

What's next in the Unitary Patent Package?

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Cover:

Bruges

This picture painted by
Raluca Vasilescu
(European Patent Attorney, RO)
is part of the
epi Artists Exhibition 2021



Raluca Vasilescu

Raluca Vasilescu is a European Patent Attorney and works in Bucharest, Romania. One of her passions is painting using watercolour technique. The sources of her inspiration are various. When travelling, she adores to take photos of old buildings for later use as subject matter for her paintings. Raluca wishes to convey a message of peace and hope for the **epi** colleagues, **epi** staff, as well as their families, friends.

Raluca Vasilescu ist eine zugelassene Vertreterin vor dem Europäischen Patentamt und praktiziert in Bukarest, Rumänien. Eine ihrer Leidenschaften ist das Malen in Aquarelltechnik. Die Quellen ihrer Inspiration sind vielfältig. Auf Reisen fotografiert sie gerne alte Gebäude, um sie später als Motive für ihre Gemälde zu verwenden. Raluca möchte den **epi** Kollegen, **epi** Mitarbeitern sowie deren Familien und Freunden eine Botschaft des Friedens und der Hoffnung übermitteln.

Raluca Vasilescu est mandataire en brevets européens et travaille à Bucarest, Roumanie. L'une de ses passions est la peinture à l'aquarelle. Ses sources d'inspiration sont variées. Lorsqu'elle voyage, elle adore prendre des photos de vieux bâtiments qu'elle utilise ensuite comme sujet pour ses peintures. Raluca souhaite transmettre un message de paix et d'espoir à ses collègues de l'**epi**, au personnel de l'**epi**, ainsi qu'à leurs familles et leurs amis.

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Editorial*

M. Névant (FR), Editorial Committee



Marc Névant

Sometimes, saying nothing is better than a long speech.



* As always, if it is necessary to recall it, the editorial reflects my personal opinion

epi expresses solidarity with Ukraine

As a pan-European organisation with more than 13,000 members exercising their profession in 38 countries, **epi**'s thoughts are with all those dramatically impacted by the ongoing use of force against Ukraine.

We, **epi**, stand in solidarity with all those, particularly civilians, suffering from the outbreak of violence in Ukraine and with all refugees seeking safety in other countries. We support the resolution adopted by the UN General Assembly on 2nd March, calling for immediate cessation of the use of force against Ukraine and renunciation of any unlawful threat or use of force against any State.

As user representatives, we support the announcement of the European Patent Office "Standing Together for Peace in Europe" and its immediate reaction to the situation in Ukraine.

Introduction

Why is everybody talking about diversity and inclusion?

J. Barrett (GB) and M. Névant (FR)

Why talk about diversity & inclusivity (D&I)?

It is now well established¹ that diversity and individual uniqueness in its people bring creativity and vitality to an organisation, enriching its business practices and making it more successful.

It is likely that, by capturing and drawing on diverse points of view, we can improve the advice and services that we can offer to clients and prospective clients. Our clients and prospective clients are, after all, focused on innovation, which itself requires novel perspectives that are more likely to arise from divergent thinking or differing experiences and perspectives. And lost opportunities or faulty products can arise without diversity.

For example², those no-touch antiseptic gel dispensers that we've all got so used to using during the covid-19 pandemic often don't work for people of colour, as a dark-skinned hand may not be light enough to register on the sensor used. These dispensers obviously weren't tested on a variety of skin tones, which it would have been if the development team had included people who do have darker skin. Similar deficiencies may be found in clinical trials protocols for testing new drugs and vaccines, for example.

But it's not just about inventors and potential patent applicants. Diversity in our own organisations could also enable **epi** members to relate more effectively to the variety of other stakeholders in our world of patent work, also including patent office personnel, associates at home and abroad, other service providers, and the wider community in which we operate.

What do people really mean when they talk about D&I?

Diversity in the workplace involves the co-working of people with differing characteristics, skills and personality traits. For example, a diverse team may comprise people from various cultural, academic and professional backgrounds; a team is also more diverse when there's a balance in traits such as gender, age and race.

More broadly, when we talk about 'diversity', we refer to any aspect or characteristic that makes one person stand out or potentially be regarded as 'different' from another – particularly those differences that are not necessarily relevant to being able to do the job at hand, or to fulfil the expectations of the organisation or team concerned. We have already noted one example where 'differences can make a difference': ethnic origin or at least skin tone in the case of the gel dispenser. And there are obviously far more characteristics of people that could be involved, such as (alphabetically):

age or generation; appearance; (social) class; colour; creed, belief or religion; culture, (mental or physical) disability; economic background; ethnicity or national origin; gender (including reassigned gender); marital, civil partnership, pregnancy or parental status; occupational or work role or status; political affiliation; race; and sexuality or sexual orientation or identity.

To ensure a diverse range of people within our teams, we need to be able to recruit from a broad range of candidates. And it's not just about getting a variety of people into our organisations: it's also about retaining people that contribute to this diversity for as long as the arrangement works for both parties. It is unlikely that someone who feels that they don't belong or that they are often excluded (from the most interesting work, decision-making processes, promotions, benefits, or other positive aspects of our work lives) will stay in or continue to add benefit to our organisation or business. This sense of inclusivity is therefore vital to maintaining and benefitting from diversity.

¹ There is a plethora of research supporting this statement, for example McKinsey & Co.'s 19 May 2020 report, *Diversity Wins: How Inclusion Matters*, available at <https://www.mckinsey.com/featured-insights/diversity-and-inclusion/diversity-wins-how-inclusion-matters#> (accessed 13Nov2021)

² Tom Haile, *This Viral Video Of A Racist Soap Dispenser Reveals A Much Bigger Problem In Tech*, 18Aug2017, available at: <https://www.iflscience.com/technology/this-racist-soap-dispenser-reveals-why-diversity-in-tech-is-muchneeded> (accessed 26Jan2022)

In general, in order to achieve and maintain diversity within our organisation – our private practice IP firm or in-house department, say – inclusiveness must be fostered; this doesn't happen automatically. To build an inclusive workplace, we need to provide those opportunities equally to all potential and existing employees. And we need to revisit and improve our procedures regularly to ensure that they're respectful to all people, regardless of individual characteristics that make up the team's diversity. Indeed, we all need to be informed and have our awareness raised, so that we can recognise and mitigate against circumstances, language and behaviours that may seem acceptable to some but are alienating to others.

Furthermore, increased inclusivity can itself lead to greater diversity. There is plenty of evidence³ to show that job candidates who represent a variety of characteristics are more attracted to work in environments where there is already a recognisable level of and accommodation for diversity. As we are now in a candidate-driven job market, where older people are retiring and younger people expect to remain only a few years with one employer, we need to increase our chances of recruiting and retaining the talent we need both for running our business or in-house department and for providing services to our internal or external clients.

A virtuous circle can therefore develop, with diversity and inclusion each supporting and even promoting the other.

How do we know that D&I really matter in business – especially in our profession?

The bottom line is that the overall performance of each of our organisations is linked to diversity⁴. By 'performance' is meant one or more of the typical business indicators, such as profitability, market share, employee turnover, etc. It seems that there is an optimal blend of talent characteristics that can improve or maximise the performance of each of our firms, departments, practices or companies.

In other contexts, it is self-evident that diversification is good for driving performance⁵. For example, if you are invested in the stock market and you are reliant on returns to help fund your retirement, then it is generally accepted that it is not a good idea to invest 99% of your resources in a single stock, simply because that one stock may have

historically performed very well. Likewise, it is not a great idea for a football team to be composed entirely of forwards, only because they score more goals than team members in other positions. By the same token, it is not sensible to people our teams, firms or companies with a homogeneous selection of individuals, even if this strategy consistently produced good results in the past.

Of course, in reality, the highly successful stock/fund, football and business managers are mainly focused on optimising the blend of people talent available to them to maximise their performance, rather than on diversity *per se*. Diversity may or may not be beneficial in and of itself – your answer to this will depend upon your subjective viewpoint – but it is undoubtedly beneficial (as shown by relatively objective performance data⁶) to provide an alternative blend of talent – of 'people diversity' – that leads to a superior performance.

Differences between those in our organisations, even if these initially lead to conflict, can produce constructive results and better advice for our clients. Cognitive diversity has been shown⁷ to be especially useful for problem-solving and innovation; and diverse juries who, like Patent Attorneys, need quickly to absorb and retain a variety of facts and case details, have been shown⁸ to recall more of these details and with greater accuracy, with consideration of a wider range of perspectives, than did homogeneous juries. These collective traits appear to be ideal for bettering our responses to examination reports, preparing for hearings, and communicating with our innovative clients.

When and where can we discuss D&I matters further?

epi Council recently tasked a working group to explore D&I matters, and consider what guidance, help and support – if any – should be available for **epi** members to navigate them. We, the authors, are both members of this group, and would appreciate your feedback, including comments on this article and the issues raised, together with any thoughts or experiences you may share on the topic in general.

We would be especially interested to hear your suggestions for any *materials* the group could provide or *actions* (such as training or education) we could take to support **epi** members in this area and help all members to meet the needs of our clients.

³ Glassdoor (amongst others) publishes regular statistics. For example, 2/3 candidates reported that diversity is important in evaluating job offers; and over 50% employees believe their company should do more to improve diversity, cited by Christine del Castillo in *Diversity in the workplace: the case for building a diverse team*, available at <https://resources.workable.com/stories-and-insights/diverse-team#> (accessed 25Jan2022)

⁴ See footnote 1

⁵ Examples adapted from Paolo Gaudiano and Ellen Hunt, *How To Convince Executives To Embrace Diversity*, 07Nov2016, available at <https://www.forbes.com/sites/gaudianohunt/2016/11/07/how-to-convince-executives-to-embrace-diversity/?sh=770ee3de7650> (accessed 25Jan2022)

⁶ See footnote 1, *ibid*.

⁷ Scott E. Page, *The Difference: How the Power of Diversity Creates Better Groups, Firms, Schools, and Societies*, 2007, available at https://www.researchgate.net/publication/24117966_The_Difference_How_the_Power_of_Diversity_Creates_Better_Groups_Firms_Schools_and_Societies (accessed 25Jan2022)

⁸ amuel R Sommers, in conversation with Anne Sasso, *Group Diversity: Mock Juries Reveal Surprising Effects of Diversity on Groups*, 05May2006, available at <https://www.science.org/content/article/group-diversity-mock-juries-reveal-surprising-effects-diversity-groups> (accessed 25Jan2022)



Patent practice

What's next in the Unitary Patent Package?

Dr. M. Thesen (DE), European Patent Attorney, Strehl Schübel-Hopf & Partner mbB

Triggered by the deposition of Austria's instrument of ratification of the Protocol to the Agreement on a Unified Patent Court on provisional application (PPA), the final preparations for the Unified Patent Court (UPC) and the Unitary Patent (UP) have been set in motion. This article seeks to summarize the timeline and relevant issues for epi members.

Introduction

The UP and the UPC are the building blocks of the Unitary Patent package which will supplement and strengthen the existing centralised European patent-granting system, which has been in the making since at least 1975¹. Unitary Patents will make it possible to obtain uniform patent protection in up to 25 EU Member States by submitting a single request to the EPO and the UPC will be an international court with central juris-

diction for infringement and revocation actions concerning patents granted by the EPO. Proponents hope that the UPC will make the Europe-wide enforcement of patents easier, offer greater legal certainty and reduce litigation costs.

This article seeks to summarize the next steps from the perspective of **epi**-members and other professional representatives to enable a smooth transition to the new era.

The Timelines

The entering into force of the PPA on January 18, 2022 is the birthday of the UPC as an international organisation with rights and duties, including the right to hire judges and staff, hold meetings of the administrative committee. The preparatory phase will last at least eight months², i.e. until September 2022 or later and will end

¹ https://de.wikipedia.org/wiki/%C3%9Cbereinkommen_%C3%BCber_das_europ%C3%A4ische_Patent_f%C3%BCr_den_Gemeinsamen_Markt

² <https://www.unified-patent-court.org/news/austria-closes-loop-protocol-provisional-application-upc-agreement-has-entered-force>

with the deposition of the ratification instrument of Germany and be followed by a sunrise period of three to four months within which applicants/patentees may opt their European patent application or patents out of the jurisdiction of the UPC and may file early requests for unitary effect³ if the patent is about to be granted. The UPC agreement will then fully enter into force on the first day of the fourth month after the deposition of the ratification, i.e. on January 1, 2023 at the earliest.

The Preparatory Phase

The Unified Patent Court Administrative Committee and the UPC budget committee have already held their respective inaugural meetings^{4,5}, adopted their rules of procedure and elected their respective chairmen. An Advisory committee will start interviewing candidate judges for the at the end of March 2022. Further, some operational rules as well as the infrastructure and the budget of the Court need to be developed⁶ and the EPO Select Committee in charge of the implementation of the Unitary Patent will complete its work, including the finalization of a communication programme for users and the EPO member states⁷. Meanwhile, the member states will start setting up their respective local or regional divisions.

We, as **epi** members, may start counselling our clients and preparing our workflows for the things to come.

Opt-out or stay in?

The first decision to make for national parts of granted EP patents is whether to opt out of the jurisdiction of the UPC. The well-tested routines of national courts and proceedings and the deterring effect of the prospect of multiple separate national invalidations speak in favour of opting out. This is to be balanced with the advantages for enforcement, in particular for cross-border or multi-national infringement proceedings and in UPC member states with courts insufficiently experienced in patent litigation proceedings. Further strategic considerations in this context have been discussed in a multitude of contributions available in the literature.

In any case, the decision for or against opting out should be a well-informed and deliberate decision by the proprietor rather than an unintended result of changing statutes. Professional representatives might want to

avoid being blamed for lack of counselling if a future case before the UPC has an unpleasant outcome for their client.

Some members of the community seem to fear that a non-entitled strawman opts out on the proprietor's behalf, maybe with the aim of delaying the procedure by the inevitably legal conundrum ensuing. Considering the substantial claim to damages faced by the strawman, this seems to be an unlikely scenario. However, the UPC proposes setting up a Google Alert for this purpose⁸.

Irrespective of the client's decision, care should be taken that the application to opt out can be validly filed only by or on behalf of the true proprietor, which may be different from the registered proprietor. Representatives might want to use the occasion for updating their data and documentation in this regard.

From a practical point of view, the application for opt out will be free of charges⁹ and needs to be filed via the UPC case management system, which is already running in the test phase¹⁰. Representatives might want to familiarize themselves with the system prior to the start of the sunrise period when the application for opt out can likely be filed.

Unitary Effect or Not?

On the Start Date of the UPC agreement, the associated EU Regulations (Regulations (EU) No. 1257/2012¹¹ and No. 1260/2012¹²) will apply, likewise. Moreover, the EPO Rules relating to the Unitary Patent Protection¹³ will enter into force on the same day.



Dr. Michael Thesen

While the request for unitary effect can be made only for patents for which the decision to grant has been published after the entry of force of the above EU regulations, the EPO has announced two options that will formally open the possibility for applicants to either delay the grant of a patent application so as to be able designate a UP or to make an early request for an EP(UP). These options are only available throughout

3 <https://www.epo.org/law-practice/legal-texts/official-journal/2022/01/a6.html>

4 <https://www.unified-patent-court.org/news/announcement-unified-patent-court-administrative-committees-inaugural-meeting>

5 <https://www.unified-patent-court.org/news/upc-budget-committee-holds-inaugural-meeting>

6 <https://data.consilium.europa.eu/doc/document/ST-7265-2013-INIT/en/pdf>

7 <https://www.epo.org/news-events/news/2022/20220208.html>

8 <https://www.unified-patent-court.org/faq/opt-out>

9 https://www.unified-patent-court.org/sites/default/files/agreed_and_final_r370_subject_to_legal_scrubbing_to_secretariat.pdf

10 <https://cms.unified-patent-court.org/login>

11 <https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0001:0008:EN:PDF>

12 <https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0089:0092:EN:PDF>

13 [https://documents.epo.org/projects/babylon/eponet.nsf/0/5637E71CD0B17502C12587B100641772/\\$FILE/SC_12_21_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/5637E71CD0B17502C12587B100641772/$FILE/SC_12_21_en.pdf)

the sunrise period and only where the EPO has despatched its Rule 71(3) communication¹⁴. In practice, experienced representatives will undoubtedly find supplementary, informal ways to further delay the issuance of a Rule 71(3) communication or a decision if the applicant strongly wishes to obtain a Unitary Patent even now.

A conclusive review of the arguments speaking in favour or against filing a request for unitary effect is beyond the scope of this article. These arguments obviously include a cost calculus, which may have changed after Brexit since UK was among the “Top 4” countries which had been used as the basis for setting the annuities. Beyond the question of costs, it should be noted that the UP offers more than the sum of a bundle of national patents for cross-border or multinational infringement

¹⁴ <https://www.epo.org/law-practice/unitary/unitary-patent/transitional-arrangements-for-early-uptake.html>

matters because a series of actions in different states, none of which would amount to a direct or indirect infringement of an individual national patent (e.g., due to the lack of double domestic nexus), may well infringe the Unitary Patent.

Once the instrument of ratification has been deposited by Germany, it will be possible to request a delay in issuing the decision to grant a European patent after despatch of a communication under Rule 71(3) EPC by the Office and before approving the text intended for grant and/or to file early requests for unitary effect already before the start of the Unitary Patent system, the latter request using a new form UP 7000 which will be made available via Online Filing¹⁵. Professional representatives should prepare themselves and their clients by adapting their letters and databases.

¹⁵ <https://www.epo.org/law-practice/unitary/unitary-patent/transitional-arrangements-for-early-uptake.html>

Conclusions

The prospect of the UPC and the UP finally becoming reality after their long and winding history fills the author of this note with pleasant anticipation. All the preparations appear to be on track and on schedule such that, barring surprises, the UPC agreement and the associated EU

Regulations will enter into effect in early 2023. This development strengthens the European Patent and is beneficial for both the associated industry and their clients. Thorough preparation and counselling will surely lead to a smooth transition.

Intermediate generalisations A review

G. Murnane (GB), European Patent Attorney, Murgitroyd & Company

Part of the skill set required by a patent attorney is the ability to generalise. Most patent claims are in themselves generalisations from one or more particular examples. When a patent attorney is instructed to draft a new patent application, he or she will often have been provided with one or more embodiments of an invention. There will have been an explanation of the advantages that the invention offers, and the problems it solves, but it is very rare that the inventor will have had an opportunity to develop every possible way of carrying out the invention. It is left to the patent attorney, not only to describe the particular embodiments that the

inventor has devised, but also to generalise the invention in the language of the claims, taking into account the prior art known at the time, so that the patent application gives the applicant a fair scope of protection which is not just limited to one or two specific embodiments.

However, after filing of the patent application and during prosecution of the application at the European Patent Office, generalisation becomes more problematic. When faced with new prior art objections, the attorney may seek to amend the patent claims, looking for amendments to the claims which balance the need to provide a useful

scope of protection for the applicant with the requirement to distinguish the claimed invention over the cited prior art. It is when using the description as a source for claim amendments that the risk is greatest of coming up against the dreaded term “intermediate generalisation”.

It may feel as if intermediate generalisations have been with us forever. However they are a relatively new phenomenon. The first mention of the term in a Board of Appeal decision was in 1992, in T 0551/90, and the expression was used only by the appellants making an added subject matter objection against an amended claim in opposition proceedings. The Board stated: *“The Appellants ... argue in effect that the relevant features incorporated into the claim are an arbitrary selection among those possible so that an unallowable intermediate generalisation has been made. In particular, they say that the claimed disposition of the conduits has only been disclosed in combination with an impeller which has an axial extent twice that normally used ...”* The Board was satisfied that there was no strict requirement for the impeller to be of any particular axial extent, and allowed the amendment.

In T 0415/91 of 13 May 1992 the Board themselves introduced the term to describe an amendment in which there was an omission from Claim 1 of the original limitation to three-phase AC: *“The expression ‘three-phase’ appears about 200 times in the application as originally filed and no other number of phases is mentioned at all. There is no suggestion that the described number of phases, three, is by way of example. The opening sentence of the description states: ‘The invention herein relates to a high DC voltage power supply adapted for incorporation within a motor vehicle electrical circuit of the low DC voltage type.’ This statement is too general to permit the deduction of an intermediate generalisation in respect of the number of phases.”* What is interesting here is that the Board did not state that intermediate generalisations should not be permitted, but simply argued that one particular sentence was not sufficient to permit the particular intermediate generalisation.

There was one more decision from 1992 referring to an “intermediate generalisation” in T 0118/91 of 28 July 1992, and again the term was introduced by the unsuccessful appellant.

Three such decisions followed in 1994, and one in 1995, and then silence until 1999, when there were a handful of decisions referring to intermediate generalisations in that year and the following years.

The first edition of “Case Law of the Boards of Appeal of the European Patent Office” which referred to “intermediate generalisations” was the 2006 edition. The term “intermediate generalisation” appeared in a discussion of T 962/98 in a section headed **“Tests for the assessing**

allowability of an amendment”: *The board did not rule out the possibility that there might be situations where some characteristics taken from a working example could be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalisation. However, under Art. 123(2) EPC, such an intermediate generalisation was admissible only if the skilled person could recognise without any doubt from the application as filed that those characteristics were not closely related to the other characteristics of the working example and applied directly and unambiguously to the more general context. In other words, in order to be acceptable, this intermediate generalisation had to be the result of unambiguous information that a skilled person would draw from a review of the example and the content of the application as filed.”*

In the 2010 edition of “Case Law of the Boards of Appeal of the European Patent Office” there was a complete section entitled **“Intermediate generalisation – non-disclosed combinations”**. This marks the appearance of the term “intermediate generalisation” in the mainstream of patent examination terminology. According to the text of the 2020 edition, the decision T 1067/97 confirms that *“According to established jurisprudence of the boards of appeal, if a claim is to be restricted to a preferred embodiment, it is normally not admissible under Article 123(2) EPC to extract isolated features from a set of features which have originally been disclosed in combination for that embodiment. Such kind of amendment would only be justified in the absence of any clearly recognisable functional or structural relationship among said features”*. However this decision does not itself use the term “intermediate generalisation”.

The term “intermediate generalisation” did not appear in the “Guidelines for Examination in the European Patent Office” until the 2012 edition, when the Guidelines were extensively rewritten and a section entitled **“Intermediate generalisations”** appeared at point 3.2.1 of Part H, Chapter V **“Allowability of amendments – examples”**. The section referred to five examples, based on five Board of Appeal decisions - T 300/06, T 461/05, T 1164/04, T 200/04 and T 166/04.

The example of T 461/05 disappeared in the 2017 version of the Guidelines, but the other four examples are still there in the 2022 version. T 461/05 described an allowable intermediate generalisation in which an original independent claim 1 was limited by adding only some features of a specific embodiment disclosed in the application as originally filed. According to the example in the Guidelines: *“This was defined by the Board using the term “intermediate generalisation” or “intermediate restriction”. The Board held that omitting features of an embodiment would introduce new information if these features are necessary for carrying out this embodiment.*

In the present case, the omitted features were considered to have their own recognisable function independent from the functioning of the rest of the system. Since they were neither presented as essential in the original application nor recognised as essential by the skilled person to carry out the invention, the Board considered that the requirements of Art. 123(2) were met."

The four remaining examples in the Guidelines can be summarised as follows:

Example 1 (T 300/06) – a specific embodiment could be read in conjunction with a broader statement elsewhere in the description, so the intermediate generalisation was allowed.

"The amended claim relates to a heddle for the harness of a loom. The original claim was limited by introducing features that were disclosed only in connection with a specific embodiment in which the eyelet of the heddle had the shape of a spindle. This shape was not included in the amended claim. In the general part of the description it was also mentioned that the eyelet could also have other shapes such as an elliptic shape. Therefore the board concluded that the amendment was allowable under Art. 123(2)."

Example 2 (T1164/04) – a feature derived from a specific embodiment was only disclosed in conjunction with other, unclaimed features, so the amendment was not allowed.

"Claim 1 relates to a water dispersible and flushable absorbent article. Amended claim 1 specifies that each of the first and second fibrous assemblies is a wet laid tissue. The application as filed referred, in connection with the

first fibrous assembly, to a wet laid tissue in combination with other features (tissue is apertured; tissue is provided with fibrils or sufficient inherent porosity). Since the first fibrous assembly is disclosed in the application as filed as being a wet laid tissue only in combination with other features which are not present in claim 1, the amendments made constitute a generalisation of the



Graham Murnane

originally disclosed technical information and thereby introduce subject-matter extending beyond the content of the application as filed."

Example 3 (T 200/04) – a new independent method claim was introduced in opposition proceedings, while the original application only had composition claims; the amended claim was considered to be a generalisation of the example methods and not allowed.

"Original claim 1 relates to a coating composition comprising at least one rosin compound, at least one polymer and an antifoulant. After amendment a new claim was introduced relating to a method for preparing a coating composition comprising the mixing of at least one rosin compound, at least one polymer and an antifoulant. The only basis for the method is the examples. The board observed that for some solutions the amount of added rosin was extremely low whereas for others it was extremely high. The subject-matter of the amended claim was considered to be an unallowable generalisation of the examples, since nothing in the description indicated to the person skilled in the art that the observed variations were not essential to make a coating composition."

Example 4 (T 166/04) – a feature of an overall disclosure described as being essential was omitted from an amendment, so the amended claim was not allowed.

"Original claim 1 relates to a multi-processing system comprising a shared memory, a directory and a serialisation point. The serialisation point is defined in functional terms. Claim 1 was amended by adding features that were addressed in the description as part of the cache coherence strategy. The board held that the incorporated features, albeit disclosed as such, had been isolated in an arbitrary manner from the overall disclosure of the cache coherent memory access architecture. At least one feature had been omitted although its function was presented as being essential to achieving cache coherence. Therefore amended claim 1 was not directly and unambiguously derivable from the original application (T 166/04)."

After the removal of the allowable amendment referred to in T 461/05, there remains only one example of an allowed amendment in the Guidelines, along with three examples of amendments which were not allowed. This suggests that arguing for the allowability of an amendment may be difficult. However, when looking closer at the examples, one should not be deterred from arguing for allowability. Example 4 concerns an unusual case in which an amendment omitted a feature whose function had been described as "essential". This is not normally the case in situations where intermediate generalisations are under discussion. Example 3 concerns an even more unusual case in which a new category of claim (a method for preparing a coating composition) was introduced in opposition proceedings, when the original application and granted patent had only included product claims (a coating composition). There are very few cases where method claims are introduced in opposition when the application and granted patent had no method claims.

The example of an unallowable intermediate generalisation that appears to have most relevance is Example 2, which refers to T 1164/04. This case concerned a water dispersible and flushable absorbent article com-

prising a liquid pervious topsheet comprising a first fibrous assembly, a liquid impervious backsheet comprising a second fibrous assembly and disposed beneath the topsheet, and an absorbent core disposed between the topsheet and the backsheet. The patentee filed an amended claim 1 as part of a first auxiliary request, which differed from claim 1 as granted in that it defined that each of the first and second fibrous assemblies is a wet laid tissue.

Claim 1 as filed included two optional features:

“said first fibrous assembly more preferably also comprising an apertured wet laid tissue”; and

“said second fibrous assembly preferably comprising a wet laid tissue”.

The Board held that the second feature provided a basis for the fibrous assembly of the backsheet being a wet laid tissue, but the first feature did not support the fibrous assembly of the topsheet being a wet laid tissue without further defining the wet laid tissue as “apertured”.

The application as filed described that the topsheet “*may be manufactured from a wide range of materials such as air laid, wet laid, or carded nonwoven materials*”. However the Board referred to this as a “general reference” which could not be regarded as a specific disclosure of wet laid tissues.

The Board stated: *“Although the application as filed discloses that the second fibrous assembly may be a wet laid tissue (see in particular original claim 1), there is no clear and unambiguous disclosure of the first fibrous assembly being, generally, a wet laid tissue. Indeed, the application as filed consistently refers, in connection with the first fibrous assembly, to a wet laid tissue in combination with the feature that the tissue is apertured (see original claim 1), or with the feature that the tissue is provided with fibrils (see original claim 14) or sufficient inherent porosity (see page 21, lines 1 to 25).”*

In fact there was an illustrated embodiment in Fig. 7 of a top sheet without apertures. The description stated: *“As depicted in Figure 7, the fibrous assembly 52 does not include discrete apertures such as apertures 50 depicted in Figures 5 and 6. However, in order to maintain fluid transmission capabilities sufficient to enable their use in absorbent articles, such webs include sufficient inherent porosity.”* The fibrous assembly 52 had been described earlier, with reference to Figs. 5 and 6, as a wet laid tissue. Hence the skilled person reading the description would understand that apertures are not essential in the wet laid tissue of the top sheet, as long as the web has sufficient inherent porosity. The actual

porosity required is not described in the application, and the skilled person would understand that this is a subjective property of the web; in other words the web must be sufficiently porous to provide comfort to the wearer. In fact elsewhere in claim 1 it is recited that the top sheet is liquid pervious.

Hence if the skilled person reads the complete disclosure carefully, he would understand that the first fibrous assembly of the topsheet may be “wet laid” from the general statement in the description that the topsheet “*may be manufactured from a wide range of materials such as air laid, wet laid, or carded nonwoven materials*”, and that it may be a “wet laid tissue” without apertures from Fig. 7 and the associated description, as long as it “sufficiently porous”. In any case claim 1 recites that the top sheet is liquid pervious.

This seems to be a fair basis for claiming a topsheet comprising a first fibrous assembly which is a wet laid tissue. The important test is whether the skilled person is presented by the amendment with information which is not directly and unambiguously derivable from the originally filed application. It is difficult to see how the idea of the fibrous assembly of the topsheet being a wet laid tissue, without defining whether the tissue is apertured or not, could be considered as new information, when the application as originally filed disclosed a topsheet of wet laid tissue with and without apertures.

Study of the “intermediate generalisation” examples in the Guidelines leads to the conclusion that we should not take the fact that an amendment can be characterised as an “intermediate generalisation” as simply meaning that the amendment is not allowable under Art. 123(2) EPC. The “intermediate generalisation” tests that have been developed in the case law of the Boards of Appeal are not simple yes/no tests. Instead we should look at what the application as a whole teaches the skilled person.

While in an ideal world every possible claim amendment would be derivable directly from a claim forming part of an exhaustive and complete set of dependent claims, covering every alternative thought of by the inventor and the drafter of the patent specification, such an ideal world does not exist. In practice the constraints of claim fees mean that the applicant will continue to have to look to the description for distinguishing features when faced with prior art of which they were not aware at the time of filing.

As a final thought, it would be helpful to redress the balance in the “intermediate generalisation” examples in the Guidelines as well, so that there are equal numbers of allowable and non-allowable amendments in the examples.

The UPC is already partially into force

A. Casalonga (FR)

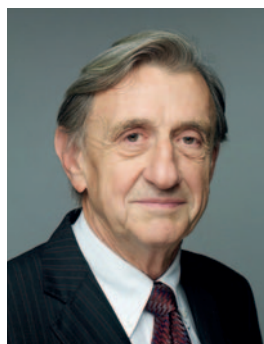
The Protocol on provisional application of the Agreement on the Unified Patent Court (UPC) entered into force on January 19, 2022 following ratification by Austria, the last country expected to do so.

The immediate consequence is the entry into force of a significant part of the UPC Agreement: almost one third of the Agreement and three quarters of the UPC Statute are now applicable.

In order to take account of Brexit, however, it is expected that the Contracting Member States will make clear in a joint declaration that ratification by the United Kingdom was not necessary for the entry into force of the protocol, contrary to what was initially planned.

What is in force:

All that is necessary (besides the establishment of a mediation and arbitration center) to enable legal actions relating to European patents, SPCs and Unitary patents (European patents with unitary effect) to be brought before the new Court on the same day as the Agreement enters completely into force.



Axel Casalonga

This includes establishment of the Administrative, Budgetary and Advisory Committees, definition of the role of the Presidents of the First Instance

and the Court of Appeal, creation of the different divisions of the First Instance and the Registry, appointment of the judges and definitive adoption of the Rules of Procedure.

● The Administrative Committee (Article 12 of the Agreement):

It is composed of one representative per Contracting Member State, with the European Commission having observer status. This committee adopts the Rules of Procedure of the Court; it appoints, by consensus, the members of the Advisory Committee based on proposals made to it by the Contracting Member States and, above all, it appoints the judges. Moreover, it is the Adminis-

trative Committee that creates the local and regional divisions upon request of the Contracting Member States (Article 18 of the Statute).

● The Advisory Committee (Article 14 of the Agreement):

Its members are proposed by each Contracting Member State and appointed by the Administrative Committee. It is composed of patent judges and practitioners specialized in patent law.

Its composition should ensure a broad range of expertise. This is even more important as the Advisory Committee plays a crucial role, not only for the appointment of judges, by assisting the Administrative Committee in this task, but also for the representation of parties by European Patent Attorneys, by giving opinions on the qualification requirements of these Attorneys.

● Appointment of judges:

The Advisory Committee shall draw up a list of the candidates it considers most qualified, which list shall include at least twice as many candidates as there are vacancies to be filled (Article 3 of the Statute). The number of candidates is more than one thousand. However, the number of positions to be filled is about 90. Indeed, the total number of local, regional and central divisions can be estimated at about twenty, with each chamber comprising three judges. As for the Court of Appeal, its two chambers each have five judges. Finally, all fields of technology must be covered by technically qualified judges, which requires a certain number of additional judges.

From the list of candidates drawn up by the Advisory Committee, the Administrative Committee shall appoint the necessary number of judges, whether full-time or part-time, so that at least one chamber can be constituted in each of the local, regional and central divisions of the First Instance and two chambers in the Court of Appeal.

As the composition of the Court should be geographically balanced, some legally qualified judges may be required to undergo training in patent law. This training, which was to be provided by a center in Budapest, will probably be provided by the European Patent Academy in Munich, as Hungary has not ratified the Agreement.

● The Presidents and the "Presidium":

As soon as the judges are appointed, the President of the Court of First Instance and the President of the Court of Appeal will be elected, respectively, by all the full-time judges of the Court of First Instance and by all the judges of the Court of Appeal, considering the fact that the first President of the First Instance must be French, as the central division has its seat in France.

The President of the First Instance shall have an important role and shall direct the judicial activities and the administration of all divisions of the Court of First Instance (Article 14-3 of the Statute). He shall supervise the sub-registries established at the various divisions (Article 25 of the Statute). It will also intervene in the proceedings, at the request of a party, to decide on the language of the proceedings (Article 49(5) of the Agreement) or at the request of a panel, to assign an additional technically qualified judge (Article 33-3 of the Agreement).

A "Presidium" is defined in the Statute (Article 15) and consists of the Presidents of the Court of Appeal and of

the First Instance, two elected judges of the Court of Appeal, three elected full-time judges of the First Instance, and the Registrar.

The Presidium appoints the Registrar (Article 22 of the Statute) and a Deputy-Registrar (Article 25 of the Statute), adopts the framework for the training of judges (Article 11 of the Statute) and may decide on the removal of a judge (Article 10 of the Statute).

The Presidium shall be responsible for the management of the Court and may also propose amendments to the Rules of Procedure (Article 15 of the Statute).

What is not yet in force:

The other provisions of the Agreement are not currently in force.

They mainly concern the primacy of Union law, the sources of law and substantive patent law, the rules of jurisdiction as well as certain general procedural provisions which will complement the Rules of Procedure.

Conclusions

The entry into force of the Protocol on provisional application marks the final implementation of the Unified Patent Court and the Unitary patent.

A three-month sunrise period will be opened before autumn of 2022 to allow for the registration of opt-outs for European patents that their owners would like to see outside the jurisdiction

of the new Unified Court and be dealt with by national courts.

At the end of the current preparation phase, which should last about eight months, the first actions before the Unified Court will be possible and the first Unitary patents will be granted, and this, at the end of 2022 or beginning of 2023.

**We also draw your attention to Mr. Casalonga's article originally published in epi information 02/2018 entitled 'Prepare yourself and be ready for the UPC'. This article contains a detailed discussion about the opt-out procedure which some readers may find helpful in view of the fast approaching sunrise period.*

<https://information.patentepi.org/issue-2-2018/prepare-yourself-and-be-ready-for-the-upc.html>

Où il est question de Expo 2020 Dubaï et de période de grâce

F. Leyder (BE)

One of the **epi** employees recently spent a winter holiday in Dubai, where she visited Expo 2020 Dubai. My thanks to her for providing the photograph accompanying this article.

2020 you would ask? Surely a mistake. Actually not. Like the 2020 Summer Olympic Games, Expo 2020 Dubai was postponed by one year to begin on 1st October 2021.

For European Patent Attorneys, international exhibitions ring a bell: Article 55(1)(b) EPC states that the display of the invention at an official, or officially recognised, international exhibition may constitute a non-prejudicial disclosure. This is one of the many variations of what is generically called a “grace period”.

Under Article 55(1)(b) EPC, a disclosure of the invention by the applicant or their legal predecessor is not taken into consideration if it occurred no earlier than six months preceding the filing of the European patent application and if it was due to, or in consequence, of such display. The Enlarged Board of Appeal clarified in G3/98 that the relevant date is indeed the date of filing of the European patent application, not the priority date.

Article 55(2) EPC states however that this applies only if the applicant states, when filing the European patent application, (i) that the invention has been so displayed and (ii) files a supporting certificate. Rule 25 EPC specifies in particular that the certificate must be issued **at** the exhibition by the responsible authority, and that it must be filed within four months of filing the European patent application (or when later entering the European phase, if a Euro-PCT application).

The mechanism of Article 55(1) EPC is a safety net. It only ensures that the disclosure at the exhibition is excluded from the prior art, nothing more. Thus, in particular, it does not protect from possible independent inventions or inventions derived from the disclosure. This explains why this mechanism has rarely been used in modern times for a display at an international exhibition¹. As displaying in an international exhibition is a voluntary act, there is no doubt that a patent application should be filed beforehand.

How can I find out where and when such an international exhibition takes place? Let's

go to the Dubai Bazaar, the place where you find anything and everything. For us European Patent Attorneys, this would be the Guidelines for Examination at the EPO. The Guidelines are now revised (and improved) every year; they have considerably grown over the last years and have become a very comprehensive and most useful tool. There we learn that the exhibitions recognised are published in the Official Journal (A-IV, 3.1; G-V, 4).



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¹ It seems Article 55(1)(b) has once been used for an invention displayed at Expo 2000 Hannover, but the author has not been able to identify the case from the information shared by the colleague who remembers it.

A search in the Official Journal, using the keywords Dubai and exhibition, limited to international exhibitions, reveals that every year, an article entitled "Synopsis of the territorial field of application of international patent treaties" appeared in issue n°4, which article mentioned since 2014 an international exhibition in Dubai from 20.10.2020 to 10.04.2021. Every year? Almost, except in 2021, when no updated synopsis was published. Corona effect? Bad luck! That is exactly when the new dates would have been published.

As European Patent Attorneys, we like to know what happens when something goes wrong. "An isolated mistake in an otherwise satisfactory system" are the words that spring to mind. Are there however any consequences?

Article 55(1)(b) EPC refers directly to official, or officially recognised, international exhibitions falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972. The non-publication of the synopsis with the new date for Expo 2020 Dubai is thus unlikely to have adverse consequences in the end (sigh of relief), even if some additional argumentation may be required to convince a Division relying on the Guidelines and the Official Journal.

The first World Expo – the Great Exhibition – took place in London in 1851. The 1928 Convention on international exhibitions regulates these exhibitions. The Bureau International des Expositions is the intergovernmental organisation in charge of overseeing and regulating World Expos; today it has 170 Member States. The complete list of exhibitions can be found on its website: <https://www.bie-paris.org>.

Let us hope that the Guidelines will in the future directly refer to the website of the Bureau International des Expositions. I would of course welcome if the EPO would in addition resume the annual publication of the synopsis, and insert a specific reference thereto in the Guidelines. If you visit Expo 2020 Dubai, keep Article 55(1)(b) EPC in mind, but forget the idea that anyone might use it, and enjoy traditional Belgian delicacies at the take away kiosk with fries and waffles². Beware: international exhibitions may not last more than six months: Expo 2020 Dubai will close on 31st March 2022!

² Belgian waffles for foreigners, but Liège waffles in Belgium (gaufres de Liège, Luikse wafels, Lütticher Waffeln) because there exists in Belgium a totally different kind named Brussels waffle.



Case Law

How much priority for entitlement to priority?

C. Rennie-Smith

The latest referral to the Enlarged Board of Appeal was made only (as of the date I write this) one month ago. In a decision issued on 28 January 2022 in consolidated cases T 1513/17 and T 2719/19¹, Board 3304 referred two questions to the Enlarged Board about entitlement to priority under Article 87 EPC. The questions read:

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

¹ The cases were consolidated because they had parties in common and the same issues were raised in both cases, albeit one was an examination appeal and the other an opposition appeal. The referrals are now pending before the Enlarged Board under the numbers G 1/22 and G 2/22. References below to "Point X" are to the reasons of the referring decision.

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

I shall comment here on the key issue raised in the second question (which the referring Board calls the "PCT joint

applicants approach”) and the general issue raised in the first question which to my mind poses unnecessary problems.

The “PCT joint applicants approach”

We are all familiar with the fundamental provision for determining priority entitlement under Article 87(1) EPC – the later European application must be filed by the same person who filed the earlier priority application or, provided evidence of a transfer can be shown, his successor in title. It has also always been the case that additional applicants for the European application are permitted provided the earlier applicant(s) or his/her successor(s) is (or are) also present as applicants. The Guidelines have, for several editions, summarised this thus:

However, in the case of joint applicants filing the later European patent application, it is sufficient if one of the applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application²

This passage includes several uses of the words “joint applicants” which is (or should I say, was?) a good description of a principle which allowed the original applicant or successor to be joined by other applicants in the later application. The important point was that there had to be identity of applicant(s) between the earlier (priority providing) application and the later (priority claiming) European application.

However, as we have recently become aware, some EPO examiners have stretched this principle to cover cases where there is not complete identity between the two sets of applicants in as much as the later (European) application stems from a PCT filing – typically, if not always, claiming a US priority – in which the original applicant(s), who in the USA were usually the inventors, reappear as applicants for the USA only and another party – typically, the inventors’ employer – appears as the applicant for other jurisdictions including the EPO. This fact situation has been allowed in a number of first instance decisions as complying with Article 87 EPC and the Guidelines mentioned above because all the earlier and later applicants appear in the PCT application, though not for the same jurisdictions, and are therefore treated as “joint applicants”. And, rather

confusingly, the expression “joint applicants approach” has recently been used to mean, or to include, this fact situation. Helpfully, the referring board has now suggested calling it the “PCT joint applicants approach”.

My reason for calling this application of the principle outlined above “stretched” is that it allows priority to be claimed in a situation where there is no identity of applicant(s) between the earlier (priority providing) application and the later (priority claiming) European application. The only connection between the earlier and later applicants is that they all appear on the same PCT application but in different capacities. In my view that is not consistent with the wording of Article 87(1) EPC which requires that the same person or his successor in title has filed both the earlier application and the later European application.

It appears that the referring board also had only limited enthusiasm for the “PCT joint applicants approach”. In points 28 to 41 of its referring decision the board describes three possible legal bases for the approach which were raised in oral proceedings before it. The first and second were said to be respectively not convincing³ and without merit⁴.

The first argument⁵ proceeded from Article 11(3) PCT which provides that an international application shall have the effect of a regular national application in each designated state and which has a mirror provision in Article 153(2) EPC. Then one turns to Article 118 EPC which provides that, where the applicants for a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants for the purposes of EPO proceedings. However, the board pointed to the differences between European and PCT applications and observed that the possibility of designating different PCT applicants for different designated States necessarily mean that the status as an applicant is limited⁶ to the designated territories. As I commented above, the only connection between the earlier and later applicants is that they all appear on the same PCT application but in different capacities.

The second argument was that the PCT joint applicants approach can be based on the unitary character of the priority right in the PCT and thus on the operation of the PCT alone. The referring board disliked this because the PCT does not create its own rules regarding the effect of a priority claim but refers to Article 4 of the Paris Convention (which of course is the “ancestor” of Article 87 EPC). Thus, the validity of the PCT joint applicants approach should be assessed in the light of the Paris Convention, in

² “Guidelines for Examination in the European Patent Office”, March 2021 edition, Part A, Chapter III, section 6.1, page III-8.

³ Point 31

⁴ Point 33

⁵ Points 30-31

⁶ Points 32-33

particular the meaning of “successor in title”, rather than the PCT. As I commented above, Article 87(1) (and the Paris convention) require the same person or his successor in title to be applicants for both the earlier application and the European application which is inconsistent with the earlier applicant remaining applicant for the USA and another applicant becoming the applicant for Europe – unless of course he is the successor in title to the earlier applicant.

The third argument⁷ was based on a national decision⁸ in which the Court of Appeal of The Hague had held that the right to priority should be determined in accord with the national law of the country granting or nullifying patents. In the case of a European patent, that law would be the EPC. Since the EPC has no particular formalities for transfer of the right to priority, proof of an agreement to transfer would be enough. While the referring board clearly liked this third argument more than the other two (it seemed “appealing”⁹), it observed that the Boards of Appeal have in several cases assessed the transfer of priority right (in other words, whether or not succession in title has been established) by applying national law¹⁰. If The Hague court approach was to be followed then, because the EPC has no formal requirements, it could be argued that the filing of a PCT application by A and B, in which B is named as applicant for a European patent and A (who was entitled to the priority) as applicant for the USA, demonstrates an implied agreement to transfer the priority right for Europe from A to B¹¹.

While the third argument is certainly more appealing than the other two, there are two major reasons for hoping the Enlarged Board is unpersuaded by it. First, as the referring board says, Boards of Appeal already make priority entitlement decisions using national law. And not just Boards of Appeal, Opposition Divisions must make such decisions and both instances are now experienced in applying the relevant case law. It is without doubt an exclusively legal issue but boards have a legally qualified member and Opposition Divisions can and do add an additional legal member for such issues. If, as I have heard suggested by critics of the EPO, the PCT joint applicants approach has been conceived by first instance management as a simple way of resolving priority entitlement issues relating, for the most part, to Euro-PCT applications claiming priority from US applications, then that is an unfair reflection on the ability of Opposition Divisions to handle legal issues.

7 Points 34-41

8 Gerechtshof Den Haag 30 July 2019, ECLI:NL:GHDHA:2019:1962

9 Point 37

10 And, I would add, also on occasion after first deciding which of two (or more) national laws should apply.

11 The referring board also saw some measure of support for this in two other national decisions (one German, one English) which will be familiar to followers of priority issues - BGH 16 April 2013 case X ZR 49/12 (Fahrzeugscheibe) and KCI Licensing Inc and others v. Smith & Nephew PLC and others [2010] EWHC 1487 (Pat) 23 June 2010

Second, if the PCT joint applicants approach were to be blessed by the Enlarged Board, we might see an unwelcome number of cases in which it is argued that dubious priority entitlement can be resolved by alleged implied agreements. That would not be any easier to deal with than the present “succession in title” cases. The fact is that, while we have no requirements in the EPC for the assessment of entitlement to priority, we have already made good that absence of requirements with a workable approach contained in reliable case law.

The First Question

The attitude of the referring board to the PCT joint applicants approach seems to be negative which suggests that the referral may have been made in order to stifle the approach before it gains more currency. However, the first question which the board has added as a preamble – whether the EPO has jurisdiction to determine a party's claim to be a successor in title – seems distinctly problematic. Three comments.

First, the referring board's reasons for including this question seem less than convincing. Two of the three parties before the board had proposed questions whether the EPO has jurisdiction to examine the entitlement to or validity of a priority claim but in the limited context of Euro-PCT applications. The referring board observes that the jurisdiction issue had already been addressed extensively in T 844/18, that in that case it was held that there is no legal basis to relieve the EPO from the obligation to make the assessment required by Article 87(1) EPC, and that it (the referring board) is inclined to agree with that conclusion¹². It further observed that there had been no explicit question of jurisdiction in its written proceedings and no challenge to T 844/18 other than a reference to J 11/95 which it found unconvincing¹³.

So why did the referring board none the less decide to question what it called the “standing practise of the boards of appeal to decide on the priority rights in general, including the entitlement to the priority right”¹⁴? The answer appears to be because the jurisdiction issue will “in spite of the decision in case T 844/18, most likely be raised again in other cases”¹⁵. With respect to the board, this is as unconvincing as the other arguments they called as much. While they mentioned jurisdiction had been questioned in other cases and commentaries, those cases were decided without the need for referral and only one commentary is actually mentioned. The referring board's conclusion¹⁶ is then

12 Point 24

13 Point 25. In J 11/95 the issue was mentioned obiter and without reasons.

14 Point 24

15 Point 26

16 Ibid

"The board is also receptive to the argument of the parties that, if questions regarding priority are to be referred to the EBA on a related matter, this is a convenient opportunity to have a final decision on the "jurisdiction issue" as well. The board therefore decides to include a question addressing the jurisdiction of the EPO to decide on the entitlement to the priority right."

We should ask since when, and on what authority, has "convenient opportunity" been an appropriate basis for referring questions to the Enlarged Board?

Second, the very description of the jurisdiction issue by the referring board prompts the question whether the first question is admissible or not. If the matter has been extensively examined and decided already in a manner which has not been convincingly challenged in the cases before the board, if earlier cases have been decided without a referral, and if the question is the subject of "standing practice", why does the referring board need the opinion of the Enlarged Board to decide the cases before it? Is there a need to ensure uniform application of the law or a point of law of fundamental importance as required by Article 112(1) EPC? As the referring board itself says (of

the PCT joint applicants approach), it is appropriate to only refer questions that are relevant for the decision in a given case¹⁷. A "convenient opportunity" does not meet that criterion.

Third, let us consider for a moment the possibility that the Enlarged Board should answer the first question in the negative. The second, and clearly relevant and otherwise admissible question about the PCT joint applicants approach, which is prefaced with the words "[i]f question I is answered in the affirmative", might then go undecided or, if decided, at best answered with an opinion which might be considered *obiter*. Fortunately (or should I say hopefully?), the very reasons why the first question need not be referred should lead the Enlarged Board to answer it clearly and emphatically "yes".

Christopher Rennie-Smith was previously a legally qualified member of the Boards of Appeal and Enlarged Board of Appeal and from 2010 to 2014 chairman of Technical Board of Appeal 3304. He is now a consultant. He can be contacted at christopher@renniesmith.eu

¹⁷ Point 27

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|--|--|---|
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Education

epi's educational activities during 2021

B. van Wezenbeek (NL), Chair of the Editorial Subcommittee of PEC

J. Gwilt, Co-Author (UK) Chair PEC

2 021 was a year that was characterized by the continuous presence of Covid-19 regulations. This meant that **epi**, and especially its professional education committee (PEC), had to improvise and adapt to the circumstances. Despite the restrictions, many activities have taken place in order to fulfill the goal of the committee: to provide professional education for **epi** members and to train students to become an **epi** member (i.e. to pass the EQE).

The professional education program started with a series of webinars in January and February entitled "collaboration with overseas patent colleagues". The webinars covered the United States (presented by Tamara Elmore), India (presented by Durgesh Mukharya), South America (presented by Leonor Galvão) and China (presented by Louise Aagaard). The number of attendees ranged from

350 to 650, with the webinars on China and the USA attracting the most attendees. The series was thus considered a great success and in July was extended to include a presentation on South-Korea by Mr. Duck Soon Chang and Mr. Jong-Dug Choi. Extending this series to cover other countries, including the EPO validation states or extension states is being considered for 2022.

In March, Tony Tangena held a series of three webinars on the topic of commercialization and valuation of IP. A further webinar on licensing was given by him in June. Attendance at these webinars was also high (around 350 to 400). Further webinars were delivered in July and November by Timothy Powell on privilege and conflicts of interest and there was a webinar on AI in September by Bastian Best. In advance of the **epi** Council meetings in May and November, so-called pre-webinars were held.

In May David Molnia and Marcus Müller presented on the new RPBoA and in November Edward Oates and Peter Thomsen presented on SPCs.

It was intended to finish the year with an in-person seminar on the new Rules of Procedure of the Boards of Appeal in Paris, but the changing restrictions led to the event becoming a hybrid event. There were 20 in-person attendees, and a further 156 people listening on-line. The presentation was also hybrid: Cees Mulder was physically present in Paris, whilst Marcus Müller was presenting online. The late switch to a hybrid event showed the versatility of both presenters and organizers.

Finally, our popular series ‘Life of a patent’, now presented by Kaisa Suominen and Rut Herbjørnsen, was held as a distance learning course in which 100 people showed interest.

It was also a busy year with respect to helping candidates with their preparation for the first online EQE in 2021. A group of enthusiastic tutors from PEC prepared a mock exam that was sat by many candidates in January. As a follow up, a total of about 40 Q&A sessions were held in February so that the trainees could ask the tutors to explain how to approach the mock papers.

For candidates preparing for the 2022 EQE, online workshops were held in the last three months of 2021. The

paper A workshop was led by Derek Jackson and Jelle Terpsma, paper B by Luis Ferreira and Andrea Pavan, paper C by Margaret Mackett and Konstantinos Vavekis and paper D by Vera Gonçalves and Claude Quintelier. Attendance ranged from 14 to 45 participants.

In addition to these workshops, the PEC also provided about 25 one-to-one tutorials. In each tutorial, candidates prepare an answer to one of the previous exams, the answer is then marked by an **epi** tutor and discussed with the candidates.

In collaboration with the EPO Academy, the yearly tutors’ meeting was held in October. The exam committees presented the exam papers of 2021 so that the tutors could discuss with the exam committees all aspects of the 2021 EQE.

Accordingly, 2021 has been a busy year for the PEC and we want to thank everyone who has contributed to the program detailed above. Together, we have already started to plan an eventful 2022, and we hope to include more in-person events. One of the main issues for 2022 is the potential start of the UP/UPC package and we are in full swing preparing educational activities at different levels on this topic. We are also already looking further ahead to 2023 and beyond, to develop an educational program that is fit to serve the needs of the **epi** members.

M. Mackett (UK) Chair **epi** students and EQE candidates Subcommittee of PEC

Mock December 2021: We updated and finalised the exam papers in all three official languages together with proposed solutions. The EPO hosted the papers in December on the *Wiseflow* system so that EQE candidates could experience exams on the system as they would in March 2022. Candidates who wished to have individual feedback signed up for feedback sessions given by **epi** Tutors and hosted by the **epi** Secretariat. We extend our thanks to the tutors who participated in the feedback sessions.

Online training courses: Our online training courses for Papers A, B, C and D were held from October to January with Paper C finishing on 17 January 2022. While we originally envisaged 15 participants for each of the training courses, we were oversubscribed. For those courses where we could, we added additional courses which ran in parallel. We hope to run these courses again later in the year.

Quo vadis EQE? Reform of EQE – digitalisation or lowering the bar?

G. Leissler-Gerstl (DE), C. D. Schober (DE)

A Summary

- A draft concept for the e:EQE is expected to be issued soon and discussed at **epi** Council meeting in autumn 2022 (C93). We hope that the results of the June 2021 conference¹ and the following considerations will be taken into account in the draft.
- The experiences from EQE 2021 and the respective tutor meeting in October 2021² should not be disregarded as a guideline for the practical set up.
- The digitalisation shall not lower the standard and thus diminish the valuable reputation of the qualified representatives before the European Patent Office (EPO).
- Therefore, the digital form of the examination must be adapted in such a way that the level of examination and the complexity of the examination papers are preserved.
- Any modular approach must take into account the influence on practical training by supervisors in law firms or companies.
- The future of the profession is worth to allow thorough and intensive discussion with the stakeholders but not changing the examination in a hurry.
- The aim should be to subject the candidates to a contemporary examination that does respect the professional representatives' established reputation applying the wise rule: *quidquid agis, prudenter agas et respice finem* (Whatever you do, do it wisely and consider the end).

B What has happened so far?

The format of the European Qualifying Examination (EQE) has changed a lot over the years. In the beginning, one had to pass all four papers in one go; if one failed in one paper, all papers had to be written again. All three languages of the EPO were used, in particular, in papers B and D prior art in all three languages was

cited, no translation was available, no dictionary. It was a closed book exam, only the texts of EPC and PCT were allowed. After some years, a modular approach was introduced, but with predetermined timeline. Nowadays, papers can be written in any order, every pass remains in force, only one language is enough, any book can be used.

The COVID-19 pandemic was a driver for change and encouraged the introduction of a digital examination, which was held online in March 2021 for the first time. It is envisaged that the EQE in 2022 and 2023 will have substantially the same structure.

The implementation of the digital form of EQE is thanks to the e:EQE working group which was established by the EQE Supervisory Board in April 2020. The e:EQE Working Group is composed of three representatives of the EPO's Examination Secretariat and three representatives of **epi**, the latter appointed by the President of **epi**. To support the **epi** members in the e:EQE working group, the President of the **epi** has created a Digitalisation Support Group (DSG) composed of members of the Professional Education Committee (PEC) and experts in the field of EQE and online exams. The main task of the e:EQE working group was not only to set up and run an online EQE in 2021, but also to lay the foundations for the future EQE, the so-called e:EQE.

A Position Paper on the e:EQE was presented at the **epi** Council meeting in November 2020 (C89)³. A Discussion Paper was presented and briefly discussed at the **epi** Council meeting in May 2021 (C90)⁴. On the initiative of the German delegation of Council members, a video conference on modernising the EQE to better test "fitness-to-practise" organised by the PEC took place in June 2021 with more than 100 participants⁵. At the November 2021 **epi** Council meeting (C91), an update was given on EQE 2022 with regard to candidates' use

1 See report on the conference on modernising the EQE to better test "fitness-to-practise" by Julia Gwilt, with Emilie Blanche and Graham Murnane ([https://www.epi-learning.org/pluginfile.php/4857/mod_resource/content/13/eEQE conference report - epi information.pdf](https://www.epi-learning.org/pluginfile.php/4857/mod_resource/content/13/eEQE%20conference%20report%20-%20epi%20information.pdf)). 13 Point 25. In J 11/95 the issue was mentioned obiter and without reasons.

2 See tutors' report on the EQE 2021 papers and the meeting between tutors and EQE committees by N. Cordes, L. Ferreira, A. Valborg Guðmundsdóttir, A. Hards, J. Hoekstra, H. Marsman, and R. van Woudenberg (<https://information.patentepi.org/issue-4-2021/tutors-report-on-the-eqe-2021-papers.html>).

3 See An **epi** update about the progress towards a future e:EQE by J. Gwilt (GB), Chair of the PEC (<https://information.patentepi.org/issue-3-2021/an-epi-update-about-the-progress-towards-a-future-eeq.html>).

4 See e:EQE - Discussion Paper (<https://information.patentepi.org/issue-2-2021/eeqe-discussion-paper.html>).

5 See report on the conference on modernising the EQE to better test "fitness-to-practise" by Julia Gwilt, with Emilie Blanche and Graham Murnane ([https://www.epi-learning.org/pluginfile.php/4857/mod_resource/content/13/eEQE conference report - epi information.pdf](https://www.epi-learning.org/pluginfile.php/4857/mod_resource/content/13/eEQE%20conference%20report%20-%20epi%20information.pdf)).

of the WISEflow platform and the announcement that previous papers would be analysed to identify the criteria to be examined.⁶

A draft concept for the e:EQE by the e:EQE working group is expected to be available soon⁷, and presumably will be presented and discussed at the **epi** Council meeting in Autumn 2022 (C93). We hope that the valuable results of the June 2021 conference and the following considerations will be taken into account in the draft.

C Why is an intensive discussion with the stakeholders indispensable?

It seems that no in-depth and representative survey was conducted after EQ 2021 to identify problems and inconveniences. At least only a rather vacuous survey is available.⁸

Since the reform of the EQE will have many implications for the training and preparation of candidates, for the reputation of the examination and professionals and for day-to-day work, etc., it is highly desirable that any revised version, before being submitted to the Admin Council, to be presented, discussed and voted at the **epi** Council.

It would also be unfortunate if the many comments made at last year's conference and in chats were not taken seriously.

D What needs to be discussed in detail?

Taking into account the results so far, it seems that there are five main aspects that require a thorough and well-prepared discussion:

- (1) What is understood by "fit to practise"?
- (2) Content and duration of the papers
- (3) Place of the exam
- (4) Timing of the modules
- (5) Proportion of multiple-choice tasks/evaluation by artificial intelligence

I. What does "fit to practise" actually mean?

According to Article 1 of the Regulation on the European qualifying examination for professional representatives (REE), the EQE is designed to establish whether a candidate is qualified to practise as a professional

representative before the EPO. Therefore, it seems necessary to discuss what do the public, clients and EPO expect from a professional representative, before discussing if EQE does adequately test the necessary knowledge and skills.

Following success at the EQE, a candidate is entitled to be registered on the list of representatives and, consequently, is allowed to represent clients before the EPO. It is of fundamental importance for our profession that the public can trust that someone who is on the list has the skills, not only to receive applications or instructions and submit or transmit them to the EPO, but also to draft, file and prosecute applications, analyse documents, prepare legal opinions, and handle oppositions and appeals. In particular what can be expected from a representative is that she/he is able to understand and apply the legal framework, in particular EPC and PCT; to understand technically the object of an invention reported to them by an inventor; to abstract the inventive idea; to formulate claims protecting the invention and a description specifying the inventive features; to amend claims in order to distinguish the claimed invention from the prior art; to understand and reflect the content of official communications; to analyse prior art references and to identify relevant documents, e.g. in order to challenge the legal validity of a patent; to evaluate patentability over the prior art; and to provide arguments in examination, opposition and appeal proceedings. This is what the EQE should test. Therefore, not only knowledge about Articles and Rules should be tested, but also skills in solving complex cases. As experience shows, this cannot be achieved by 1.5 to 2.0 hour papers and answering multiple choice questions.

Although increasingly expected by some clients, especially from Asia, the work of a European patent attorney is not to carry the client's instructions to the EPO but a creative one by understanding an invention and also arguments by EPO and/or other parties, needs of an applicant or a third party, and drafting/amending/attacking claims to reflect those needs. This is not just about answering questions or choosing options. The European patent attorney is the one who gives the client the options to choose from.

From the beginning, it was, and is not, the task of the EQE to test the technical knowledge of candidates - because the existence of technical knowledge is certified by the technical grade that a candidate must show before being admitted to enrolment.

Hence, is lowering the bar of the exam an option, at all? What consequences would this have for the profession?

Although lowering the bar could raise the examination pass rate, many disadvantages would arise, such as:

⁶ See report from the 91st Council Meeting held by videoconference on 13th November 2021 by M. Névant (https://patentepi.org/assets/uploads/documents/epi-reports/211113_C91_Report.pdf).

⁷ As of 7 March 2022.

⁸ See eEQE 2021 Context and feedback from participants vis-a-vis digitalisation ([https://www.epi-learning.org/pluginfile.php/4334/mod_resource/content/4/02b_eEQE - Context and feedback from participants.pdf](https://www.epi-learning.org/pluginfile.php/4334/mod_resource/content/4/02b_eEQE_-_Context_and_feedback_from_participants.pdf)).

- Decline of reputation of the profession over time
- Quality of work at risk
- Increase of work for Examiners because of incomplete understanding of objections and lack of adequate reactions.
- Increase of work for Examiners by more need for explanation
- Loss of trust by clients, public and EPO

Thus, it is important that the level of the EQE is not lowered and that the skills described above should continue to be tested in Papers A to D of the EQE. Only the format may change.

II. Content and duration of the papers

Although methodology courses are undoubtedly useful for candidates to learn how to handle papers, searching and finding keywords should not be the goal for passing the EQE. Rather, papers should be designed to test key competencies and, as a lesson from past exams, there should be less predictability and more variability.

1. The key competencies to be tested in Papers A, B, C, D1, and D2

Paper A tests the ability to understand and abstract the subject-matter of an invention from the information received, to formulate claims that cover all new and inventive features of an invention and are distinguished from the prior art. In Paper A, candidates have to draft an application with a set of claims that it is neither too broad nor too narrow.

Paper B tests the ability to understand official communications, analyse cited prior art documents, find distinguishing features, amend claims and present arguments in support of patentability. In Paper B candidates are required to respond to an official communication and amend the claims in response to the objections raised by the examiner and to the prior art cited by the examiner.

Paper C tests the ability to understand the subject-matter of a granted patent, to identify the relevant prior art and to substantiate the challenge to the validity of the patent. In Paper C, candidates must prepare a notice of opposition on the basis of information and documents provided.

Paper D1 tests the legal knowledge about the provisions of EPC and PCT.

Paper D2 tests the application of the legal framework of the EPC and PCT in a specific case and the ability to assess a complex case and give options for further action and advice.

Decades of experience teach that Papers A to D of the EQE comprehensively test the knowledge and skills that can be expected of a European patent attorney.

2. Reduction of time per paper

With the envisaged provision of only 1.5 to 2.0 hours of work, papers will inevitably be less complex and demanding, as only some arguments can realistically be provided. Above all, an opposition under Paper C is thus no longer meaningful to test.

The necessity of paper C has been discussed frequently in the past. The argument for omitting Paper C has been that many candidates have not yet drafted a real notice of opposition at the time of the EQE and that their supervisors may not have experience with a real opposition case either. However, knowledge of the grounds for opposition and how to draft a notice of opposition is very important for anyone drafting applications, as it shows what to look out for in order to amend claims and furnish arguments if an opposition or invalidity action is later filed.

Even with a new format of papers with breaks after 1.5 or 2 hours, it is still possible to draft an opposition paper or legal paper with corresponding complexity, for example by allowing access only to part of opposition reasons or questions in a first part of an exam, and access to further opposition reasons or questions, where the scenario is the same, in a second or further part of the exam.

The problem with reduced time per paper can be solved by conducting a digitised exam in test centres. There can be a change in the type of such centres. Why not use rooms in patent offices, in patent firms and patent departments, with supervisors as invigilators?

III. Place of the exam

A digitised exam, which can consequently be conducted online, certainly allows a move away from the pre-pandemic testing in test centres. Apart from the fact that this seems convenient at first glance, since many candidates do not have to travel to the test centres⁹, the question arises as to whether the idea of conducting the EQE from home is really wise.

Although examination software, such as WISEflow¹⁰ mentioned at the beginning of this article, has recently found its way into everyday university life with increasing frequency in order to automate a multitude of processes from the preparation of examinations to participation and examination viewing, the EQE as a legal professional qualification cannot be compared with simple examinations at universities. The recognised reputation of a

⁹ See Benchmarker's impressions: "No going back to exam centres!" (https://www.epi-learning.org/pluginfile.php/4335/mod_resource/content/5/02c_Benchmarker_002_PP.pdf).

¹⁰ See <https://www.uniwise.co.uk/wiseflow>

European patent attorney already makes it impossible to measure EQE against conventional university standards.

It should therefore be discussed whether the exam should be taken online at a test centre or from home. Pro and cons of an online-at-home exam are summarized in the following table.

Online at home

| Contra | Pro |
|--|-------------------------------|
| Duration and complexity of the papers forcibly reduced. | No travel stress |
| Only 1.5 to 2.0 hours per paper too short for a demanding examination | No costs for travel and hotel |
| Online monitoring stressful for candidates, as only a small movement is possible to avoid leaving the monitored field. | Using own computer |
| Online monitoring exhausting for invigilators, as a large number of candidates have to be observed on monitors at the same time. | |
| Stress for candidates, as they are responsible for reliability of technical equipment, such as WiFi or Internet connection. | |
| Stability of the WiFi or Internet connection has an influence on the writing flow | |
| Prestige of EQE and eventually reputation of European patent attorneys devalued | |

Although it is foreseeable that future candidates will be used to online examinations from home due to their university experience, the EQE requires special scrutiny in order to live up to the reputation of a European patent attorney in the future.

IV. Timing of the modules

Despite all the zeal for reform of the EQE, it should not be forgotten that an essential part of the education to become a European patent attorney is the practical training in law firms or companies. Less time for practical training is a disadvantage for all stakeholders – supervisors, candidates and EPO.

The motivation of a supervisor in a law firm or a company is usually to train qualified junior staff. However, operational concerns must not be neglected. The envisaged modularisation of the examination with the completion of a first module already after one year of candidate training and the possible offering of the modules more than once a year is certainly in the interest of the candidates, but in no way takes into account the legitimate operational concerns of the law firms and companies that train the candidates. When the exam modules are spread over many months,

candidates will be permanently in an „exam mode“ and will have less chance to practically work on files. In addition, they will need more support from supervisors for the different modules, or need more training courses. Moreover, there is another important aspect when changing the timing of modules – the capacity of the Examination Committees (EC). Changes in the timing as envisaged will multiply the work of the ECs. For example, offering modules every 4 or 6 months means to prepare papers every 4 or 6 months and to mark papers more than once a year. Who shall do this work? Meanwhile most of the EQE examiners or tutors are **epi** members, not EPO members, and have only limited free time to do this work. To find more examiners might be possible, but drafting all these papers cannot be done by new committee members. It is a task for experienced members who have already marked papers. Where will you find those members?

If papers can be written at any time, who will invigilate? Invigilators will not be available all year around. Shall invigilation be skipped for the first modules?

A summary of pros and cons for the envisaged change of timing of modules is provided in the following table.

Timing of modules first module already after one year candidate training/ modules more than once a year

| Contra | Pro |
|--|--|
| Shortened training period, too little on-the-job training | Provides more flexibility for candidates |
| Scale applied to the training time too low | Contributes to shortening candidate training |
| Taking modules every 6 months stressful for candidates, not enough time to learn while working or at the expense of practical training | |
| Not in the interest of supervisors | |
| Not in the interest of tutors, who are usually on a voluntary basis, as workload increases significantly | |
| Not enough resources for preparing EQE papers | |

V. Proportion of multiple-choice tasks/ evaluation by artificial intelligence

Although a digitised exam might be seen as an invitation for more multiple choice tasks and automatic evaluation by artificial intelligence, a closer look shows that this is not appropriate because of the complexity of a "fit to practise" test. This form of testing is well-suited for pure knowledge tests and can be used in some part of the exam, especially in paper D1.

Smart papers are required, which can certainly be evaluated through the supportive use of artificial intelligence, but query whether the candidate is qualified to work as a European patent attorney. Such clever questions require immense know-how, which is currently available among the tutors. A reform that transfers the know-how from the tutors and thus from the **epi** to third parties, such as professional seminar providers or universities, is certainly not in the interest of **epi**.

As has been outlined many times, multiple choice questions (MCQ) can test knowledge but not skills. MCQ have nothing to do with real life. The work of a European patent attorney is a creative one, not choosing between options. For drafting, arguing, presenting arguments before a division or board etc., it is not enough to know articles and rules and some strategical methods, but deep understanding of an invention, abstraction of inventive ideas, formulating claims that protect an invention etc. have to be created, articles and rules have to be understood and applied. This can neither be tested by MCQ nor by any kind of artificial intelligence.

Moreover, it seems so easy to test candidates by using MCQ, where a computer can do the "marking". However, it is not the case, as the MCQs have first to be created, which is a heavy burden. In the present format of the pre-exam, twenty questions have to be created, which already requires enormous resources. One has to keep in mind that the exam papers have to be provided in three languages which have to be equivalent. This is particularly difficult for MCQ. If the questions are not equivalent in all three languages, they have to be neutralized. Despite enormous efforts, this happens every year at the pre-exam. If one multiplies the MCQ, one multiplies the problems. For the EQE, thousands of MCQs would have to be drafted. Who should do this work? And those questions could not just be reused every year, but checked, some taken out, new ones provided, etc.

It is not foreseeable how autocorrection could work with this type of examination applied by the EQE. It seems that autocorrection can be applied to a format that only looks for the presence of keywords without checking the context and understanding or application of the rules. This may be useful for checking methodology, but not for checking testing "fit to practise".

Thanks to the e:EQE working group

Last but not least, the authors would like to thank the e:EQE working group for their commitment and work so far. The Discussion Paper already shows that the thinking is outside the box and that an attempt is being made to lead the EQE into the future. The authors look forward to the forthcoming Concept Paper.

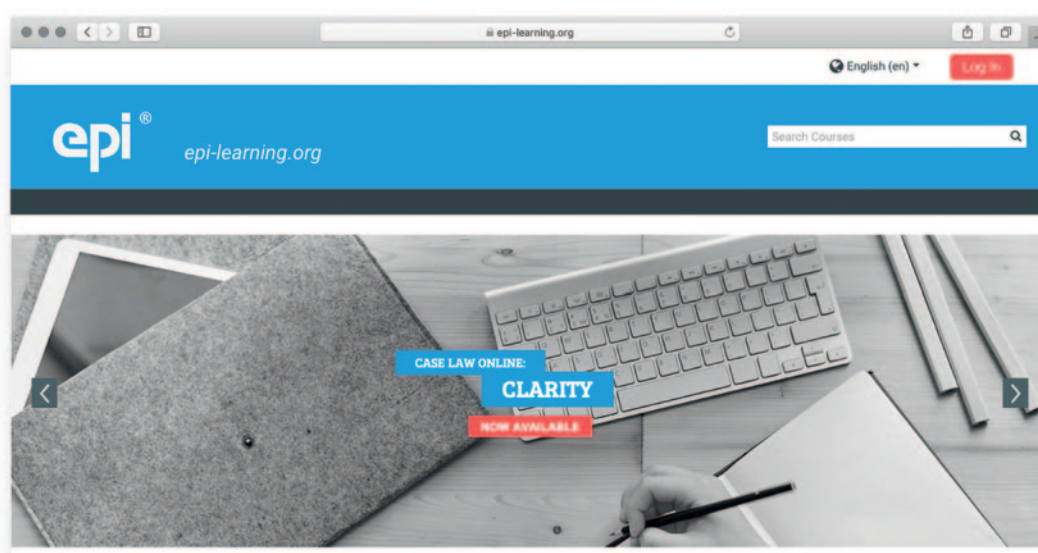
epi Student membership

epi student members have access to additional information on the **epi** learning website, including the student forum described below. Other benefits of student membership include receiving alerts about **epi** training courses, priority access to our educational events, and reductions on course fees for **epi** educational events, such as tutorials, Mock EQEs, seminars and webinars. Candidates for **epi** student membership may apply, at

any stage of their training, to the **epi** Secretariat (epi.student@patentepi.org), simply by filling in the online application form¹, providing the necessary documents² and paying the fee.

- 1 <https://patentepi.org/en/epi/form/47/registration>
- 2 <https://patentepi.org/en/epi-students/epi-studentship/rules-governing-the-epi-student-membership.html>

epi-learning



epi-learning¹ is the platform for all online training activities organised by the **epi**.

epi Students are automatically registered in this platform and can take advantage of support and training offers specifically designed for **epi** Students.

To register you on the platform we need your consent. This will be presumed when you fill in the survey link² the required data.

¹ <https://www.epi-learning.org>

² https://www.surveymonkey.de/r/epi-learning_platform

Via **epi-learning**, **epi** Members can access relevant online courses, online lessons, and other resources, such as recordings of the following webinars:

- New Rules of the Procedure of the BoA and further developments
- Supplementary Protection Certificates (SPC)
- Conflicts of Interest
- Privilege in patent matters
- Collaboration with overseas patent colleagues

You can find more training offers on **epi-learning**³.

³ <https://www.epi-learning.org/course/>

EQE Training Courses in Maastricht

N. Blokhuis (NL), N. Duhayon (BE), I. Surdej (BE) and J. Declerck (BE)

Since 2014, Maastricht University has been preparing candidates for the European Qualifying Examination (EQE). This training is for candidates who already have a basic understanding of European patent law. One of the cornerstones of our courses is the interactivity: two tutors and group sizes limited to 16 participants stimulate the exchange of ideas and learning from each other.

The Pre-Exam methodology encompasses a 2-day workshop focusing on Claim Analysis, followed by a 1-day workshop for the Legal Questions of the Pre-Exam. The training for each of the main exam papers starts with a 3-day workshop (A and B are combined). Following each of the training courses, access is provided to Maastricht University's electronic learning environment for further practice and online support from fellow students and the tutors all the way up to the EQE. The presentations, cases and model solutions of the workshops are available for subsequent study in this system. In addition, the online system comprises assignments which are set up to improve the skills of the participants and to boost their confidence. Discussion of experiences and possible answers are encouraged.

If possible, the workshops will take place live in Maastricht. However, if necessary or preferable, the workshops may take place via Zoom.

At the basis of each of the courses are specially developed methodologies to solve the current papers using a pragmatic and efficient approach. After providing some background and theory, the most important aspects of the methodologies are illustrated by solving cases. Some of the cases are based on old exam papers, others are specially made for the Maastricht courses. Materials are provided electronically during the course to reduce the books needed and to facilitate electronic note-taking.

Of course, the tutors closely follow all developments in the EQE. The methodologies are continuously adapted to accommodate for such developments, including the e-EQE and the new exam format in which some of the papers are split up into multiple parts. But also more subtle changes in the structure of the exams and/or the desired answering structure are taken into account.

Training for the Pre-Exam

Pre-Exam – Claim Analysis

The teaching encompasses how to apply the theoretical concepts such as scope of protection, novelty, inventive step, clarity and allowability of amendments in a practical way to the type of questions asked in the Pre-Exam.

Workshop duration: 2 days: Monday 7 and Tuesday 8 November 2022. Online learning trajectory: from November 2022 to March 2023: about 7 assignments will be set out.

Pre-Exam – Legal Questions

The legal questions of the Pre-exam require you to quickly and correctly apply your legal knowledge to a legal situation presented in each of the 10 questions. The one-day course will teach you a practical methodology for answering multiple-choice legal questions.

Workshop duration: 1 day: Wednesday 11 November 2022.

Online learning trajectory: from November 2022 to March 2023: about 6 assignments will be set out.

Training for EQE Papers A and B

In Paper A, a set of claims and the introductory portion of a European patent application have to be drafted. In Paper B, a response to a communication from the examining division has to be drafted, while taking account of the cited prior art and the instructions from the client. The training covers the skills needed to tackle both electricity-mechanic and chemical aspects of the current combined-technology papers. The methodologies borrow from real-life skills and approaches to drafting applications and answering office actions to provide an intuitive approach. We apply them step-by-step as a group to A and B papers and cases covering combined-technologies, focussing on the parts of the answer where most of the marks can be gained.

Workshop duration: 3-days: Monday 14 - Wednesday 16 November 2022. Online learning trajectory: from November 2022 to March 2023: about 8 assignments (1 A and 1 B case, 2 full A/B papers with combined-technologies, 1 full A and 1 full B chemistry paper, 1 full A and 1 full B electricity-mechanics paper); one of the assignments will be marked by one of the tutors.

Training for EQE Paper C

In Paper C, a notice of opposition has to be drafted following the grant of a European patent. In the course, a newly developed, simple and efficient methodology for tackling Paper C will be taught, which has been successfully applied by many of our previous candidates. The methodology will be put into practice with various example cases.

Workshop duration: 3-days: Monday 24 - Wednesday 26 October 2022. Online learning trajectory: from October 2022 to March 2023: about 8 assignments (6 C cases and 2 full C Papers); one of the cases will be marked by one of the tutors.

Training for EQE Paper D

In Part I of Paper D, a set of legal questions have to be answered. In Part II, a legal opinion must be drafted following an inquiry from a client. An intuitive methodology will be taught for answering Part I questions and for analysing and preparing a response to the inquiry in Part II. The methodology will be put into practice with example questions and cases.

Workshop duration: 3 days: Monday 10 - Wednesday 12 October 2022. Online learning trajectory: from October 2022

to March 2023: 2022 assignments (6 with a set of Part I questions, 1 Part II case and one full Part II paper); one of the assignments will be marked by one of the tutors.

For detailed information of and registration for the Pre-Exam and Main Exam training courses, see:

www.maastrichtuniversity.nl/education/course/eqe-exam-training

All course material and teaching will be in English.

The courses are given by a team of renowned teachers.

CEIPI preparation courses for the European Qualifying Examination 2023

A complete range of high-quality courses using proprietary high-quality training material



CENTER FOR INTERNATIONAL
INTELLECTUAL PROPERTY STUDIES

Preparation for the EQE pre-examination 2023

Preparatory seminar for the EQE pre-examination from 24 to 28 October 2022 in Strasbourg or online

Fee: 1.800 €. Closing date for receipt of applications: 30 September 2022.*

Intensive course "Mock examination" for the pre-examination on 26 and 27 January 2023 online

Candidates take two complete CEIPI mock exams according to the format of the e-EQE and discuss the papers with the tutors in plenary sessions.

Fee: 750 €. Closing date: 9 December 2022.*

Preparation for the EQE main examination 2023

Introductory "Methodology" courses on papers A+B, C and D in Paris or online

Papers A+B: 16 September 2022

Paper C: 17 September 2022

Paper D: 14 – 15 September 2022

Each part (A+B, C, D) can be attended separately. Fee: papers A+B or C: 600 €, paper D: 900 €.*

Closing date: 12 August 2022.

Preparatory seminars for papers A+B, C and D in Strasbourg or online

Papers A+B and C: 14 to 18 November 2022

Paper D: Paper D: 9 to 13 January 2023 in Strasbourg or 16 to 20 January 2023 online

Fee: 1.800 € for each five-day seminar (ABC or D), 925 € for the A+B or C part, respectively.*

Closing date: 14 October 2022.

Intensive courses "Mock examination" for papers A+B, C and D online

Candidates take mock exams according to the format of the e-EQE and discuss the papers with the tutors in plenary sessions.

Papers A+B: 24 January 2023

Paper C: 25 January 2023

Paper D: 31 January & 1 February 2023

Courses A+B, C or D can be attended separately. Fee per course: 750 €. Closing date: 9 December 2022.*

**The CEIPI offers reduced package prices for candidates enrolling simultaneously for the complete range of courses preparing for one or more papers of the EQE. Further information about the courses and enrolment is available in OJ EPO 3/2022 and on our website: www.ceipi.edu.*

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Committee Reports

Report of the Online Communications Committee

J. Gray (GB), Chair

1. Introduction

In addition to the regular interactions with EPO and other **epi** bodies (see **epi** Information 2/2021), OCC members have been busy in various pilots, 'working groups', 'focus groups' and 'round tables', some of which are discussed below. As OCC Chair I have joined in **epi** Board meetings and in the regular 'bilateral' meetings with the EPO president and his team.

2. Decommissioning of online filing (CMS) 31 December 2021

Users of the CMS online filing system were forced to switch in short order to Online Filing 2.0¹. In view of various issues encountered or anticipated by users of all

sizes, **epi** suggested that the closure of CMS should be delayed for a time while the functionality of OLF 2.0 is still developing to what CMS currently offers. EPO's VP1 Steve Rowan and Chief Information Officer Diego Eguidazu Alonso kindly met with me and **epi** President Francis Leyder on 22 December, to explain honestly why this was just not possible. We then discussed what measures are being taken to reduce stress and risk for representatives and their clients, as reported on the **epi** website (News item 23 Dec 2021²).

3. Online Filing 2.0

Former CMS users are adapting to OLF 2.0, although the great majority of applications are still filed via the old client-server system eOLF. The EPO continues to improve

¹ <https://www.epo.org/applying/online-services/online-filing-20.html>

² <https://patentepi.org/en/epi/news/f49d262b-a30b-4bfb-b2cd-8596386e6f26>

OLF 2.0, as evidenced by the “Release Notes³” issued whenever there is an update. A **dedicated opposition form** 2300 will be provided soon, which addresses one major headache. We have put on record our disappointment that the OLF2.0 system seemed rather half-finished when launched, especially when transition from CMS was forced upon users.

4. DOCX filing

Filing of application documents in DOCX format at the EPO is possible as a pilot only, for participating users within the OLF 2.0 system. USPTO, INPI(FR), WIPO, JPO and KIPO have launched similar programmes, with differing degrees of success.

Following initiatives from **epi**, several meetings have been arranged with EPO experts to identify the issues. Led by Ronny Vavrin, we have identified many issues for the group to explore in more detail. Even the simple question “what is DOCX?” has no simple answer, neither in terms of technical format nor content. In January, “Round Table” meetings with EPO and WIPO experts were joined by several OCC members and Marjut Honkasalo for EPPC. The work addressed three (overlapping) areas:

- Legal and policy
- Drafting and amending technical documents
- Business change, workflows and future tools

Marjut, David Brophy and I reported as “rapporteurs” to the eSACEPO meeting (below). The problem is not how to define a system. The problem is how to define a system that is easier for both the office and the users, and legally and technically sound. Credit to the EPO for facilitating this deeper study.

5. New User Area (final name to be decided...)

Several OCC members/associates and other **epi** members have continued to participate in the focus groups around a new user portal for integrating current Mailbox etc & My Files functions with post-filing procedural actions. The pilot has (finally!) been extended to paralegals, and management of multi-user roles will be enabled shortly. The plan is to launch the system for general use in May 2022, which leaves not much time for intensive testing and feedback by this new user group. (After all, paralegals are likely to be the real power-users.) You and your teams are encouraged to get involved and give feedback during the pilot. (<https://www.epo.org/applying/online-services/improving/user-area-services.html>)

³ <https://www.epo.org/applying/online-services/online-filing-20/release-notes.html>

We continue to question the utility of a system that replicates/imitates some but not all functions of a proper case management system. The benefits of the new system may make more sense, as and when more functions are added. For its part, we think that the EPO understands now that machine-machine interfaces (APIs) are critical to the utility of any system, for volume users. The new system also promises to support alternative authentication methods, besides smart cards.

A drawback at this stage is the lack of integration of fee payment with the other tasks: once the “task” (e.g. a response to a Rule 71(3) letter is “completed” in this system, the user still needs to go elsewhere to pay the requisite fee (see also below)).

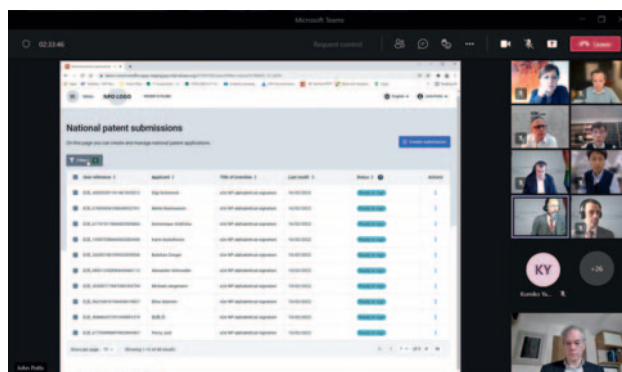
6. eSACEPO – SACEPO Working Group on the Electronic Patent Process

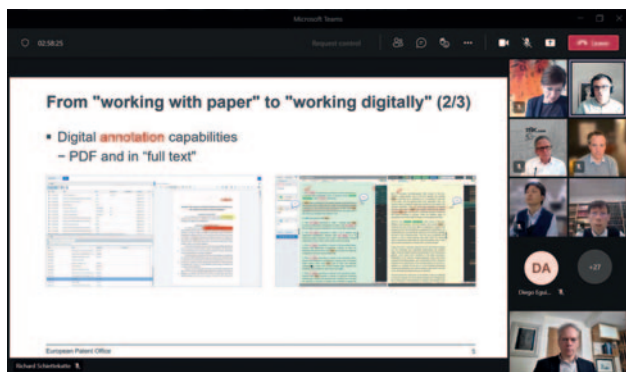
The meeting of eSACEPO was held online on 17 February 2022. This group includes key management and experts from within the EPO, several members of OCC, as well as participants from industry and private practice in China, Japan, Korea and USA, other representatives from **epi** and European business organisations and a paralegal.

The agenda covered the following topics, most of which had slide presentations which are available for anyone interested:

- EPO Strategic Plan – Update
- Oral proceedings in examination and opposition by VICO
- New Online User Engagement programme
- Online filing 2.0
- IT cooperation projects – including new “Front Office” for national filings
- E-business Patent Grant Process
- Central Fee Payment – Update and further steps
- Update on DOCX
- Patent Information systems (Register, Espacenet)
- User Enquiries & Intelligence
- Unitary Patent

Two screenshots from the meeting are shown below, followed by more detail on just a couple of agenda topics for further discussion.





7. Central Fee Payment

This project has been generally successful and brings together the diversity of payment mechanisms in a good and more real-time manner. On the other hand, in eSACEPO we pressed the case that the Central Fee Payment



John Gray

platform must not be seen as a substitute for properly integrating fee payment into the new online filing systems for substantive & procedural steps. It was always promised that this development would serve as a platform (back-end), from which payments can be integrated into those EPO systems that already have payment integrated one way or the other.

In eSACEPO we learned that the existing fee payment functions will be turned off 'as soon as' the last piece of functionality for automatic debit order users is added to the new Central Payment platform (expected during September 2022). This allows zero transition time for those users (approx. 10%) who rely on such functions. No matter how wonderful the new system is, and how few users are directly affected, users need time to develop and test robust procedures, before being forced to switch systems at short notice.

8. New "Front Office" for national filings

The new system developed in collaboration between EPO, NPOs and our own Ben Grau is looking good – we saw demonstrations (see screenshot). It is expected that eventually more countries will use this even than use eOLF at present. Lithuania and Spain are in advanced stages. Another tranche of 6 countries should come on board during 2022. EPO want to 'enable' all offices to adopt by end of Strategic Plan mid-2023. The offices will hopefully progress this willingly, but of course they cannot be forced. Any closure of eOLF must be delayed until new systems replicate functionality for all users, and a long sunset period should be allowed.

8. Interacting with the OCC

The above is only highlights of our activities.

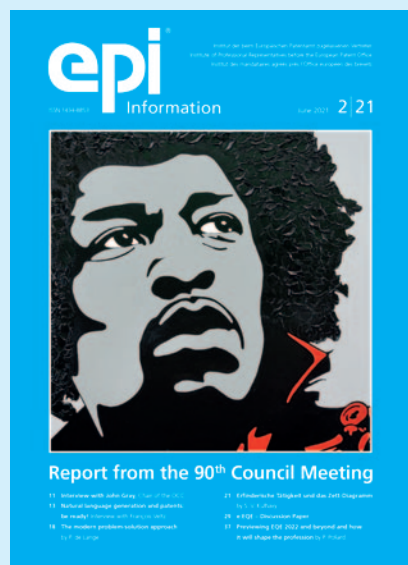
Thanks always to the **epi** members who report to us the random issues they face with EPO IT systems. You can submit issues and information directly to the OCC Chair at OCC@patentepi.org.

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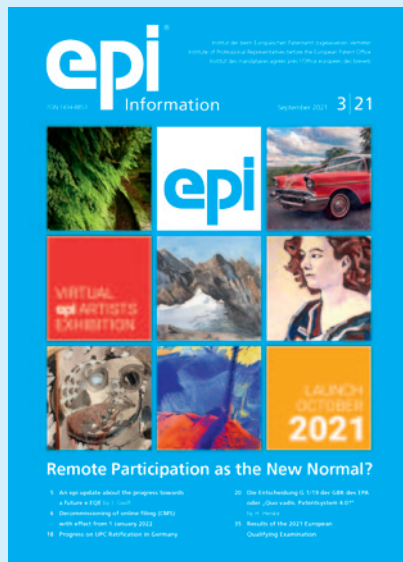
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¹ <https://patentepi.org/r/info-2201-01>
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120th Board Meeting by videoconference on 7 April 2022

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92nd Council Meeting in Munich on 7 May 2022

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