

VEREENIGDE NEWS

International newsletter of VEREENIGDE

Dear Reader,

A lot has happened since our first issue of VEREENIGDE News, not only in relation to our firm but also to relevant IP-law. In this issue you can read about some of the latest developments.

In the interim, Frans Dietz has retired and I have the honour of succeeding him as the new Chairman of VEREENIGDE. It is a wonderful challenge to contribute to the further growth and success of VEREENIGDE. We are continuously seeking opportunities to optimise our services to our clients in response to an ever changing environment.

We are very proud that VEREENIGDE is opening an office in Munich soon. In this new office we will handle European patent applications for a complete range of technologies. We recognise that having an office in both The Hague and Munich is beneficial for clients who are represented before the European Patent Office by our firm. In fact, the examination of European patent applications, opposition procedures against European patents and appeal procedures all generally take place either in Munich or in The Hague, so we will always be close to the people involved at the European Patent Office.

There are some relevant upcoming changes in law and regulations regarding European and Dutch patent applications. EPC2000 will enter into force on 13 December 2007. Furthermore, we expect that the London Agreement which relates to the translation requirements for granted European patents will enter into force early 2008. Moreover, in early 2008 the Dutch Patent Act will change with respect to the language requirements for filing Dutch patent applications. In this issue, we will provide information about these changes. You can also read about how to take advantage of them. Last but not least, this newsletter contains an interesting overview of developments in Benelux trademark opposition proceedings.

If after reading this issue you have any questions, please do not hesitate to contact us. We will be pleased to provide you with further information.

Cees Jansen, Chairman



Cees Jansen

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London Protocol: reduction of translation costs of European patents in major EPC states

By Leo Jessen

France has recently ratified the London Protocol. As a result, the protocol will finally come into force soon, probably in the spring of 2008.

European patents have to be translated into the national languages of the member states of the European Patent Convention (EPC) to become valid in these countries. This is a relatively costly procedure, especially when the patent has to be validated in a large number of member states. This translation requirement is based upon Article 65 EPC.

In 2000 a number of member states of the EPC signed a Protocol to Article 65, which was designed to reduce the translation requirements for European patents in a number of EPC states¹. These EPC states include some of the more patent-minded countries in Europe, such as the United Kingdom, Germany, France and the Netherlands. The President of France, Mr. Sarkozy, has recently signed a law in France, ratifying the London Protocol. This means that the protocol will finally come into force, probably in the spring of 2008.

For the countries that have ratified the London Protocol, two different translation regimes will come into existence:

- In the countries having one of the three official languages (English, German or French) as a national language, a granted European patent

can be validated directly, without a translation.

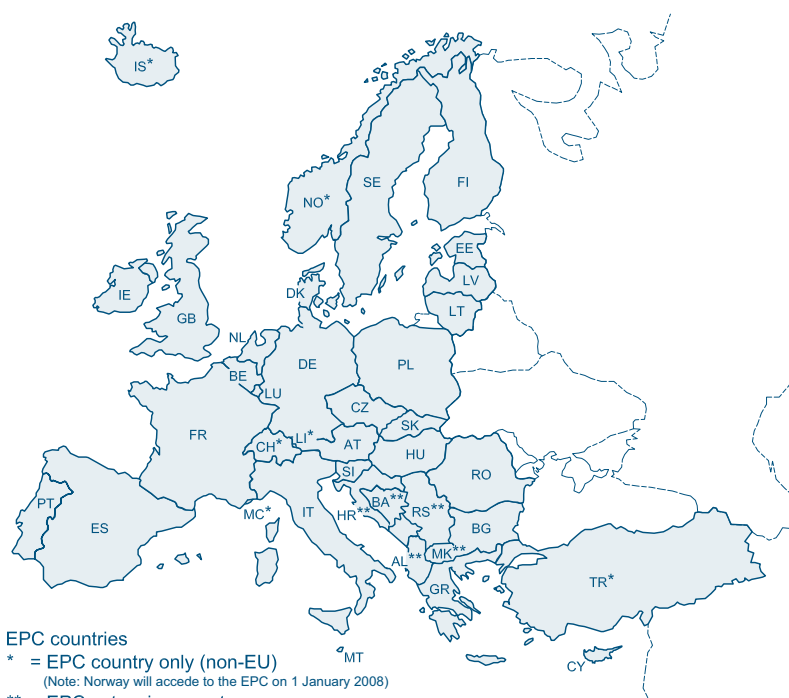
- In the countries that have another language as a national language, such as the Netherlands, one of English, German and French shall be chosen, in which the patent may be validated. So far, all the countries concerned have chosen English.

For the latter group of states, a patent granted in German or French will still require a full translation.

In the London Protocol, countries have the option of requiring a translation of the claims into a national language of that country. So far most of the countries have made use of this provision.

When the European patent application is therefore filed in English, it can be validated after grant directly in all of the states party to the London Protocol, with only the claims having to be translated into the respective national languages. For countries having French or German as a national language, these English claims will already be available in the granted patent. Therefore, this can reduce the translation costs considerably.

VEREENIGDE can arrange for validation of European patents in all of the member states of the EPC. When the London Protocol comes into force, for the states party to the London Protocol only an English text and translations of the claims into the national languages will be required, which will make the process of validation in these countries even easier and more cost effective.



¹ UK, Germany, France, the Netherlands, Switzerland, Lichtenstein, Sweden, Denmark, Monaco, Luxemburg^A, Iceland^B, Latvia^B and Slovenia^B (^A=not yet ratified; ^Bby accession)

The Benelux trademark opposition procedure

By Michiel Haegens

In 2004, a trademark opposition procedure was introduced in the Benelux. Now, 3.5 years later, a large number of opposition proceedings are pending and a number of opposition decisions have been issued. Therefore, it is time to provide you with an overview of developments in the Benelux opposition proceedings and discuss the decisions

Prior to 2004, parties could only enforce their rights against a Benelux trademark application by means of a Court case. As such cases were time-consuming and expensive, this tool was only used if all other means were exhausted and could therefore hardly serve as a pressure tool. With the introduction of the Benelux opposition procedure in January 2004, oppositions could be lodged against applications including classes 2, 20 or 27 only. In the following two years, the classes against which an opposition could be directed were gradually expanded and since 1 January 2006, an opposition can be directed against any Benelux application or against the Benelux part of any International Registration (hereafter: IR).

According to the information provided by the Benelux Office for Intellectual Property (hereafter: BOIP), over 2,000 oppositions have been filed since the introduction of the procedure in 2004. Currently, almost 1,000 oppositions are pending. So far (by 15 November 2007), 17 decisions have been issued. Taking into account these figures, over 98% of the oppositions filed were withdrawn or cancelled prior to a decision.

The Benelux opposition procedure bears the following characteristics:

1. The opposition needs to be filed within two months after the first day

of the month following the publication of the application. The opposition needs to be filed on the first (working) day of said month at the latest.

2. The opposition can be based on either a prior trademark application/registration or on a well-known mark (Article 6bis Paris Convention). It therefore cannot be based on other rights, for example trade name rights or copyrights. One of the Benelux oppositions was even rejected as the opponent based his case exclusively on copyright infringement.

3. The opponent has only one opportunity to file arguments and may be given an extra round to file proof of use. In this extra round, any additional arguments and information brought forward not explaining the evidence will not be taken into account.

4. The Benelux area deals with two official languages: Dutch and French. In principle, the language in which the application was filed will be the language of the opposition proceedings. If the opposition is directed against the Benelux part of an IR, the applicant can choose which language he prefers. Nevertheless, parties can mutually change the language of the proceedings or request that arguments be filed in English as well. The decision will however be in either Dutch or French.

5. An appeal can be filed against the decision of BOIP with one of the High Courts in either The Hague, Brussels

or Luxembourg.

6. The cost decision is directly enforceable.

A study of the 17 decisions lodged so far reveals a number of interesting results.

A. It must be said that the decisions of BOIP are characterized by their clear and quite elaborate grounds. BOIP always refers to current European and Benelux case law in general and applies it to the case at hand. Over the last two years, BOIP has further streamlined the format of its decisions.

B. In 6 out of 17 decisions, BOIP decided in favour of the opponent. In 2 cases the opposition was partially accepted, and in 9 cases the opposition was rejected.

C. Only two oppositions were based and judged on other prior rights than trademark rights. The one regarding copyrights (mentioned above) was rejected and Campina's opposition based on the notoriety of its mark was a set-up (see frame next page). However, this decision gives a good view of how the evidence filed was judged and can serve as an excellent starting point if you wish to base an opposition on the notoriety of your client's mark.

D. Only in two cases was the language of the proceedings French. In 15 decisions, the language of the proceedings was Dutch, which means that the large majority of the applications against which an opposition was filed were filed in Dutch. Only in one case did parties agree to exchange arguments in English.

E. 15 Oppositions were directed against a Benelux application and only 2 oppositions against the Benelux part of an IR. This may, among other things, be explained by the fact that the opponent in the majority of such cases may choose to initiate a central attack (by taking action against the basic registration) rather than filing oppositions in each of the designated countries.

The basis of the opposition differs (EU, IR and/or Benelux trademarks were invoked) with the emphasis on prior Benelux marks. Regarding invoking a prior Community trademark (CTM) which is subject to the use requirement, BOIP may come up with an interesting view, as will be explained later on.

F. Although in 8 cases (one of) the mark(s) on which the opposition was based was subject to the use requirement, proof of use was requested in only 5 cases. It is interesting to note that in most cases in which the evidence was requested and judged, the prior mark was found valid for only a limited list of goods and services and as a consequence BOIP decided that the goods and services were dissimilar and rejected the opposition.

G. In each case in which the opposition was either accepted or rejected as a whole, a cost award was appointed in the amount of € 1000.

Benelux opposition procedures

Trademarks involved	Opposition Rejected or Accepted	Benelux application or International Registration	Opposition based on	Language
1. ETEX ./ ETEC device	Accepted	Benelux	Benelux	Dutch
2. FIRST ./ device	Rejected	International	Benelux	French
3. CAMPINA device ./ Campina device	Accepted	Benelux	Notoriety	Dutch
4. device ./ HELIOS device	Rejected	Benelux	Benelux	Dutch
5. RALTEC ./ RALTEC	Rejected	Benelux	Benelux	Dutch
6. AIRE ./ AIRA device	Accepted	Benelux	Benelux	French
7. SYNERGIA device ./ Synergy device	Rejected	Benelux	Benelux	Dutch
8. NOFLIK device ./ NOFLIK	Rejected	Benelux	Benelux	Dutch
9. NAVTEQ a.o. ./ NAVTURK	Rejected	Benelux	CTM	Dutch
10. LOTTO a.o. ./ LOTTE	Accepted	Benelux	International	Dutch
11. B & Q ./ B & Co device	Accepted	Benelux	CTM	Dutch
12. VIVIUM ZORGGROEP ./ VIVA! ZORGGROEP device	Rejected	Benelux	Benelux	Dutch
13. DANTHERM HMS device ./ KAN-THERM	Accepted	International	CTM	Dutch
14. MORE ./ COFFEE & MORE device	Rejected	Benelux	Benelux	Dutch
15. MORE ./ COFFEE & MORE device	Rejected	Benelux	Benelux	Dutch
16. TRIFLEX ./ TRIDEX	Acc./Rej.	Benelux	CTM	Dutch
17. ROCK & REPUBLIC ./ REBEL & REPUBLIC	Acc./Rej.	Benelux	CTM	Dutch

H. So far, none of the decisions have been appealed.

Although, of course, an opposition is often filed on the assumption that an agreement may be reached during the statutory cooling-off period, the above analysis of the decisions so far shows that if the adversarial part of the opposition proceedings is entered into without sufficient research, the proceedings may often lead to a negative outcome.

Of course, the applications or registrations on which the oppositions are based must be reviewed thoroughly and the possible other relevant (prior) rights of the applicant should be clear. Furthermore, if the prior mark on which the opposition is based is

subject to the use requirement, the opponent should have a clear view of its capacity to prove genuine use of the mark in the Benelux.

In this respect, interesting case law can arise. According to Article 2.26 sub 2a Benelux Treaty on Intellectual Property, a trademark can be declared invalid if, after the date of registration, it is (without a valid reason) not used in a normal manner for five consecutive years *in the Benelux*. Clearly, while drafting this Article the legislative commission did not bear in mind that the plaintiff may rely on a CTM registration as well. As a result, the current text of the law valid in the Benelux is contrary to the text in the European Regulation. The Benelux Office has drafted a request for review of this text and is aware of the fact that if an opposition is filed based on a CTM registration which is subject to the use requirement and which is used, but not in the Benelux, it has to decide whether to follow ruling Benelux law or European legislation.

Considering the characteristics of the procedure and our experience so far, some strategic notes can be made on how to approach the proceedings from the view of the applicant and opponent.

Prior to or simultaneously with the opposition proceedings, the applicant may be contacted and requested to voluntarily withdraw the application or limit its list of goods and services. During the opposition proceedings,

Campina logo well known

Dutch dairy producer Campina needed an official notification that its mark was judged to be well known for a foreign procedure. To obtain such a decision, Campina filed a Benelux application for its device and also filed, via a related company, an opposition solely based on the notoriety of the same device. Campina filed many different documents in support of its claims. Not surprisingly, the other side filed no counter arguments with respect to the contents. The Benelux Office



for Intellectual Property judged each document filed and came to the conclusion that the evidence filed proved the notoriety of the mark in Benelux.

This decision is very useful as the Office set forth its evaluation criteria and applied these to the evidence filed. Therefore, it can serve as a good example if an opposition is filed on the basis of the notoriety of a mark.

Changes under EPC2000

the opponent has to file arguments first, after which the applicant may request proof of use (if the mark relied on is subject to the use requirement) and/or file counter arguments.

Consequently, if the opponent's mark is subject to the use requirement, it would be wise for the applicant to only request such proof of use first and file counter arguments after the proof of use has been filed. Then, the opponent cannot react to arguments filed on behalf of the applicant in response to the filing of the evidence.

Furthermore, the applicant may not wish to react to a cease and desist letter from the opponent, but to await the actual opposition proceedings if the applicant already knows that a demarcation will be difficult to reach. When taking the decision not to correspond with the opponent, the applicant does not give away any of its arguments to which the opponent could react. In such cases, the opponent is unaware of any of the applicant's possible arguments and can only guess possible counter arguments and make some preliminary notes thereto.

Conclusion

Considering the number of oppositions filed and our experience therein, the Benelux opposition procedure has become an important tool. Not only does it clear the air in a long-lasting conflict with a competitor, but it can also be used to put serious pressure on the other side. This is supported by the figures which show that nearly all oppositions are cancelled or withdrawn without a decision having to be rendered.

Trademark owners should be warned not to enter opposition proceedings too light-heartedly, as past decisions show that such an approach is often reprimanded by the Benelux Office. However, if a clear overview of the rights of both parties and the possible arguments of the other side prior to the opposition proceedings are obtained, the opposition can be filed with confidence and will – statistically – result in a positive solution at very reasonable costs.

As mentioned in our newsletter of June 2006, EPC2000 will enter into force on 13 December 2007. EPC2000 applies to all European patent applications and patents filed after this date. Transitional provisions determine to what extent EPC2000 applies to applications pending or patents granted before this date.

Under EPC2000, filing procedures will change considerably for the benefit of the applicant. Bart van Wezenbeek will focus on this topic in his article and highlight some interesting consequences. For completeness' sake, the most important other changes to EPC2000 can be summarized as follows.

1 Substantive patent law remains largely unchanged. The main amendments are in Article 54(3), concerning the novelty-destroying effect of prior European patent applications, and Article 54(5), expressly providing for use-limited product protection for a second or further medical use of a known substance.

2 New in EPC2000 is that a request for limitation or revocation may be filed at any time throughout the term of the European patent.

3 Decisions of the boards of appeal can be contested by filing a petition for review if certain fundamental procedural defects occurred in the appeal proceedings or a criminal act may have had an impact on the decision. The purpose of a petition for review is not to obtain a review of the application of substantive law.

4 The revised Article 121 EPC2000 (further processing) extends the

application of further processing and makes it the standard remedy for missed time limits in the European patent grant procedure. Further processing will be available for all missed time limits in the grant procedure, with the exception of those excluded under Article 121(4) EPC2000 (see also the list of exclusions in Rule 135(2) EPC2000). As in the past, Article 121 EPC does not apply to the time limits to be observed by the parties in opposition and opposition appeal proceedings. Also further processing is available for partial loss of rights or where the missed time limit is one which is fixed by the Convention.

5 Re-establishment of rights (Article 122) is now also possible under EPC2000 in respect of the priority period. The request must be filed within two months of the expiry of the priority period. Re-establishment of rights is not possible in respect of any period for which further processing under Article 121 EPC2000 is available. However, re-establishment of rights is possible in respect of the time limit for requesting further processing.

EPC2000 New filing procedures

By Bart van Wezenbeek

The changes in the European Patent Convention, generally known under the name EPC2000, will enter into force on 13 December 2007. Many of these changes relate to the modernising and streamlining of the law, but the most important changes are caused by the adaptation to TRIPs and to the Patent Law Treaty (PLT)¹. This article focuses on the new procedures for filing a patent application, which now comply with the requirements of PLT.

Art. 5 PLT requires that a filing date shall be accorded to an application on the basis of three simple elements. These elements are specified in new Rule 40(1) EPC as:

- a) an indication that a European patent is sought;
- b) information identifying the applicant or allowing the applicant to be contacted; and
- c) a description or reference to a previously filed application.

This also means that European patent applications can be filed in any language (Art. 14(2) EPC). Of course, a translation in an official language (i.e. English, French or German) should be filed afterwards (within two months, Rule 6(2) EPC). The originally filed text, however, remains the authentic text, meaning that translation errors can be repaired.

There is no definition of 'language' given in the EPC and it is thus assumed that any language would in fact be possible. However, the European Patent Office (EPO) acknowledges that it cannot accommodate all languages and urges applicants who file an

application in a language the EPO is not familiar with, to file a translation as soon as possible. If the applicant does not file a translation of his own motion, then the EPO will issue an invitation to do so.

An applicant who has his place of residence outside the contracting states of the EPC may file an application, but is obliged to appoint a professional representative (Art. 133(2) EPC) for further communication with the Office. Thus, foreign applicants may, for the purposes of obtaining a filing date, file an application with the EPO, but should then appoint a professional representative, also for the act of filing



If the EPO is not able to contact the applicant, it cannot do anything but wait until the applicant contacts the EPO.



the translation. In practice this would mean that such an applicant would not get an invitation to file a translation, but an invitation to appoint a professional representative.

It will be more problematic if not only the description, but also the indication

that a patent is sought and/or the information identifying the applicant are filed in a language the EPO is unfamiliar with. Although the EPO has indicated that it will be diligent in deciphering incoming information in non-EPO languages, in some cases it is conceivable that the EPO will not be able to ascertain whether the requirements of Rule 40 EPC are being fulfilled. If the EPO is able to contact the sender of the information (e.g. because they have the fax number from which the information was sent), it will send a request for more information on what has been filed. If the EPO is not able to contact the applicant, it cannot do anything but wait until the applicant contacts the EPO.

Further, it follows from Rule 40(1) that it is no longer necessary to file claims with the application to establish a filing date. If no claims are filed, the EPO will invite the applicant to file claims with a time limit of two months (Rule 58 EPC). It should be emphasized that late filing of claims has two disadvantages: first, late-filed claims can only be filed in the language of the proceedings (English, French or German) and second, late-filed claims should not contain any added matter (Art. 123(2) EPC). It is to be expected that European Examiners will be very critical with respect to this

latter requirement, since compliance with Art. 123(2) is regarded as very important in European case law. Rule 40 now also enables filing by reference. Again, to obtain a filing date, the requirements of Rule 40(1) (a) and (b) should be fulfilled, and

¹ The European Patent Organisation is a contracting party to the PLT since 2001

Dutch Patent Act amended - written opinion for € 100

By Johannes van Melle

to complete the filing by reference the filing date and number of that application and the office with which it was filed should be stated. Also a statement should be made to the effect that the referenced application will replace the description and any drawings (Rule 40(2) EPC). If the claims of the referenced application are also to be included, this should be indicated at filing. If this is not indicated, the claims will be deemed not to have been filed and can only be filed later, running the risk of non-compliance with Art. 123(2) EPC.

Filing by reference is limited to one single reference. It will therefore not be possible to combine two earlier applications, or, for that matter, to combine a paper description with an application filed by reference. Only filing of a single application by reference together with a paper version of the claims is permitted.

Filing by reference can be useful if the applicant has no time or no opportunity to file a paper description and drawings (and if the application to be filed should be identical to the referenced earlier application). Another example where filing by reference can be used is the filing of divisional applications.

Thus, under the new EPC, filing possibilities are extended. However, some of the new possibilities entail disadvantages or even risks. Continuation of your filing strategy as developed under the 'old' EPC is therefore recommended.

On 3 July 2007, the Dutch parliament (House of Representatives) approved changes to the Netherlands Patent Act ("Rijksoctrooiwet 1995"). It is expected that the new patent act will enter into force by the beginning of 2008.

The Netherlands Patent Act came into force on 1 April 1995 and provides the legal basis for obtaining a patent in the Netherlands.

Foreign applicants usually obtain a Dutch patent through national registration via the European Patent Convention. Alternatively or additionally, however, they can apply directly in the Netherlands to acquire a Dutch registered patent.

It can be concluded from the issuing procedure for a registered patent that the Dutch Patent Office does not play an active, judging and testing role, in contrast to the proceedings of the old Act before 1995. Eighteen months after the filing date or the priority date, the application is registered in the patent register and in effect a Dutch patent is granted. At that moment, the application is laid open for public inspection. Although no substantive examination takes place during the granting procedure and no opposition exists, advice on the validity of a patent can be obtained from the Dutch Patent Office. However, ultimately, the only way to test the validity of the patent is in court proceedings.

We will now explain how the recent amendments offer interesting opportunities for foreign applicants to obtain an early test on the validity of their application.

The changes have to be approved by the Dutch Senate, which is expected to take place within the next few months. The new patent act will probably enter

into force by the beginning of next year.

According to the explanatory memorandum accompanying the amendment act, the amendments to the Dutch Patent Act were primarily prompted by a desire of the Ministry of Economic Affairs to improve the legal certainty regarding registered patents and to increase the accessibility of the Dutch patent system for individual inventors and for small and medium enterprises (SMEs) by reducing costs. It is generally assumed that this will promote the innovative climate in the Netherlands.

Accordingly, several changes will be made in the new patent act, the most relevant of which are:

1. Under the new patent act, it will be possible to file Dutch patent applications in the English language. Only the claims must be translated into Dutch. This change in the patent act is independent of the London Protocol for European patents, which takes away the necessity to provide a translation for issued European patents.
2. The Dutch Patent Office wants to provide low-cost search reports. It is rumoured that the patent office is going to provide high-quality searches for € 100. These searches will include a "written opinion", similar to current European Patent Office practice.
3. The "annuities clock" for Dutch patents will start ticking one year earlier

Continued from page 7

than it does now. At present, the first annuity is due five years after the filing date. This will be decreased to four years from the filing date, resulting in a three year tax-free period after filing.

4. Abolishment of the “small patent”. The small patent, with a duration of only six years, is currently granted without a novelty search to keep costs low. The original goal of the small patent was to stimulate SMEs to file patent applications.

The latter two changes will now be briefly commented on, before aspects of the first two changes are discussed. According to the memorandum, the shortening of the tax-free period (item 3) was meant to bring the legislation on annuities more in line with other European states – only Switzerland, Italy and Great Britain have longer tax-free periods.

The abolishment of the six-year patent (item 4) is generally seen as an improvement of the legal certainty. Indeed, a registration has a presumption of validity, which also applies to the unsearched, six-year patent. The general consensus is that such a patent has not been favourable for fair marketplace conditions. It is now believed that the legal uncertainty arising from this unsearched patent does not balance with the possible positive effect for SMEs. The abolishment of the six-year patent will at least result in Dutch registration patents (with a maximum duration of 20 years) that have a search report – providing better initial indications on the validity and value of the patent.

VEREENIGDE opens office in Munich

Early 2008, VEREENIGDE will open an office in the very center of Munich, Germany (Bayerstraße 25, 80335). With our presence in both The Hague and Munich, the cities where the two main offices of EPO are located, we will be in an excellent position to handle our clients’ IP matters optimally.

With respect to the first two changes indicated above, item 2 addresses the matter of a written opinion by the Patent Office as to the patentability of an application, which, together with the search report, will further improve the validity estimation of the registration patents for the general public. This search report can be requested up to thirteen months after the priority date. One opportunity to amend the application is given after the receipt of the search report.

Written opinion strongly subsidised

This written opinion will be strongly subsidised by the Dutch government in its desire to promote innovative spirit among SMEs. It appears that a ‘national search type’ will be available for only € 100, whereas the current rate is € 340. A ‘national search type’ is principally intended for applicants desiring only a Dutch national patent, in contrast to the ‘international search’ which is intended for applicants wishing to present this search before the EPO or the WIPO, which will accept the search and accordingly reimburse its fees. The international search type fees are in line with the international search fees and amount to € 794 at present.

It will be interesting to see how this facility for Dutch search opinions will be received. The memorandum gives some figures on the application numbers for 2005. It appears that of the 2,373 issued Dutch patents in 2005, only 20% were foreign applicants. The facility is therefore meant for Dutch SMEs, 30% of which are estimated, according to the memorandum, to provide an English text intended for international use. It may well be that the current legislation changes will demonstrate that this is a severe underestimation and that the Dutch patent marketplace will experience a surge of foreign applicants.

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