



# INFORMATION

APRIL 2003

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## LETTER FROM THE PRESIDENT

MALCOLM ROYAL - PRESIDENT, FICPI

As I write this last letter to you as President of FICPI, the preparation for the World Congress in Berlin is drawing towards completion. The working program has been developed over a long period of time and with much debate within FICPI. It is now coming together in what we hope will be a significant educational and networking success. You need to know what changes are likely and how they will affect your business.

As in more recent years, the Congress begins with a seminar on changes in USPTO practice. This seminar will be addressed by our newly elected Member of Honour, His Honour Judge Paul R Michel, Circuit Judge, Court of Appeals for the Federal Circuit (CAFC).

Following the opening of the Congress, we will be addressed by Mr. Jose Luis Arnaut, Minister Assistant to the Prime Minister of Portugal, and our new Member of Honour, Dr. François Curchod, former Deputy Director-General of WIPO.

The session on patent harmonisation and other matters etc. will be addressed by Mr Nicholas Godici, Commissioner of the USPTO, and Dr Jürgen Schade, President of the German Patent Office.

From OHIM, we will have Dr. Alexander v Muhlendahl and Dr. Martin Schlotelburg discuss aspects of the future of the trademark and design systems respectively. In relation to the involvement of the patent attorney in litigation, we will be addressed by Mr. Walter Holzer, President of epi, and His Honour Judge Michael Fysh QC SC, who is bound to provide an entertaining presentation.

To complete the program, Dr. Ingo Kober, President of the EPO, will address us on the future developments of the European patent system.

The social program is in the capable hands of the Patentanwaltskammer, and I can assure you that it will be a program of great interest and entertainment both for delegates and for accompanying persons.

Finally, I apologise to all members for not having been able to lead the Federation as I would like to have done over the last 12 months due to my illness. I had great plans to visit most Associations and Sections, but that was not possible in the circumstances.

I do trust that I will see you all in Berlin.

ACTING FOR IP WORLD-WIDE

## OUR NEW LOOK

For over a year FICPI has been working on ways to improve its image, its influence and the standing of its members. One of the first tangible results can be found in Information's new look. In the coming months this redesign will be extended to the website and brochures for new members and the press.

To support these initiatives we have also arranged for key FICPI spokespeople to prepare articles on current issues for international magazines and specialised local press. These articles will describe the activities of FICPI and stress its achievements and stature. You will start to see these articles shortly.

Overall we are committed to continue refining these approaches and making sure that when something important occurs in the IP World, FICPI's views are heard.



# COMMUNITY PATENT

TERRY JOHNSON – PRESIDENT, EUCOF (EUROPEAN UNION MEMBERS COMMISSION OF FICPI)

The Commission Proposal consists of two proposals:

- Proposal for a Council Regulation on the Community Patent of 1 August 2000 (COM(2000) 412 final)
- Commission Working Document on the planned Community Patent Jurisdiction of 30 August 2002 (COM(2002) 480 final)

## 1. THE JURISDICTIONAL SYSTEM

**(a)** The jurisdictional system will be based on a unitary system for the CP, the aim being to secure uniformity of jurisprudence, high quality of work, proximity to users and potential users, and low operating costs.

**(b)** The Court of Justice is to have exclusive jurisdiction, inter alia relating to invalidity, infringement proceedings, declaration of non-infringement, and counter claims for invalidity. The Court of Justice will also have exclusive jurisdiction for granting interlocutory injunctions/provisional measures. The CP may also be the subject of proceedings for claims or damages.

**(c)** Litigation of CP shall at first instance be before a judicial panel established by a Council decision according to Article 225a of the EU Treaty.

**(d)** An appeal shall lie with the Court of First Instance of the European Union. (CFI).

**(e)** The judicial panel referred to above shall be called the Community Patent Court (CPC), will be attached to the CFI, and will have its seat at the CFI.

**(f)** The CPC may hold hearings in Member States other than that in which it is located.

**(g)** It is expected that the CPC will be organized into chambers, each of which shall have three judges.

**(h)** The judges shall be appointed by unanimous decision of the Council for a fixed term. Candidates for appointment must have an established high level of legal expertise in patent law. However, technical experts will assist the judges in handling of cases.

**(i)** Proceedings before the CPC are to be in the official language of the Member State where the defendant is domiciled, or, where there are two or more official languages in a Member State, the official language chosen by the defendant. However, at the request of the parties and with the consent of the CPC, any official language of the EU can be selected as the language of the proceedings.

**(j)** The CPC shall be established at the latest by 2010. Each Member State is to designate a limited number of national courts to have jurisdiction in post-grant matters relating to CP until that time.

## 2. LANGUAGES

**(a)** Up to the grant of the CP, the language regime for the CP will be the same as provided under the EPC. The approach, however, allows for an applicant to file an application in a

non-EPO language, and providing that the applicant provides a translation into an EPC language, the cost of that translation will be borne by the system referred to as "mutualisation of costs".

**(b)** Upon the grant of the CP, the applicant must file a translation of all claims into all official EU languages, unless a Member State renounces translation into its official language. These translations are to be filed in the EPO, the costs being borne by the applicant.

**(c)** The amount of a renewal fee for a CP must not exceed the level of the corresponding renewal fees for an average European Patent.

**(d)** The Commission is invited by the common political approach to carry out a study of possible further cost savings, e.g., in respect of services provided by patent agents.

## 3. NATIONAL PATENT OFFICES

**(a)** Although the EPO will be central to the administration of CPs and alone will be responsible for examination and grant of such patents, the common political approach states that all national offices will have an important role to play. This role includes advising potential applicants for CPs, receiving applications and forwarding them to the EPO, disseminating patent information, and advising SMEs.

**(b)** Applications of CPs can be filed with the national office of a Member State in its working language(s).

**(c)** On behalf of the EPO and at the request of the applicant, national patent offices of Member States having an official language other than those of the EPO may carry out any task up to and including novelty searches in their respective language(s).

**(d)** National patent offices of Member States having as their official language one of the EPC languages, which have experience of co-operation with the EPO and which need to maintain a critical mass, may, if they wish, carry out search work on behalf of the EPO.

**(e)** Work referred to in paragraphs (c) and (d) above will be based on partnership agreements with the EPO, these agreements being subject to periodic independent review.

## 4. RENEWAL FEES

**(a)** Renewal fees for CPs will be payable to the EPO and will be distributed 50:50 between the EPO and the national patent offices of the Community Member States in accordance with a distribution key which will be decided by the Council.

## 5. Review

**(a)** The Commission will present a report to the Council on the functioning of all aspects of the CP, five years after the grant of the first CP. Further reviews should be made periodically thereafter.

# FURTHER COMMUNITY NEWS

HELMUT SONN – MEMBER, EUCOF

## COMMUNITY TRADEMARKS

1. The Commission proposed on 27 December 2002 (COM(2002) 767 final) a Regulation amending Regulation (EC) No. 40/94 on the Community Trademark.
2. These amendments should enable the Community to ratify the TLT and generally streamline proceedings before OHIM and make them more secure. In this context, it also proposes the total abolishment of searches (Art 39).
3. A meeting of the Council on the topic "Competitiveness" scheduled for 19 May 2003 will not only discuss a decision on the abovementioned amendment of the Regulation on Community Trademarks, but will also discuss a possible decision on a further Regulation (a proposal dating from 1997), which would add to the CTM Regulation a part linking it with the Madrid Protocol (the "Link" Regulation). The pressure to go forward with the "Link" is now increasing in view of the US accession to the Madrid Protocol.

## COMMUNITY DESIGNS

1. The Community Design Regulation and the Implementing and the Fees Regulations were published in 2002.
2. Accordingly, OHIM began accepting applications as from 1 January 2003, though the earliest application date accorded to a Registered Community Design will be 1 April 2003, the official starting date for the system.
3. The Designs Department has a staff of 23 split into 4 groups of Examiners plus a co-ordinator. To date, around 400 CD applications have been received.
4. Electronic filing of CDs is not yet possible.
5. Euro Locarno should be used by Applicants if possible.
6. All relevant fees must be paid up front, not over the course of implementation.
7. There should be a searchable designs database by the end of the year.

## ANTI-COUNTERFEITING REGULATION

On 20 January 2003 the Commission issued a proposal for a new (totally amended) Regulation concerning customs actions for infringing goods.

This proposal will also be discussed by the Competitiveness Council of the EU on 19 May 2003. It would bring many new procedural changes, such as destruction of infringing goods by customs authorities without prior Court decisions in certain cases, and enlarging the intellectual property rights to which it is applicable.

## DIRECTIVE ON ENFORCEMENT

The Commission finally issued on 30 January 2003 its long-awaited proposal for a Directive on measures and procedures to ensure enforcement of IP rights.

The Competitiveness Council on 3 March 2003 approved it, taking the view that it would enhance the efficiency of the

fight against counterfeiting and piracy within the EU. It relates to all types of IP rights and would have to be implemented in all national IP laws of all Member States (including new Member States) once decided by the European Parliament and the Council of Ministers.

## RECOGNITION OF PROFESSIONAL QUALIFICATIONS

On 7 March 2002 the Commission presented its proposal for a new Directive which would regulate the freedom of establishment and the freedom of services of all professions, in place of the Diploma Recognition Directive of December 1988 (No. 89/48/EEC) and all specialised Directives concerning particular professions.

Legal professions of many Member States were concerned about this text, since in their view it would lead to drastically lowered qualification standards in some Member States, as it would allow persons less qualified than those of a host Member State to provide legal services in that Member State.

At the moment, the European Parliament's Legal Affairs Committee is dealing with the matter. It held a hearing in October and has now issued a Draft Report on 6 February 2003 containing a host of amendment proposals.

## FREEDOM FOR PATENT ATTORNEYS TO PROVIDE SERVICES IN OTHER MEMBER STATES

The Commission sued the Italian Republic in respect of perceived deficiencies in its legal system.

This system required a residence or place of business in Italy, and enrolment in the Italian Register of Patent Attorneys, by way of passing the Italian qualifying examination. Although a similar system could be applied for patent attorneys of other Member States wanting to establish themselves in Italy according to the Diploma Recognition Directive (No. 89/48/EEC), such foreign patent attorneys cannot do so if they only provide services occasionally or temporarily for their clients in Italy. The freedom to provide services enshrined in the Treaty establishing the European Union requires much less restrictive provisions, and is thus violated. Hence the Court action by the Commission, resulting in a decision of the European Court of Justice C-131/01 (13 February - 2003).

## DIARY DATES

**Colloquium, Nice**

April 8-9, 2003

**World Congress, Berlin**

June 2-6, 2003

**World Congress, France**

June 2006

## EULOGY

**Hélène Chrétien Dubuc**

Hélène passed away suddenly on February 26, 2003. Hélène was well known to the FICPI family, having attended every FICPI congress for close to 20 years and many FICPI EXCO s and Forums. She was the spouse of Jean Dubuc (CA), a past president of FICPI Canada and former EXCO member. She collapsed while finishing a round of golf, near their winter retreat in Florida. She will be missed by many FICPI friends from around the world.

**Robert Mitchell,**

President, FICPI (CA)

## CONTRIBUTE

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NEXT NEWSLETTER:

**NOVEMBER 2003**

PLEASE SEND ALL  
CONTRIBUTIONS TO  
THE EDITOR BY LATEST,  
10 NOVEMBER

## COMMUNITY PATENT CONTINUED FROM PAGE 2

It is to be noted that the Council states at the end of the common political approach that filing a translation of the claims into all the official EU languages upon the grant of the patent means within a reasonable time from the date of grant, and during this time the granted patent shall be valid irrespective of availability of translation of all the claims into all official EU languages. It is noted that the German delegation considers that a reasonable time would be within two years from the date of grant of the CP and no other delegation seems to disagree with this interpretation. The full document is available at: <http://register.consilium.eu.int/pdf/en/03/st06/st06843-re01en03.pdf>.

## NICE COLLOQUIUM

MALCOLM ROYAL – PRESIDENT, FICPI

The first FICPI/AIPLA Colloquium was held in Rome in 2001 in conjunction with the FICPI Forum. The Colloquium dealt with the then current proposal of the EPO to unilaterally amend the time limit for entries of the national phase under Chapter II, from 20/21 months to 30/31 months.

The Colloquium was a huge success and met our objectives, which were to allow the views of the users of the Patent System to be aired and discussed in the presence of WIPO and patent officials. The outcome was that those using the system required certainty and predictability in the grant. Many, including FICPI, took the view that we would be happier to have an additional search undertaken than to continue on with the current process of examination.

Since then much has changed, and there are a number of proposals before WIPO for amendment of the PCT.

Again, the meetings that take place in Geneva are undertaken in circumstances that pose difficulties for those other than officials. Applicants/users find it difficult to influence the proposals at an early or formative stage so that later interventions are less effective.

Accordingly, FICPI has sought the assistance of AIPLA again to organise a Colloquium, this time dealing with the Patent Co-operation Treaty amendments that are being proposed at WIPO at the moment.

FICPI President Malcolm Royal will moderate the first day, and the President of AIPLA, Mr Ron Myrick, will moderate the second day.

It is hoped that following the explanations given by the official representatives, those who use the system will have ample opportunity to give their views as to what system they would like to be put in place. We may be wrong, but we believe that there may be some views that differ from those of the official bodies. "We want to bring those into the open," said Malcolm Royal, President of FICPI.

The meeting is taking place as we go to press. We shall produce a full report and circulate it to the various officials who have a voice and vote at WIPO.

## LETTER FROM THE EDITOR

MICHAEL HAWKINS – EDITOR, INFORMATION

Firstly, I hope all our readers approve of the new design of FICPI INFORMATION as part of the work currently underway in developing FICPI's profile.

Secondly, I confirm that I will be retiring from my role as President of the Publications Commission at the Berlin World Congress, so this is the last issue for which I am responsible.

It has indeed been a great pleasure and privilege to be the Editor of FICPI INFORMATION for the past 6 years.

In thanking all the numerous contributors to FICPI INFORMATION over this period, I also particularly thank Brigitte Froud for her superb work in its design and production.

