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Interview with European Patent Attorneys

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On October 24th, 2006, 3 JPO examiners who went to EPO for the Examiner Exchange (Oct.16th-27th) interviewed Prof. Dr. Heinz Goddar and Mr.Christian Appelt who are world-famous European attorneys. The article below is based on what they talked for the interview and edited by TOKUGIKON Editorial Committee. Please note that this article is essentially based on a literal transcript of what they have talked about, so that not everything has been expressed as clearly and precisely as they usually would like to do it for a written article.

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1. About their careers

- *First of all, we'd like to ask why you decided to be patent attorneys. Could you tell us about it?*

(Prof. Dr. Goddar) When I had finished my high school and was in the army, I was not sure how I should decide, whether I should study physics or law. I wanted to study either physics or law, and then by coincidence, I

got a brochure from an advisor for academic studies, concerning the profession of a patent attorney. I read it and I thought that this would be a nice compromise, so I started to study physics and studied also a little bit of law. Besides that, but more in fun – it was a full study of physics. I have a diploma in physics, a doctor's degree in physics, and between my diploma and my doctor's degree, when I was working on my doctor's thesis at Mainz University, I decided finally - on the way, I sometimes thought I should possibly stay as a physicist at university- to go ahead with my original idea, to become a patent attorney. So I studied civil and contractual law, during my doctor's thesis as a physicist, then I got my examination and I started the normal training as a patent attorney.

(Mr. Appelt) Thank you for that question. Actually, the answer is relatively simple. Already when I was at university, I was interested in becoming a patent attorney. I first heard of that profession already at school, simply because my father, who's a mechanical engineer, has been an inventor of various patent applications and I was in contact with a patent attorney of his company at that time. Then I forgot about all that and started working in physics, and when my studies came to an end, closing with graduation, I thought it would be very interesting to have some experience in a foreign country and I wanted to start my career in IP. I didn't want to study in a foreign country, but I really wanted to work in

a foreign country after finishing university. Then I was thinking about where the most important countries in intellectual property and especially patents are. Germany is one of the important countries, but I am German, so I know of course the IP situation here. The second country which typically comes into one's mind is the United States. I already had some experience in the United States as I have been there for a couple of months during my university time. And of course I thought about Japan; because in Japan, most patent applications are filed worldwide. I had never been to Japan at that time, so I decided to make my professional experience there whenever it would be possible to go to Japan. The German Academic Exchange Service, sponsored by the German Government, granted me a scholarship for a 2 years program in Japan, where I both could study the language and had the opportunity to work in the area of intellectual property, and I went to Japan at the end of 1995, after I had entered Boehmert & Boehmert already in the beginning of 1995.

- As we see, over several years, Mr. Appelt has worked at a patent office and companies in Japan and would you tell us what kinds of jobs you have been involved in?

(Mr. Appelt) In Japan, I have been working in three different locations, actually. The first one was in Osaka; I was working there with "Hokuto Patent Attorneys Office". Then I went back to Tokyo and was working with the patent department of Ebara Seisakusho. The patent department at that time consisted of about 30 persons. Finally, I was with the Intellectual Property Department of Sony Corporation. So that was a nice overview of the various kinds of IP work – namely within a private practice firm, and in industry, i.e. in a company's IP department, first with a smaller IP department, with about 30 persons, then with the huge IP department of Sony, at that time there were 250 people involved in the IP department. That gave me a very interesting overview of the various kinds of work in IP

Japan and I very much enjoyed my time in Japan severally on the one hand and with the above-mentioned firm and companies on the other hand.

- Were there many foreign patent attorneys in Ebara Seisakusho or Sony then?

(Mr. Appelt) There was none in the IP Department of Ebara Seisakusho. And as far as I know, at least at that time when I was with Sony, that was 1997 actually, also none.

- What did you do in Sony or Ebara Seisakusho?

(Mr. Appelt) Naturally I was of course involved in foreign prosecution and litigation matters. So whatever there was in foreign applications in Europe and United States there was a natural tendency to give it to me. It was, of course, easy for me to work with IP matters of Europe because that was my own country's jurisdiction. But I was also involved in prosecution of Japanese patent application, which, I have to admit, was a little bit difficult for me, just due to the language. So it took, of course, a long time to read and understand official communication in Japanese, but it was a very good experience. I even once attended an oral interview at the JPO, actually, that was for prosecution matter for an application Ebara Seisakusho had filed with the JPO.

- Regarding your experience of the interview in JPO, did you find differences between JPO and another patent office?

(Mr. Appelt) At that time, I had the feeling that the oral proceedings were more formal at JPO than I remember from both the GPTO and EPO. Both before the EPO and the GPTO, if there are oral proceedings, you're sitting in front of one examiner, or the examining division, which means three people, and you definitely make a decision at the very end but, the proceedings and

the discussion itself are relatively informal, while procedurally JPO seemed to be more formal, having more “rules” to follow during discussion.

However, as far as I can see it, there are a lot of possibilities before JPO to be in touch with examiners. Also what our Japanese patent attorneys, with whom we are cooperating, told me is that it is possible to be in touch, to inform them, to call them in order to discuss certain matters and this is the same for GPTO, and for the EPO and I think this is a very good opportunity because very frequently, some things are just better clarified with a 15 minutes’ discussion than what you can do in 10 pages of writing. And my feeling is that this is more difficult at the USPTO. I believe, again, the proceedings are similar between Japan and Germany, and Europe and very, very good and I hope that this remains.

At EPO we have noted a recent tendency to proceed faster to formal oral proceedings. Nowadays, the world is living on statistics, being in my opinion also one of the reasons, why EPO is faster in summoning oral proceedings, as all patent offices are somehow in a competition, to have short examination procedures, so what is the average time from application or from request for examination until grant. And with some simple measurements like that one, the PTOs can, of course, cut down that time. Whether this, however, helps the applicant, is not clear. And there are some points, of course, which are good, like acceleration. Sometimes however delays are even desired by the applicants, as it also delays costs.

But not all measurements, like cancellation of possibility for extending the 51 (4) communication deadline, do help the applicant. And in our experience, although you frequently hear in public discussion, typically from those people who are not involved in intellectual property, that the examination procedure should go faster, while frequently the applicants, however, have to start with the

application, typically years before the product can enter the market. They frequently do not know at that time what is needed on the market, so very frequently, they do not want to have it accelerated but even delayed, and if they want to have patenting proceedings accelerated, then there are certain measurements to request for acceleration, at EPO for example the PACE program. The average time until grant before EPO is currently about 45 months, but you can cut it down to about 19 months if you file a request for PACE, which however has been requested in 2005 for only about 6,5% of the cases. So I think the statistics put some pressure on the patent offices, like JPO or EPO, where sometimes it is not really necessary but it comes more from the political side. In my opinion clearly flexibility is the most important aspect for the applicants.

2. Difference of patent systems and examination standards

- With the final goal of establishing a global patent system, it is important to use the search results and examination results obtained by other offices, and to use them efficiently, it might be necessary to unify the examination standards. Do you think there is any difference of standards of inventive step between EPO and JPO and do you think also, between JPO and GPTO?

(Prof. Dr. Goddar) Well, I think the following, based on many experiences. My personal belief is that the level for inventive step required by the JPO and the GPTO is similar and it would be on about this level here (Prof. Dr. Goddar was pointing, when saying this, to a level of about 80 – 90 of a scale of 0 – 100, with “100” marking the absolutely highest level of inventiveness) – same requirement for inventiveness by JPO and by GPTO. The European Patent Office (EPO) is probably here (Prof. Dr. Goddar was pointing, when saying this, to a level of about 60 of the aforementioned scale) – a lower degree

of inventiveness is probably necessary there. Why this is so, is explained below. . The USPTO's requirements for inventiveness are even lower, however, like here (Prof. Dr. Goddar was pointing, when saying this, to a level of about 40 of the aforementioned scale). For applicants, wherefore, there is no problem with fulfilling of the inventive step requirements in the United States: Pretty low standard, unfortunately, which means that a lot of junk patents flood the market. Very, very big problem for the industry, particularly for small enterprises, in the United States: It is so difficult and expensive to fight the validity of patents, big problem! In my personal experience, I can say of the USPTO – rather low, EPO - a lot higher, GPTO, probably still higher, and same level, possibly, the JPO.

Now, what causes the difference between the EPO and the GPTO? I have thought about this for a long time and meanwhile, based on many discussions also with Supreme Court judges in Germany, I have come to the following idea, and it is interesting that the same problem now plays a role in the United States Supreme Court decision-making process. When I say 'GPTO', I mean also, of course, including the Federal Patent Court and the German Federal Supreme Court, because they decide at the end in Germany. So, the difference is as follows. The EPO follows the famous problem-solution approach, which we don't have to explain in detail. The biggest – not problem, but the main feature of this approach in the context I am now referring to, is that the EPO would consider the combination of two documents of prior art, A and B, only as leading to obviousness if in at least one of the documents you have a hint to the other document. For example, the one is a document related to a car brake, and the other one to an alloy, and the invention is a car brake with a special alloy for the brake disk.

The EPO would say the following: The expert would only have had a reason to combine the two documents A

(car brake) and B (alloy) if either you find in the car brake document A, as closest prior art, some sentence like 'one should also try other alloys, preferably copper-iron alloys, because they might even improve this', then the expert will look at it and say 'Ah, here I have to combine it'. Or, you may find in the alloy publication, a hint where they say that this alloy of document B could be of specific use for brake purposes - for planes, for motorcycles, etc.; only then they would "combine".

So, it is necessary - I would even say, it is absolutely necessary now at the EPO – that you find inside of one of the documents, which you wish to combine, a hint which makes you looking to the other document. If not, there is inventiveness. In the latter case, the EPO would come with this famous sentence: 'The expert could combine, but he would not have done so', he had no reason! Germany is different. Germany says this is one approach you can take; they look at the two documents differently and they say 'Did the expert, the ordinary man's skilled in the art, out of his own conceptual ideas, his education, his knowledge at the priority date of the patent – did he see a sufficient reason to try to "combine"? ' So it is not necessary that you have a hint in the documents as such, but it is only in the horizon of the ordinary man's skilled in the art who decides. So you come, in many more cases, to a result of non-inventive step, than the EPO would come. This is approximately my idea, but...

(Mr. Appelt) I essentially agree, although I have the feeling that the could-would approach is getting more and more difficult. At least the German Patent and Trademark Office says that if there are two documents, which are in principle available for the expert, GPTO would typically combine it, and would not follow the problem-solution approach as before the EPO. That also leads to the result that at EPO, a combination of document D1 and document D2 might be DIFFERENT from a combination of document D2 and D1, because

depending on which document you start, the problem would be a different one. This might even lead to the result that a claim in view of a combination of D1 plus D2 is not inventive but in view of D2 plus D1 is inventive, just because you start with a different problem. This is something that would typically not happen before GPTO, where simply both documents would be taken into account. So in a nutshell, probably GPTO and JPO are very similar, in the standard for inventive step. EPO might be slightly lower, and USPTO is even lower. It's also the experience we typically have with our US clients, because they frequently notice that inventiveness requirements at EPO or GPTO are higher than at USPTO.

-You mentioned the standard for inventive step in JPO is the same level as the GPTO, but do you have any experiences to think so?

(Mr. Appelt) I just can confirm what we have said before, and most of my experience of course result from cooperation with Japanese patent attorneys and applications of our clients before JPO. For us, as German and European patent attorneys, for me at least, it's always easy to work with the JPO. Why? Because the whole system is very close to ours. The way of thinking, the claim structure etc. is the same. So typically, I can always fully compare an objection, an office action of the JPO, with a parallel one the EPO or GPTO, while the inventiveness requirement seems to be the same, and also the procedural way of activity is probably closer, and that makes it much easier to cooperate between Europe and Japan, when preparing and prosecuting patent application.

- Do you have other impressions of JPO?

(Prof. Dr. Goddar) What impressed me - I had once, actually twice, the opportunity to visit with the Japanese Patent Office, and the last time was two years ago: I was

with the examinations division. I could see, in a biotech case, technically rather hopeless for me, but it doesn't matter, that all examiners have free access to all the data banks of this world. Cost doesn't play a role, which means, whatever data banks exist and is of interest to the examiner, it cannot be remote enough, the examiner can access – this is something which I find excellent. So on the spot, the examiner showed to me how she was now entering all these cost-bearing databases. This is different for the GPTO examiner: She/he needs, so to say, the signature of a director if she/he wishes to spend the money for the search on an outside data bank. I find the above mentioned possibility in the JPO excellent. The much broader, wider access and the discretion of the individual examiner to go into even cost-bearing external databases, irrespective of cost.

(Mr. Appelt) In any case, I think we on the European side, and I think the same also applies to the USPTO, we all have to acknowledge the very good job the JPO is doing, especially on the electronics sector, so I don't know for how many years it is already possible to file all applications online, electronically at JPO, while the other patent offices are much slower in this respect. I really believe that JPO in this respect is the leading patent office in the world.

You can of course now also file electronically, for example, at the EPO, but the numbers of electronically filed cases are much lower. It also has a little bit to do with the “culture” of applicants, but I really believe that the JPO has done a perfect job in getting that computerized.

There is a big difference between Japan and Europe, and especially Germany. At EPO you at least have essentially all files available electronically and you can make an online file inspection, but even this is not possible for GPTO cases, so I really think that JPO is excellently utilizing all electronic means that we have

and they are by far the leaders in the world.

(Prof. Dr. Goddar) It's ridiculous, we get all our cases – one of our largest clients is Microsoft, another one is Intel – from many clients in electronic form. Then, we have to produce first paper – we send it to the patent office and they import it electronically and scan it. I mean, it is ridiculous; it is not a smooth system.

3. Quality of Patent

- I'd like to ask you about the quality of patents. In expediting patent examinations all over the world, from the opinions of users, in Europe, it seems there are concerns about the quality of the patent. Then, I would like to ask you from the point of view of the quality of patents. Would you tell us what is the quality of patents in Europe?

(Mr. Appelt) I think, from my personal point of view, – there are different methods and attitudes for considering the state of art, on a higher level of the JPO, or EPO and GPTO, and obviously on a somewhat lower level, by the USPTO, but quality of patents are mainly determined, in my opinion, by the quality of the search. Because if you don't find the relevant prior art, the examiner can't do anything. If you did not find the relevant document, but it's there, then what can you do in the examination? Nothing, because you look at what you have and if you don't find the very relevant document, you have a big problem. And besides the effect which Heinz Goddar has already mentioned, the USPTO inventiveness requirement is closer to the JPO and EPO novelty requirement, and as also the searches seem to be not that perfect, at least in some areas of technology, and this is also what our US applicants tell us, the quality is different at USPTO. Many US applicants file of course first at USPTO, then they frequently file a PCT application, claiming priority of the US-application, and what they do there is designating, as

the international search authority, the EPO. Because a lot of our US clients tell us, that only then, they get a proper search. They probably could have done the same thing at the Japanese Patent Office, because the search there is perfect enough, but possibly for language reasons, they don't.

(Prof. Dr. Goddar) Just as a little interruption, but I wanted to say, I just heard from a client in the United States, a big one, I cannot tell you the name, but they have made excellent experiences with KIPO, which is the Korean Patent Office, which now is an international search authority under PCT: KIPO works extremely fast, and they are really selling swiftly excellent search services. If you ask clients, in certain technical fields, it's too slow for them. They go then to KIPO, in order to get very quick, good, search results. KIPO seems to sell this in the United States, I mean to promote these services.

(Mr. Appelt) So the search, I think is the crucial factor. If the search is done well, typically also the examiners do a good job, because the level of the examination is good. This leads, typically, to good quality patents, currently in Europe, at GPTO, and at JPO, as far as we can see, because the search is good and then the examiners do a good job on what they have.

(Prof. Dr. Goddar) From a political viewpoint, what the attitude is towards patents and quality of patents, I firmly believe, and I know that many other people believe so too – that a patent office has not the applicants only as “clients”, that is a total misapprehension. The patent office has not only to grant good patents for good inventions but it has a tremendous possibility and duty to prevent bad patents from existing, because these are obstacles for technical development. Bad patents are a disaster – good patents are very good, but it is a very balanced role, which an examiner has to play. Not only to grant good patents but also positively, to prevent bad

patents, because they are as much an obstacle against technical development as good patents are a promoting element for technical development.

(Mr. Appelt) On the medium term, what also ensures the higher level of granted and valid patents is a good second instance proceeding – what I mean is, opposition or invalidation proceedings, both in Germany and at the EPO, we have the opposition proceedings plus the follow-up invalidation proceedings. In Japan, you have combined opposition and invalidation, so you only have now the invalidation proceedings, but this also is a good possibility for a Third Party to introduce further state of art, which cannot be covered by search or by the examination procedure, like e.g. public prior use. This can be only done by effective inter-parties proceedings.

(Prof. Dr. Goddar) I see a patent office, so to say, as the authority, which is not only responsible for the granting of new patents, and preferably only good ones, but also as a watchdog, continually to look into the future of these patents in the country and to destroy “junk” patents on request if it becomes necessary. The patent office, of course, usually has this dual task, but the second part, in the United States, practically is not available.

-I'd like to ask about the speed and quality. Actually, in Europe, there is almost no applications related with PACE while in JPO, this system is adopted and then JPO is requested to examine faster and faster, but in Europe, I am surprised that they don't use PACE. Are they satisfied with the speed?

(Mr. Appelt) I have to admit, first of all, I also was very surprised about the relative low numbers for requests for acceleration under the PACE program, especially as the PACE request does not involve any official fee – you just file it – it's free for the applicant, so why don't they do that? The reason behind that is that

– as I shortly mentioned at the beginning – a lot of applicants want to delay costs for the proceedings. They have to be first in filing – first come, first serve – so they have to have an early filing. At the time of filing, they do not yet know whether they need it for the product, whether the competitor is going to do that, whether the product will be successful or not, so they want to have their rights secured by an early filing. And then they want to have the costs delayed until they know more about the success on the market. An examination procedure of three to four years in average is typically absolutely fine for the applicant. Second point – because the number of acceleration requests is so low – EPO can do the acceleration without additional costs and without any detrimental effect on the quality of the examination procedure – it's only done earlier. So this is why the quality is not going down with a PACE request. This would be more difficult, if e.g. 50% of the applications would request for acceleration.

(Prof. Dr. Goddar) Five percent of the applicants actually do so, as I said: If 50% of the applicants used it, I am sure the EPO would have to introduce a fee or an abbreviated procedure, but presently it is not necessary. It just works due to the low number of requests.

We have, for many of our big clients, US clients for example, the explicit order – not do accelerate the procedure at the EPO – “only if we tell you”. This happens, however, in more than 5% of the cases. They do not need these other patents early; maybe the clients even drop the applications after some years, when new products come. Only in five or ten percent of all cases, such clients need an early patent. Then, they tell us, and then we go into PACE.

(Mr. Appelt) Frankly speaking, we have more requests from our clients to requests for a delay and for additional extensions of time, as long as possible in order to delay the proceedings than having requests to accelerate the proceedings. This is in complete contrast

to what you always see in the public media.

(Prof. Dr. Goddar) I think the reason is particularly when people complain, and this is what our clients do about the USPTO is an institution, where you don't have something like a PACE procedure, where you can, informally and easily, get a quick examination. There, you have a problem, because there, also the five percent important inventions, where the client wishes to have a patent as quickly as possible, cannot be handled. They are all at the three- and a-half year limit and this is too long, of course. If you give, however, the applicants the possibility, at their discretion, to get everything earlier, they will – also in Japan, I am sure – not make use of this in a tremendous number of cases – it will be five percent, ten percent or so – this is really the industry's practice. If you open this relief for industry, I think that all the discussions in public, this complaining about long examination times, will deflate.

(Mr. Appelt) Really, in a nutshell, it's not important to lower the average time, such statistics they just do not show the real situation, but it's good for the applicant to have the flexibility to decide upon, whether the case should be accelerated or delayed. If this flexibility is given, that's the best for the applicant and we have that, both be for the EPO, the PACE requests, and at the GPTO, where it is not formalized, but you typically can ask for an acceleration, if desired. The guidelines of EPO say that they will try to provide you with a next communication, either the examination report or search report, within six months after that PACE request. Typically, it is even shorter but there is no guarantee and it is not binding.

(Prof. Dr. Goddar) At the GPTO, you don't have a formal PACE or similar program, but if you call a German examiner and tell him: Look, this case is really important, I need it for this, he says 'Give me some reason to distinguish this case from others'. If you say

that license negotiations are pending or there is some infringement, he will exactly do what the EPO does, i.e. he will take this file, put it on top and work on this much earlier than he would otherwise.

4. Future of European Patent System

-The next question is about the future of the European Patent system. On June 19th, their president, Pompidou said that implementation of the London Agreement and the adoption of the EPLA was important. I would ask to you that if it is decided that the European patent court will be established, how the European court will be made. What country does become a model, do you think? And if community patent court is established, there will be national courts, European patent courts and community patent courts in Europe. Do you think it is desirable for European applicants, patent holders or are there any alternatives?

(Mr. Appelt) Very good question. Actually, we have three topics. One is the London agreement. The second is the European Patent Litigation Agreement, the EPLA. The last one is community patent. Let's start with the last one, because it can be summarized easier. The community patent is in discussion since decades, actually, I have to say, and the expectation were always changing – it will come, it will not come, it will come, it will not come – my current feeling is, the community patent will not come into force in the near future, because the countries could not agree on a standard set of regulations – mainly language problems, which is the biggest problem.

One of the goals of the community patent was to make patenting in Europe cheaper, mainly by reducing the number of translations. The idea was, no translation for the specifications, but translation of the claims in all languages of the European Union. We have currently (2006) 25 members of the European Union with 20 different languages, so you have to translate all the

claims into all the languages. What is a certain problem is that according to the latest regulations, which had been in discussion, the binding version would be the translated version. That means if you go to a Greek court to enforce your community patent, the Greek version of claims would be the legally binding version, even if the patent, which has been granted in English beforehand, has a different scope of protection, when considering the claims in the original language of proceedings. In a nutshell, the community patent will probably not that easily come into force, but will probably never come – I actually now expect that it will not come, at least not during my professional career.

The second thing – and probably the better solution – is the London Protocol, because the EPC does not, necessarily, provide that a European patent that has been granted by the EPO must be translated, but EPC simply has a provision that the national countries can, if they wish so, provide for a regulation that, in order to have that patent valid, it has to be translated. Nowadays, essentially all the European EPC member countries have that requirement, except Luxembourg. By the way, when the European patent system was founded at the beginning, Germany did not have that requirement; we have some old European patents which are not yet translated into German. So the London agreement would just cut down the translation costs tremendously for most of the countries – the only problem we have here is France. France still has to rectify that and they did not, and we don't know when it is going to happen. If France does, the London Protocol would come into force, that would cut down translation costs tremendously. So the London Protocol definitely is a good idea for all applicants.

Last aspect – litigation. The EPLA also is a reasonable system and covers the second aspect that should be covered by the community patent, so to take the result at the beginning, if the community patent is not coming, one can put into place two systems, which reach then the

goals which were originally intended to be achieved by the community patent but could not, due to language problems – namely the London Protocol for translation and the EPLA for centralized litigation proceedings.

(Prof. Dr. Goddar) Maybe a brief additional comment from my side. As the community patent dies, this is essentially for the following reason, that the translation of the claims into all of the EU member countries' languages would be binding if litigation was in that language. The EPC patent, however, has only one binding language, which is the official language, which you use in all litigation proceedings in all European countries and which would also be binding if you go later on into the EPLA. The Community patent has been fought against by European industry mainly because of this language problem. Not the cost of the translation – no – the binding character, because what you get is a bundle of patents in 17 or more languages – they will never be identical and these translations cannot be made, I would say, as “carelessly” as presently translations under EPC patents. Under EPC, the translations have absolutely no binding character, but with a Community Patent they would be binding. That means that such translations, for a Community Patent, must be by attorneys. The translations, in that case, would practically be legal opinions – very expensive, very responsible work by attorneys!

This is where the community patent dies. With regard to the London Protocol, France is still uncertain whether and when to ratify. In 2007 there is a presidential election in France, a year later is the parliament election. Accordingly, our friends in France don't think that anything will happen before this. And particularly, there are rumors, in France and also from other people, that the fate of the London Protocol may be closer related to EPLA than we all think, because if EPLA comes, which is now supported by the European Commission, which means they have practically given up the idea of a

Community Patent already, it has a consequence: There must be a central European patent court – there will be regional courts everywhere, but also a central European patent court, and this European patent court needs a location. There are very many people who believe that France will make a deal then. They will say, okay, we rectify the London Protocol, but only if the European patent court comes into France. Some location in France – possibly Strasbourg – which would be a compromise with Germany. Hopefully not Paris, but this will be the deal. France will not rectify, I predict this, the London protocol without any deal; without anything in addition. This “addition” is probably the location of the European patent court, many people believe, and I think that is going to be.

- If the London Protocol is implemented, does it influence on the interpretation of claims?

(Prof. Dr. Goddar) No problem! The language protocol will not change this, because already now, the only binding version, even of an English language EPC patent, designating Germany, is the English version of the claims. Neither the attached translation of the claims only, in an EPO patent, has any meaning in a German court, nor is the translation of the whole patent, which is filed at and published by the GPTO, of any importance. The claims are the English ones, so a German patent litigation, out of an English language European patent, starts with presenting to the German court, because the court language is German, an authentic translation of the English claims into the German language.

This translation may be – and often is – different from the published translation, which was only for information purposes before. Then, at the German litigation court, there might be a fight between the parties, i.e. the patentee and the defendant, what is the meaning of these English claims. I have had a procedure in Dusseldorf where we had language experts on both sites – Oxford

dictionary here and Webster there, to decide what this word really does mean in German. But at the end of the day, what the court is then finally basing the decision on, is the English version. So the missing of the language protocol does not influence the interpretation of the claims at all.

(Mr. Appelt) There has been a recent survey in Europe, regarding what do applicants and inventors and private practitioners etc. expect from the European side and they have, of course, also covered EPLA and community patent. That survey was just published in the middle of this year, as there was a public hearing in July 2006. In a nutshell, the result is that most users of the system can live without the community patent – EPC is a good system. London Protocol, because of cost saving, and EPLA would be an advantage, because the big cost factor is just translation, and so the most important part is saving of costs without influencing the litigation later on.

(Prof. Dr. Goddar) The London Protocol has only to do with this “money burning machine”, i.e. the translation requirement under EPC. The London Protocol has absolutely no influence on patent litigation. Today, the situation is as follows: If a translation is filed at the patent offices of, say, Germany, France, Finland, Sweden, with the original language of the patent being English, still English is the binding version of the claims even in the countries of Germany, France, Finland, Sweden. If the translation as filed and published in Germany, France, Finland, Sweden, in this example, is narrower than the original English version, say: If you would have translated “alcohol” as “methanol”, then there is a gap between this narrow translation and the broad meaning of “alcohol” in the original patent. If now somebody in e. g. Germany in good faith starts using ethanol, isopropanol, or other alcohols, but not, of course, methanol, he can continue to do this, even after the patent owner later on will have filed a revised, now

sufficiently “broad” translation in Germany, France, Finland, Sweden.

After the aforementioned correction, the party which has started to use an alcohol different from methanol before the corrected version of the claims, with the correct translation of “methanol”, would have been published by the national patent offices in Germany, France, Finland, Sweden, the good-faith-user can continue to use the alcohol he used which had been located in the “gap”. In other words, if translations are prepared and filed, they don't have to be of high quality, but they should not be narrower than the European patents.

As soon as the London Protocol will have been accepted, because of the lack of a necessity to file translations in countries like Germany, France, Finland, Sweden ..., the aforementioned problem of a possibly too narrow translation will no longer exist. Otherwise, the London Protocol has nothing to do with patent applications and claim interpretation. The original language of the claims will remain binding, and EPLA will not change this situation."

(Mr. Appelt) Additionally and due to newer developments and decisions of the European Court of Justice in 2006, cross border injunction is essentially not possible any more without implementation of the EPLA.

(Prof. Dr. Goddar) The European Court of Justice in July has published decisions, actually two decisions, which have destroyed all the former, particularly Dutch theories of spider-in-the-web etc. They have essentially stated patent litigation, as soon as it involves validity questions, and I, personally, have never seen a patent litigation without a validity question, is only for the national courts, so you have no cross-border litigation. This does not mean that it would be necessary to come to something like EPLA, rather one could leave “everything” with the national litigation courts that

presently are used, with great success, in countries like Germany. The purpose of EPLA is to create a centralized litigation possibility. If now, however, everybody would say that EPLA should be established, the next step would be a diplomatic conference, where the member countries of the EPC would come together and make a decision. This conference could still take place end of 2007, but more realistically, in 2008.

If, at that conference, they decide, yes, we make EPLA, that must be ratified by all of the member countries of the European Patent Convention, and this takes 7 to 8 years. So in the most favorable case, we will from now on, in 10 years, have an introduction of EPLA. The EPLA has a transition period of 5 to 10 years, where the national courts still can act, so I cannot foresee, even under EPLA, that before the expiration of 15 years from now on, you would have any first court decision by a European patent court. In other words, if EPLA is adopted, it will be a model for the far-reaching future, actually, a very far-reaching future.

- Thank you very much!

profile

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profile

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