



INFORMATION

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ACTING FOR IP WORLD-WIDE

AMBITIOUS GROWTH PLANS FOR JAPANESE PATENT OFFICE

The Vice President of the CET, Mr. K. Takami, had an opportunity to meet with Mr. Imai, the newly appointed Commissioner of the JPO in August 2003. The Commissioner outlined his plan for the JPO to achieve the timeliest and highest quality patent examination in the world. Among the actions planned:

1. Recruitment of 100 fixed term patent examiners per year for the next 5 years for a total of 500 new examiners.
2. Recruitment of 98 part time searchers.
3. Outsourcing of search for domestic applications, estimated at 190,000 cases in 2004.
4. Expansion of outsourcing in other areas.
5. Reduce the time taken to issue first office action from 24 months to 0.

LETTER FROM THE PRESIDENT

FRANCIS AHNER – PRESIDENT, FICPI

We have all noticed that we are now, more than ever, going through a phase of frenzied acceleration of reform of all kinds, and industrial property is often affected by such, sometimes breathtakingly fast, progress, even when it is not at the epicentre of such reform.

Such an observation is by no means surprising, and we ought to congratulate ourselves on the progress achieved, as industrial property has often done much to establish new economic systems at national, regional or international level.

The European Patent – in force since 1978 – acted as precursor, and the Community trade mark and design have come to being as a result. Perhaps, soon, there will be a Community Patent alongside a new, unified juridical system.

Our profession and, hence, our Federation, has already been and will surely once again be further affected by such developments.

Nevertheless, the prime objective that has been the structural *raison d'être* of FICPI, i.e., the strengthening of professional links between members at an international level, at the present time risks being turned on its head and inevitably diluted among many other concerns.

Despite ongoing globalization, we must above all remember the concept of the right to protection that is still necessary if there is to be an equitable, worldwide economic equilibrium. The liberalization of trade, the authorization of parallel imports, the failing of international law, the likening of protection policies to abuse of a dominant position, and compulsory licences are all, perhaps, evolutions rendered necessary by the establishment of new economic areas within the world. Yet, globalization must not be allowed to upset the equilibrium. In general terms, industrial property has undoubtedly taken on the role of a stabilizing factor, opposing uncontrolled economic liberalism, which would only endanger the investment mechanisms of our value-producing societies and therefore innovation and progress.

A desire for stabilization must be the focus of all our reflections and actions.

More specifically, what are the dangerous reforms that lie in store

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for our profession? Unfortunately, even at first glance, there are quite a number of them:

- Some national or regional patent offices, although under pressure from users because of sizeable backlogs, point to the alleged poor quality of the patent applications filed at those offices. Such accusations were indeed made by the EPO at the most recent Trilateral Meeting in Vienna and at our AIPLA/FICPI Colloquium in Nice.
- In a general presentation document that led to political agreement regarding the establishment of the Community Patent, the European Commission felt it necessary to slip in an observation on the savings that will yet have to be made, particularly in terms of the fees charged by the profession.
- We have to prepare objective responses to make in reply to these various, totally unjustified, "attacks".
- Still within the context of the introduction of the Community Patent, it was suggested that national offices could assist applicants in accessing the patent system and also provide advice on patents to SMEs.

Clearly, therefore, the desire is for such offices to fulfil a role traditionally carried by our profession. We will have to react, firstly through a demonstration of our professionalism and the quality of our services and then by ensuring that the various actors properly understand that national offices cannot fulfil such roles without also raising problems of conflict of interest. "One cannot be both judge and accused."

- The protocol on disputes involving European patents, the Community Trade Mark Courts and the future legal system relating to the Community Patent will undoubtedly affect our profession.
- We will have to become involved and act in order to demonstrate the full worth of our role, *vis-à-vis* such bodies, particularly because of our dual technical and legal education. We will have to:
 - assert our presence at the stage of new systems of teaching, research and training that are currently being set up, for example, the "European Academy" proposed at the most recent EPO Administrative Council, or the new epi/CEIPI course on Patent Litigation in Europe, the intention to award a diploma, enabling us to appear before these future legal bodies;
 - extend our actions aimed at obtaining recognition of the professional privilege that covers much more than the simple confidentiality obligations to which many of us are now subjected, which will enable us to overcome distortion and discrimination in the conditions of practice in our industrial-property professions, principally in Europe. Obviously, this also impinges upon our right to represent and notions of professional links with other industrial property actors;
 - Deregulation of the professions in the wake of the Mutual Recognition Directive appears to be at odds with the direction the FICPI has always followed, namely recognition of a protected title guaranteeing a level of professional qualification assessed by examination. However, perhaps the FICPI label, although optional, could nevertheless be imposed, given our Federation's reputation across the world. It is up to us to work further in this direction.

- The same consideration could apply to the resumption of discussions on the liberalization of services within the context of the WTO, our concern still having to be that of promoting the FICPI as a label of quality.

At any rate, amid all these conflicting eddies and currents, I consider we should maintain our course towards respect for a high level of professional qualification.

It would be illusory to wish simply to turn one's back on the reform projects that are just around the corner, and to adopt a systematically negative attitude that would certainly be interpreted as self interest, causing the various opinions that the FICPI might express in national or international fora regarding such and such a reform to lose all credibility.

On the contrary, we must get involved in all these reform mechanisms and make our positions known, offering a reliable argument based on our wide experience acquired at international levels.

Acting thus, the reliability and quality of our services have led some public organizations to give genuine credence to the arguments we have developed – sometimes, ultimately, they have even listened to us. Our active presence at WIPO has made it possible, in everyone's interest, to safeguard our role of representation under Article 6 of the PLT.

Our continuous presence at WIPO, although costly, should be pursued, as it also has a positive effect on our Federation. Recognition of this image of quality in association with our Federation should also stimulate the accession of new members. It should also help give it greater weight and elicit a higher level of recognition on the part of representatives from the various national and international authorities.

Nevertheless, all these actions will still have to be carried out with due respect for a certain equilibrium. We have, for example, clearly expressed, in our reply to the WIPO Patent Agenda, that account must still be taken of the interests of all users of the patent system. Because of our interventions in favour of both active and passive players in the patent system, we are actually better placed than anyone else when it comes to knowing that a balance between the rights of the patentee and the rights of third parties is fundamental.

We have to further increase our membership and definitely make it more homogeneous across the globe – the symbol of our Federation. In this area, our efforts at expansion must clearly not be to the detriment of maintaining quality, which is an image we must preserve in the future.

We must ensure that our code of ethics is upheld and respected – alongside commitments to quality service, such a code must also guarantee good relationships between members. Here, too, we will have to find a balance, faced as we will be by the spirit of unbridled competition often advocated by many international organizations.

Yet again, a concern for balance must underpin our every consideration and action, as, clearly, frenzied competition, is often incompatible with respect for our representatives objectives of quality.

We will have to better adapt to evolution in our profession in the future. The prospect of combined legal and technical judges should raise the profile of the dual legal and technical qualification of the majority of us in terms of our activity of advising, preparing and representing our clients. It will not be a matter of simply appearing before such courts, but also, one of acting within the framework of alternative dispute resolution mechanisms, for example.

There has been a recent proliferation of new mechanisms involving primarily facilitation, expertise, mediation and arbitration because they satisfy the desire for speed and are more cost-effective.

It has come to our notice that our field of activity is continuing to expand. Intellectual Capital now forms a large portion of business value. In certain technological fields, such as telecommunications and, above all, biotechnologies, Intellectual Capital is often a company's major asset. Our profession is and will increasingly be requested to carry out or to participate in this type of evaluation. We will, therefore, also have to be further involved in these new activities that are carried on, in particular, within the context of corporate mergers and acquisitions. We will also have to open up to the world of regulatory affairs, and not only in the field of medicinal products.

Sometimes, however, evolution of this kind might require closer ties with other professions, such as barristers, accountants or even investors. Such closer ties could obviously be envisaged within the context of an inter-professional structure.

Here, too, it will be essential for these changes to be implemented in a balanced manner, particularly to avoid too great a dilution of our identity.

We will obviously pursue our actions in a spirit of continuity in terms of our past motivations and policy. No doubt some adaptations will be required, but, as already discussed at some length, balance must always be preserved.

It is in this spirit that I would dearly like to be able to consolidate our role as representatives and our credibility in the field of trade marks and designs. The increasing complexity of the field in the wake of reforms and progress, particularly in connection with the Internet, has tended to give rise to a divergence from the world of patents. We will also have to monitor re-establishment of balance in this area.

This desire for equilibrium also arises in the composition of our new Bureau, with the appointment of Danny Huntington, an American Vice-President and Gert Schmitt-Nilson, a German Assistant Secretary General, the latter country still being, if anyone needed reminding, the centre of gravity of our membership.

This desire to be more representative, more credible and, therefore, more attractive must also come into play at the level of the CET Group, which is the FICPI kingpin. The various working groups of that commission include industrial property specialists from all parts of the globe. Eclecticism, such as this, gives the CET and FICPI as a whole an incomparable wealth of knowledge that makes it an organization that is both listened to and valued – that alone ought to guarantee the long-term development of our profession as industrial property attorneys.

FICPI IN ACTION

A major role of FICPI is to ensure the views of its members and the interests of the profession are made known at appropriate fora. During 2003, FICPI has been represented at the following events:

MEETINGS WITH OFFICIAL BODIES

A meeting was organized with WIPO in Geneva to discuss, in particular, the issue of international harmonization in Patent Laws and with EU Commission in Brussels.

ATTENDANCE AT MEETINGS ORGANIZED BY OFFICIAL BODIES

FICPI was represented at various meetings of Standing Committees on Patents (SCP), Trademarks (SCT) and Information Technology (SCIT), organized by WIPO in Geneva (Switzerland) and at a user's meeting organized by OHIM in Alicante (Spain). FICPI also attended a conference on Grace Period organized by the European Commission (EC) in Brussels (Belgium) and at the International Forum on the PCT procedure:- Recent changes – WIPO/EPO International Academy/EPI – Munich Nov 2003

RELATIONS WITH SISTER ORGANIZATIONS

FICPI was invited as observer to a Forum organized in Lisbon (Portugal) in April 2003 by the Asociación Interamericana de la Propiedad Industrial (ASIPI) and was also represented at ASIPI's Congress held in Mexico in November 2003. FICPI was also invited as observer to an AIPLA meeting organized in Washington D.C. (USA) and also participated as observer at the APAA General Assembly held in Kota Kinabalu (Malaysia) in October 2003. FICPI also participated in an NGO Roundtable organized in London (UK) on the issue of international harmonization of Patent Laws within the context of the draft Substantive Patent Law Treaty (SPLT) prepared by WIPO.

INTERNAL MEETINGS

A number of Bureau telephone conferences took place, as well as FICPI CET meetings in Nice (France) in April 2003 and in London (UK) in November 2003. An Executive Committee meeting (ExCo) was held in Singapore in January 2004.

WORLD CONGRESS

BERLIN – JUNE 2003



The World Congress returned to Europe in June 2003, graciously hosted by the Patentanwaltskammer. The location chosen was the historic city of Berlin, beautifully refurbished and a fascinating city to explore. The superb organisation extended to the weather, which provided a week of beautiful sunshine, ensuring the social program progressed without a hitch.

Attendance at Berlin was at historic levels with over 500 professionals from around the world. The theme of the

Congress was "Dialogue on the Future" and included a wide ranging list of topics from discussion of the WIPO Patent Agenda concerning the future of the patent system itself, through to marketing of IP firms. Within this spectrum there were discussions on harmonization, cross border practices, developments of the trade mark and design systems and the involvement of patent practitioners in litigation. The working program was well attended despite the attractions outside the Congress centre. Speakers were of the highest calibre, all experts in their field, and included Judge Michael Fysch, high level representatives from WIPO, the President of the EPO, and the Vice President of OHIM.

A pre-conference seminar on US practice drew a large group of interested practitioners, with the opportunity to hear FICPI's Member of Honour, Judge Paul Michel, provide his views on some of the thornier issues.

As is usual at the Congress, the discussions gave rise to a number of resolutions that formally expressed the Federation's view on significant issues. The resolutions are reproduced on pages 14 to 23 in all three official languages. Electronic versions may be found on the FICPI website (www.ficpi.org), as can the papers from the Congress.

The social program was varied and even innovative with the accomplished musicians on the opening reception demonstrating how easy it was to make music from hoses and funnels. An organ recital and evening at the Railway museum were warm ups for the full day excursion that offered a variety of venues with all roads leading back to Schoss Diedersderff for an afternoon of German hospitality, food and of course "beverage".

The climax of the Congress was the final banquet with the changing of the Presidency, but not before those present had paid tribute to the extraordinary courage and devotion to duty shown by Malcolm Royal over the past three years. He was greeted with a standing ovation and, in a break with tradition, Maggie Royal thanked everyone for the support and encouragement provided to Malcolm as he fought his illness. A truly heartfelt demonstration of the meaning of "the FICPI family".

In assuming the Presidency, Francis Ahner thanked the membership for the confidence shown in him, acknowledged the outstanding work undertaken by Malcolm and assured everyone of his commitment to continue in the manner expected of this position. Perhaps thinking of when his new found responsibility would be lifted, he reminded everyone of the next World Congress in Paris in 2006.

The party continued in to the night, some even saw the dawn, and the Congress wrapped up with committee meetings for those involved before leaving Berlin with new memories, friends and appreciation for the challenges facing the IP practitioner.



NGO ROUNDTABLE MEETING ON PATENT LAW HARMONISATION

IS THERE ANY WAY FORWARD? BY JAN MODIN

Some twenty-five non-governmental organisations attended a “roundtable” meeting in London on 11-12 November 2003. FICPI was represented by its new President, Francis Ahner, and Work and Study Committee (CET) members, Jan Modin, Julian Crump, and Robert Mitchell. In contrast to the regular WIPO meetings of the Standing Committee on the Laws of Patents (SCP), no government representatives were invited. Some WIPO representatives were however present as observers.

US and British-based organisations, AIPLA and CIPA, took the initiative to convene the roundtable discussion after the failure of the last SCP session in May 2003 to achieve any real progress on the proposed Substantive Patent Law Treaty (SPLT). The aim was to find out whether the users of the patent system could reach agreement. It was felt that there were too many unrelated and contentious issues in the current drafts of the SPLT which were hampering progress in the negotiations. The roundtable discussions, therefore, focused on a limited set of key topics:

- First-to-file
- Grace period
- Definition of prior art
- Prior art effect of earlier, unpublished applications

At the time of the meeting, it became known that AIPPI had recently passed a resolution on this matter and was organising a seminar in Geneva for late January 2004. Furthermore, on November 7, 2003, the patent offices of the Trilateral Cooperation (JPO, USPTO, EPO) concluded a memorandum of understanding, suggesting that further substantive harmonisation should proceed in two stages: a first stage including the majority of the substantially non-political provisions in the recent drafts of the SPLT, followed by a second stage dealing with first-to-file/first-to-invent and industrial applicability/utility.

Most of the first day of the meeting was given over to pre-prepared, objective presentations by invited speakers on the issues involved in each of the four selected topics, with the audience being given suitable opportunities to ask questions or seek clarification of the points being made by the speakers. Each NGO was then given the chance to present briefly its views on the issues, and to indicate where it could be flexible.

Finally there was a short discussion about how to go forward. The first presentation was given by Timothy Roberts of CIPA (Chartered Institute of Patent Agents), who explained that, in fact, there is much in common between US law and UK law with respect to the principles underlying the granting of patents to independent, competing inventors making the same or similar inventions. Mr. Roberts conclusion was that both systems are basically “first to invent” systems, differing from one another only in respect of how they decide who is the “first” inventor. In UK and Europe nowadays, there is an irrebuttable presumption that the first to file is also the first to invent, whereas in the US there is a rebuttable presumption that the first to file (senior party) is also the first to invent. Nevertheless, in the majority of US interferences this presumption is not rebutted, and the senior party wins.

FICPI’s Vice President, Danny Huntington, observed that of some three hundred and fifty thousand US patent applications filed each year, only about three hundred are subject to interference proceedings, and felt that, for society and the public in general, it would be sensible to abolish the interference system. This view was broadly supported by the US based NGOs, and all of them, including AIPLA, IPO, and the

IP section of ABA, confirmed that they would prefer a system based on the first-to-file principle. They agreed to take this conclusion back to the US, where Congress would have to be lobbied, and to the offices of the Trilateral Cooperation that had recently decided to defer this issue to a “second basket”.

FICPI President, Francis Ahner, presented the Federation’s established position in favour of an international grace period, with a duration of twelve months, and without a declaration by the applicant listing relevant prior disclosures. Robert Mitchell supplemented this with experience from Canada where a first-to-file system and a grace period have been combined successfully for a number of years; in Canada, the grace period is used only as a safety net, and not as part of filing strategy. As expected, some European NGOs were opposed to a grace period, and argued that if a grace period were to be introduced at all, then it should be limited to a duration of six months, and that there should be a mandatory requirement for the applicant to make a declaration on filing.



To a large extent the NGOs – especially those based in Europe – recited their well-known positions, and argued for maintenance of their present systems. This was certainly true in respect of the prior art effect of unpublished applications, with the representatives of European NGOs arguing strongly for the “novelty only” standard of patentability for a later application over the whole contents of an earlier unpublished one, whilst most US representatives required a “novel and unobvious” standard, together with anti-self collision and terminal disclaimer provisions.

Overall, the consensus that some had hoped for beforehand was not reached, but the representatives did broadly agree, subject to approval by their respective governing bodies, to urge the SCP to confine its further discussions to the four selected issues.

FICPI intends to spend time on this matter at its forthcoming ExCo meeting in Singapore. Hopefully, it will be possible to agree on a more precise position than the provisional one expressed in London, viz:

“[FICPI] strongly support[s] the development and subsequent ratification of an effective Substantive Patent Law Treaty under the auspices of WIPO for reasons of harmonisation, legal certainty, efficiency, and economy. A package comprising at least the following provisions would be compatible with [FICPI’s] established positions and resolutions, i.e.:

- First-to-file,
- An harmonised international grace period, and
- A clear definition of the state of the art that is compatible with the first-to-file system, and with an international grace period that affords certainty for all users of the patent system and solves inter alia the double patenting problem.”

In London, the focus was to resolve, or at least discuss, transatlantic differences. Surely though, an even greater challenge is to deal with current North-South tensions. It has become evident during recent WIPO meetings (SCP on substantive patent law harmonisation, and the Working Group on PCT Reform) that the developed, industrialised countries of the northern hemisphere require a stronger, deeply harmonised patent system, which is confined to classical IP issues, whilst the developing and least developed countries of the southern hemisphere (including Latin America, Africa, and India) are generally unhappy with the consequences of TRIPS and wish to put the issues of public health, biodiversity, traditional knowledge, and genetic resources firmly on the agenda for consideration in the context of the international patent system. FICPI, which is a truly international organisation, will have to take this into account in the development of its positions.

PURPOSIVE CONSTRUCTION COMES TO THE DIGITAL WORLD

The doctrine of “purposive construction” appears to have been widely adopted in the patent world as the basis for resolving ambiguities and ensuring words are given the meaning originally intended. It seems we are not alone in this endeavor, as may be seen from the following discussion:

Once upon a time, computer professionals noticed that 2^{10} was very nearly equal to 1,000 and started using the SI prefix “kilo” to mean 1024. That worked well enough for a decade or two because everybody who talked kilobytes knew that the term implied 1,024 bytes. But, almost overnight a much more numerous “everybody” bought computers, and the trade computer professionals needed to talk to physicists and engineers and even to ordinary people, most of whom know that a kilometer is 1000 meters and a kilogram is 1,000 grams.

PREFIXES FOR BINARY MULTIPLES

Then data storage for gigabytes, and even terabytes, became practical, and the storage devices were not constructed on binary trees, which meant that, for many practical purposes, binary arithmetic was less convenient than decimal arithmetic. The result is that today “everybody” does not “know” what a megabyte is. When discussing computer memory, most manufacturers use megabyte to mean $2^{20} = 1\,048\,576$ bytes, but the manufacturers of computer storage devices usually use the term to mean 1,000,000 bytes. Some designers of local area networks have used megabit per second to mean 1 048 576 bit/s, but all telecommunications engineers use it to mean 106 bit/s. And if two definitions of the megabyte are not enough, a third megabyte of 1,024,000 bytes is the megabyte used to format the familiar 90 mm (3 1/2 inch), “1.44 MB” diskette. The confusion is real, as is the potential for incompatibility in standards and in implemented systems.

Factor	2^{10}	2^{20}	2^{30}	2^{40}	2^{50}	2^{60}
Name	kibi	mebi	gibi	tebi	pebi	exbi
Symbol	Ki	Mi	Gi	Ti	Pi	Ei
Origin	kilobinary: $[2^{10}]^1$	megabinary: $[2^{10}]^2$	gigabinary: $[2^{10}]^3$	terabinary: $[2^{10}]^4$	petabinary: $[2^{10}]^5$	exabinary: $[2^{10}]^6$
Derivation	kilo: $[10^3]^1$	mega: $[10^3]^2$	giga: $[10^3]^3$	tera: $[10^3]^4$	peta: $[10^3]^5$	exa: $[10^3]^6$

MORE DETAILS MAY BE FOUND ON [HTTP://PHYSICS.NIST.GOV/CUU/UNITS/BINARY.HTML](http://physics.nist.gov/cuu/units/binary.html)



ELECTRONIC FILING OF PCT APPLICATIONS

In August 2003, the International Bureau as receiving Office (RO/IB) announced that, with effect from 25 August 2003, it was ready to receive international applications in electronic form from registered users participating in the PCT-SAFE pilot. August 25, 2003 also saw Dutch electronics giant Philips become the first to file a fully electronic international application with RO/IB using PCT-SAFE ("Secure Applications Filed Electronically") software. The availability of this upgraded secure electronic filing facility means that some PCT users are now able to file their international applications either on-line or using physical media such as CD-R.

The PCT-SAFE software, which is available to all PCT users from January 2004. Users will be able to submit validated applications without the printing, copying and mailing normally associated with such a transaction. PCT-SAFE also notifies users, almost immediately, that their application has been received and is being processed.

HOW DOES IT WORK?

The new system has been built on an enhanced version of the PCT-EASY software. This will facilitate the transition to PCT-SAFE for users who currently prepare the request part of their international applications using the PCT-EASY software. The PCT-SAFE software makes it possible for applicants to continue to create and file PCT-EASY type applications (paper plus diskette). In the process of completing an electronic application, the system validates the data entered using a "traffic light" system. This indicates any fields which have been incorrectly or inconsistently completed to help avoid problems relating to the international application once it is filed. Applicants may also choose whether the international application is to be filed using physical media or on-line. Depending on which means of filing is selected, a completed international application in electronic form is either saved on physical media and filed or directly transmitted electronically to the specified receiving Office, and in particular, as announced above, RO/IB.

The PCT-SAFE Editor – a new easy to use software for authoring the body of an application – is also included in the PCT-SAFE software. The PCT-SAFE Editor is a user-friendly option that enables the preparation of the body of a PCT application in the required electronic format (eXtensible Markup Language (XML)). XML is an industry standard computer readable format that is very useful for searching, storing and exchanging patent information. When operating the Editor, applicants can choose whether to convert the body of an application created using a word processor to the XML format, or whether to prepare the application body from scratch within the Editor. Once created by the PCT-SAFE Editor, the applicant combines the body of the application with the request part of the application by indicating its location

using the PCT-SAFE software. RO/IB also offers applicants an option to prepare components of the body of the application in PDF format.

WHAT ARE THE ADDITIONAL BENEFITS TO USERS COMPARED WITH PAPER FILING?

The use of PCT-SAFE delivers a number of benefits to PCT applicants. These include:

- Electronic on-line transmission which shortens the process of filing and almost immediate assurance that the international application has been received.
- Easy transition from PCT-EASY to PCT-SAFE.
- The validation software within PCT-SAFE creates documents that meet PCT requirements allowing users to be confident that their applications are correctly formatted.
- An on-line submission reduces printing, copying and mailing costs of applications.
- The use of XML formatting means that the documents submitted are fully searchable; both during the PCT procedure and once they enter the public domain.

IS THE PCT-SAFE SYSTEM REALLY SAFE FOR THE SUBMISSION OF PATENT APPLICATIONS?

The PCT-SAFE system offers a high degree of integrity and security in the transmission of patent-related data. Applicants wishing to submit an international application on-line will first need to apply for a digital certificate. The digital certificate is used by the system to digitally sign the international application and to create a secure connection with the receiving Office for the transmission of the international application package. The secure connection ensures that the application is not legible during transmission, and the digital signature ensures that any alteration is detectable.

HOW CAN I OBTAIN IT?

PCT-SAFE software may be downloaded, free of charge from www.wipo.int/pct-safe. Alternatively, a free-of-charge CD installation may be obtained from the PCT-SAFE Help Desk at pctsafe.help@wipo.int or by writing to the PCT-SAFE Help Desk, WIPO, 34 chemin des Colombettes, P.O. Box 18, CH-1211 Geneva 20, Switzerland.

DRAFT ONCE, FILE ANYWHERE!

WIPO is cooperating closely with the Trilateral Offices (EPO, JPO and USPTO) to create compatible systems that allow for the on-line filing of PCT applications from different receiving Offices paving the way for a PCT version of Online Filing (E-PCT).

If you are interested in learning more about PCT-SAFE, please visit the PCT-SAFE web site at www.wipo.int/pct-safe.

OBTAINING TRADEMARK PROTECTION IN THE UNITED STATES UNDER THE MADRID PROTOCOL¹

BY ALBERT TRAMOSCH

As of November 2, 2003, users of the Madrid Protocol can designate the United States in their international applications and requests for subsequent designation. There are a number of unique issues that will arise with respect to U.S. Protocol practice. These are summarized below.

DECLARATION OF INTENT TO USE

Designation of the U.S. under the Protocol will automatically include a declaration of intent to use. Under U.S. law, the declaration must be signed by the applicant or his U.S. qualified representative, but many agents outside the U.S. are not qualified to practice before the USPTO. Unless the request is signed by the holder or a supplementary declaration is signed by the U.S. representative, there is a risk that the declaration could be deemed invalid under U.S. law.

DESCRIPTION OF GOODS & SERVICES

Since the U.S. requires that the goods and services in a trademark application be named "in an explicit manner," most specifications will have to be amended during U.S. prosecution. There is no possibility of filing a preliminary amendment in the USPTO, but amendments can be lodged at WIPO with effect for the U.S. only. Unfortunately, this will usually not avoid a first office action refusal.

BASIS FOR FILING IN THE U.S.

Requests for extension to the U.S. will be treated as regular U.S. trademark applications, under a new statutory basis ("Section 66"), analogous to the present "Section 44" applications. It will not be possible to include any other basis if the Protocol is used: Once a Protocol application, always a Protocol application.

REPRODUCTION OF THE MARK

The USPTO is changing its drawing requirements for all applications to conform to Madrid Protocol practice. It will begin to require color drawings whenever color is claimed (plus a written claim of color), and the size of drawings must conform to the WIPO standards.

GROUND FOR REFUSAL OF A PROTOCOL APPLICATION

A request for extension of protection to the United States will be examined in the same way as regular applications. All of the same grounds for refusal will apply. It's expected that the refusal rate will be 90% or higher.

TIME LIMITS FOR RESPONSE

The USPTO will notify only WIPO of a first refusal. It will not contact the holder or any U.S. attorney. Since the time limit for response to a U.S. office action cannot be extended, there is no flexibility if something goes wrong. U.S. law firms will have to be creative to overcome this potential danger.

The U.S. is changing its practice so that failure to respond will result in abandonment only in respect of the goods or services actually refused. A registration will issue for the remainder.

OPPOSITION, APPEAL AND CANCELLATION PROCEDURES

In general, the same procedures for opposition, appeal and cancellation will apply to Section 66 application as for other U.S. applications. Electronic communication will be required in many instances for Protocol applications.

GRANT; CERTIFICATE OF EXTENSION OF PROTECTION

The U.S. will issue a "Certificate of Extension of Protection" for registrations under the Protocol. Those marks can be registered only on the Principal Register, and will be subject to the five-year time limits for cancellation and "incontestability."

AFFIDAVITS OF CONTINUING USE

The U.S. will require affidavits of continuing use for Protocol registrations. The deadlines (6 years, and every 10 years) will be counted from the date of the Certificate of Extension of Protection, not from the International Registration date.

"REPLACEMENT" OF EXISTING U.S. REGISTRATIONS

The U.S. will expressly implement the "replacement" provisions of the Protocol, in that a registered extension of protection will be back-dated to the date of an earlier identical national registration by operation of law. The holder can ask the USPTO to note that fact in its records and inform WIPO.

CENTRAL ATTACK AND TRANSFORMATION

The U.S. will implement the requirements under the Treaty for "central attack" and "transformation." The resulting U.S. national application will be placed in the queue of pending applications for examination, with a new U.S. serial number.

BUSINESS TO BUSINESS

GLOBAL IP ESTIMATOR'S TIMELINE MODULE

BY JOHN R.S. ORANGE

From time to new products are introduced for the IP practitioner. Members of FICPI are, by definition, in private practice and may not always have the time or resources available to evaluate these new products and share information about them with other practitioners. In an attempt to bridge that gap it seems useful to include

appraisals of these products when the opportunity presents itself, without any intention of endorsing or recommending any particular product. If you have experience with a product or service that has proven valuable in your practice and would like others to know about it please forward a review for consideration.

AL ALBANIA				
Stage	Category	Description	Year	Amount
Filing	Official Fees	File Application	2004	96
	Official Fees	Claims Over 10		30
	Associate's Charges	File Application		559
	Associate's Charges	Claims Over 10		80
	Associate's Charges	Claim Priority		80
	Associate's Charges	Prepare Abstract		120
	Translation	Translation & Typing		1,006
	Miscellaneous	Conforming Drawings to Foreign Specs.		400
	Miscellaneous	Photocopying		3
	Miscellaneous	Facsimile Charges		3
	Miscellaneous	Courier		50
	Miscellaneous	Miscellaneous In-House Costs		100
	In-House	In-House Service Charges		800
			Stage Total	3,327
Granting	Official Fees	Grant Fees	2006	72
	Associate's Charges	Reporting Grant		240
	Miscellaneous	Miscellaneous Costs		100
	In-House Charges	In-House Service		250
			Stage Total	662
			Country Total	3,969
			Total Annuities	10,243
			Total Including Annuities	14,232

Figure 1

The Global Estimator software appeared several years ago and quickly became the de facto standard for estimating the cost of patent, trademark and design applications in different countries. Anyone involved in the Patent Cost debate recognised the data produced by this program as realistic and accepted it as a datum. As shown in Figure 1, the reports produced by Global Estimator grouped the costs by country and did not reflect when the costs would be incurred in those countries. A new product known as the Timeline Module has been introduced by Global Estimator to address this problem.

The Timeline Module is a useful tool for creating an IP budget, as it allows for allocation of costs to future years when they are expected to be incurred. Rather than simply looking at a bottom-line figure (e.g. it will cost \$31,511 to gain protection



via a PCT International application, PCT National Phase and EPO Validation Phase in the United Kingdom), decision-makers are empowered with a more detailed break-down of costs to come.

A sample report is shown in Figure 2 for a hypothetical application. The details of the application, number of pages, number of claims, are provided as before so the report can be customised for a particular application. Thereafter the countries required are selected and the typical costs computed from the database maintained by Global Estimator and updated monthly to ensure the costs are current. The country selection accommodates parallel routes, i.e. national in parallel with PCT and EPO to meet complicated strategies.

In order to display the estimates in a year to year cost it is necessary to export the data to an Excel spreadsheet. The export function, in keeping with the simplicity of the rest of the module, is similarly easy to use and provides reports in four different formats. However, one of my few dislikes of the module stems from this function. The timeline information is exported to four separate workbooks, identified by descriptive file name suffixes. My preference would be to instead have a single workbook with the four reports on separate pages.

As can be seen from Figure 2 (below), the summary report distributes the costs on a year by year basis for each application to allow a cash flow to be determined and totals the expense per year. Using the module is quite intuitive; user-friendliness is one of its key merits. The user has control of priority and application dates, and has the option of excluding filing, granting, examination and maintenance fees at the click of a button as well as selecting different combinations of countries and routes.

Not only is the Timeline module easy to use, but the user is given the freedom to alter the calculation settings in a general or country-specific manner. Default values can be entered

specifying the average length of time to a patent exam and to a patent grant. A discount rate may also be included and the report may be prepared in the chosen currency. Finally, if more particular information is known from experience, the user can override the default time spans for specific countries. Figure 3 is a screenshot showing these options.

A positive of the export functionality is the varied way the timeline information is presented. Estimates can be viewed organized by category (Official, Associate, In-House, and Miscellaneous totals by year), by stage (Filing, Examination, Granting, Maintenance and Chapter II totals by year), or in the condensed and summary reports for those not wanting to be bogged down in detail.

A second downside is found in that while the module is helpful for estimating patent and trademark IP costs, timeline reports are not offered for designs.

In all, though, IP Estimator's Timeline Module is a valuable addition for those wishing to clarify the future costs of a foreign filing program for clients.



Figure 3

	TOTAL	DISCOUNTED 0%	2004	2005	2006	2007	2008	2009
PC PCT (International)	7,961	7,961	7,961	0	0	0	0	0
SE Sweden	27,387	27,387	7,076	350	1,854	0	0	6,466
SG Singapore	13,510	13,510	2,301	0	2,294	0	1,129	389
US United States of America	15,533	15,533	3,570	0	0	2,769	0	1,484
PCT – National Phase								
EP European Patent Office	11,958	11,958	0	4,546	919	960	2,962	2,571
IL Isreal	9,446	9,446	0	2,222	0	0	350	574
NO Norway	23,692	23,692	0	7,397	443	793	443	585
EPO – Validation Phase								
CH Switzerland	11,844	11,844	0	0	0	0	0	2,705
FE France	14,823	14,823	0	0	0	0	0	3,646
GB United Kingdom	12,960	12,960	0	0	0	0	0	2,105
Total	149,114	149,114	20,908	14,515	5,510	4,522	4,884	20, 525

Figure 2

NEW PATENT ACT & RULES IN EFFECT IN INDIA

As of May 2003 significant amendments were made to the Indian Patent Act and related rules.

- 1) Definition of Invention: According to Section 2 (1) (j) of the Patents (Amendment) Act, 2002, an invention means a new product or process involving an inventive step and capable of industrial application wherein inventive step means a feature that makes the invention non-obvious to a person skilled in the art.
- 2) Definition of food has been made more definitive under Section 2 (1) (g) stating that it is meant for 'human consumption' thus eliminating any ambiguity.
- 3) A method or process of testing applicable during the process of manufacture has become patentable.
- 4) A process for treating plants to render them free of disease or to increase the economic value or that of its product has become Patentable.
- 5) A 'chemical process' includes biochemical, biotechnological and microbiological processes. For applications on the subject of biological material, if such material is not available with the public, the application should be completed by depositing the material to an authorized depository institution as may be notified by the Central Government in the Official Gazette and fulfilling certain provisions as laid in the Act.

Other features of the revised act are Unity of invention criteria similar to those under the PCT , a deferral of Examination of up to 4 years is possible, laying open to inspection after 18 months and a twenty year patent term.

IP IN THE NEWS

MICROSOFT LOSES BROWSER SUIT

The University of California and Eolas have been awarded US\$521 million following a finding that Microsoft had infringed US patent 5,838,906. The patent related to a technique that allows other applications to work within a browser. The decision by a Federal jury in Chicago is being appealed. (CNNmoney)

MICROSOFT DEVELOPING IBM – SCALE PATENT PROGRAM

In June, Microsoft hired Marshall Phelps from IBM, the executive who began IBM's patent-based revenue program in 1985. Phelps is credited with making technology companies aware of how valuable a patent portfolio could be, if astutely monetized. Microsoft has been granted 3,000 patents and applied for over 5,000 more.(www.theregister.co.uk)

IT APPLICATIONS DOUBLE

Patent Applications from the European information technology sector have more than doubled in the past decade according to a report by Eurostat. The report showed that the total share of patent applications from the information, communication and technology (ICT) sectors received by the European Patent Office (EPO) from the 15 EU member states in 2001 was 2.3% larger than in 1991.

According to the report, the percentage of ICT patent applications made to the EPO by EU inventors more than doubled from 6.8% in 1991 to 15.5% in 2001. In the same year, ICT applications to the EPO from Japan accounted for 18.7% of the total, with 24% from the US.

Inventors in Germany were the keenest EU patent filers in the ICT sector in 2001. Of a total of 9,421 ICT patent applications filed from the EU, German inventors filed 29.9%, the UK filed 18.6%, France 15.3%, the Netherlands 10.4%, Sweden 8.9% and Finland filed 7.5%.

The report also analyzes applications filed per million inhabitants in 2001. Finland is the leader in this category,

with 136 ICT patent applications filed per million, followed by Sweden with 94 per million and the Netherlands with 62. (Managing IP)

LEMELSON PATENTS FOUND UNENFORCEABLE

Key patents owned by the Lemelson Foundation relating to image recognition devices (bar code readers) have been found unenforceable as a result of "prosecution laches". The Court found that the delay in inserting claims in to an application that had several generations of continuations or continuation in parts rendered the claims unenforceable. In the decision it is noted that the original applications had been filed in 1954 and 1956 but that some of the patents in suit issued from applications filed in 1993 claiming parentage to the first filed applications. The claims in some of the patents would not expire for 55 years after the earliest filing date! The Court noted that in some cases the claims were added years after his original patents had expired in order to cover commercial products already in the marketplace, and that this would unreasonably delay the time when the public could use the claimed inventions. For those interested one of the family of patents is U.S.Patent 4,979,029.

AMAZON SUED UNDER INTERNET PATENTS

On January 12, 2004, Soverain Software LLC filed a complaint against Amazon.com for patent infringement in the United States District Court for the Eastern District of Texas. The complaint alleges that Amazon's website technology infringes several patents obtained by Soverain relating to "Internet Server Access Control and Monitoring Systems" (U.S. Patent No. 5,708,780) and "Network Sales Systems" (U.S. Patent Nos. 5,715,314 and 5,909,492) and seeks injunctive relief, monetary damages in an amount no less than a reasonable royalty, treble damages for alleged willful infringement, prejudgment interest, and attorneys' fees. (SEC filing)

1999 ACT & NEW REGULATIONS FOR HAGUE AGREEMENT

New regulations have been adopted that will simplify design registration under the Hague Agreement. The 1999 Act came in to force December 23 2003, three months after Spain deposited its ratification.

The 1999 Act was adopted by a Diplomatic Conference in Geneva on July 2, 1999. The Act is not yet in force. It will enter into force 3 months after six states have ratified or acceded, provided that at least three of those states have a "certain volume of activity in the field of industrial designs", i.e. at least 3000 applications for registrations filed per year. FICPI participated in a meeting of the Working Group to discuss the revised regulations. At the date of the meeting (June 2003) eight countries had ratified or acceded to the Act, namely: Estonia, Iceland, Republic of Moldova, Romania, Slovenia, Switzerland, Ukraine and Kyrgyzstan. Two of these countries, Switzerland and Slovenia have the required volume of activity. Therefore, only one additional country with the required volume of activity was needed to ratify or accede to the 1999 Act to enable the Act to enter into force.

On September 23, 2003, the Government of Spain deposited with the Director General of the World Intellectual Property Organization (WIPO), its instrument of ratification of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

Given that Spain is the eleventh Contracting Party to the 1999 Act and, according to the most recent annual statistics collected by the International Bureau, the third Contracting Party to the 1999 Act (along with Slovenia and Switzerland) to have the volume of activity in the field of industrial designs required by Article 28(2) of the 1999 Act for such Act to enter into force, it follows that the 1999 Act of the Hague Agreement entered into force three months after the deposit by Spain of its instrument of ratification, namely on December 23, 2003.

With the entry in to force of the 1999 Act three different Acts will have to be administered by the International Bureau. The three Acts are currently complemented by two sets of Regulations:

- the Regulations under the 1999 Act, and
- the Regulations under the 1960 and 1934 Acts, as amended January 1, 2002.

In order to simplify matters for the International Bureau, Offices of Contracting Parties and users of the Hague systems, a set of unified Common Regulations are to be adopted to replace the existing two sets of Regulations. There will then be only one set of Regulations to deal with, and also

a legal framework would be provided for the combined international procedure under the three Acts.

The Secretariat of WIPO drafted and proposed Common Regulations for consideration by the Working Group. These are based, very largely, on the existing provisions of the 1999 Act Regulations with further provisions, as necessary, to cover special requirements under the 1960 and 1934 Act procedures. In fact, the main body of the proposed Common Regulations deals with the international procedure under the 1999 Act and/or the 1960 Act. As far as the 1934 Act is concerned, the corresponding international procedure is dealt with in a separate Chapter of the Common Regulations. This is aimed at avoiding undue complication of the provisions of the Common Regulations and also the Chapter can easily be removed when the 1934 Act falls into disuse. This is expected soon as Spain accounted for 90% of international applications filed under the 1934 Act.

The discussions of this Session of the Working Group resulted in the proposed Common Regulations being agreed for submission to the Assembly of the Hague Agreement. At its twenty-second session, which took place in September 2003, the Assembly of the Hague Union adopted Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act and decided that those Common Regulations would enter into force on April 1, 2004.

The Assembly of the Hague Union further decided that, as from April 1, 2004, the Common Regulations would replace both the Regulations under the 1999 Act and the Regulations under the 1960 Act and the 1934 Act.

The text of the Common Regulations will be available shortly on WIPO's website, at the following address: www.wipo.int



LATEST NEWS UPDATES

Developments in the IP field, such as new decisions or practices, and reports on FICPI events and activities are posted to the "What's New" page of the FICPI web site www.ficpi.org. If you are aware of new developments or want to draw members attention to events of interest to FICPI members, please forward a note to jorange@mccarthy.ca.

RESOLUTIONS

BERLIN RESOLUTIONS AS DISCUSSED BY THE CONGRESS

RESOLUTION 1

DEVELOPMENT OF THE INTERNATIONAL PATENT SYSTEM

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Recognising the basic right of all countries to pursue development of sectors of vital importance to their socio-economic, scientific and technological welfare;

Believing that appropriate systems of protection for intellectual property contribute to such development;

Being supportive of the continued development of the international patent system in a manner that maintains the credibility and relevance of such systems; and

Recognising that, whilst the TRIPS Agreement provides minimum standards *inter alia* for patents, alternative mechanisms for protecting inventions do exist that cater to the different, particular needs of countries and regions, including unexamined patents, revalidation patents and patents of importation,

FICPI resolves that:

- (i) The development of the international patent system should continue in a manner that provides flexibility to and meets the needs of users by providing patent protection through national, regional and international routes
- (ii) Such development should balance the rights and interests of both active and passive users of the system, and should operate to the benefit of the public in all nations
- (iii) Any nation should be free to adopt additional forms of protection which do not conflict with the TRIPS Agreement, that it deems most appropriate in the public interest in sectors of vital importance to its socio-economics, scientific and technological development.

RESOLUTION 2

STRENGTHENING THE PCT INTERNATIONAL PHASE

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Having closely followed the work on PCT reform in recent years, in particular the modification of the search and examination system becoming effective January 2004;

Noting that the time available for conducting international preliminary examination will be shorter than under the present system;

Also **noting** that the reformed search and examination system is likely to result in a large part of the work load being moved from the international phase to the national phase comprising parallel procedures involving similar considerations and duplicate efforts;

Further **noting** that national patent authorities that have to decide on the grant of patents on the basis of international patent applications need a firm foundation with a reliable report on patentability from the PCT authority;

Reiterating the importance to patent applicants and third parties of having a comprehensive, high quality search made during the international phase as a basis for deciding whether and where to enter the national phase and to enhance the presumption of validity of any patent based on an international patent application;

Considering that only a relatively small number of applicants are likely to demand international preliminary examination since such a demand will no longer be necessary for extending the International phase; and

Also **considering** that some applicants have to rely on examination during the international phase in order to have claims of reasonable scope deemed allowable by the PCT authority before entering the national stage in any designated countries,

FICPI resolves that the relevant

international and national authorities should continue to develop the PCT system so as

- to consolidate the international phase procedure, while leaving the ultimate right to grant patents to the national and regional patent offices,
- to provide a flexible system permitting PCT applicants to request supplementary and top-up novelty searches in addition to the basic search under the present system, and/or to request a full examination procedure involving an effective dialogue with the examiner and possible claims amendments, and
- to take measures to maintain and further improve the quality of search and examination in accordance with the common framework on quality and efficiency which is to be incorporated into the PCT Guidelines for search and examination, whilst maintaining the present time limits under the PCT.

RESOLUTION 3

IMPLEMENTATION OF THE PATENT LAW TREATY (PLT)

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Considering that FICPI has played an active role in the WIPO process of developing the Patent Law Treaty (PLT) for many years;

Noting that the progress towards the PLT being broadly implemented is very slow;

Stressing that the harmonizing effect of the PLT will facilitate the efforts of applicants to file and prosecute patent applications;

Considering that Patent Offices will be able to take advantage of the PLT not only because of the simplification of certain procedures, but in particular by exchanging experiences between Offices;

Noting that FICPI has consistently opposed mandatory exceptions in the

provisions concerning representation; and

Stressing that the PLT will serve as a model even for those countries which are not yet contracting parties,

FICPI resolves that all contracting parties, and more particularly the members of the so-called tri-lateral offices, should increase their efforts to achieve implementation of the PLT on a global basis, by ratifying the PLT and implementing it in their legislation.

RESOLUTION 4

QUALIFICATION OF PROFESSIONAL REPRESENTATIVES, AND PRACTICE ACROSS NATIONAL BORDERS

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Considering that patents for invention, trade and service marks and registered and unregistered designs for example, (hereinafter IP rights), have become strategic issues for the development and competitiveness of the economies of all countries of the world;

Considering that IP rights are generally each of great economic importance to the right holder;

Taking into account that the protection of innovation and of marks has become increasingly important for enterprises, at national, regional and international levels;

Considering that the increasing complexity of IP protection and validity evaluation of IP rights requires the availability for enterprises of professional advice in all countries of the world;

Taking into consideration the lack of international harmonisation of IP legislation in both formal and substantive matters as well as in enforcement procedures;

Considering the importance of languages in the preparation of applications, interpretation of the scope of protection, and thus, enforcement of IP rights; and

Taking into account the interface of IP law with legislation in other areas for a proper creation, maintenance, evaluation and enforcement of IP rights in each jurisdiction,

FICPI resolves:

1) That the existence of qualified professional representatives in all

countries of the world should be a strategic goal for governments to make available to local industry quality professional advice for the understanding and management of IP issues;

- 2) That consistent with previous resolutions made in Cannes in 1988 and Helsinki in 1999 and while taking into account transitional provisions governing professional representatives who are already qualified to represent clients, professional representatives should be required to pass a qualifying examination on national, regional and international law in the relevant field of IP rights before being admitted to practice in that field in a particular country;
- 3) That if legislation for cross-border provision of services is enacted, that legislation should guarantee that a professional representative qualified in one country, before being accepted to practice as a free professional in another country (host country), should be required to satisfy such additional requirements as may be deemed necessary by the host country including where deemed appropriate sufficient knowledge of the language of the host country, to provide quality advice to clients in that host country;
- 4) That a qualified professional representative should operate under a protected title recognised as such in any particular country;
- 5) That a client should enjoy client attorney/agent professional privilege in connection with any direct or indirect communication with a professional representative in his own country or another; and
- 6) That due to reasons of public interest, associations of free professionals in each country should establish sets of rules on ethical conduct, continuing education and cover for professional liability to be complied with by free professional representatives in that country.

RESOLUTION 5

COMMUNITY PATENT – REPRESENTATION BEFORE THE PATENT COURTS

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin,

Germany from June 2 to June 6, 2003, passed the following Resolutions:

Whereas on August 30, 2002 the Commission issued a working document on Community Patent Jurisdiction – (COM 2002) 480 – in which it states, on page 24 in the Notes on the provisions of Title III of the Statute of the Court of Justice with regard to Art. 19 (3), prescribing the obligatory representation by a lawyer, that a change is necessary for litigation concerning the role of patent attorneys in Community Patent proceedings;

Whereas Art. 17 of this part of the working document refers to “technical advisors” and provides such a change in that it allows technical advisors who are professional representatives appearing on the list maintained by the EPO to speak at hearings;

Whereas one of the major objectives of reform of the European Patent System is cost reduction;

Is of the opinion that the right to be heard is devalued if it does not include the right to file written statements;

Has further to observe that in national procedures concerning European or national patents in many Member States and in all *inter partes* proceedings before the European Patent Office users (including large industry and SMEs) are permitted to use the services of patent attorneys who act alone to present their cases;

Considering that under a Community Patent System users would be confronted with the increased cost burden of representation by a lawyer compared with existing national systems and the European Patent System without any real justification;

Considering that any party should be free to choose whether it wants to be represented by a patent attorney, or a lawyer, or both;

FICPI urges therefore all constitutional bodies of the EU to put qualified patent attorneys on an equal footing with lawyers with regard to actions before the Community Patent Court and the European Court of First Instance relating to Community Patents and to provide that Patent Attorneys may represent parties in such proceedings.

RESOLUTION 1

DEVELOPPEMENT DU SYSTEME INTERNATIONAL DES BREVETS

La **FICPI**, Fédération Internationale des Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays, réunie à l'occasion de son Congrès Mondial à Berlin, Allemagne, du 2 au 6 juin 2003, a voté la résolution suivante :

Reconnaissant le droit fondamental de chaque pays à développer des secteurs d'importance vitale dans les domaines socio-économique, scientifique et technologique;

Estimant que les systèmes appropriés de protection de la propriété intellectuelle contribuent à un tel développement;

Adhérant au développement continu du système international des brevets de façon à maintenir la crédibilité et la pertinence de tels systèmes;

Reconnaissant que, bien que les accords ADPIC fournissent des standards minimum notamment pour les brevets, il existe des mécanismes alternatifs de protection des inventions qui couvrent les différents besoins particuliers des pays et des régions, tels que des brevets délivrés sans examen, des brevets de revalidation, et des brevets d'importation;

La FICPI demande que :

- (i) le développement du système international des brevets continue, de façon à assurer de la flexibilité et à satisfaire les besoins des utilisateurs en fournissant une protection par brevet par les voies nationale, régionale et internationale;
- (ii) un tel développement respecte un équilibre des droits et des intérêts à la fois des utilisateurs actifs et passifs du système et bénéficie au public dans tous les pays;
- (iii) chaque pays soit libre d'adopter d'autres formes additionnelles de protection qui ne soient pas contraires aux accords ADPIC, qu'il estime le mieux appropriées à l'intérêt public dans des secteurs d'importance vitale pour son développement socio-économique, scientifique et technologique.

RESOLUTION 2

RENFORCEMENT DE LA PHASE INTERNATIONALE (PCT)

La **FICPI**, Fédération Internationale des Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays, réunie à l'occasion de son Congrès

Mondial à Berlin, Allemagne, du 2 au 6 juin 2003, a voté la résolution suivante :

Ayant précisément suivi les travaux sur la réforme du PCT au cours des dernières années, en particulier la modification du système de recherche et d'examen qui sera effective à partir de juin 2004;

Notant que le délai disponible pour la réalisation de l'examen préliminaire sera plus court que dans le système actuel;

Notant également que le système de recherche et d'examen tel que modifié entraînera probablement un transfert d'une grande partie de la charge de travail de la phase internationale vers la phase nationale qui comprend des procédures parallèles impliquant des analyses similaires et des efforts multipliés;

Notant encore que autorités nationales de brevets qui doivent décider d'accorder des brevets sur la base de demandes de brevet internationales ont besoin de fondements solides incluant un rapport fiable sur la brevetabilité provenant de l'autorité PCT;

Réaffirmant l'importance, pour les déposants et pour les tiers, de disposer d'une recherche, adaptée et de grande qualité, effectuée pendant la phase internationale, constituant une base pour décider si et où engager les phases nationales, et augmentant la présomption de validité de tout brevet résultant d'une demande de brevet internationale;

Considérant également que certains demandeurs doivent s'appuyer sur l'examen effectué pendant la phase internationale pour avoir des revendications de portée raisonnable, considérées comme accordables par l'autorité PCT, avant d'engager la phase nationale dans l'un quelconque des pays désignés;

La FICPI demande aux autorités compétentes, nationales et internationales, de poursuivre le développement du système PCT de telle façon que

- la phase internationale de la procédure soit renforcée tout en laissant le droit final de délivrer les brevets aux Offices de Brevets nationaux et régionaux,
- il en résulte un système souple qui permette aux déposants PCT de demander des recherches de nouveauté complémentaires, en plus de la recherche de base du système actuel, et/ou de demander une procédure d'examen complet

comportant un dialogue effectif avec l'examineur et la possibilité de modifier les revendications, et

- des mesures soient prises pour maintenir et améliorer encore la qualité de la recherche et de l'examen conformément aux principes relatifs à la qualité et l'efficacité qui doivent être introduits dans les Directives PCT pour la recherche et l'examen, tout en maintenant les délais actuels fixés par le PCT.

RESOLUTION 3

MISE EN ŒUVRE DU TRAITE SUR LE DROIT DES BREVETS (TDB)

La **FICPI**, Fédération Internationale des Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays, réunie à l'occasion de son Congrès Mondial à Berlin, Allemagne, du 2 au 6 juin 2003, a voté la résolution suivante :

Considérant que la FICPI a joué pendant de nombreuses années un rôle actif dans les travaux de l'OMPI relatifs à l'élaboration du Traité sur le Droit des Brevets (TDB);

Notant que l'évolution vers une large mise en œuvre du TDB est très lente;

Soulignant que l'effet d'harmonisation du TDB facilitera les efforts des déposants, lors du dépôt et du suivi des procédures de leurs demandes de brevets;

Considérant que les Offices de Brevets pourront bénéficier du TDB non seulement en raison de la simplification de certaines procédures, mais surtout par l'échange d'expériences entre Offices;

Notant que la FICPI a de façon constante exprimé son opposition à des exceptions obligatoires dans les dispositions relatives à la représentation; et

Soulignant que le TDB pourra servir de modèle même pour les pays qui ne sont pas encore des Etats membres;

La FICPI demande que les Etats membres, et en particulier ceux des offices dits « trilatéraux », accentuent leurs efforts pour parvenir à la mise en œuvre du TDB d'une façon globale, en ratifiant le TDB en le mettant en œuvre dans leur législation.

RESOLUTION 4

QUALIFICATION DES MANDATAIRES EN PROPRIETE INDUSTRIELLE (PI), DROIT D'EXERCER EN DEHORS DU TERRITOIRE NATIONAL

La **FICPI**, Fédération Internationale des

Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays, réunie à l'occasion de son Congrès Mondial à Berlin, Allemagne, du 2 au 6 juin 2003, a voté la résolution suivante :

Considérant que les brevets d'invention, les marques commerciales et de services et les dessins et modèles enregistrés et non enregistrés, notamment (ci-après droits de PI), sont devenus des enjeux stratégiques pour le développement et la compétitivité des économies de tous les pays du monde;

Considérant que les droits de PI sont généralement d'une grande importance économique pour le détenteur de droit; Tenant compte du fait que la protection des innovations et des marques a pris une importance croissante pour les entreprises, aux niveaux national, régional et international;

Considérant que la complexité croissante de la protection de la PI et de l'évaluation de la validité des droits de PI requiert que les entreprises puissent disposer dans tous les pays du monde de conseils émanant de professionnels;

Prenant en considération l'absence d'une harmonisation internationale des législations de PI, à la fois sur la forme et sur le fond, ainsi que pour ce qui concerne l'exercice des droits;

Considérant l'importance des langues pour la rédaction de demandes, l'interprétation de l'étendue de la protection et, par conséquent, l'exercice des droits de PI;

Tenant compte de l'interface entre les lois relatives à la PI et la législation dans d'autres domaines pour une réalisation correcte de la création, du maintien en vigueur, de l'évaluation et de l'exercice des droits de PI dans chaque juridiction;

est d'avis :

- 1) Que l'existence dans tous les pays du monde de mandataires qualifiés doit être un objectif stratégique pour les gouvernements, pour que les industriels locaux puissent disposer de conseils de qualité émanant de professionnels pour la compréhension et la gestion des questions de PI;
- 2) Qu'en accord avec de précédentes résolutions adoptées à Cannes en 1988 et à Helsinki en 1999 et tout en tenant compte de dispositions transitoires s'appliquant aux mandataires déjà qualifiés pour représenter des clients, les mandataires doivent être tenus de satisfaire à un examen de qualification portant sur les

législations nationale, régionale et internationale dans le domaine concerné des droits de PI, avant d'être autorisés à exercer dans ce domaine dans un pays déterminé;

- 3) Que si une législation est promulguée visant la fourniture de services au delà des frontières, cette législation doit garantir qu'avant de pouvoir exercer comme professionnel libéral dans un autre pays (pays hôte), un mandataire qualifié dans un premier pays doit être tenu de satisfaire à toutes conditions supplémentaires qui pourraient être exigées par le pays hôte, y compris, lorsque cela sera jugé approprié, une connaissance suffisante de la langue du pays hôte de façon à pouvoir fournir des conseils de qualité à des clients dans le pays hôte;
- 4) Que, dans chaque pays, un mandataire qualifié doit exercer sous un titre protégé, reconnu comme tel;
- 5) Qu'un client doit bénéficier du privilège de confidentialité à l'égard de toute communication directe ou indirecte avec un mandataire dans son propre pays ou dans tout autre pays; et
- 6) Que pour des motifs d'intérêt général, les associations de professionnels libéraux de chaque pays doivent mettre en place des règles, concernant la déontologie, la formation continue et une couverture responsabilité civile, auxquelles les mandataires libéraux doivent se conformer dans ce pays.

RESOLUTION 5

BREVET COMMUNAUTAIRE – REPRESENTATION DEVANT LES TRIBUNAUX DES BREVETS

La **FICPI**, Fédération Internationale des Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays et en particulier dans tous les Etats Membres de l'Union Européenne, réunie à l'occasion de son Congrès Mondial à Berlin, Allemagne, du 2 au 6 juin 2003, a voté la résolution suivante :

Considérant que, le 30 août 2002, la Commission a publié un document de travail sur la Juridiction relative au Brevet Communautaire (COM (2002) 480) dans lequel elle déclare, en page 24 dans les Notes sur les dispositions du Titre III du Statut de la Cour de Justice relatives à l'Art. 19 (3), prescrivant la représentation obligatoire par un avocat, qu'une modification est nécessaire pour les litiges en ce qui concerne le rôle des

conseils en brevets dans les procédures relatives aux Brevets Communautaires;

Considérant que l'Art. 17 de cette partie du document de travail fait référence à des « experts techniques » et prévoit une telle modification en ce qu'il permet aux experts techniques, qui sont des mandataires professionnels figurant sur la liste tenue à jour par l'OEB, de prendre la parole aux audiences;

Considérant que l'un des objectifs principaux de la réforme du Système Européen des brevets est la réduction des coûts;

Est d'avis que le droit d'être entendu perd de sa valeur s'il n'inclut pas le droit de déposer des conclusions écrites;

Fait en outre observer que, dans les procédures nationales concernant des brevets européens ou nationaux dans plusieurs Etats Membres, et dans toutes les procédures inter partes devant l'Office Européen des Brevets (OEB), les utilisateurs (y compris la grande industrie et les PME) ont la possibilité d'utiliser les services de conseils en brevets qui agissent seuls pour soutenir leurs cas;

Considérant que dans un Système de Brevet Communautaire, les utilisateurs seraient confrontés à des coûts de représentation additionnels par avocats en comparaison avec des systèmes nationaux existants et au Système Européen des Brevets, sans aucune justification réelle;

Considérant que toute partie doit être libre de choisir si elle veut être représentée par un conseil en brevet, ou un avocat, ou les deux;

Demande en conséquence avec insistance à tous les organes constitutionnels de l'UE de placer les conseils en brevets qualifiés sur un pied d'égalité avec les avocats en ce qui concerne les actions devant le Tribunal du Brevet Communautaire et le Tribunal Européen de Première Instance, relatives aux Brevets Communautaires, et de prévoir que des conseils en brevets peuvent représenter les parties dans de telles procédures.

RESOLUTION 1

ENTWICKLUNG DES INTERNATIONALEN PATENTSYSTEMS

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution :

Anerkennend das grundlegende Recht aller Länder, Bereiche von vitaler Bedeutung für ihr gesellschaftlich-wirtschaftliches, wissenschaftliches und technologisches Wohlergehen weiter zu entwickeln;

meinend, dass geeignete Systeme für den Schutz des geistigen Eigentums zu einer derartigen Entwicklung beitragen;

unterstützend die kontinuierliche Entwicklung des internationalen Patentsystems auf eine Weise, welche die Glaubwürdigkeit und die Bedeutung dieser Systeme erhält;

anerkennend, dass, während das TRIPS-Abkommen unter anderem für Patente Minimum-Standards setzt, alternative Formen für den Schutz von Erfindungen existieren, welche für unterschiedliche, spezielle Bedürfnisse von Ländern und Regionen dienlich sind, zu denen ungeprüfte Patente, Schutzerstreckungspatente und Einführungspatente gehören,

kommt FICPI zu dem Schluss,

- (i) dass die Entwicklung des internationalen Patentsystems in einer Weise fortgeführt werden soll, die für die Nutzer Flexibilität bietet und ihre Bedürfnisse erfüllt, indem Patentschutz auf nationalem, regionalem und internationalem Weg verfügbar ist;
- (ii) dass diese Entwicklung die Rechte und Interessen der aktiven und der passiven Nutzer des Systems in Einklang bringen muss und in allen Ländern zum Nutzen der Öffentlichkeit wirken soll, und
- (iii) dass jede Nation frei sein soll, zusätzliche Formen des Schutzes, die nicht gegen das TRIPS-Abkommen verstoßen, zu gewähren, die sie in Bereichen von vitaler Bedeutung für ihre gesellschaftlich-wirtschaftliche, wissenschaftliche und technologische Entwicklung für am besten geeignet hält, im öffentlichen Interesse zu liegen.

RESOLUTION 2

STÄRKUNG DER INTERNATIONALEN PHASE DES PCT

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland,

vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution:

Nach **aufmerksamer Beobachtung** der Arbeiten der vergangenen Jahre an der PCT Reform, insbesondere an der Änderung des Recherchen- und Prüfungssystems, die im Jahr 2004 in Kraft treten soll;

Kenntnis davon nehmend, dass die Zeitspanne, die zur Durchführung der vorläufigen internationalen Prüfung zur Verfügung steht, kürzer ist als zum jetzigen Zeitpunkt;

ferner **Kenntnis davon nehmend**, dass das geänderte Recherchen- und Prüfungssystem wahrscheinlich einen großen Teil der Arbeitslast aus der internationalen Phase in die nationalen Phasen hin verlagert, so dass in parallelen Verfahren ähnliche Überlegungen angestellt und Tätigkeiten doppelt ausgeführt werden;

weiterhin **Kenntnis davon nehmend**, dass die nationalen Patentbehörden, die die Erteilung von Patenten auf der Grundlage internationaler Patentanmeldungen beschließen, von Seiten der PCT-Behörde eine sichere Grundlage in Form eines zuverlässigen Berichts zur Patentfähigkeit benötigen;

wiederholt auf die Wichtigkeit für Patentanmelder und Dritte **hinweisend**, während der internationalen Phase eine umfassende Recherche hoher Qualität zu erhalten, um für den Anmelder eine Entscheidungsgrundlage zu schaffen, ob und gegebenenfalls wo die nationale Phase eingeleitet werden soll, und um die Vermutung des Rechtsbeständigkeit eines auf der Grundlage einer internationalen Patentanmeldung erteilten Patent zu stärken;

berücksichtigend, dass erwartet wird, dass nur eine vergleichsweise kleine Zahl von Anmeldern die vorläufige Prüfung nach Kapitel II beantragen wird, da ein derartiger Antrag zur Verlängerung der Internationalen Phase zukünftig nicht mehr nötig ist; und

ebenfalls **berücksichtigend**, dass einige Anmelder auf das Prüfungsverfahren während der internationalen Phase angewiesen sind, um Anspruchsfassungen mit angemessenem Schutzzumfang zu erhalten, die von der PCT-Behörde für erteilbar erachtet werden, bevor sie in einem der benannten Länder in die nationale Phase eintreten;

kommt FICPI zu dem Schluss, dass die bedeutsamen internationalen und nationalen Behörden damit fortfahren sollen, das PCT-System weiterzuentwickeln, um

- das Verfahren in der internationalen Phase zu stärken, wobei jedoch das letzte Recht zur Erteilung von Patenten bei den nationalen und

regionalen Patentbehörden verbleiben soll,

- ein flexibles System zu schaffen, das es dem PCT Anmelder erlaubt, eine ergänzende und "top-up" Neuheitsrecherche zusätzlich zu der Basisrecherche nach dem existierenden System zu erhalten, und/oder ein vollständiges Prüfungsverfahren zu beantragen, das auch einen effektiven Dialog mit dem Prüfer und die Möglichkeit von Anspruchsänderungen umfasst, und
- Maßnahmen zu ergreifen, um die Qualität der Recherchen- und Prüfungsverfahren in Übereinstimmung mit den gemeinsamen Qualitätsanforderungen, wie sie in die PCT-Richtlinien für Recherche und Prüfung eingefügt werden, zu bewahren und noch weiter zu verbessern, während die gegenwärtigen Fristen nach dem PCT beibehalten werden.

RESOLUTION 3

INKRAFTSETZUNG DES PATENTRECHTSVERTRAGES (PLT)

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution:

Berücksichtigend, dass FICPI viele Jahre lang eine aktive Rolle bei der Schaffung des Patentrechtsvertrages (PLT) durch die WIPO gespielt hat;

feststellend, dass die weitgehende Inkraftsetzung des PLT sehr langsam vorankommt;

betonend, dass der Harmonisierungseffekt des PLT die Arbeit der Anmelder erleichtert, Patentanmeldungen einzureichen und weiter zu verfolgen;

berücksichtigend, dass die Patentämter in die Lage versetzt sein werden, aus dem PLT Nutzen zu ziehen, nicht nur aufgrund der Vereinfachung bestimmter Verfahren sondern insbesondere durch den Austausch von Erfahrungen zwischen den Ämtern;

feststellend, dass FICPI sich ständig gegen zwingende Ausnahmen in den die Vertretung betreffenden Bestimmungen gewandt hat; und

betonend, dass der PLT sogar für diejenigen Länder als Modell dienen wird, die noch nicht Mitglieder sind;

kommt FICPI zu dem Schluss,

dass alle Mitglieder des PLT, ganz besonders die Mitglieder der als trilaterale Patentämter bekannten Patentämter, ihre Anstrengungen zur

weltweiten Inkraftsetzung des PLT erhöhen sollen, indem sie den PLT ratifizieren und in ihre Gesetzgebung überführen.

RESOLUTION 4

QUALIFIKATION FÜR DIE BERUFLICHEN VERTRETER UND DIE GRENZÜBERSCHREITENDE BERUFS AUSÜBUNG

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution:

In der Erwägung, dass u.a. Patente auf Erfindungen, Marken für Waren und Dienstleistungen und eingetragene und nicht-eingetragene Muster (im folgenden IP-Rechte genannt) in allen Ländern dieser Welt für die Entwicklung und die Wettbewerbsfähigkeit der Volkswirtschaft strategische Bedeutung erlangt haben;

in der Erwägung, dass IP-Rechte für den Rechtsinhaber jeweils von großer Bedeutung sind;

in Rechnung stellend, dass der Schutz von Innovation und Marken auf nationaler, regionaler und internationaler Ebene für Unternehmen zunehmende Bedeutung bekommen hat;

in der Erwägung, dass die zunehmende Kompliziertheit des IP-Schutzes und der Beurteilung der Rechtsbeständigkeit von IP-Rechten für Unternehmer aller Länder der Welt die Möglichkeit der Inanspruchnahme professioneller Beratung erfordert;

in Rechnung stellend das Fehlen einer internationalen Harmonisierung der IP-Gesetze, sowohl in formeller als auch in inhaltlicher Hinsicht, und der Verfahren zur Rechtsverfolgung;

berücksichtigend die Bedeutung der Sprache bei der Ausarbeitung von Anmeldungen, der Bestimmung des Schutzzumfangs und folglich der Durchsetzung von IP-Rechten;

in Rechnung stellend die Berührung von IP-Recht und Gesetzgebung in anderen Bereichen für die geeignete Schaffung, Aufrechterhaltung und Geltendmachung von IP-Rechten im jeweiligen Zuständigkeitsbereich;

kommt FICPI zu dem Schluss,

1) dass das Vorhandensein von qualifizierten beruflichen Vertretern in allen Ländern der Welt ein strategisches Ziel der Regierungen sein sollte, um für die nationale Wirtschaft qualitativ hochwertige berufliche Beratung zum Verständnis und zur Behandlung von IP-Problemen zur Verfügung zu stellen;

- 2) dass in Übereinstimmung mit 1988 in Cannes und 1999 in Helsinki gefassten Resolutionen und unter Berücksichtigung von Übergangsbestimmungen für berufliche Vertreter, die bereits zur Vertretung von Rechtssuchenden befähigt sind, berufliche Vertreter verpflichtet sein sollten, eine Eignungsprüfung in nationalem, regionalem und internationalem IP-Recht auf dem relevanten Gebiet des IP-Rechts vor der Zulassung zur Berufsausübung auf diesem Gebiet in einem bestimmten Land abzulegen;
- 3) dass, wenn gesetzliche Regelungen für die grenzüberschreitende Berufsausübung bestehen, ein beruflicher Vertreter, der in einem Land befähigt ist, bevor er zur freiberuflichen Berufsausübung in einem anderen Land (Gastland) zugelassen wird, eine zusätzliche Qualifikation, die in dem Gastland für erforderlich gehalten wird, einschließlich, wenn für notwendig erachtet, der Beherrschung der Sprache des Gastlandes nachweisen muss, um nationalen Rechtssuchenden in dem Gastland qualitativ hochwertige Beratung erteilen zu können;
- 4) dass ein beruflicher Vertreter unter einer geschützten Berufsbezeichnung, die in dem bestimmten Land als solche verstanden wird, tätig werden sollte;
- 5) dass ein Rechtssuchender bei unmittelbarem oder mittelbarem Verkehr mit einem beruflichen Vertreter in seinem eigenen oder einem anderen Land die beruflichen Mandant/ Anwaltsvorrechte genießen sollte; und
- 6) dass aus Gründen des öffentlichen Interesses Organisationen freier Berufe in jedem Land Regeln zur Berufsausübung, zur ständigen Weiterbildung und zur Berufshaftpflichtversicherung, die von den freiberuflichen Vertretern in dem Land einzuhalten sind, aufstellen sollten.

RESOLUTION 5

GEMEINSCHAFTSPATENT – VERTRETUNG VOR DEN PATENTGERICHTEN

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution:

In Anbetracht dessen, dass die Kommission der Europäischen Gemeinschaften am 30. August 2002 ein Arbeitspapier über die Gerichtsbarkeit

für das Gemeinschaftspatent (KOM [2002] 480) unterbreitet hat, in dem auf Seite 25 [deutscher Text] in der Erläuterung zu den Bestimmungen des Titels III der Satzung des Gerichtes bezüglich deren Artikel 19(3), welcher die Vertretung durch einen Rechtsanwalt zwingend vorschreibt, festgestellt wird, dass in Verfahren betreffend ein Gemeinschaftspatent eine Änderung der Prozessordnung im Hinblick auf die Rolle von Patentanwälten erforderlich ist;

in Anbetracht dessen, dass Artikel 17 dieses Teils des Arbeitspapiers "Technische Berater" betrifft und die erwähnte Änderung dadurch herbeiführt, dass als Technische Berater zugelassene Vertreter, die in einer beim Europäischen Patentamt geführten Liste eingetragen sind, das Recht zum Vortrag in der mündlichen Verhandlung erhalten;

in Anbetracht dessen, dass eines der Hauptziele der Reform des europäischen Patentsystems die Senkung der Kosten ist;

die Meinung vertretend, dass das Recht zum Vortrag unzulänglich ist, wenn es nicht das Recht zum schriftlichen Vortrag umfasst;

feststellend, dass es den Beteiligten (einschließlich großer Unternehmen und KMUs) in vielen Mitgliedsstaaten in nationalen Verfahren betreffend europäische oder nationale Patente und vor dem Europäischen Patentamt in allen zweiseitigen Verfahren gestattet ist, sich der Dienste eines Patentanwalts zu bedienen, der ihren Fall allein vertritt;

in der Erwägung, dass sich unter einem Gemeinschaftspatentsystem die Beteiligten mit einer gegenüber den existierenden nationalen Systemen und dem europäischen Patentsystem erhöhten Kostenlast durch die Vertretung durch einen Rechtsanwalt ausgesetzt sehen, ohne dass hierfür eine wirkliche Rechtfertigung besteht;

in der Erwägung, dass jeder Partei die Wahl freistehen sollte, entweder durch einen Patentanwalt oder durch einen Rechtsanwalt oder durch beide vertreten zu werden;

fordert FICPI daher alle zuständigen Stellen der EU auf, qualifizierte Patentanwälte mit Rechtsanwälten hinsichtlich der Verfahren vor dem Gemeinschaftspatentgericht und dem Europäischen Gerichtshof erster Instanz betreffend Gemeinschaftspatente gleichzustellen und vorzusehen, dass Patentanwälte in derartigen Verfahren vertretungsberechtigt sind.

RESOLUTIONS

RESOLUTIONS AS DISCUSSED AT THE ExCo IN BERLIN

RESOLUTION A

CONSIDERATION OF PRIOR TRADE MARK RIGHTS IN IP OFFICES

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Having closely followed the discussions about consideration of prior trade mark rights by IP Offices which are processing a trade mark for registration,

Noting the proposal of the European Commission to delete the system of searches under Article 39 of the Community Trade Mark Regulation, which includes:

- 1) searches among prior Community Trade Marks and notification to the owners of the prior marks when the searched application is published, and
- 2) searches by those national IP Offices that decide to operate a search in their own registers,

Noting also that certain national authorities have been seeking expressions of view concerning possible ending of the system of ex officio examination and refusal of applications under their national law on the basis of prior registered marks;

Considering that awareness of the existence of conflicting trade mark rights is important to owners of both later marks and prior marks;

Considering also that private searching and monitoring of prior rights imposes cost burdens on small and medium-sized businesses;

Considering further that well-conducted and thorough official searches at the application stage provide valuable assistance

to small and medium-sized businesses in avoiding adversarial proceedings later and in making the use of the trade mark system available to more businesses;

FICPI Resolves (1) that IP Offices which currently undertake search and/or examination of prior rights, including IP Offices of states acceding to the European Community, should maintain those systems with, where necessary, an

improvement in the quality of searches to meet the needs of small and medium-sized businesses for reliable consistent information; and

Further noting the different traditions of dealing with prior rights in various national systems, including:

- registration systems without any searching, examination or opposition at the IP Office, and leaving consideration of prior rights to the Courts,
- systems without searching or examination but allowing opposition at the IP Office by owners of prior marks before or shortly after registration of a later mark,
- systems with searching and opposition,
- systems with searching, ex officio examination/refusal, and opposition;

FICPI Resolves (2) that the relevant international and national authorities engaged in discussion of convergence of trade mark practices should agree that the availability of opposition proceedings at the IP Office should be required as a minimum standard for dealing with prior rights.

RESOLUTION B

REVALIDATION PATENTS

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its World Congress held in Berlin, Germany from June 2 to June 6, 2003, passed the following Resolutions:

Considering that investments in developing countries may be dependent on the availability of adequate patent protection for the potential investors, and that in many cases such protection is not available for lack of absolute novelty of the invention resulting from the prior publication or the granting of patents to the inventor for the same invention in other countries;

Recognising that so-called revalidation patents provide an exception to overcome the absolute novelty impediment referred to above, and also constitute a vehicle for the transfer of technology to the developing countries;

Noting that the possibility of obtaining revalidation patents is contemplated in

the 1889 Montevideo Treaty on Patents adhered to by Argentina, Bolivia, Paraguay, Peru and Uruguay; and that article 1(4) of the Paris Convention for the Protection of Industrial Property provides that "the term 'patents' shall include the various kinds of patents recognized by the laws of the countries of the Union, such as patents of importation," and furthermore that such provision of the Paris Convention (1967) is ratified by article 2.1 of the Treaty on Trade-Related Aspects of Intellectual Property Rights (TRIPS);

Noting that revalidation patents, rather than contradicting the provisions and terms set forth in the Patent Cooperation Treaty (PCT), supplement them by affording the possibility for protection beyond the PCT rules;

Recognising that since TRIPS does not make it mandatory to afford protection for revalidation patents, those member countries that do so may freely regulate them in accordance with their own national interests by requiring local industrial exploitation within a reasonable term;

Recognising that the examination made by national patent offices to determine the patentability of an invention is facilitated in revalidation patent applications, as a result of prior examinations made in other jurisdictions; and

Stressing that, in strict compliance with article 4bis(1) of the Paris Convention, the autonomy of the local authorities to grant patents valid for the respective territory shall be preserved, therefore

FICPI Resolves:

to recommend to those national governments who may obtain benefits to their economies derived from the so-called revalidation patents to consider the introduction or maintenance of suitable legislation to regulate them in accordance with their own national interests, including the requirement of immediate publication of the revalidation application for the protection of third party interests.

RESOLUTION A

PRISE EN COMPTE DES DROITS DE MARQUES ANTERIEURS PAR LES OFFICES DE PROPRIETE INDUSTRIELLE

La **FICPI**, Fédération Internationale des Conseils en Propriété Industrielle, largement représentative de la profession libérale dans plus de 70 pays et spécialement dans tous les Etats membres de l'Union Européenne, réunie pour son Comité Exécutif à Berlin, Allemagne, du 2 juin au 6 juin 2003, a adopté la résolution suivante :

Ayant suivi de près les discussions sur la prise en compte des droits de marque antérieurs par les Offices de P.I. qui traitent une marque en vue de son enregistrement,

Notant la proposition de la Commission Européenne de supprimer le système des recherches selon l'article 39 du Règlement sur la Marque Communautaire, qui comprend :

- 1) des recherches parmi les marques communautaires antérieures et la notification aux titulaires des marques antérieures quand la demande faisant l'objet des recherches est publiée, et
- 2) des recherches par ceux des Offices de P.I. qui décident de pratiquer une recherche dans leurs propres registres,

Notant aussi que certaines autorités nationales ont souhaité que des points de vue s'expriment au sujet de la fin possible du système de l'examen ex officio et du rejet de demandes selon leur loi nationale sur la base de marques enregistrées antérieures;

Considérant que la connaissance de l'existence de droits de marques conflictuels revêt est importante à la fois pour les titulaires de marques postérieures et antérieures;

Considérant que la recherche privée et la surveillance de droits antérieurs imposent des charges financières aux petites et moyennes entreprises;

Considérant en outre que les recherches officielles, bien faites et approfondies, au stade de la demande procurent une aide appréciable aux petites et moyennes entreprises en évitant des procédures contentieuses ultérieures et en rendant l'utilisation du système des marques accessible à plus d'entreprises;

La FICPI Demande (1) que les Offices de P.I. qui effectuent aujourd'hui une recherche et/ou l'examen des droits antérieurs, y compris les Offices de P.I. des états accédant à l'Union Européenne, maintiennent ces systèmes

avec, là où c'est nécessaire, une amélioration de la qualité des recherches pour satisfaire les besoins des petites et moyennes entreprises en information fiable et de valeur; et

Notant en outre les différentes traditions de traitement des droits antérieurs dans les divers systèmes nationaux, comprenant :

- Les systèmes d'enregistrement sans aucune recherche, procédure d'examen ou opposition à l'Office de P.I., et laissant aux Tribunaux le soin de prendre en compte les droits antérieurs,
- Les systèmes sans recherche ni examen mais permettant l'opposition devant l'Office de P.I. par les titulaires de marques antérieures avant ou peu après l'enregistrement d'une marque postérieure,
- Les systèmes avec recherche et opposition,
- Les systèmes avec recherche, examen/refus ex officio, et opposition;

La FICPI Demande (2) que les autorités nationales et internationales engagées dans la discussion d'un rapprochement des pratiques en matière de marques s'accordent sur le fait que l'existence d'une procédure d'opposition devant l'Office de P.I. doit constituer un standard minimum pour le traitement des droits antérieurs.

RESOLUTION B

BREVETS DE REVALIDATION

La **FICPI**, Fédération Internationale des Conseils en Propriété Intellectuelle, largement représentative de la profession libérale dans plus de 70 pays et en particulier dans tous les états membres de l'Union Européenne, réunie à l'occasion de son Comité Exécutif à Berlin, Allemagne, du 2 au 6 juin 2003, a adopté la résolution suivante :

Considérant que les investissements dans les pays en développement peuvent dépendre de l'existence d'une protection par brevet appropriée pour les investisseurs potentiels, et que, dans de nombreux cas, une telle protection n'est pas disponible pour défaut de nouveauté absolue de l'invention, résultant de la publication antérieure ou de la délivrance de brevets de l'inventeur pour la même invention dans d'autres pays;

Reconnaissant que les brevets dits de revalidation constituent une exception pour éviter l'obstacle précité de nouveauté absolue, et constituent aussi un vecteur pour le transfert de technologie vers les pays en développement;

Notant que la possibilité d'obtenir des brevets de revalidation est envisagée dans le Traité de Montevideo de 1889 sur les brevets, auquel ont adhéré l'Argentine, la Bolivie, le Paraguay, le Pérou et l'Uruguay ; et que l'article 1 (4) de la Convention de Paris pour la Protection de la Propriété Industrielle dispose que « le terme « brevets » désigne les différents types de brevets reconnus par les lois des pays de l'Union, par exemple les brevets d'importation », et qu'en outre cette disposition de la Convention de Paris (1967) est ratifiée par l'article 2.1 de l'Accord sur les Aspects des Droits de Propriété Intellectuelle relatifs au Commerce (ADPIC);

Notant que les brevets de revalidation ne sont pas en contradiction avec les dispositions et les termes du Traité de Coopération en matière de Brevets (PCT) mais les complètent en offrant la possibilité d'une protection au-delà des règles du PCT;

Reconnaissant que puisque les accords ADPIC ne rendent pas obligatoire de prévoir une protection par des brevets de revalidation, les pays membres qui le prévoient peuvent établir leurs règles librement, en fonction de leurs intérêts nationaux propres, en exigeant une exploitation industrielle locale dans un délai raisonnable;

Reconnaissant que l'examen effectué par les offices de brevets nationaux pour déterminer la brevetabilité d'une invention est facilité dans le cas de demandes de brevets de revalidation, du fait des examens déjà effectués par d'autres autorités; et

Mettant l'accent sur le fait que, strictement en accord avec l'article 4bis(I) de la Convention de Paris, l'autonomie des autorités locales pour délivrer des brevets valables pour leur territoire respectif doit être préservée,

La FICPI adopte la résolution suivante :

de recommander aux gouvernements nationaux qui peuvent obtenir, pour leurs économies, des bénéfices résultant des brevets dits de revalidation, de prendre en considération l'introduction ou le maintien d'une législation appropriée en vue d'établir leur règles en fonction de leurs propres intérêts nationaux, ces règles comprenant l'exigence de publication immédiate de la demande de revalidation pour protéger les intérêts des tiers.

RESOLUTION A

BERÜCKSICHTIGUNG VON ÄLTEREN MARKENRECHTEN IN ÄMTERN FÜR GEWERBLICHEN RECHTSSCHUTZ

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution verabschiedet:

Nach genauer Verfolgung der Diskussion über die Berücksichtigung von älteren Markenrechten durch Ämter für gewerblichen Rechtsschutz, die Markeneintragungen durchführen,

unter Kenntnisnahme des Vorschlags der Europäischen Kommission zur Abschaffung des Recherchensystems unter Artikel 39 der Gemeinschaftsmarkenverordnung, welches

- 1) Recherchen unter früheren Gemeinschaftsmarken und Mitteilungen an die Inhaber älterer Marken, wann die recherchierte Anmeldung veröffentlicht wurde, und
- 2) Recherchen von den Ämtern des gewerblichen Rechtsschutzes, die beschlossen haben, Recherchen in ihren eigenen Registern durchzuführen, beinhaltet,

ebenfalls **zur Kenntnis nehmend**, dass einige nationale Behörden Äußerungen über eine mögliche Abschaffung des Systems der ex officio Prüfung und Zurückweisung von Anmeldungen aufgrund von älteren eingetragenen Marken unter ihrer nationalen Gesetzgebung eingeholt haben;

unter Berücksichtigung der Tatsache, dass die Kenntnis der Existenz kollidierender Markenrechten sowohl für die Inhaber jünger als auch älter Marken wichtig ist;

unter gleichzeitiger Berücksichtigung der Tatsache, dass die private Recherche und Überwachung von älteren Rechten kleineren und mittleren Unternehmen eine Kostenlast aufbürdet;

des weiteren unter Berücksichtigung der Tatsache, dass gut durchgeführte und sorgfältige amtliche Recherchen im Stadium der Anmeldung für kleinere und mittlere Unternehmen eine wertvolle Hilfe darstellen, um spätere kontradiktorische Verfahren zu vermeiden und die Verwendung des Markensystems einer größeren Anzahl von Unternehmen zugänglich zu machen;

verabschiedet FICPI die Resolution (1), dass Ämter für gewerblichen

Rechtsschutz, die gegenwärtig Recherchen und/oder Prüfung auf ältere Rechte durchführen, einschließlich Ämter für gewerblichen Rechtsschutz von EU-Beitrittsstaaten, diese Systeme beibehalten und nötigenfalls die Qualität der Recherchen verbessern sollten, um den Bedürfnissen kleinerer und mittlerer Unternehmen nach zuverlässigen und einheitlichen Informationen gerecht zu werden; und

des weiteren unter Berücksichtigung der unterschiedlichen Traditionen in der Behandlung von älteren Rechten in verschiedenen nationalen Systemen, z.B.:

- Eintragungssystem ohne jegliche Art von Recherche, Prüfung oder Widerspruch bei den Ämtern für gewerblichen Rechtsschutz, wobei die Berücksichtigung von älteren Rechten den Gerichten überlassen wird,
- Systeme ohne Recherche oder Prüfung, das jedoch Widersprüche von Inhabern älterer Rechte bei den Ämtern für gewerblichen Rechtsschutz vor oder kurz nach der Eintragung einer jüngeren Marke zulässt,
- Systeme mit Recherche und Widerspruch,
- Systeme mit Recherche, ex officio Prüfung/Zurückweisung und Widerspruch;

verabschiedet FICPI die Resolution (2), dass die zuständigen internationalen und nationalen Behörden, die an der Diskussion über die Anpassung der Markenpraxis beteiligt sind, sich darauf einigen sollten, dass die Möglichkeit von Widerspruchsverfahren beim Amt für gewerblichen Rechtsschutz als Mindeststandard für die Behandlung älterer Rechte gefordert werden sollte.

RESOLUTION B

EINFÜHRUNGSPATENTE

FICPI, die Internationale Vereinigung von Patentanwälten, welche den freien Berufsstand aus mehr als 70 Ländern umfassend repräsentiert, kam zu ihrem Weltkongress in Berlin, Deutschland, vom 2. bis 6. Juni 2003 zusammen und verabschiedete die folgende Resolution :

In der Erwägung, dass Investitionen in Entwicklungsländern davon abhängig gemacht werden können, dass für den Investor angemessener Patentschutz erhalten werden kann, und dass in vielen Fällen ein solcher Patentschutz wegen mangelnder absoluter Neuheit der Erfindung, weil sie schon früher veröffentlicht wurde oder weil dem Erfinder bereits in anderen Ländern Patente für die gleiche Erfindung erteilt

wurden, nicht gewährbar ist;

aner kennend, dass sogenannte Einführungspatente eine Ausnahme darstellen, um das oben erwähnte Hindernis der absoluten Neuheit zu überwinden und auch eine Instrument zum Technologietransfer in die Entwicklungsländer bilden;

er kennend, dass die Möglichkeit der Erteilung von Einführungspatenten im Patentvertrag von Montevideo aus dem Jahre 1889 vorgesehen ist, dem Argentinien, Bolivien, Paraguay und Uruguay angehören, und dass Art. 1, Abs. 4 der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums vorsieht, dass "zu den 'Erfindungspatenten' die von den Gesetzgebungen der Verbandsländer zugelassenen verschiedenen Arten gewerblicher Patente, wie 'Einführungspatente', zählen, und dass fernerhin diese Bestimmung der Pariser Verbandsübereinkunft (1967) durch Artikel 2.1, des Übereinkommens über handelsbezogene Aspekte der Rechte des geistigen Eigentums (TRIPS) ratifiziert wurde;

er kennend, dass Einführungspatente statt den Bestimmungen und Bedingungen des Patentrechtsübereinkommens (PCT) zuwiderzulaufen sie dadurch ergänzen, dass sie die Möglichkeit des Schutzes über die PCT Regelungen hinaus ermöglichen;

aner kennend, dass das TRIPS Übereinkommen die Gewährung von Einführungspatenten nicht vorschreibt, die Länder, die es dennoch gewähren, sie frei nach ihren eigenen nationalen Interessen ausgestalten können, indem sie die Ausübung in ihrem Land innerhalb einer angemessenen Zeit fordern; aner kennend, dass die von nationalen Patentämtern zur Bestimmung der Patentfähigkeit einer Erfindung durchgeführte Prüfung betonend, dass in strenger Beachtung von Art. 4bis, Abs. 1, der Pariser Verbandsübereinkunft die Unabhängigkeit der nationalen Behörden zur Erteilung von in dem betreffenden Land gültigen Patenten erhalten bleiben muss,

kommt FICPI zu dem Schluss, jenen nationalen Regierungen zu empfehlen, die für ihre Wirtschaft aus Einführungspatenten Vorteile ziehen können, die Einführung oder die Beibehaltung geeigneter gesetzlicher Regelungen unter Berücksichtigung ihrer eigenen nationalen Interessen, einschließlich des Erfordernisses der unverzüglichen Veröffentlichung der Einführungspatentanmeldung zum Schutze der Interessen Dritter, zu erwägen.

NEW MEMBERS

A WARM WELCOME IS EXTENDED THE NEW MEMBERS OF THE FICPI FAMILY.

Mr. Tai Keung CHENG, China
Mr. Jinguo XU, China
Ms. Louise AUDHLAM-GARDINER, Jersey, Channel Islands
Mr. Hong-Shik PARK, South Korea
Mr. Eui In HWANG, South Korea
Mr. Dong Yol YOON, South Korea
Ms. Won-Hee LEE, South Korea
Ms. Boh Young HWANG, South Korea
Ms. Insil LEE, South Korea
Mr. Manho SONG, South Korea

ADMITTED BY THE BUREAU IN NICE, APRIL 2003 (REPORTED TO BERLIN EXCO):

Mr. Ea Roo KANG, South Korea;
Mr. Changse Leon KIM, South Korea;
Mr. Duck-Rog LEE, South Korea;
Mr. Ho Hyun NAHM, South Korea;
Mr. Dukkyu CHOI, South Korea

ADMITTED BY THE BUREAU BY TEL./EMAIL CONFERENCE IN MAY 2003 (REPORTED TO BERLIN EXCO):

Mr. Doo-Hyun MOON, South Korea;
Mr. Constantinos KILIMIRIS, Greece.

ADMITTED BY THE BUREAU IN BERLIN IN MAY 2003 (REPORTED TO THE BERLIN EXCO):

Mr. Alberto L. R. Berton Moreno, Argentina;
Mr. Antonio Tavira, Spain.

ADMITTED BY THE BUREAU IN LONDON IN NOVEMBER 2003 (REPORTED TO THE SINGAPORE EXCO):

Mr. Jonathan Agmon, Israel.

ADMITTED BY THE BUREAU BY TEL. CONFERENCE IN JANUARY 2004 (REPORTED TO THE SINGAPORE EXCO):

Ms. Patricia Villegas, Dominican Republic;
Mr. Xiaoguang Yang, China;
Ms. Marta Berkemeyer, Paraguay;
Ms. Nina Mikhailovna Vasilieva, Belarus;
Mr. Armin Keuper, Argentina;
Mr. Martin Bensadon, Argentina;
Ms. Magdalena Bachrata, Slovak Republic;
Mr. Zhongjun Zheng, China;
Mr. Felipe Claro, Chile.

ADMITTED BY THE BUREAU IN SINGAPORE (REPORTED TO THE SINGAPORE EXCO, BUT NOT YET INFORMED OF THEIR ADMISSION):

Mr. Kutlu Oytac, Turkey.

ADMITTED BY THE EXCO IN SINGAPORE

Dr. Maura O'Connell Ireland
David Brophy Ireland



VENICE FORUM

The next Open Forum, FICPI's 8th will be held in Venice from the 6th to 9th of October 2004. The Forum is open to all and will be in the familiar three parallel sessions giving participants the choice of different topics at all times. The program can be found on the FICPI web site, www.ficpi.org under latest news and an online booking form will be available.

A full social program is planned for accompanying persons during the day. The event will be held on the Lido, a short water bus from St. Marco and accommodation will be at the Westin Excelsior.

IN MEMORIUM

DR. ERNESTO D. ARACAMA ZORRAQUÍN R.I.P.

With great sadness we announce the passing of our colleague Dr. Ernesto Aracama Zorraquín on August 11, 2003, in the City of Buenos Aires, at the age of 82 years.

Dr. Ernesto Aracama Zorraquín was one of the world's best known and highly respected professionals in the field of Industrial Property Law. He was a founding member and president of the Inter-American Association of Industrial Property (ASIPI); professor of Intellectual Property at the Argentine Catholic University School of Law, frequent speaker in national and international forums; prolific writer and author of "Medios distintivos y publicidad comparativa en Derecho Argentino", among a vast list of articles on Industrial Property topics published in local and foreign law reviews. He was also active in international associations such as AIPPI, FICPI and INTA, where he was highly regarded and appreciated by all. All of us who have had the privilege of working with him shall always remember his gentlemanly qualities, his vast knowledge in the field of Industrial Property Law, and his ability to communicate his ideas clearly and precisely so that they could be readily comprehended by everyone. With sorrow we extend our deepest condolences to all his family members.

ALFREDO RAIMONDI by Paolo Stucovitz

As most of you already know, Alfredo Raimondi passed away during the last month of July and Margherita and Lucia asked me to write some words of remembrance.

Even if I accepted the commitment I realize just now how difficult it is for me: during twenty years of common working and daily life his continuous teaching has been to look forward to the future and to take care of the developments without wasting time looking to the past, so that it now seems to me to betray his memory and efforts spending time for a posthumous celebration: it is something that Alfredo would have refused in principle.

It was always me, even if forty years younger than he was, to ask for slowing to conclude what previously begun and before starting a new enterprise.

As anybody knows his human and professional merits, his titles and appointments, I would like to remind now some personal features like his ability to teach me without let me be offended when, looking at the first drafts of a patent, written by myself, he said: "yes quite clever, you have well understood, but..." meanwhile fully devastating the draft and explaining that: "first of all what it is, then where it is, to what is interconnected and finally what it does; and always taking the reasoning to the extreme frontiers to look for the

real limits of the patent"; or hence, after two days of studying a problem I decided to involve him into the case and was regularly stopped after forty seconds of explanation as, just looking at the drawings, he was able to ask me: "why there is not ... ?" The answer regularly was: "that's why I am here, have you an idea ?"

I have also been always astonished by the love the clients had for him even if he used to criticize them very hardly for they inaccuracy or superficiality in respect of the patents; the harder he was with them the higher their respect become.

I was able to explain the fact only referring to his high morality, politeness, honesty and ability to take one's party, never discussed during fifty years of profession and appointments as official of the various association.

Finally I would like to remind the grandsons that, during the last struggle of the granddad, were (with some irreverence) laughing at the "black lady" saying that any decision was postponed up to the approval of the grandfather: Margherita was present and I stopped her attempt to recall them to a higher seriousness saying: "please do not add one word, he is so alive and vivid into their hearts that any further comment can only reduce his imagine".

It is the same for me for whom he has been a second father and a great master.