

ASEAN REGIONAL SYMPOSIUM ON TEACHING AND TRAINING OF INTELLECTUAL PROPERTY

KUALA LUMPUR, JULY 6 - 8, 1995

THE EUROPEAN PATENT ATTORNEY : HIS TRAINING AND PROFESSION .

by

Mme Renate Remadas,
Vice President of the European Patent Office (EPO)

ASEAN Regional Symposium

on Teaching and Training of Intellectual Property

6 - 8 July 1995

Kuala Lumpur
Hotel Hilton

The European Patent Attorney: His Training and Profession

Mrs R. Remandas
Vice President of the EPO

1. The European Patent Attorney

Within the framework of this seminar, which deals with teaching and training in the field of intellectual property, I would like to present the European patent attorney, his training and profession, as well as his legal status.

The status of the European patent attorney is characterised by the particular responsibility of acting in the patent system of a highly-developed economic and technological region. Through his technical and legal expertise, the European patent attorney not only serves the interest of his clients but also acts as a partner to the European Patent Office.

a. The European patent attorney is a creation of the European Patent Convention.
The status of this profession was developed autonomously and independently from the national laws of the EPC Contracting States. The European patent attorney's enrollment on the list of professional representatives before the EPO, his membership of the Institute of Professional Representatives before the EPO and the rules on professional conduct are all governed by European law.

b. The creation of the European patent attorney did not affect the continuation and practice of the profession of patent attorney in the Contracting States of the EPC. The national patent attorney continues to exercise his authority and pursue his activities within the framework of the existing patent legal system, and continues to represent his clients before their national patent offices. European patent law has not intervened with the legal status of the national profession, nor with representation before the national offices; the national and European legal status of the patent attorney are independent from each other. In practice however, European patent attorneys are usually

also registered at the national level, having obtained the national qualification before the European one.

With the development of the European patent system, training in European patent law and the European Qualifying Examination, which is the prerequisite for enrollment as a European patent attorney, have been receiving more and more attention and are beginning to serve as a model in Europe. This development is supported by the fact that the material criteria for the patentability of an invention are the same for national and European patents.

The patent attorney has access to valuable information, such as the extensive case law of the Boards of Appeal of the EPO, whose important decisions are published in the three official languages, as well as published case law reports and a growing amount of literature on European patent law - all this information also has an effect at the national level.

This situation goes hand in hand with the fact that training as a national patent attorney increasingly includes European patent law in the syllabus. The patent attorney's training and examination in the Contracting States are usually a first important step towards training as a European patent attorney, even though, as already mentioned, registration as a national patent attorney is not a prerequisite for enrollment as a European patent attorney.

c. In order to practise as a professional representative before the EPO, the European patent attorney must be entered on the list of professional representatives before the EPO. The representative must be a national of one of the EPC Contracting States, have his place of business or employment within the territory of one of the Contracting States and have passed the European Qualifying Examination (EQE).

Candidates for the EQE must possess a university-level scientific or technical qualification and have at least 3 years' experience in the patent or another appropriate field. There are certain exceptions to these basic requirements, for instance concerning the registration of nationals of non-Contracting States. Legal practitioners qualified in one of the Contracting States can also act as representatives before the EPO in that they are entitled to appear before the national patent offices.

For the first few years of the EPO's existance, transitional rules were implemented whereby persons in the Contracting States authorised as representatives before their national patent offices were entered on the list of professional representative before the EPO. This so-called "Grandfather-Clause" also applies to new acceeding Contracting States, for a period of 1 year from the date of accession, in order that a European patent profession be created within the country concerned.

Excluding the exceptions already mentioned, the European patent attorney, as outlined by the EPC, is therefore a professional with a university-level scientific or technical qualification, whose professional training includes at least 3 years' work experience and whose professional qualification is established by passing the European Qualifying Examination.

I would now like to say a few words about the European patent attorney's training and the European Qualifying Examination.

2. Training as a European patent attorney

a. The minimum 3 years' working experience in the patent field required for a European patent attorney to sit the qualifying examination can be obtained as an assitant to a professional representative either in the free profession or in industry. The training is full-time and should cover all the activities involved in the handling of European patent applications and European patents. The content of the training is defined by the entire field of activities of a professional representative before the EPO. The trainee patent attorney thereby gains professional experience which will provide him with the knowledge necessary for his future occupation. The person supervising the training ensures that the trainee is fully integrated in the daily practice of the profession, such that the training takes on the form of an "apprenticeship".

This is of course a description of the ideal situation for training. There are a number of reasons why, in practice, this ideal is not always possible, without the person supervising the training being to blame. The training experience can be limited, for example, in small companies or in Contracting States in which European patent practice is limited. Furthermore, not all trainees can be given the opportunity of taking part in all the activities of the professional representative before the EPO. It is therefore necessary to provide the future patent attorney with further training opportunities, in addition to the day-to-day practical work experience.

b. It is of course most important that the candidate's training be closely supervised by a professional representative. In patent agent's offices or companies where there are larger numbers of professional representatives, groups of trainees can be offered more intensive training by means of regular meetings with their supervisors, for the systematic discussion of issues arising from their daily work experience. These so-called "in-house" training courses have become well established. They are supplemented by

external training opportunities, which exist at both a national and international level.

The European Patent Office and the Institute of Professional Representatives before the EPO are both involved in the organisation of several training courses, which aim to accompany the practical training period and provide specialised knowledge of European patent law and practice. Since 1991, for example, a limited number of candidates have been able take part in the EPO training programme for patent attorneys, spending up to 4 weeks full-time at the EPO under the supervision of a training officer, thus gaining an insight into the work of the European Patent Office.

Training opportunities that exist since the establishment of the EPO are the training courses in European patent law run jointly by the CEIPI and EPI, with the active co-operation, comprising personal, practical and financial support, of the EPO. This training scheme is designed to accompany the professional practice and prepare the candidates for the European Qualifying Examination. The EPO and CEIPI have signed a contract for co-operation in the field of training activities, thereby establishing the "Euro-CEIPI" training programme. Furthermore, the director of the International Section of the CEIPI, Dr. Stauder, who already delivered a speech this morning and who is responsible for the European training programmes, is also an employee of the EPO. This long-term co-operation has lead to the CEIPI becoming established at the European level as an institution for training in European patent law.

Another training institution established at the European level is Queen Mary and Westfield College in London, which also co-operates with the EPO and CEIPI to offer further training opportunities.

In addition, various courses available in the Contracting States also provide some training focussed on the preparation for the European Qualifying Examination.

c. A substantial part of the future European patent attorney's training consists in preparation for the European Qualifying Examination. The EQE papers test the candidate's capabilites and knowledge relevant to the European patent grant procedure, law and practice. The candidate must demonstrate a thorough knowledge of European patent law, of the Paris Convention in so far as it concerns European patent law as laid down by the EPC, and of the Patent Co-operation Treaty, as well as knowledge of all the decisions of the Enlarged Boards of Appeal of the EPO and of the landmark decisions of the Boards of Appeal of the EPO.

Furthermore, the candidate is required to have a general knowledge of national law, of the laws of the Contracting States in so far as these concern European patent law, as well as of US and Japanese patent law, to the extent that they are of importance to the proceedings before the EPO. The candidate is now even required to show knowledge of the Agreement relating to Community Patents, which is expected to come into force in the not too distant future.

The EQE consists of four written examination papers.
The first 3 papers consist of questions dealing with the European patent grant procedure and for which technical expertise is required.

In the first paper (Paper A), the candidate has to draft the independent claim or claims and the introduction of a European patent application, based on information which would normally be at the disposal of the patent attorney. This entails finding the best formulation to ensure the broadest possible and nonetheless acceptable patent protection in the interest of the client.

In the second paper (Paper B), the candidate is expected to draft a reply to an official letter provided in the form of a communication from the Examining Division concerning the prior art.
These two papers (A and B) can be answered either in the field of Chemistry or Electricity/Mechanics.

In the so-called "Opposition paper" (Paper C), presented in the form of a letter from the client, the candidate is required to draw up a notice of opposition to a European patent.

These three examination papers represent the typical work of a European patent attorney and place the candidate in the different situations with which he will be confronted in the European patent application and grant procedure.

The fourth paper (Paper D) consists of a number of legal questions. The candidate has to answer a client's enquiry in form of a legal opinion, for which specialised and comprehensive proficiency in legal matters is required. An object of this paper is inter alia to test the candidate's knowledge of the case law of the Boards of Appeal.

Besides technical and legal expertise, the EQE in principle also requires the linguistic ability to answer the questions in one of the three official languages, though a non-official language can also be used. In paper C, the candidate's understanding of the other official languages is tested.

In practice the examination papers fullfil two important aims. Firstly, they set the standard according to which the training for future European patent attorneys should be performed.

Secondly, owing to the fact that their content so closely reflects the practical work of a patent attorney, the EQE papers have themselves become an important instrument of training, with which the candidates can judge their own capabilities. The papers' success as an instrument of training is certainly due to the fact that the EPO is now making them available to the public, together with examples of answers written by candidates and the corresponding examiners' reports, in a compendium published annually.

At this point, I would like to mention that as from this year, EPO examiners with at least 4 years' working experience at the EPO are entitled to sit the European Qualifying Examination. Those who then wish to enter the profession of European patent attorney on leaving the EPO, must undergo at least another 2 years of relevant working experience outside the EPO.

At the end of last year and in order to support young trainee patent attorneys, the EPI created a list of so-called "EPI-students", who will regularly receive information on training material as well as the Institute's official quarterly publication "epi-information". The list is also distributed among the students, in order to give them the opportunity of getting in contact with one another during their training - the aim being to encourage them to organise study groups among themselves, which would benefit their training and preparation for the EQE.

The profession is nowadays attracting a growing number of candidates for the European Qualifying Examination.
In 1995 there were 820 candidates enrolled for the EQE, representing a 25% increase on the previous year. The high standard of the examination is shown by the fact that not all candidates pass the exam at their first attempt. Those who fail, however, have the opportunity of re-sitting the papers they failed. On average, the pass-rate of successful candidates has established itself at around 37%.

3. The profession of European patent attorney

a. The profession of European patent attorney is brought under one umbrella organisation in the Institute of Professional Representatives before the EPO (known as the EPI), without any distinction being made between those practising in the free profession and those employed in industry. The European patent profession is a uniform profession. The European patent attorney automatically becomes a member when his name is entered on the list of professional representatives before the EPO. At present, about 5.500 patent attorneys are registered on the list of the EPO.

The Institute of Professional Representatives before the EPO was founded by the Administrative Council of the EPO in 1977, according to provisions laid down in the EPC. The Institute has an influence on the shaping of the profession, particularly through its co-operation with the EPO in matters concerning the European Qualifying Examination, as well as in disciplinary measures, as one of the EPI's duties is to promote compliance by its members with the Rules of Professional Conduct, inter alia through the formulation of recommendations. Furthermore the EPI plays an important role in the development of the industrial property system in Europe.

b. The rules of professional conduct for the European patent attorney are based on fundamental principles. The general professional obligations state that a professional representative must "exercise his profession conscientiously and in a manner appropriate to its dignity" and "conduct himself in such a manner as not to prejudice the necessary confidence in his profession". A further important duty is the observation of professional secrecy. Finally he must avoid conflicts of interest; in the case of refusal or withdrawal of his professional services, he must inform the client immediately.

These rules are supplemented by The Code of Professional Conduct, which is laid down in the form of recommendations. These provide the model of the reliable and independent adviser, who serves the interests of his clients while at the same time maintaining good fellowship and fair competition among his colleagues. Advertising measures are to a large extent forbidden by the Code, in order to avoid commercialised competition among professional representatives.

c. The European patent attorney's profession is basically that of a highly-specialised consultant in his special field: acting as adviser to the inventor, formulating the patent specification and in particular the wording of the claims, drafting the patent application, participating in the grant procedure, continuing to act as counsellor to the inventor, ensuring the maintenance of the patent, its defence against infringement as well as preparing and settling licence contracts / agreements - all these activities, and many more, are typical aspects of the patent attorney's work. Dealing with foreign patent applications and patents are also a frequent part of his activities. A particular challenge is the fact that he can represent inventors and companies from a large number of Contracting States, which offer a broad variety of cultures and languages. The profession of European patent attorney thereby particularly distinguishes itself by the nature of its European diversity.