyder (BE)  
Chairman

1. The Harmonisation Committee deals with all questions concerning the worldwide harmonization of Patent Law, and in particular within the framework of WIPO.
2. The 2005 General Assembly of WIPO decided that an informal Open Forum would be held in Geneva, followed by an informal session of the Standing Committee on the Law of Patents (SCP).
3. For the Open Forum that took place from 1 to 3 March in Geneva, the member States proposed subjects, and also foreign speakers (including three who also happen to be *epi* members). The final programme was the result of tough negotiations. It is available on the WIPO website, as well as most presentations.
4. The informal session of the SCP was held from 10 to 12 April, also in Geneva. Its purpose was to agree on a work program for the SCP, taking into account the discussions of the Open Forum. During Day 1, a number of delegations re-stated their position. Basically, the extremes were represented by:
  - the joint position of US and JP: the SCP should work towards an SPLT prioritising the issues of (1) definition of prior art (2) grace period (3) novelty (4) inventive step; and
  - the position of the „Friends of Development“ (FoD) led by Argentina, that wished to be able to discuss any and all subjects without any prioritisation. A list of 9 issues for the work program of the SCP was later submitted in writing: (1) development and policy space for flexibilities (2) exclusions from patentability (3) exceptions to patent rights (4) anticompetitive practices (5) disclosure of origin, prior informed consent and benefit-sharing (6) effective mechanisms to challenge the validity of patents (7) sufficiency of disclosure (8) transfer of technology (9) alternative modes to promote innovation. However, it was clearly stated that the list was not exhaustive, and that any State should retain the right to have any subject that it wanted to discuss added to the list.

Despite numerous breaks and coordination meetings, and remarkable efforts by the Chair supported by many delegations, the FoD refused to accept any limitation of the list of subjects to be discussed, or any prioritisation, whilst US and JP never explicitly accepted to discuss any other subject.

The final position of the EU can be summarised as follows:

- full support to discuss the 4 items proposed by US and JP;
- some of the 9 items proposed by the FoD should contribute to the development of a more balanced patent system: exclusions from patentability, exceptions to patent rights, sufficiency of disclosure, it being understood that there should be no derogation from the TRIPS principles;
- discussions on disclosure of origin and traditional knowledge should continue in the Intergovernmental Committee (IGC), on the basis of the EU proposal;
- the questions of prior informed consent and benefit sharing are discussed elsewhere, there should be no duplication.

At the end of Day 3, the informal meeting was concluded with an acknowledgement of failure. The SCP will thus not meet in July, for lack of a work program.

„The meeting was unable to agree on a work program for the Standing Committee and consequently the matter was referred to the General Assemblies in September 2006.“ (Francis Gurry, vice-Director General of WIPO).

5. The situation was discussed during the 29th meeting of the Committee on Patent Law (CPL), on 2-3 May. In preparation of that meeting, the EPO prepared a paper essentially containing a summary of the proceedings of a Group B+ WG 1 Expert Meeting which took place on 27-28 March in Tokyo, a summary of the status of the negotiations towards a SPLT, and some proposals.

The members of Group B+ (i.e. the industrialised nations) agreed in Tokyo to consult relevant stakeholders in the member states on the outstanding issues in order to reach an agreement. They further agreed to make every effort to reach an agreement on the provisions related to the Prior Art, the Grace Period, the Novelty and the Inventive Step/Non-Obviousness at the next Plenary Session.

The EPO paper was „intended to assist the delegations of the Contracting States in their consultations regarding the SPLT“ (such consultations should be taking place, if not already completed, when this report will be published).

During the CPL meeting, *epi* drew the attention of the EPO to the fact that the negotiations in Group B+ exclude *epi* as observer, thus do not provide an opportunity for us to intervene extemporaneously.

In response to the request of the EPO for feedback from the users, the chairman of the Harmonization Committee prepared a short draft position paper that

was submitted to the Council on 16 May at its meeting in Salzburg. The Council approved the following positions:

### epi views on open issues

Basically, *epi* always inclines for any harmonisation that leads to the prior art being identical in all States and with respect to all applicants.

*First-to-file*: essential in any SPLT.

*Hilmer doctrine*: must be abandoned by the US.

*Effect of conflicting applications*: to be taken into account for novelty alone.

*Treatment of conflicting PCT applications*: in a harmonised system, they should form part of the secret prior art as from their filing/priority date, thus providing a true first-to-file system; for the same reason, they should enter the state of the art at the date of publication under Art. 21 PCT.

*Abstract*: the Abstract should continue to be subject to Art. 3(3) PCT and should not form part of the „whole contents“.

*Anti-self-collision*: the effect of a conflicting application should be the same independently of the applicant, thus there should be no anti-self-collision mechanism.

*Grace period*: *epi* remains opposed to any kind of grace period, however should one be conceded in a harmonised system comprising first-to-file and the abandonment of the Hilmer doctrine, it should have the following features:

- a duration of 6 months preceding the priority date;
- publication of an application by a patent office should be included;

- a formal declaration should be mandatory;
- third party rights should be mandatory.

*Experimental use*: no exception should be allowed based on the nature of the invention or the intent of the inventor.

*Inventive step*: no elements of methodology should be included at Treaty level.

*Secret commercial prior use*: the effect of secret commercial prior use should be the same independently of the applicant, thus it cannot be assimilated to novelty-destroying prior art when performed by the inventor/applicant.

### EPO reflections on the issue of conflicting applications

*Enlarged novelty*: *epi* rejects the introduction of a new concept.

*No harmonisation*: *epi* believes that every effort should be made to harmonise the definition of the prior art in order to maximise the chances of work made by one office being useful to another.

*No mosaic*: *epi* does not approve the proposal. [Note: this was a proposal to allow conflicting applications to be taken into account for inventive step, however only in combination with common general knowledge; it is a known concept in some jurisdictions.]

*Further EPO idea regarding a compromise solution*: the effect of a conflicting application should be the same independently of the applicant, thus *epi* rejects the idea.

## Report on on-line filing with the EPO

R. Burt (GB)

The EPPC have been asked to consider requesting a modification of the Implementing Regulations to introduce a new Rule analogous to Rule 85(2) EPC to protect applicants when there is a problem with the EPO on-line filing servers such that filing with the EPO is impossible; during March 2006 there were problems with the EPO servers being unavailable.

The problems with PatXML have not yet been resolved and it still cannot be recommended for use by applicants. The pdf version of the Epoline on-line filing software is working well. There are still problems for some applicants using version 3.0 of the on-line filing software;

however, users of the 2.10 version report no problems except that it does not appear to be being updated despite indications from the EPO that service packs will be available.

The new fee schedule came into effect on 1 April 2006. The EPO web site contains the following information: Service packs containing the revised fees (EP and PCT) for implementation in Online Filing software versions 2.10 and 3.0 were made available on the same day. Unfortunately, there has been a problem with the migration of existing data for certain cases, and these service packs will have to be updated. The new service packs will be

made available via Live Update and in the download centre on the EPO website. For the latest information see under the „Hot News“ section of the web site. The EPO has indicated that using the non-updated software will not result in any loss of rights (see *Official Journal 3/2006*, page 192, for more information).

Applicants are reminded that the on-line filing software cannot yet be used for filing documents in appeals or oppositions. Decisions of the Boards of Appeal in decisions T 781/04 and T 514/05 confirm that appeal documents filed electronically will be deemed inadmissible.

## Requests for Postponement of Oral Proceedings before the Boards of Appeal

Chris Mercer  
President of epi

On 21st June, 2006, there was an MSBA meeting. This meeting was chaired by Mr. Messerli, VP DG3, and was attended by a large number of Board of Appeal Chairmen. It was also attended by a number of epi members. A complete report on the meeting will be published in due course. However, I feel that it is worthwhile to publish a note on the above subject as soon as possible.

The subject of postponement of Oral Proceedings is dealt with in a Notice from the Vice Presidents of DGs 2 and 3 published in OJ EPO 2000, 456. I would urge anyone who is considering requesting a postponement of Oral Proceedings to read this Notice carefully.

It was made clear at the meeting that Appeal Boards are prepared to grant postponements of Oral Proceedings on receipt of an adequately *reasoned and substantiated* request invoking serious grounds.

Requests which are *not* supported by reasons at all will be refused. However, even if reasons are given, a postponement will only be granted if the reasons are serious in the sense of the guidelines set out in the Notice. Moreover, it is also necessary to provide the Appeal

Board with convincing reasons why another representative cannot take the case over.

The list of reasons set out in the Notice is not exhaustive and the Boards, when exercising their discretion, will consider other serious reasons of a similar nature. The following is a non-exhaustive list of reasons which have been found to be unpersuasive:

- planned booking of a holiday;
- alleged booking of holiday without indicating the date of booking and without corroborating evidence;
- bank holiday in the country of residence;
- other appointment fixed after the receipt of the Board's summons; and
- the representative has other commitments in the following days.

Thus, if you need to request a postponement of an Oral Proceedings, it is advisable to make it clear to the Appeal Board why the reasons are serious, based on circumstances existing before the Summons is received, which justify a postponement.

## Décisions de la Commission de Discipline de l'Institut des mandataires agréés près l'Office européen des brevets

**CD 1/05** – Décision du 1<sup>er</sup> février 2006

*Composition de la Chambre:*

Président : M. Georges Leherte  
Rapporteur : M. Jean-Paul Kédinger  
Membre : M. Johan de Vries

*Faits:*

X, mandataire agréé européen auprès de l'OEB, a déposé une demande de brevet européen au nom de son mandant. La demande a été reçue par l'OEB en mai 2000. La 3<sup>ème</sup> annuité due pour cette demande ayant été acquittée tardivement, l'OEB a invité le mandataire (X), en juin 2002, à payer la surtaxe de retard due. Cette

surtaxe n'a pas été réglée dans les délais prescrits. De ce fait, l'OEB a émis en janvier 2003 une notification de Constatation de la perte d'un droit, la demande de brevet susvisée se trouvant ainsi réputée retirée. Cette décision a été confirmée par l'OEB en mars 2003, les observations de février 2003 du mandataire n'ayant pas été retenues.

X a présenté en mai 2003 une requête en restitutio in integrum ; son argument unique a consisté à dire que „le courrier Chronopost a mis plus de temps que prévu pour parvenir à l'OEB de telle sorte que le délai n'a pas pu être respecté“.

En juin 2003, l'OEB informe le mandataire que sa requête est considérée comme irrecevable, car présentée hors délai. X n'ayant pas présenté d'observations en réponse à la lettre de juin 2003, l'OEB a émis en octobre 2003 une décision de rejet de la requête en restitutio in integrum, pour les motifs suivants : la requête a été présentée hors délai, l'acte non accompli ne l'a pas été en temps utile, la taxe de restitutio in integrum n'a pas été acquittée dans les délais.

Un recours était possible contre cette décision.

En décembre 2003, X présente des observations sur cette décision. Ces observations ont été considérées comme irrecevables par l'OEB, car celles-ci ne constituaient pas un recours explicite et la taxe de recours n'a pas été acquittée dans les délais impartis.

La perte de droits a de ce fait été confirmée par l'OEB en mars 2004.

Dans le même temps, le titulaire de la demande de brevet s'inquiétait auprès de X sur la situation de sa demande de brevet. En décembre 2003, X indique qu'il y a un problème résultant du paiement tardif de la 3<sup>ème</sup> annuité, par suite d'un retard postal, et (5 jours plus tard) qu'il met „tous ses efforts pour obtenir la suite de la procédure“, qu'un „examineur va se prononcer sur cet avis (de recherche) et nous pouvons discuter avec lui, le cas échéant modifier le brevet“ et que „Dès que j'aurai ce document, je reviendrai vers vous“.

En février 2004, X écrit à l'avocat du titulaire „nous attendons que l'examineur ouvre la procédure d'examen. Nous n'avons pas d'influence sur la date d'ouverture“ et „nous avons fait un recours ; je vous communiquerai la décision dès que je l'aurai mais la procédure est toujours longue“.

Enfin, en septembre 2004, X écrit encore à son mandant que „la personne contactée (de l'OEB) m'a assuré que tout était en ordre et que nous allions recevoir confirmation par courrier“, en joignant „une demande d'instruction pour les annuités“ (en fait, pour le paiement de la 5<sup>ème</sup> annuité).

Ayant eu copie auprès de l'OEB du dossier de la demande de brevet européen en cause, le titulaire de la demande de brevet a pris conscience de la situation réelle, ce qui a motivé la saisine, le 21 décembre 2004, de la Commission de discipline de l'epi, la demanderesse considérant que les agissements du défendeur „sont manifestement contraires“ au Code de Conduite Professionnelle des Membres de l'epi.

La plainte et les pièces concernées ont été communiquées le 7 mars 2005 au défendeur, par le rapporteur de la Chambre saisie, en lui demandant de s'exprimer sur les termes de cette plainte dans un délai de deux mois à compter de la réception de cette communication.

X a fait répondre le 9 mai 2005 à cette communication que par suite de très gros problèmes de santé, il n'a pas pu répondre à la lettre susvisée du 7 mars 2005 et sollicitait en conséquence une prolongation d'un mois du délai imparti.

Par lettre Recommandée avec Accusé de Réception du 15 juin 2005, le rapporteur a fixé au défendeur un nouveau délai expirant un mois après réception de cette même lettre.

Le 16 juillet 2005, X a fait répondre qu'il n'était toujours pas en mesure de répondre à la plainte dont il a fait l'objet et que de ce fait, il sollicitait une nouvelle prolongation.

#### *Motifs de la décision*

Bien que n'ayant ainsi jamais reçu d'observations de X défendeur sur la plainte dirigée contre lui, la Chambre considère avoir en sa possession toutes les informations et tous les éléments utiles lui permettant de rendre sa décision.

Il n'appartient pas en principe à une Chambre de discipline de prendre position sur une erreur isolée faite par un mandataire agréé au cours d'une procédure devant l'OEB.

Dans la présente affaire, les pièces montrent que X a multiplié les erreurs qui ont finalement conduit au rejet définitif de la demande de brevet en cause.

Ces erreurs sont les suivantes :

- non paiement d'une annuité (3<sup>ème</sup>) dans les délais prescrits,
- non paiement de cette même annuité avec surtaxe de retard, dans les délais prescrits,
- dépôt hors délais d'une requête en restitutio in integrum avec omission de l'accomplissement de l'acte en cause (paiement de la 3<sup>ème</sup> annuité avec surtaxe) dans les délais prescrits,
- dépôt d'observations contre la décision rejetant la requête en restitutio in integrum, alors qu'il y avait lieu de déposer un recours contre cette décision avec paiement de la taxe requise.

La Chambre considère que cette multiplicité d'erreurs ne peut pas être excusée par les difficultés de santé dont X a fait état dans sa lettre de décembre 2003 à l'OEB, car de l'avis de la Chambre, l'article 122 CBE implique que l'organisation administrative du bureau d'un mandataire agréé prévoit une continuité malgré une éventuelle maladie du mandataire.

En outre, le contenu de la lettre de septembre 2004 de X à la demanderesse constitue indiscutablement une déclaration fautive ou fallacieuse au sens de l'article 1<sup>er</sup>, 1<sup>er</sup> paragraphe du Règlement en matière de discipline des mandataires agréés, puisqu'à la date de cette lettre X savait pertinemment que la demande de brevet en cause était définitivement rejetée.



De plus, dans cette même lettre de septembre 2004, X demandait à la demanderesse ses instructions sur le paiement de la 5<sup>ème</sup> annuité, alors qu'il savait pertinemment à cette date que la demande de brevet en cause était définitivement rejetée.

Pour toutes les raisons qui précèdent, la Chambre considère que le comportement de X est de nature à compromettre la confiance que l'on doit pouvoir accorder à la profession (article 1<sup>er</sup>, 2<sup>ème</sup> paragraphe du Règlement en matière de discipline).

Enfin, en ne donnant pas à la demanderesse toutes informations utiles sur l'état du dossier de sa demande de brevet, X n'a pas eu avec sa cliente les rapports normaux exigés par le paragraphe 4 a) du Code de conduite professionnelle.

D'autres circonstances encore font qu'un simple avertissement ou blâme ne seraient pas une sanction suffisante. Pour cette raison, l'affaire doit être renvoyée au Conseil de discipline de l'Office Européen des Brevets, conformément à l'article 6.2 du Règlement en matière de discipline des mandataires agréés.

#### CD 3/05 – Décision du 15 mai 2006

##### Composition de la Chambre:

|              |                        |
|--------------|------------------------|
| Président :  | M. Georges Leherte     |
| Rapporteur : | M. Patrice Monain      |
| Membres :    | M. Christoffer Sundman |
|              | M. Bruno Muraca        |

Vu la plainte déposée par X à l'encontre de Y.

Après avoir examiné les faits contenus dans ladite plainte, présentés par le plaignant X comme un manquement à l'article 3 (b) des Règles de conduite professionnelle, en particulier

- le fait, selon le plaignant X, que Y, qui a exercé dans le passé au sein du Cabinet Z1, représente aujourd'hui un client dans une affaire d'opposition formée par l'un des clients du Cabinet Z1, et
- que Y avait auparavant formé pour ce client du Cabinet Z1 une opposition à l'encontre d'un brevet européen délivré au nom d'un autre titulaire,

Après avoir transmis cette plainte à Y,

Après avoir examiné la réponse de Y,

Après avoir examiné la réponse du plaignant X,

Vu que les faits contenus dans ladite plainte ne sont pas susceptibles de fonder une allégation de manquements aux Règles de conduite professionnelle,

Vu en particulier

- que les deux oppositions formées devant l'Office européen des brevets ne concernent ni les mêmes brevets, ni les mêmes titulaires,
- que les domaines techniques concernés dans ces deux brevets ne sont pas identiques,
- que le titulaire du brevet européen représenté par Y était déjà client du Cabinet Z2 dans lequel travaille aujourd'hui Y, avant même l'arrivée de celui-ci,

DECIDE QUE : La plainte de X est rejetée.

L'Affaire est classée.

## Pre-Announcements epi-Seminars

On October 27, 2006 a seminar will be held relating to „PCT Strategies“. This seminar will be organised by *epi* in the framework of the current project of Continuing Professional Education.

The seminar will be held at the High Tech Campus Eindhoven in The Netherlands. Further information on the program of the seminar, registration form and registration fees will be published on the *epi*-website (see „*epi*-News“), and will be sent by e-mail to *epi*-members in Belgium and The Netherlands.

CPE seminars relating to „Dealing with PCT“ are also under preparation, with the collaboration of WIPO. More information will be published on the *epi*-website as soon as possible (see „*epi*-News“).

It is the intention of *epi* to repeat the seminar „Amendments to European patent applications during examination“ in the autumn 2006. Further information and relevant dates will be published on the *epi*-website (see „*epi*-News“) as soon as available.

## CEIPI-epi Course on Patent Litigation in Europe

*epi* Members interested in the Course should consult the *epi* website [www.patentepi.com](http://www.patentepi.com)

## Update of the European Patent Attorneys database

For the attention of all *epi* members

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. Be aware that the list of professional representatives, kept by the EPO, is the list used by the *epi*. Therefore, to make sure that *epi*

mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 5.1.1 of any change in your contact details by sending an e-mail to [gchiste@epo.org](mailto:gchiste@epo.org)

Thank you for your cooperation.

## The European Patent Academy – an approach for the new member states

W. Torlot (EPO)

When the European Patent Academy was set up 18 months ago, one of its key target groups, was current and future professional representatives before the EPO. In an article in the previous edition of *epi* information, William Torlot, the Head of the Unit for Patent Professionals in the Academy, described the Academy's approach to helping candidates preparing for the EQE. In this edition, attention turns to patent attorneys in the newer EPC contracting states.

In the last 7 years, the European Patent Organisation has grown by 12 new contracting states bringing with them about 1250 new *epi* members. Joining the Organisation, as many of you know, brings to the surface a number of fears for the ongoing security of people's professions but also some considerable challenges in coming to terms with new laws and procedures.

Traditionally, the approach taken for training in new member states has been to run introductory courses accompanied by the setting up of basic training. What has unfortunately occurred in some countries, however, is that a concentration of activity at the time of accession to the EPC has died away to nothing quite rapidly. Basic training has proved to be more enduring with the CEIPI-*epi* European patent law course providing a solid foundation through a systematic approach and complete tuition in the legal basis and practices of European patent law. The course is currently running in over 30 cities throughout Europe. However, for Article 163 attorneys with considerable national patenting experience this does not entirely correspond to their needs for a re-tuning of their current skills to European practices and procedures rather than a solid start in a new profession.

### Understanding the needs

In order to really come to terms with the problems faced by patent attorneys in the new member states, a work-

shop was run last December by the Academy together with the *epi* and hosted by the Czech Patent Office. This workshop, entitled „Developing the Patent Attorney Profession in the EPO's New Member States“ brought together the respective *epi* board members plus representatives from national patent attorney associations and national patent offices of the new member states with a view to identifying the best way to proceed in terms of training and education. A number of very clear messages were received at that meeting:

- The overall need is for attorneys to get up to speed in practical competence so that they can gain the confidence of the local industry
- Training must not be sporadic but should be continuous professional education
- Courses should be on a practical level such as mock procedures and not theory
- While EQE training is not an immediate priority, knowledge of the exam is needed to support future candidates and promote the development of the profession.

A more detailed analysis of the precise needs of this group resulted in a number of topics being identified, all of which are suited to being addressed in practical workshops:

- a) Managing the formal issues of European and International applications
- b) Improving patent drafting skills
- c) Understanding and responding to an examiner's communication (including making amendments)
- d) Opposition and appeal procedures
- e) Oral proceedings
- f) An introduction to the requirements of the EQE and how candidates need to prepare (for potential candidates *and* supervisors who have not taken the EQE)

## A regional approach

With sheer size and geographical spread of this target group, the logistical demands of organising training are a challenge. In order to give equal access to training opportunities but at the same time to efficiently address urgent needs, the approach is to promote a regional programme. In this way the workshops identified above can be run over a 2 to 3-year period in each country within the region but, for really urgent needs, participants will only have to travel to a neighbouring country to be able to attend in a much shorter time-span. The first of these regional programmes has now been set up in Poland, the Czech Republic and Slovakia and will commence in the autumn. More details about this programme can be found on the Academy website (<http://academy.epo.org/schedule/index.en.php>)

## Other practical assistance

For many attorneys starting to work with the EPC, a closer look at the ways of working at the EPO provides a useful insight. In the past, study visits have been organised for patent attorneys from new member states where they get a chance to see an oral proceeding, to meet some examiners and to hear from the EPO about working methods and new developments. This kind of opportunity will continue.

In addition to this and the practical workshops mentioned above, a number of other projects are being developed in partnership with the *epi*. One example is a distance learning project aimed at both future and

current patent attorneys in countries where there are fewer European files. Here the idea is to provide „dummy“ EP files based on old EP applications and oppositions which have been pedagogically structured to provide a learning experience as they are progressively worked on over a period of several months. This project, which will be launched later this year, will provide files in all three official languages, focusing on a number of different substantive and formal issues and will simulate working on a real EP file.

With regard to oral proceedings, the Academy is developing e-learning products which will give an insight into how oral proceedings are conducted and the tactics which attorneys may adopt. In addition a new project in co-operation with the British Council is looking to provide courses where attorneys may practise and sharpen their patent-related rhetorical skills in both written and oral English. Furthermore web-based exercises are being developed to complement the practical workshops mentioned above, whereby exercises will be provided to give guidance and put skills into practice.

*The expertise within the patent attorney profession is vital to the success of addressing this target group. Whether it is for training events or the development of projects, the epi and the Academy need professional representatives to help us as tutors, expert speakers or consultants. If you are interested in becoming a tutor or working as an expert on one of the projects listed above, please get in touch with the epi Secretariat ([info@patentepi.com](mailto:info@patentepi.com)) or William Torlot by e-mail at: [wtorlot@epo.org](mailto:wtorlot@epo.org) or by telephone: +49 89 2399 5023.*

## Taking care of business (methods)

### How the EPO today refuses inventions involving non-technical features

A. Engelfriet\* (NL)

In the past few years, an often-heard allegation was that business methods, especially computer-implemented ones, can be patented at the European Patent Office. The required 'technical character' of the invention supposedly is no more than an exercise in proper claim drafting.<sup>1</sup> Recently, however, the EPO Boards of Appeal have been issuing several decisions on how to assess such inventions. These decisions make it virtually impos-

sible to argue in favour of inventive step when part of the invention is realized through non-technical features.

Probably the new, rigorous approach was in response to the large number of business method-related patent applications filed in the past years.<sup>2</sup> But this is not just about Internet e-commerce techniques. Even a method for designing a core loading arrangement for a nuclear power plant may lack technical character (T 914/02).

These new decisions (most notably T 641/00 and T 258/03) significantly affect the assessment of an invention's technical character and inventive step. The implications are discussed below.

\* Arnoud Engelfriet, European patent attorney working at Philips Intellectual Property & Standards in the Netherlands.

1 See e.g. Stefan Wagner, „Business Method Patents in Europe and their Strategic Use – Evidence from Franking Device Manufacturers, SFB Discussion Paper No. 386, September 29, 2004; John M. Conley, „The international law of business method patents“, Economic Review 4 (2003), Federal Reserve Bank of Atlanta, pages 15-33; Keith Beresford, „European patents for software, E-commerce and business model inventions“, World Patent Information 23 (2001) 253-263; Johannes Lang, „Europe grants e-commerce patents too“, Managing Intellectual Property 97 (2000), p. 13-15.

2 An overview of the current status of patents in the field of e-commerce can be found in Yen-Chun Jim Wu, „Unlocking the Value of Business Model Patents in E-Commerce“, Journal of Enterprise Information Management, 18 (2005), pp. 113-130 and in Biju Paul Abraham, Soumyo D. Moitra, „Analysis of internet patents on methods of electronic business“, International Journal of Electronic Business 3 (2005), pp. 427-446.

## Technical nature of invention

The first requirement for a patentable invention is that it has technical character.<sup>3</sup> The EPO applies different criteria for methods, devices and computer programs. It is up to the applicant to prove the existence of technical character (T 258/97).

### Methods

In the 1994 landmark decision T 762/92 (Sohei) a method was considered not excluded „if technical considerations concerning particulars of the solution of the problem the invention solves are required in order to carry out that same invention.“ This was interpreted by many as meaning that the mere mention of technical features in the claim sufficed to pass the „technical character“ hurdle.

In T 931/95 (Pension Benefit System) the applicant argued exactly that. The Board however decided that using technical means for a *purely non-technical purpose* or for *processing purely non-technical information* would not make a method technical. This approach was used in several cases. For example in T 914/02 the method could be carried out exclusively mentally, and despite the fact that technical considerations may have been involved, the claim was held non-technical.

The recent Hitachi decision T 258/03 (confirmed in T 531/03) came to a different conclusion, going even further than the Sohei case. The Board noted that technical inventions include „activities which are so familiar that their technical character tends to be overlooked, such as the act of writing using pen and paper“ (reason 4.6). Given this fact, it is illogical to reject some methods that use technical means on the ground that the technical means are too commonplace. The assessment of technical character should be done without any reference to the state of the art whatsoever.

Thus, following this decision, a method claim that recites technical means always has technical character, regardless of the purpose or use of these means. If a claim is only indirectly concerned with technical activities, as was the case in T 914/02, it can still be rejected as a mental act or method of doing business as such.

In many cases these technical means will be a computer or other programmed apparatus. The claim is then treated as a computer-implemented invention.<sup>4</sup>

### Devices

It is well established that a device or apparatus, being a physical entity or concrete product, necessarily has technical character (T 931/95, T 258/03). This applies even if the purpose of the device is supporting an economic activity (T 931/95 headnote 3). Thus such a claim can never be rejected for lack of a technical character.

### Computer programs

Like devices, programs for computers are inherently technical. Any computer program will, when run on a suitable computer, produce technical effects such as electrical currents, pictures on a display screen or signals sent over a network. Art. 52(2) and (3) EPC however declare that programs for computers *as such* are not inventions because they lack technical character (see T 1173/97, reason 5.2). To resolve this apparent contradiction, T 1173/97 and T 935/97 introduced the concept of the „further technical effect“.

To quote from the Guidelines (C-IV 2.3.6), „a further technical effect may be found e.g. in the control of an industrial process or in processing data which represent physical entities.“ In other words, if a method claim to an industrial process or data processing technique is technical, so is the corresponding computer program claim. Further technical effects can also be found „in the internal functioning of the computer itself or its interfaces“ or „the efficiency or security of a process, the management of computer resources required or the rate of data transfer in a communication link.“ It may be difficult to rely on such effects, as they are often close to the normal technical effects exhibited by any computer program.

More generally speaking, merely referring to improved efficiency, a user-friendlier interface or better performance is unlikely to be accepted today. For instance, the graphic design of menus is, as a rule, not a technical activity (T 244/00). A specific design may however be considered technical (T 643/00, T 125/01). Similarly, creating a model to represent information or designing diagrams is generally considered an intellectual activity and hence not technical (T 49/99, T 244/00, T 125/04).

A patentable claim actually has to claim a specific effect that is related to the solution of a technical problem. Merely identifying a possible technical effect in general terms will not be sufficient (e.g. T 258/97). One positive example is T 60/98, where a new game rule made the *implementation* of a computer game less complex, which was sufficient to qualify for a technical effect.<sup>5</sup>

## Inventive step

Today it is often possible to jump the hurdle of technical character. However for business method applications, the hurdle of inventive step generally proves too steep. The Board of Appeals generally uses the problem-solution approach (see Guidelines C-IV 9.8) to prove that such inventions are obvious.

### Determining the closest prior art

The first step in assessing inventive step is to determine the closest prior art. The closest prior art is that combination of features, disclosed in one single reference, which constitutes the most promising starting point for

<sup>3</sup> To confuse matters, sometimes the EPO equates „invention“ with „has technical character“, leading to phrases like „the alleged invention“ in communications. In other cases the EPO will speak of „invention without technical character“. This article uses „invention“ to mean „the claimed features“.

<sup>4</sup> As explained in detail in Gérard Bloch, „The Patentable Business Methods“, EPI Information 3 (2002) 83-86.

<sup>5</sup> These examples were taken from a presentation by Dr. Stefan Steinbrener titled „Patentability of computer-implemented inventions“, delivered at the EPO Information day at the European Parliament on 30 March 2005. Dr. Steinbrener is chairman of Board 3.5.1 from which most of the decisions cited in this article originated.

an obvious development leading to the invention. Of course this single reference must be part of the state of the art.

The state of the art comprises everything made available to the public before the (effective) filing date of the patent application (Art. 54(2) EPC). While the English text of the EPC uses the term „state of the art,“ the German and French texts use „Stand der Technik“ and „l'état de la technique“, both meaning the state of the *technical* art. This difference has never received much attention until decision T 172/03.

In this decision, the term „state of the art“ was redefined to only include publications in some field of technology. Publications in the field of commerce and business methods are irrelevant to the state of the art. As a consequence, such non-technical documentation cannot be used as a starting point for assessing inventive step.

#### *Formulating the technical problem*

The second step is to determine the distinguishing feature(s) of the invention over the closest prior art and to identify the technical problem that is solved by these features. The objective technical problem must be so formulated as not to contain pointers to the solution. For example, incorporating distinguishing features into the technical problem would be impermissible hindsight.

At the same time, it is established caselaw that non-technical features cannot contribute to inventive step. Based on this principle, T 931/95 and T 641/00 decided it was permissible to include non-technical features into the technical problem.

In T 931/95 the Board assumed that the skilled person had knowledge of the non-technical features so that only the technical aspects of the claimed apparatus were taken into account. In T 641/00 (and earlier in T 1053/98) the non-technical features were deemed a framework or set of constraints of the technical problem that is to be solved. The skilled person would be given those constraints and asked to solve the technical problem.<sup>6</sup>

The technical problem is then usually formulated as providing an implementation of the non-technical features on a computer system. As will be discussed below, such an implementation is usually deemed to be obvious.

A good example is T 531/03. The invention here related to a system where point-of-sale terminals report product codes of products being purchased to a store controller. The controller looks for certain „triggering products“, and looks up the discounts applicable to these products. At the end of the transaction the system generates a single discount certificate that could be redeemed at a later purchase. This single certificate included only the triggering products for which a discount applied. In the closest prior art, a separate certificate was generated for each triggering product.

The Board concluded that the only problem that could be derived was „encouraging consumers to revisit the

same store“. This is clearly a marketing and hence non-technical problem. The technical problem then was formulated as „how to adapt an electronic coupon generation system so that it generates a single cumulative discount certificate for a transaction.“ Note that here the non-technical feature of the single discount certificate is incorporated into the technical problem, even though this feature was novel compared to the available prior art.<sup>7</sup>

#### *Defining the skilled person*

The obviousness of the technical problem must be assessed from the point of view of the average skilled person. The person skilled in the art is an ordinary practitioner. He is not creative, has no fantasy and is a captive of prejudices in his field. He works in the field of the technical problem, but may consult colleagues in other fields that may be relevant.<sup>8</sup>

When dealing with inventions comprising non-technical features, the skilled person is a technically qualified person, not a businessman, economist, actuary or accountant (T 641/00). Consequently, while the skilled person has access to all technical literature published before the effective filing date, he will not consider business or economic literature (T 172/03). And as explained above, he has no need to consider such literature since the non-technical features are a given to him anyway.

#### *Determining obviousness*

If the solution to the technical problem is obvious to a skilled person, the invention lacks an inventive step. This is the ground on which the vast majority of business method-related applications will be rejected. With the current caselaw, there is virtually no possibility of proving inventive step by relying on non-technical features.

As noted above, the non-technical aspects of the invention are given to the skilled person as a framework or set of constraints based on which the technical problem is to be solved. An inventive step can exist only if the technical solution is nonobvious *when the non-technical features are assumed to be known*.

This approach has proven to be a formidable hurdle for many business method patent applications. The actual technical implementation usually is not the focus of the invention. In many cases, the implementation is phrased as „computing means for performing a business step“. Obviously, these can be implemented without inventive activity, regardless of how clever the business step actually is (T 172/03).<sup>9</sup>

A related doctrine that is sometimes used is the so-called „circumvention of the technical problem.“ When a technical problem has been identified, yet the features of

<sup>6</sup> In T 764/02 the Board, in the same composition as in T 641/00, found that this approach was not contrary to the established jurisprudence of the Boards of Appeal (reason 11.6). A referral to the Enlarged Board hence was refused.

<sup>7</sup> The applicant argued that a technical problem could be found in reducing the amount of paper used for printing. However this problem could not be derived from the application as filed.

<sup>8</sup> Derk Visser, *The annotated European patent convention*, H. Tel Publisher, 12th ed. 2005, at p. 77.

<sup>9</sup> The reasoning in T 641/00 provides a very good example. A more extensive discussion of this case is Arnoud Engelfriet, „Treatment of non-technical features in the problem-solution approach at the EPO“, Iusmentis website, 1 October 2005. <http://www.iusmentis.com/patents/epc/comvik/>

the solution are deemed non-technical features, the Board in T 258/03 has held that these features do not actually solve the problem. Means „aimed at circumventing a technical problem rather than solving it by technical means“ cannot be taken into account for assessing inventive step (T 258/03, reason 5.7). These can then be ignored or even made part of the technical problem.

This doctrine is applied in particular when the applicant only presents generally worded technical effects, such as saving time or energy, reducing traffic load and so on. Such effects can be achieved by suitably designed administrative or business rules and so do not confer a technical character to the claimed solution.

## Conclusion

With its new criterion for technical character, the EPO appears to open the door for patents on computer-implemented business methods. However, this door is firmly closed by the new, rigorous application of the inventive step criterion.<sup>10</sup> Effectively, a patent related to a business method will be limited in scope to only a specific nonobvious technical implementation thereof.<sup>11</sup> This will certainly reduce the number of granted European patents on such inventions. It is to be expected that this will also reduce the number of European patent applications in this field.

# Italy, Final Decision in Appeal Against Pharma Patent Term Reduction

F. de Benedetti (IT)

## Office Had No Power to Recalculate SPC Terms, Says Board of Appeal

*In its decision on the appeal against application of the Italian law reducing the terms of Supplementary Protection Certificates, the Board of Appeals of the Italian Patent and Trademark Office states that the Office had no power to recalculate the terms of the SPCs in the first place.*

Four years ago the Italian Government issued a law which provided for a reduction of the duration of Supplementary Protection Certificates (SPCs) applied for before 2 January 1993. The law provided for a gradual, six-months-a-year reduction system, but left practical issues unanswered. The law's basic principle was supplemented with additional criteria by the Italian Patent and Trademark Office (IPTO), which also proceeded to recalculate the terms of SPCs and publish the new terms.

Late in 2003 many pharmaceutical companies lodged an appeal with the special Board competent for appeals lying from the IPTO's decisions and measures. The only appeal not to be dismissed on procedural points was the one filed by SIB, which followed a different procedure and raised objections concerning the constitutionality of the law itself.

The Board stayed proceedings and referred the case to the Constitutional Court, which declared the referral inadmissible but indicated that the Board had no competence on the IPTO's administrative procedure of updating its records with the new reduced terms. At that point, the Board had to reconsider the original appeal in the light of the Constitutional Court's decision.

*The Board on 16 March 2006 finally issued a decision whose main point of interest is the statement that the IPTO was not competent to recalculate the terms of the SPCs.*

## The decision of the Board of Appeal

The Board's decision states that the IPTO had no power to recalculate the term of the SPCs and consequently also no competence to apply the law according to criteria not specified by the law itself. Its initiative of making said recalculation was therefore taken „outside any power given to the same Office“. In addition, the Board underlines the Constitutional Court's findings that the recalculation of the duration of the SPCs by the IPTO has an immediate negative impact on the legitimate interests of the right holder, particularly because of the disclosure of the new reduced term to third parties.

However, as expected the Board was forced to dismiss the appeal, since it cannot review a decision that the IPTO was not competent to take in the first place.

## Practical consequences

The appeal, though technically rejected, has made it clear that the IPTO cannot take any initiative in recalculating and publishing, either in its database or by any other means, the new reduced term of the SPCs. It is expected therefore that the IPTO will maintain the original SPC terms, merely indicating the applicability of the law providing for the gradual reduction of their duration.

*The lack of competence of the IPTO as to the recalculation of the terms of SPCs is particularly evident for*

<sup>10</sup> As already suggested earlier in Henk Hanneman, „The patentability of 'methods of doing business'“, EPI Information 1 (2000) 16-22.

<sup>11</sup> This is in line with the third suggestion of Fink (2004), who notes that the main problem of „business method patents“ is overbroad scope and not so much technical character. Matthew E. Fink, „Patenting Business Methods in Europe: What Lies Ahead?“, Indiana Law Journal 79 (2004), pp. 299-321. Plotkin (2005) instead suggests to more stringently enforce the industrial application (utility) requirement to limit software and business method patentability. Robert Plotkin, „Software Patentability and Practical Utility: What's the Use?“ International Review of Law, Computers & Technology 19 (2005), pp. 23-26.

those aspects which were contested in the appeal and relate to the additional criteria set out by the IPTO itself, namely:

- a) shortening the SPC term in its last year, when the remaining duration is less than one entire year and
- b) shortening the SPC term starting from the first year of the law's applicability when the SPC was not in

force yet since the basic patent had still to complete its normal 20-year term.

*It follows that the final reduced term, when these aspects are involved, remains uncertain and falls within the jurisdiction of an ordinary Court (specialised IP section).*

*For further information on the Board's decision, please contact Società Italiana Brevetti at roma@sib.it*

## Kunstbetrachtung im Patentwesen

G. Kern (DE)

Anmerkung zu den in epi Information 2006/1, Seiten 23 ff. von S.V. Kulhavy (CH) erhobenen Forderungen an das EPA:

Erfindungen sind bekanntlich nicht beim *epi* vorzutragen, sondern unmittelbar beim EPA anzumelden. Wer mit der ultimativen Erfindung des Erfindens und der erfinderischen Tätigkeit vor dem EPA scheitert, sollte sich vielleicht ernsthaft mit den wissenschaftlichen

Begrenzungen Künstlicher Intelligenz befassen und sich gelegentlich mit Fuzzy Logic trösten.

Außerdem sagt man, Patentrecht beruhe auf der Kreativität von Erfindern oder mit anderen Worten, auf einer besonderen Art künstlerischer Leistung. Wen sollte es danach wundern, dass die Prüfungsverfahren in den Patentämtern dieser Welt gewissermaßen der anderswo gewöhnlichen Kunstbetrachtung gleichen?

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