FICPI 7th Open Forum

Prague 11 October 2002

New Challenges as well as New Possibilities

Lise Dybdahl

I. Introduction

Every magazine, every brochure you receive unsolicited or television spots in the middle of a good film give advice as to what one should eat in order to become or stay healthy. In comparison - it is rare to see a list of what to do as a patent attorney in a country which has just recently joined the European Patent Organisation or how to accommodate to the new situation in order to keep the business healthy.

In my contribution to today's panel discussion I will try to give you my recipe: Principally, it consists of the following elements: 1. training and education, 2. development of a new business concept, 3. improvement of language skills, in particular in English and German, and 4. specialisation. It is obvious that each individual patent attorney office will have to combine these ingredients in the most suitable way for it taking its present situation into consideration - and perhaps develop their own and different ideas.

II. 1. Training and education

As you all know the European patent attorneys registered on the EPO's List of professional representatives consist of two groups, the so-called grandfathers and those who have been entered on the List after having passed the European qualifying examination. Both groups need training.

The grandfathers should attend courses and seminars in European patent law. Quite a number are offered on a private basis in various towns in Germany as well as some in London. Various international patent attorney organisations regularly organise seminars where themes relating to European patent law are discussed. This FICPI Open Forum is one example. It could also be recommended to attend public oral proceedings in the EPO in Munich - in particular, because it helps one to familiarise oneself with the particular, primarily English and German, language used in patent appeal proceedings. Every year the International Academy of the EPO holds a number of seminars dealing with various aspects of the European grant procedure, search and patent information. Participating in the various committees of *epi* as a member contributes to making one familiar with the multifaceted European patent system.

As important for the grandfathers is, however, the training of the next generation. In future, the young members of the patent attorney's office will have to pass the European qualifying examination in order to become a European patent attorney. A university-level degree in science or technology is needed plus a three year full-time training period under the supervision of a person who is already entered on EPO's List of professional representatives in order to be enrolled for the examination. Alternatively, a three year full-time period where the young patent attorney has represented his employer, situated in an EPO Member State, allows for enrolment for the EQE, the European qualifying examination. During the three year training period, the candidate should spend a great deal of time preparing for the EQE. As an employer it is very important that you allow the candidate enough time during these three years for him or her to study and prepare for the examination. Only in this way has a candidate a fair chance of passing the examination which is quite comprehensive and which only about 40% pass in their first attempt.

Preferably, the candidate should also be given the possibility to work on European patent applications or patents. It is optimal if these activities could include European or at least national opposition files as one of the examination papers in the EQE relates to an opposition case and is considered by the candidates to be difficult. Courses organised jointly by *epi* and CEIPI are available. Normally, candidates form a smaller group and every second week they discuss with the tutor and have lecturers come in, be it from their home country or from abroad. This *epi*/CEIPI course called Basic Training in European Patent Law lasts two years and is already running in many EPO member states. For many years CEIPI furthermore has been organising courses, every year one week in January and one week in February, directly relating to the examination itself. Once a year, within the framework of *epi,* the candidates can prepare or train on the examination papers of the previous year and have them corrected by an *epi* member. They are called *epi* tutorials and are announced in *epi* information. EPO publishes the so-called Compendium containing the examination papers of the year, the markers' reports with model solutions and examples of candidates' answers for each paper in German, English and French which have obtained a very good mark. Since last year the Compendium also exists on an interactive CD-ROM together with a number of legal texts and decisions.

Candidates who have completed advanced specialised studies or training courses in the field of industrial property in any of the contracting states may be granted a

reduction of up to one year on the period of three year full-time training, I mentioned before. And candidates who have completed the one-year period of study with CEIPI in Strasbourg culminating in the "Diplome d'Etudes Internationales de la Propriété Industrielle" will be granted a reduction of six months. This CEIPI course is not the *epi*/CEIPI course I mentioned before, but a full-time study of one year.

To the patent attorney associations in new member states I have a further suggestion. I believe it would be a good idea to create a tri-partnership with the national central industrial property office and one or two universities. It has proved to be useful for a country to establish a post graduate degree in industrial property law either at a national technical university or as a superstructure of the national law studies. Irrespective of how the degree is offered, graduate engineers, lawyers or economists should be accepted as participants and without regard to their nationality.

In those countries where an examination already exists and has to be passed in order to be able to represent before the national patent office, it appears to be advisable to harmonise the national examination with the European qualifying examination - at least in the patent related part of the national examination, as opposed to trademarks and licence law. Another solution could be that at least part of the national examination can be omitted if a candidate has passed the corresponding part of the European patent attorney examination. I may add that some statistics show that candidates in the EQE obtain better results if they come from a country where the passing of a national examination in industrial property is a must in order to be able to represent before the national central industrial property office.

II. 2. Development of a new business concept

When the European Patent Convention enters into force in respect of a new member state, the composition of patent applications changes fundamentally. The number of nationally filed applications from abroad will be remarkably reduced and will be substituted by designations of the state in question in European patent applications and PCT applications. This means that for some years - that is to say the average time for granting a European patent - preparation of translations of patent applications will hardly be necessary. This is linked to the fact that it takes some years before European patents will be validated in the new member state and thus need to be translated in order to have legal effect there. Within that period - three to five years - the patent attorneys in the new member state should develop a new business concept. They should put the

emphasis on developing the patent awareness of the national companies. This includes offering services in the field of searches, combined with an analysis of the relevant technical area, they should inform national enterprises of the increased possibilities to take up new productions via the increased number of patents valid in their country as licensees.

Moreover, the patent attorneys should prepare themselves for representing national clients in oppositions against European patents validated in their country and last, but not least enhance their professional level in order to play an important role in patent litigation. The "patent litigation" market is increasing. The reason is that since the conclusion of the TRIPS Agreement in the mid-90es there has been much more focus on intellectual property rights which today are carriers of huge investments by companies all over the world. Furthermore, the likelihood of a collision between various kinds of holders of right increases when the number of rights valid in a given country grows considerably and behind them the economic values or investments dependent upon their maintenance. Such a development has taken place in many countries which have ratified the EPC in recent years.

II. 3. Improvement of language skills

In general, patent attorneys in any country are considered to be one of the professions having an excellent knowledge of foreign languages. At the same time, it is often claimed in the context of the European qualifying examination that candidates from member states not having one of the official languages of the EPO as their mother tongue have a handicap in the EQE to become a European patent attorney due to the fact that the examination papers are in German, English and French. By way of a foot note, I stress that answers to the examination papers may be drawn up in any of the official languages of the Contracting States.

I think we should try to analyse this statement. Whereas the pass-rate of the Nordic candidates for first sitters is between 25 and 29%, Denmark with the highest, it is 17% and 44% for Italian and Dutch candidates, respectively. The Dutch percentage is moreover 7% higher than the total average. It is already the general impression that young persons in the East European countries are good at foreign languages. This also coincides with my personal experience. However, as is the case in for instance my home country Denmark, I am afraid that this is only a qualified truth. Daily relations with engineers and lawyers who do not have an EPO language as their mother tongue,

either, but who in a professional connection have to express themselves in one or several of the official languages of the EPO show that many professionals are worse and less precise than professionals from the other countries expressing themselves only in English. In particular, the Dutch are generally very good at foreign languages at a high level. Furthermore, German is still a principal language in the patent world in Europe among engineers as well as lawyers.

If the new generation of patent attorneys in the East European countries wants to compete with other European patent attorneys, it is in my view indispensable that candidates from these countries like those from other countries not having an EPO language as their mother tongue have at least a six month stay in an English and/or German-speaking country during the university education or later, but definitely in relation to a professional activity. To these remarks from me, the critical listener would immediately say but the level of language skills of the colleagues in my country is the same as mine. This may be the case. On the other hand, you will have to take into account that, in a perspective, it is competition with European patent attorneys from other EPO Member States and not national colleagues which will be decisive.

II. 4. Specialisation

The last, so to speak, ingredient in my recipe concerns specialisation. Here I am sure the opinions of the health gurus will differ. Traditionally, patent attorneys form offices together with a number of associates in order to be able to offer their services to inventors and companies, irrespective of which technical field the invention relates to. This business concept has been universally accepted for half a century and still is.

Today in other free professions a new trend can be observed. For instance law office firms, with many employees, as in the patent attorney offices, in both smaller and bigger countries, alike make their mark as especially experienced in e. g. taxation law, the law of the sea or intellectual property law. I believe specialisation in a given technical field could be a way for European patent attorneys in a new EPO Member State to qualify themselves in order to acquire clients from the US, Japan and other EPO countries in competition not only with their fellow countrymen but in fact with European patent attorneys from EPO countries having one of the three official languages of the EPO as their mother tongue.

Talking about law firms, I draw your attention to the fact that pursuant to Article 134(7) EPC legal practitioners (avocats) may also represent before the EPO. A legal

practitioner does not need to pass the European qualifying examination. He has to be qualified in one of the Member States and have his place of business within such State. This right only exists to the extent that he is entitled, within the said State, to act as a professional representative in patent matters.

Over 850 legal practitioners are currently entered in an internal EPO list. 60 of them are representing in pending files for the time being. A legal practitioner is entered in the list when he represents before the EPO for the first time in a case involving a European patent application. He must demonstrate that he is qualified and entitled to represent clients in patent matters at a national level. Moreover, the applicant must file an authorisation. This must also be done for every subsequent patent application. In the case of a lawyer accompanying a professional representative (a European patent attorney) in opposition or appeal proceedings before the EPO, such documentation does not have to be provided.

III. Final remarks

All the measures I have suggested that a new "grandfather" should take in order to secure his own and the next generation's future make up a heavy task. I do not underestimate it. At the same time I think we have to agree that it always belonged to the privilege and obligation of the mature generation to see to it that the business he is responsible for adapts to the changing times and markets. And the reality is that those who are best at it are the winners of tomorrow.

It is characteristic of my suggestions that they all relate directly to the performing of the profession. On a more political and general level, the new "grandfather" or "grandmother" should take initiative to argue in favour of his or her country spending a higher proportion of the gross national product on education, research and development of new products. An immediate effect is that the national activity in the patent field will increase and create more work for the patent attorneys. Secondly, the whole society will benefit from it in competition with other countries. In fact, I can't find any argument against such an initiative.

My final remark in this introduction to our later discussion relates to the technological development. Not only do patent attorneys make a living from it, they are also surrounded by it when performing their work. At present, when the development of new ways and means in the field of telecommunication is so fast, this implies that in future we are going to see more and more cases where the patent attorney appointed

does not live in the same country as the patent applicant. It becomes less and less important where the patent attorney physically speaking has his place of business. In other words, this means that once all EPO Member States have abandoned the requirement in national law that a patent attorney may only represent before the national patent office if he has his place of business in the State in question and/or is a national of the said State, the free competition in this profession will be complete within Europe. When it comes to filing European patent applications by European patent attorneys, this situation is reality today.