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Cover:

Holly Golightly

Oil painting on cardboard by
Ingrid Fritz

(European Patent Attorney, DE)

was part of the **epi** Artists

Exhibition 2018 at the EPO, Munich



Ingrid Fritz

Ingrid Fritz ist zugelassene Vertreterin vor dem Europäischen Patentamt und arbeitet bei einem internationalen Mikroskop-Hersteller, der in der Nähe von Ulm (Deutschland) ansässig ist. Zum Ausgleich der eher kopflastigen Patentarbeit greift sie in ihrer Freizeit gerne zu Papier oder Leinwand und Farbe und besuchte verschiedene Mal- und Zeichenkurse in St. Ives, Augsburg und Ulm.

Das gezeigte Bild (Öl auf Karton) „Holly Golightly“ wurde in der **epi** Artists Exhibition 2018 erstmals präsentiert. Es ist als Hommage an Audrey Hepburn zu verstehen, die – bis heute unvergessen – die Rolle der leichtlebigen Holly in dem US-Spielfilm „Frühstück bei Tiffany“ verkörperte.

Ingrid Fritz, Professional Representative before the European Patent Office, works for an international microscope manufacturer, which is located near to Ulm (Germany). To balance the rather top-heavy patent work, she likes to use paper or canvas and paints in her free time and attended various painting and drawing courses in St. Ives, Augsburg and Ulm. The shown painting (oil on cardboard) “Holly Golightly” was first presented at the **epi** Artists Exhibition 2018. It is to be understood as a homage to Audrey Hepburn, who – unforgotten until today – played the role of the easy-going Holly in the US feature film “Breakfast at Tiffany’s”.

Ingrid Fritz est mandataire agréé près l'Office européen des brevets et travaille pour un fabricant international de microscopes situé près d'Ulm (Allemagne). Pour équilibrer sa charge de travail plutôt conséquente, elle aime utiliser du papier ou une toile et peindre pendant son temps libre. Elle a suivi divers cours de peinture et de dessin à Saint-Ives, Augsburg et Ulm. Le tableau représenté (huile sur carton), « Holly Golightly », a été présenté pour la première fois à l'exposition d'artistes de l'epi 2018. Il doit être compris comme un hommage à Audrey Hepburn, qui – inoubliable à ce jour – a joué le rôle du personnage facile à vivre de Holly dans le long métrage américain « Diamants sur canapé ».

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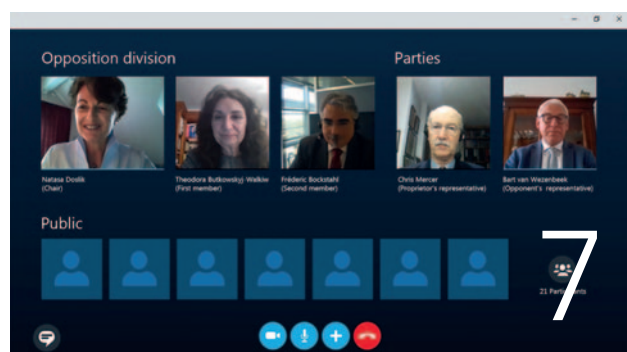
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Editorial

The World After: business as usual?

M. Névant (FR), Editorial Committee

« Qu'est-ce qui a changé ?

Pas grand-chose

Je n'ai pas rangé les questions que je me pose »

(extract from a song from 2 French rappers (known as Bigflo and Oli), which can be translated as follows:

"What has changed? Not much, actually. I still keep asking myself the same questions").

A long time ago a pandemic spread across the planet, forcing about 3 billion people to be placed in quarantine. Thousands of people died and the model that ruled the world was on the brink of collapsing in what was then considered to be the worst health crisis ever. This, in fact, triggered a radical change in the way society was organized: capitalism was dead!

Worldwide companies started making a virtuous use of the patent system, no longer filing hundreds of applications (until the lockdown rather easily granted by IP5 offices), but instead focusing on those inventions actually making



Marc Névant

a contribution to the art. The EPO did not present, before the Administrative Council, amendments to the EPC which significantly impacted the life of practitioners without first reaching a consensus with **epi**. Members of the Boards of Appeal, relocated in beautiful Venice (freed from tourists and cruising ships), did not feel compelled to implement "a dynamic interpretation of the EPC" at the request of the EPO, in fear of having their term of office terminated.

Oops. So long for science fiction. Let's go back to reality!

Time will tell whether users of the IP system will change their behaviour once the Covid-19 crisis is over. Recent facts tend to show that it is unrealistic. Immediately after the lockdown was implemented in most western European countries, the EPO decided unilaterally and at very short notice and certainly without proper consultation that Examination Oral

Proceedings would be held via videoconference except in exceptional circumstances. Whether or not this makes sense is not the point. The decision-making process is appalling. I can recall President Campinos' speech, when he addressed Council members in November last year, in which he stressed the importance of the relationship between EPO and **epi** ("one of EPO's closest partners for the last four decades"). I leave it to our readers judge for themselves if this is an appropriate way to treat a very close partner.

More recently, the Enlarged Board of Appeal (EBA) issued opinion G 3/19¹ (Pepper), concluding that plants and animals exclusively obtained by essentially biological processes are not patentable. A summary of the Opinion is available here². In essence, the EBA concluded that new Rule 28(2) EPC (introduced by the Administrative Council in 2017) "allowed and indeed called for a dynamic interpretation of Article 53(b) EPC". I will not try to understand the reasons why the EBA had to rephrase both of the EPO President's questions, de facto answering their own questions, seemingly giving in to political pressure. Let just say that while the opinion of the EBA may bring (according to some observers) greater legal certainty in the relevant field, the overall legal uncertainty for applicants and the general public might now be much greater. The EBA has indeed just made it clear that they can change their interpretation of the EPC as they see fit (in a dynamic way shall I say) or, even worse, that the Administrative Council can change, of its own volition, the meaning of Articles of the EPC by amending the corresponding Implementing Regulations.

1 [http://documents.epo.org/projects/babylon/eponet.nsf/0/44CCAF7944B9BF42C12585680031505A/\\$File/G_3-19_opinion_EBoA_20200514_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/44CCAF7944B9BF42C12585680031505A/$File/G_3-19_opinion_EBoA_20200514_en.pdf)
2 <https://patentepi.org/en/epi/news/dc401749-c702-4a87-ba8f-262065717810>

The above examples are typical of political and/or legal sleight of hand that should be dispensed with in the World post Covid-19. This is, however, unlikely to happen as long as specific interests take precedence over the general interest. It is therefore quite doubtful that things will change in the IP "ecosystem" in the World post Covid-19.

It is impossible to conclude this Editorial without having a thought for all those of our members impacted by the Covid-19 pandemic, whether personally or professionally. On behalf of the Editorial Committee I wish all our members well in these very harsh times.

The functioning of our Institute has been impacted too, and appropriate steps have been taken by the Presidium

not only to support the activity of the Secretariat, the Presidium, the Board and Committees but also to react to various activities (e.g. the cancellation of the 2020 EQE or the decision to hold Examination Oral Proceedings via videoconference). The **epi** website has been regularly updated in this respect (as reported elsewhere in this issue).

Finally, as you may know, the Council meeting that was planned to take place in Glasgow on 11th and 12th May has been cancelled. It will be now held as an e-Council on 29th June. On this occasion, (new or reappointed) Council members will elect a new Board, members of the Disciplinary Committee, and the Internal Auditors. Let's make the meeting a success and an important step for a return to a more normal life!

News from epi

M. Névant (FR)

As indicated in the editorial of this issue of **epi** Information, the Presidium took appropriate steps to support the activity of the various bodies of **epi**, and to react to decisions impacting our profession. A message from the Presidium was sent to members on 31st March 2020 (and made available on our website) with information about:

- Cancellation of the Council meeting in Glasgow
- **epi** Secretariat continuity plans activated
- **epi** letter to the EPO regarding the EQE cancellation
- Short report of the "mock e-Council" meeting of the AC
- Letter from the EPO President regarding oral proceedings by videoconference
- Message from the International Bureau regarding postal mail and e-mail

The content of this message is reproduced below.

Cancellation of the Council meeting in Glasgow

In this situation, when a state of emergency has been declared in several countries, with international travel essentially limited to repatriation, it is clear that the meeting of our Council that was planned to take place in Glasgow on 11th and 12th May cannot take place as planned. It has also become clear that no spring meeting can be organised later this year contrary to what could be done in 2010 when the eruption of Eyjafjallajökull disrupted air travel in Europe. The Presidium has been looking at the situation created by the impossibility to organise a spring meeting of our Council, with the support of our By-Laws Committee. We will let you know what contingency plans will be implemented once they will have been adopted by the Board¹. In the meantime, Council members should please keep the date of 11th May available in case a videoconference meeting can reasonably be organised on that date.

epi Secretariat continuity plans activated

Measures have been implemented to ensure, as far as possible under the circumstances, support for the Presidium, Board, Council and committees. The Secretariat's business continuity plans have been activated, with most staff working from home. The offices will remain closed until further notice; no visitors will be admitted.

epi letter to the EPO regarding the EQE cancellation

You are no doubt aware that the March EQE session was cancelled, and that it is planned to organise a postponed session in September, if possible. In this regard, the Presidium has decided to send a letter to the President of the EPO, which is published <https://patentepi.org/r/info-2002-01>.

Short report of the "mock e-Council" meeting of the AC

Last Wednesday, during a "mock e-Council" meeting of the Administrative Council of the European Patent Organisation, the President of the EPO presented his report. The report included several actions related to the present situation. In particular, as part of support to the users in the patent granting procedure, two points were cited in the slides:

(and made available on our website) with information about:

- Extension of time limits for all procedures, postponement of all oral proceedings (examination, opposition, appeal) until 17 April 2020 [orally, it was indicated that this date would "soon" be postponed]

¹ The decision was subsequently made to hold the 88th Council meeting by videoconference on 29th June 2020

- Preparation of the adjustment of legal framework to further facilitate the use of video-conferencing for oral proceedings.

Your president intervened to explain the difficult situation of many of our members and their clients, and to thank the Office for its understanding that the users are also affected by the crisis.

The President of the Boards of Appeal also presented his report. Finally, the situation created by the decision of the German Constitutional Court was briefly discussed.

Letter from the EPO President regarding the use of video-conferencing for oral proceedings

Your president has received a letter from the President of the EPO, wherein he explains that the EPO would now like to establish video-conferencing as the standard way of conducting oral proceedings in examination, and to allow this in opposition upon request of a party or at the instigation of the division. The letter can be read <https://patentepi.org/r/info-2002-02>.

The EPO intends to inform users about this measure at a videoconference meeting of the SACEPO Working Party Rules on 31st March 2020, which the **epi** delegates will join.

Message from the International Bureau regarding the use of postal mail and e-mail

Your president has received this morning a kind message from the International Bureau wishing well to all their **epi**

friends and asking us to ensure that the **epi** members who use the PCT are made aware of a practice change announced on the WIPO website yesterday.

As noted in WIPO Update on COVID-19² press release on March 16, 2020, the International Bureau remains in full operation. However, given the unreliability of postal systems worldwide due to the COVID-19 pandemic, the International Bureau (also as receiving Office) has suspended all communication by postal mail until further notice. The International Bureau will transmit all PCT-related documents only via email to the email address provided in relation to each international application. Please note that PCT-related documents are also available through ePCT and also on PATENTSCOPE for published international applications.

For PCT applications in which the applicant or agent has not provided a contact email address, the International Bureau urges PCT users to urgently provide the contact email address in relation to their pending international application(s). The International Bureau has published detailed instructions on its website at www.wipo.int/pct/en/news/2020/news_0008.html on how to submit the contact email address in relevant cases.

All PCT users are strongly encouraged to avoid PCT-related submissions by postal mail and to communicate with the International Bureau exclusively by appropriate electronic means.

Further messages relating to **epi** activities were sent to members and posted on the website, see <https://patentepi.org/r/info-2002-03> and <https://patentepi.org/r/info-2002-04>.

2 https://www.wipo.int/pressroom/en/articles/2020/article_0004.html

News from the EPO

New Services of the Boards of Appeal

The Boards of Appeal have introduced new services on their website

Selected decisions

This service, which is designed to complement the existing list of recently published decisions¹ of the Boards of Appeal, will alert users **to all newly published decisions for which the board has provided a headnote or a catchword**. Usually, a board will use a headnote or catchword if it wishes to provide a brief summary of a particular point of law or draw attention to an important part of the reasons for the decision.

The list of selected decisions² will show all decisions with a headnote or catchword published on or after 1 January 2020 and will be automatically updated as each decision is released for publication on the EPO website.

1 <https://patentepi.org/r/info-2002-05>

2 <https://patentepi.org/r/info-2002-06>

Links to selected decisions in the HTML version of the Case Law Book

Building on this new list of selected decisions, **links to selected decisions** are now being added to the **HTML version of the Case Law Book** (9th edition, July 2019). It will help readers to identify new decisions within their thematic context.

For more information, see the communication³ on the Board of Appeal website.

Feedback on these two new services would be welcomed from users. Please send any comments or suggestions you may have to Frédéric Bostedt, Legal Research Service of the Boards of Appeal, at fbostedt@epo.org.

3 <https://patentepi.org/r/info-2002-07>



Patent practice

Mock Videoconference Opposition Oral Proceedings

D. Brophy (IE), J. Gray (GB), B. van Wezenbeek (NL), C. Mercer (GB)

The EPO is running a pilot on the use of videoconferencing (ViCo) in opposition oral proceedings. In this context, a mock opposition oral proceedings (OPs) was held by ViCo on May 5, 2020, organised jointly between **epi** and the EPO. The purpose of the exercise was to test how well the ViCo option works in *inter partes* proceedings to which members of the public have access.

In this report, the four **epi** members who took part in the mock OPS outline first the agreed format and technology, then describe our experience under various headings, both technical and human/procedural, and we conclude with recommendations to **epi** members.

Format and technology used

Format

A relatively simple opposition case was agreed: a simple novelty objection was raised, which would be overcome by submitting amendments during OPs by email.

An experienced opposition division was convened by the EPO, while **epi** provided four participants: Chris Mercer was the patentee's representative, Bart van Wezenbeek was the opponent's representative, and their respective clients were David Brophy and John Gray. In addition, there were 15-20 extra attendees on the EPO side representing members of the public (and observing progress to identify issues).

Technology

The platform used by the EPO is Skype for Business (SfB). The meeting details were circulated in advance, which allowed the **epi** members to join the ViCo the day before in order to test connections and to see if each side could hold a private conference in parallel for discussions during the OPs both while in session and during breaks.

On the patentee side, Zoom was used for the private conference and, on the opponent's side, Microsoft Teams was used. The members of the Division have their own private conference which they use during adjournments.

Experience

At a basic level, everyone was able to connect, and to stay connected, throughout the OPs. Everyone was able to hear what was said and the Opposition Division chair was careful to ensure that all parties were properly connected at all times, pausing proceedings as necessary to allow connectivity, audio or video issues to be resolved.

However, the overall experience was mixed. We identified several issues which are detailed below, some of which are technical and some of which relate to procedural aspects and the human user experience of conducting OPs in this medium.

Skype for Business

The **epi** participants are unanimously agreed that the EPO's chosen platform, SfB, has significant limitations and that a more suitable videoconferencing solution should be found. We believe it is important that **epi** members take note of the limitations if they intend to participate in the current pilot of ViCo in opposition proceedings.

1. Support and access to the software

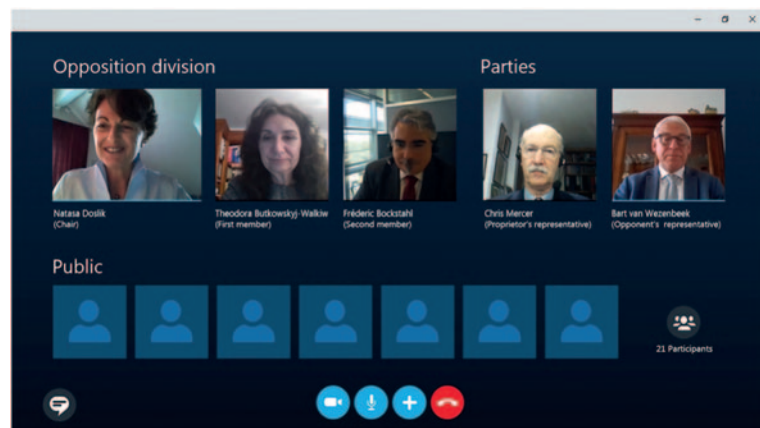
Microsoft has decided to retire SfB and pushes new subscribers to Microsoft Teams (which is not backwards compatible). This can lead to confusion when trying to find the correct software for first time use. The easiest way to access the ViCo is through a web client and one should be prompted to download the web client on trying to connect for the first time.

2. Limited gallery view

In the ViCo, the maximum number of users that can be viewed is five, plus one's own thumbnail image. This meant that, even with just one opponent, it was impossible to see the faces of all seven agreed attendees (3 EPO, 2 representatives and 2 clients) at the same time. (At any rate, this is the situation under Covid-19, where everyone is in their own house or office.)

The **epi** members were agreed that, when presenting at physical oral proceedings, it can be crucial to be able to see the reactions of everyone in the room, which simply is not possible using this software. One can therefore miss important visual cues because of this technical limitation.

This also makes the software inherently unsuitable for multi-opponent oppositions. Even with a single opponent, a representative will often be assisted by one or more assistants and/or presentation may be shared between two representatives. We note that other platforms have much more generous gallery view options.



As seen in the screenshot above, kindly provided by the EPO, the video quality can be good. This screenshot is taken from a video recording of the mock oral proceedings which can be viewed here <https://e-courses.epo.org/course/view.php?id=196>. The layout in the video has been edited and labelled to make the proceedings easier to follow, but things are messier in real life. It can also be seen that there is a great deal of wasted (black) real estate on the screen.

The screenshot represents what could be seen if there were only the three members of the opposition division and the two representatives present and the viewer had pinned these five participants to the main screen. There is also a thumbnail on each device of the person using the device. If the members of the public had enabled their video feeds, they would have been visible in the small icons. The name shown is the name you use when entering the meeting and so it is advisable to check that it is appropriate!

3. Visibility of participants

In the mock oral proceedings, each representative was accompanied by his client. Thus, there were seven players, all at different locations. Moreover, there were a large number of "members of the public". Using the SfB system, it is possible from the representative's point of view to have only five full images and the representative's image as a thumbnail. All the other attendees are shown below the main images as unlabelled icons. It is very difficult to locate the video feed of anyone who is not currently on screen. It is possible to "pin" up to five feeds so that they are permanently visible, but you are then stuck with those five faces. They are easily lost again if you switch views or decide to view a speaker who is not already pinned. Losing the feed from one of the members of the opposition division or the opposing attorney, and then finding it again and pinning it to remain visible, is a major distraction during what can already be a pressurised procedure.

Further, for non-pinned feeds, the order in which they are shown is dependent on who speaks. The feed of a person is only brought to the gallery if (s)he is speaking. In normal meetings with people you know, this normally is not a problem but, in case of oppositions, you want to see at least the faces of the opposition division (of which the second and third members hardly speak). This means that these at least should be permanently pinned to the gallery.

As said above, in case of an opposition with a three-member opposition division, a representative for the patent owner and a representative acting for the opponent, this means that the five available slots are filled. If you are one of those five (and thus would have a small feed of yourself) there is one free slot. This means that, if a party consists of more people, it is impossible to have them all on the screen together. A possible solution could be that more than one person is sitting in front of one camera, but this may bring additional problems, e.g. of control over the camera and microphone, smaller images and “social distancing” conflicts.

Members of the public could also speak until muted. The EPO later changed the permissions of the “public” to mute them. There is also a chat function which, during the oral proceedings, was used by the members of the public. This highlighted the need for the EPO to clearly define in advance permission levels for everyone attending the oral proceedings. However, it could be envisaged that, during the oral proceedings, some members of the public or members of the parties should be allowed to speak. It is not known if, during the oral proceedings, the permission levels could be changed and/or whether, for these members, the microphone can be muted/unmuted.

4. Chat window

A text chat channel is available. Everything typed here is visible to everyone on the ViCo, including members of the public. There is no private chat available. Sending messages using a different piece of software (e.g. Zoom or Teams) for a private conversation is certainly possible but the attorney may not see this when concentrating on the main ViCo window.

Most alternatives to SfB cater for private chat messages.

One of the “members of the public” also used the chat window to comment on technical issues of patentability during the arguments which, of course, is something that should be prevented.

5. Visual aids and screensharing

In conventional oral proceedings, parties are frequently permitted to use a flipchart or whiteboard, will point to drawings (enlarged or normal size depending on the room layout) or will show and share versions of drawings

with highlighted parts to assist in understanding. The simple case chosen for the mock OPs did not lend itself to such visual aids. The opposition division were reluctant when asked to share a proposed claim amendment onscreen, because then the video images are replaced by the shared screen. Again, this seems to require looking into another ViCo platform where video images can be displayed together with screensharing.

We are aware that introducing such materials and explanations may give rise to admissibility objections but does not see that these are different in principle from the questions that arise when such materials form part of a party’s presentation in physical OPs. Visual aids in some cases are key to assembling/conveying the facts or arguments that are decisive for the case.

We therefore believe that clarity is needed from the EPO as to whether, and in what circumstances, screensharing and the sharing of visual materials is to be permitted.

6. Interpreters

No interpretation was involved in the mock OPs and we understand that OPs requiring interpretation will not be eligible for the current pilot which the EPO is running. It is apparent that SfB would not be capable of handling any involvement of interpreters. We are aware of specialist solutions that can do this (which has been tried for example in the Administrative Council).

7. Parallel private channels

As noted above the **epi** participants used both Zoom and Teams as a “side channel” to allow for private conversations by text, audio and video while the OP ViCo was live. In general, we found that this worked well although there were a few issues to be aware of.

- a) Each user’s experience was specific to their individual hardware and software set-up. When Teams was used as a side channel, we found that one attorney’s computer muted the microphone within the ViCo OP, while the other’s did not. It is therefore crucial to test the side channel in advance if at all possible.
- b) During adjournments, stopping the video feed and muting the audio feed within SfB freed up the same hardware to be used in the side channel. This too may be hardware-dependent and should be tested. Best practice is to establish the SfB call to the EPO before opening the side channel and to keep the SfB ViCo open throughout.
- c) Two screens should be used if at all possible. This allows the SfB ViCo window to always be in full size view, even if there is a parallel text chat, if one needs to use email or look at documents.

- d) The biggest danger with a side channel is that there is “leakage” into the OP ViCo, which remains fully active during adjournments. Users need to be scrupulous about muting within each application whenever they are not actually speaking and intending to be heard.
- e) The biggest limitation in the side channel is that video and audio are only usable during the interruptions. If the team members are not in the same room, then (unless they have a separate device and adequate bandwidth) they cannot see and hear each other while the OPs are in progress.

Filing of documents and amendments

The Patentee filed an amendment to restore novelty. The procedure was that this was sent to the members of the opposition division by email. One member of the opposition division then shared it with the other representative. The representatives had to then share it in a separate email with their clients.

This procedure could be improved by having an email thread that includes all parties (and their accompanying persons) and all members of the division. Any documents that need to be “handed out” could then be sent as a “reply to all”, greatly reducing the complexity of the procedure.

We also felt that requiring one of the examiners to carry out all the administrative tasks during the OPs was too burdensome and that the division should be supported by a formalities officer throughout the OPs.

Signatures, identification and data privacy

When filing amendments, the EPO required the representative to sign the email in a particular format. It is suggested that, if an email thread were created at the opening of OPs by an EPO official, then it would be immediately evident that a simple email sign-off from any of the parties would sufficiently identify their submission (given that it is invariably confirmed orally on the record that they have sent a document or an amendment).

The representatives were required to identify themselves at the start of proceedings e.g. using an EPO attorney's badge or passport held up to the video camera. Given the presence of members of the public, this could involve sharing sensitive information with a wide and anonymous group. Thought should be given to improving this procedure. The chair of the division was careful to interrupt a representative trying to establish the correct spelling of an email address for another division member, due to GDPR concerns, and the same considerations should apply to all personal data that need to be shared.

In the mock OPs, both representatives were **epi** members. However, it is possible for employees or lawyers to represent in OPs. It was not clear how this would be dealt with at ViCo OPs.

General clarity on procedures

It would be helpful for parties taking part in ViCo OPs to be provided with a document summarising the procedure, with sections covering the operation and control of the software, signatures, how to make amendments, the rules applying to text chat, how to interrupt or draw attention to problems, and so on. This would allow users to familiarise themselves with the procedure and provide a document for the chair to refer participants to during the OPs.

Recommendations and Advice

Anyone considering taking part in ViCo opposition OPs should think very carefully about how the limitations set out above will affect their presentation and participation.

At present, opposition OPs are only being held with the consent of all parties. If you believe that your presentation will be adversely affected by the shortcomings outlined above, then ViCo OPs may not be suitable.

Conversely, the **epi** participants were agreed that, for simple cases, where the numbers on both sides are very limited (preferably just one attorney with no accompanying persons or clients) and where one does not anticipate needing to rely on visual aids for your presentation, then ViCo OPs may provide an acceptable alternative.

It is imperative to thoroughly test one's connection in advance, using the exact equipment and software that you intend to use on the day. The EPO will facilitate test calls which can be arranged by contacting the EPO Serviceline or by e-mail serviceline@epo.org. Make use of this opportunity to also test any side channel you are considering using (e.g. a parallel video or voice call from the same machine using different software). Technical requirements are explained at <https://www.epo.org/applying/online-services/proceedings/technical-guidelines.html>. The EPO has also published further guidance for those using ViCo oral proceedings at <https://www.epo.org/news-events/news/2020/20200519.html>. Be aware that if your connection is unsatisfactory at any point, the EPO should be alerted immediately, so that proceedings can be paused.

Use two screens, headphones and a microphone if available. Consider in advance whether you want to sit alone in a room or with other people (your client or colleagues?) and whether these should then be visible on the screen or not.

Reform of the European Qualifying Examination

C. Mulder (NL)

In view of the cancellation of the European Qualifying Examination in March 2020 and the uncertainty about the circumstances of the 2021 EQE, it is required to rethink the conditions of the examination as well as whether it can be held in another form if bringing larger groups of candidates together is still a health risk in March 2021. In this article a reform of the EQE is proposed with the aim of simplification. In addition, other manners to conduct the EQE are worked out to prevent that the 2021 EQE has to be cancelled again due to *force majeure*.

I – Restructuring the EQE

1) Pre Examination and its effects

In 2012, a Pre-Examination ('Pre-Exam') was introduced with the intention to stimulate candidates to start their preparations for the Main Examination ('Main Exam') earlier and to work as a filter for those who are not yet well prepared. The idea was to relieve the Main Exam of unprepared candidates and hence unnecessary work. A candidate can only enrol for the Main Exam after having passed the Pre-Exam. After a few years of experience with the Pre-Exam, it turned out that the workload and costs of preparing the cases and drafting unambiguous multiple-choice (MC) questions are exceedingly high. In addition, an unexpected number of appeals were filed.

It would be worthwhile to have a report investigating and reporting whether the Pre-Exam has fulfilled its goals. In some discussions, the abandonment of the Pre-Exam was advocated. Currently, there is apparently no intention to amend or abolish the Pre-Exam. Therefore, I have taken the liberty to work out my own manner of restructuring the EQE.

2) Abandoning the legal questions of the Pre Exam

For the Pre-Exam, it is my proposal to skip the legal questions. The current legal questions only test considerably basic knowledge and can (easily) be answered if one is able to quickly identify the Rule in the EPC or PCT, or the appropriate 'implementing' text in the EPO Guidelines of PCT Applicant's Guide. Because each question in the current system requires four statements, there are normally two statements where the answers can be guessed. One learns little from this type of questions.

If not abandoned, the Pre-Exam could be held with "closed books" and test more basic knowledge.

The often-heard suggestion of creating a 'pool of questions' sounds easier than its realisation: making say 1,000 legal questions is perhaps not the problem, but keeping 1,000 questions up-to-date is an enormous job, which people tend to forget/ignore. (I have a lot of experience in keeping large sets of questions up to date.)

3) Limiting the Pre Exam to claim analysis questions only

For the Pre-Exam, it is my proposal to keep the claim-analysis questions: this is a unique exam in the world and tests vital knowledge of trainee patent attorneys. The best example is the 2019 Pre-Exam: there were two inventions (instead of one case in the previous exams) + a set of MC questions: this worked out very well.

The Pre-Exam Claim-Analysis tests basic knowledge of the candidates in relation to novelty, inventive step (problem-solution approach), allowability of amendments and scope as well as clarity of the claims.

The current claim-analysis questions are more focused on content and less on 'speculating/guessing' whether a statement is TRUE or FALSE. More flexibility could be added by not requiring that each question be followed by four statements.

The MC Pre-Exam Claim-Analysis could be organised at regular intervals, say 2-3 times per year. This could be done directly at a computer with immediate results. If the MC Pre-Exam CA is failed, it should not be allowed to take a new one in say the forthcoming 6 months. The latter period could be shorter if the score is closer to PASS.

4) Effect on the Main Exam

We must realise that European patent attorneys are highly esteemed for their professional training and skills. It should be the aim of the EQE to maintain the high standard of testing whether a candidate is fit to practice.



Cees Mulder

For the Main Exam, I do not see how the current Papers A, B and C can be altered. These papers test important skills of trainee patent attorneys in a pre-defined (although not very realistic) setting.

However, the duration of the exams may be reconsidered. Currently, the time allocated to Paper A is 3 hours. In view of the task set, this should become 3.5 hours – the same duration as for Paper B. The current time allocated to Paper C is 5.5 hours. In recent years, the size and content of this exam paper have grown outside doable proportions (e.g. in the 2019 C Paper the candidates effectively had to attack nine claims). Limiting the effective number of claims to 6 (including any splitting due to the use of ‘and/or’) would seem enough to test the skills of the candidates to draft a notice of opposition. Under these conditions, the duration of the C Paper could be limited to 4 or max 4.5 hours.

In view of the proposed deletion of the legal questions from the Pre-Exam, changes should be effected in EQE Paper D. At least a part of the DI questions could be cast in multiple choice. To improve the intelligence of the MC questions, questions could have a variety of statements (not necessarily limited to four) and a variety of answers (not necessarily limited to true/false) as well as the use of more sophisticated manners of grading. For instance, it could be asked how confident a candidate is about his or her answer (percentage): if a higher confidence is indicated, more points can be gained or lost. Another manner to test the knowledge of candidates by means of multiple choice is to give a list of say four statements followed by two statements indicating:

- a) Statements 1, 2 and 4 are true,
but statement 3 is false.
- b) Statements 2 and 3 are true,
but statements 1 and 4 are false.

By removing the legal questions from the Pre-Exam, the candidates do not have to study twice for the legal questions. After the introduction of the Pre-Exam, the results of the legal questions in Paper D showed a decline because the candidates do not feel like studying for Paper D again after having passed the Pre-Exam.

The new Paper DI could also be organised at regular intervals (2-3 times per year), preferably at a computer with immediate results. If Paper DI is failed, it should not be allowed to take a new one in say the forthcoming 6 months. The latter period could be shorter if the score is closer to PASS.

Current Paper DII should become a stand-alone paper, perhaps with a duration of 4 hours. It has always been a mix of applying basic knowledge (i.e. answering DI-style ques-

tions) and giving sound advice to a client. Apart from dealing with formalities issues, the new Paper DII should put more emphasis (allocating more points) on giving advice to the client.

With respect to sitting the EQE, a condition could be that a candidate is only allowed to sit the Main Exam after passing the MC Pre-Exam Claim-Analysis paper as well as the Paper DI and, of course, after fulfilling the 3-year full-time training period. Candidates should be allowed to sit the Pre-Exam one year after the registration of the start of their professional activity.

II – Simplify the Grading of the Main Exam Papers

By introducing the Pre-Exam, it was hoped to reduce the number of badly prepared candidates that sit the Main Exam multiple times. One of the grounds was that correcting exam papers of the ‘perpetual resitters’ requires a lot of capacity of the correction system.

In my opinion this is not true: the correction of a candidate who is not (well) prepared, is relatively simple and can be short. Being a tutor for more than 20 years, I have corrected several hundred exam papers made by candidates in their preparation for the Main Exam. When I start reading their answer, I can immediately see: this candidate is never going to pass (simply not “fit for practice”). After reading the whole answer, one could give such a candidate a grade “FAIL”, without spending any time to find out whether the candidate scored 17, 21 or 26 points. Doing this is a waste of time and resources. Furthermore, this work could be done by one marker. By not involving a second marker, the correction process could be shorter.

On the other side of the grading spectrum: the correction of a particularly good candidate also can be done quickly. If a corrector sees: this appears to be a good answer: this candidate is surely fit for practice. After reading the whole answer, one could give such a candidate a grade “PASS”, without spending any time to find out whether the candidate scored 61, 67 or 78 points. Doing this is also a waste of time and resources. This work could also be done by one marker.

Most of the correction time of EQE Papers is devoted to candidates that score between “FAIL”, “COMPENSABLE FAIL” and “PASS”, i.e. between 40 and 50 points: in this region, every mark counts. In this situation having two correctors may be required.

Furthermore, the compensation system could be abolished. Passing a Main Exam paper would then require scoring at least 50 points.

III – How to conduct the EQE

If the corona pandemic is still ruling in March 2021 and travelling is (still) restricted, bringing large groups of candidates together in an exam hall poses a health risk and may be impossible. International travel may still be impossible, difficult, unsafe, expensive (e.g. if airlines must keep free seats between passengers).

1) EQE at multiple locations

A solution may be to have – instead of the current 11 locations – a plurality of locations where the EQE is held. In every town where there are say 10 to max. 15 candidates, an exam could be organised with an official invigilator and a local patent attorney as supervisors. More remotely living candidates could travel to the exam location. In principle, there should be at least one exam centre per country. If a big hall is available, a larger number of candidates can be allowed to sit the exam, provided the health and safety can be guaranteed.

A consequence of this manner of examination is that the number of official invigilators (currently only members of the exam committees) must be expanded. In addition, safely transporting the exams to all locations as well as getting the answer papers back to München requires a lot of logistics.

2) Electronic EQE

In view of the pandemic, the EPO has proposed to speed up the process of coming to an electronic EQE ('e- EQE'). Plans to come to a computer based EQE exist already for many years and some testing has been conducted at small scale in Munich (70 volunteers in 2020). In its communication from 20 April 2020, the Supervisory Board of the EQE has indicated: *"In 2021, the Exams will be organised according to the current format."* In view of the uncertain situation, this may not be realisable.

If in March 2021, the EQE cannot be held in the manner we have known before 2020 and conducting exams at a plurality of locations is not a viable option, having an e-EQE may be indispensable. Cancelling the EQE for a second time due to *force majeure* must be avoided at all costs. In principle, the EQE must be held at least every 25 months (Art. 1(2) REE).

Apart from the technical implementation of an e-EQE, I do not foresee major problems for this type of exams. In view of the corona pandemic, most teaching at universities and other institutions is currently done online and exams are conducted while the students are at home. This all works well. However, my proposal is to thoroughly test how this works for exams on a scale like the EQE with emphasis of the avoidance of initial teething troubles. Another point of concern is that today, the candidates at the exam are provided with a pile of paper containing the

documents pertaining to the exam. Will they be allowed to print the exam papers at home (e.g. the 2019 EQE Paper C encompassed 37 pages – should we allow for printing time?), because without a kind of overview and being able to quickly find technical features in the documents, browsing through the pages of a printed paper is today an essential asset.

It should also be considered that an open-book exam combined with an electronic exam implies that all sources should be available electronically, e.g. also the Articles and Rules of the EPC and PCT, the EPO Guidelines, the PCT Applicant's Guide and the Euro-PCT Guide, etc. Eventually, this will have an impact on the manner the questions are asked at the exam (particularly in Paper D).

With respect to concerns about fraudulent behaviour in an e-EQE, there are today software packages which effectively monitor fraud (even for closed-book exams at home). For 'exams at home' conducted by universities, measures to prevent fraud are in place – so these could also be employed for the e-EQE. In my opinion, we should not worry too much about fraud and the e-EQE: let this be solved by the experts in the field. Minimum system requirements could be set in relation to the type of computer, the internet bandwidth and the availability of a printer. In addition, a microphone and webcam should be operational for invigilation.

IV – Working Group on Reform of the EQE

In view of the pandemic, a *Working Group on the Reform of the EQE* has recently been set-up with engagement of the EPO and **epi** to come to proposals and defining a plan progressing towards a new format of the EQE.

Conclusion

Due to the corona pandemic, a rethinking the current form of the European Qualifying Examination is required. In this article, it is proposed to restructure the EQE and to change the manner of grading of the exam papers. In addition, proposals are formulated to conduct the EQE if bringing together large groups of candidates in March 2021 is not yet possible.

There is no time to waste because if the pandemic is still affecting 'normal' life in 2021, another form of conducting the EQE must be in place. The plans for a new EQE should be ready and available in March 2021. We should start thinking and planning now to avoid that the 2021 EQE has to be cancelled again due to *force majeure*.

Divide and conquer!

A proposal for an amended Rule 36 EPC

H. Vissel (DE)

Increasing procedural efficiency is probably the most common goal of the European Patent Organisation and the parties involved in the proceedings before the European Patent Office (EPO). At the same time, it is one of the most challenging tasks, in particular, if legal risks are to be minimized. Amending Rule 36 EPC would allow for reducing administrative burden and reducing legal risks.

Eine Steigerung der Verfahrenseffizienz liegt im Interesse nicht nur der Europäischen Patentorganisation, sondern auch sämtlicher in den Verfahren vor dem Europäischen Patentamt (EPA) beteiligten Parteien. Gleichzeitig ist sie eine der anspruchsvollsten Aufgaben, insbesondere wenn es darum geht, rechtliche Risiken zu minimieren. Eine Änderung der Regel 36 EPÜ würde es ermöglichen, den Verwaltungsaufwand zu verringern und gleichzeitig rechtliche Risiken zu minimieren.

Accroître l'efficacité des procédures est probablement l'objectif le plus commun de l'Organisation européenne des brevets et des parties impliquées dans les procédures devant l'Office européen des brevets (OEB). En même temps, c'est l'une des tâches les plus difficiles, en particulier si l'on veut minimiser les risques juridiques. La modification de la règle 36 CBE permettrait de réduire la charge administrative et de diminuer les risques juridiques.

When amending procedural provisions it is very important to take all participants (i.e., the parties, including the applicants, patent owners, opponents and third parties; the representatives; and bodies of the EPO, including the Receiving Section, Search Divisions, Examining Divisions, Opposition Divisions, Legal Division, the Boards of Appeal and the Enlarged Board of Appeal) involved in the proceedings before the EPO into account when striving to increase procedural efficiency and, in particular, reducing administrative burden.

For example, it seems to be almost universally acknowledged that the Rules of Procedure of the Boards of Appeal (RoPBoA)¹ in force since January 1, 2020² might (but not necessarily³) increase procedural efficiency in the second instance but will certainly reduce the procedural efficiency in the first instance.⁴ For sure, the new RoPBoA will increase the workload of the parties and their representatives.⁵ In addition, authors have already questioned the compliance of the former RoPBoA with fundamental rights, e.g., the right to be heard, enshrined in the European Patent Convention (EPC).⁶

Unfortunately, initiating amendments of the Implementing Regulations to the EPC by the Institute of Professional Representatives (**epi**) is not explicitly foreseen in the EPC. Typically, the President of the EPO, who is also responsible for establishing the agenda of the Administrative Council meetings, initiates amendments to the Implementing Regulations. It is thus not surprising that such proposals primarily take into account wishes from the administration and seldom experience from daily practice of the applicants, patent owners, opponents and their respective representatives.

However, the rules of procedure of the Administrative Council allow for third parties like the **epi** to propose to the President topics to be set on the agenda of Administrative Council meetings.⁷ This procedure could be used to allow for a decision of the Administrative Council⁸ on the proposed Rule 36 EPC to increase the procedural efficiency for the benefit of both the applicants and the EPO without compromising legitimate legal interests of third parties.

To motivate the proposal, the legal provisions leading to the increased administrative burden associated with filing divisional applications are discussed first.

According to Article 100 (c) EPC, an opposition may be filed on the ground that the subject-matter of the European patent extends beyond the content of the application as

¹ OJ EPO 2019, A63.

² Art. 24(1) RoPBoA.

³ <http://patentblog.kluweriplaw.com/2019/12/16/happy-new-year-entry-into-force-of-the-new-rules-of-procedure-of-the-boards-of-appeal/>; Anetsberger et al., "Increasing Formalism in Appeal Proceedings – The EPO Boards of Appeal Headed to a Mere Reviewing Instance?", **epi** Information 2015, 63; Thesen, "Get Your Act Together - The New Rules of Procedure of the Boards of Appeal are coming", **epi** Information 2020, 8.

⁴ Thomas, "Some Thoughts after the Conference on the New Rules of Procedure of the Boards of Appeal", **epi** Information 2019, 11, 14.

⁵ <https://www.juve-patent.com/news-and-stories/legal-commentary/epo-adopts-boards-of-appeal-revised-rules-of-procedure/>

⁶ Wegner, Hess, "The right to be heard before the EPO Boards of Appeal - overruled by formal regulations?", **epi** Information 2014, 32.

⁷ Art. 19 2.2, [http://documents.epo.org/projects/babylon/eponet.nsf/0/053CF320F6312A95C12583C500467DCD/\\$File/Rules_of_Procedure_AC_EN.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/053CF320F6312A95C12583C500467DCD/$File/Rules_of_Procedure_AC_EN.pdf)

⁸ Art. 33(1)(c) EPC.

filed, or, if the patent was granted on a divisional application, beyond the content of the earlier application as filed.

Most professional representatives according to Art. 134 EPC will agree that the approach of the European Patent Office with respect to the allowability of amendments, in particular in view of Article 123(2) EPC, is strict. The German Federal Court of Justice has provided very good arguments why it does not follow the (sometimes too strict) jurisprudence of the Boards of Appeal in this respect.⁹

Nevertheless, professional representatives will have to take into account the established case law when filing divisional applications. In most cases, this requires ensuring that the complete content disclosed in the description, claims and drawings of the earlier application is also disclosed in the divisional application.

It seems as if this requirement could be met by using filing by reference for the divisional application.¹⁰ However, Rule 137(1) EPC does not allow for amending the (divisional) application before the European search report has been established.

Therefore, the divisional application will have to be filed with a set of claims differing from the original set of claims of the earlier application if the applicant wants different subject-matter to be searched for the divisional application.

A further possibility would be to file the divisional application by reference to the description and the drawings of the earlier application only and file the new set of claims separately. However, in this case the disclosure of the original set of claims of the earlier application, in particular explicitly expressed dependencies in the original set of claims, gets lost.

Hence, the diligent professional representative will refrain from filing by reference¹¹ and file the drawings of the earlier application, the description of the earlier application, a list of clauses corresponding to the original set of claims of the earlier application as additional description pages,¹² a set of amended claims to be searched for the divisional application.

This “copy-process” can lead to unnecessary errors because a special (mathematical) character might not

be available in a new program version or fonts for the language, in which the application was originally filed, may not be available.¹³ Moreover, with the exception of the set of amended claims, the whole description, all drawings and the original set of claims of the earlier application have already been processed by the EPO and it has to be done a second time for the divisional application. In addition, the current version of the Guidelines prescribes that claim-like clauses in the description must be deleted prior to grant.¹⁴ Furthermore, during examination of the divisional application the Examining Division will have to check with respect to every amendment if the claimed subject-matter is disclosed both in the earlier application and in the filed divisional application.

Thus, the current procedure generates considerable administrative overhead which does not seem to serve any legitimate purpose and could be removed with the proposed Rule 36 EPC.

The proposed Rule 36(1) EPC prescribes that a divisional application is automatically filed by reference to the earlier application and that the reference is deemed to include a reference to potential claims and/or drawings of the earlier application.¹⁵ Thus, refiling of application documents is avoided and Examining Divisions, Opposition Divisions, Boards of Appeal will only have to check if the claimed subject-matter is disclosed in the earliest application.

The Enlarged Board of Appeal considered it “unsatisfactory that sequence of divisional applications each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years”.¹⁶ Meanwhile, the filing of sequences of divisionals is discouraged by levying an additional fee for divisionals filed on divisionals.¹⁷ In addition, there may be a legitimate interest for even allowing European patents with identical claims, for example, if two applicants originally filed one common application and later want to be able to prosecute the claimed subject-matter independently.

The requirement that the divisional application has to be filed directly with the EPO is maintained (cf. proposed Rule 36(2) EPC) and the translation requirements are adapted (cf. proposed Rule 36(3) EPC). The legal fiction of

⁹ e.g., Federal Court of Justice, Decision of November 8, 2016 - X ZB 1/16 Ventileinrichtung, GRUR 2017, 54, Marginal No. 52-54; Judgment of February 11, 2014 - X ZR 107/12 - Kommunikationskanal, OJ EPO 2015 Special Edition 2, 119.

¹⁰ Rule 40(2) EPC.

¹¹ A method in any case rarely used; see Mulder, Visser, “Proposals for Streamlining the Filing Date Requirements of the European Patent Convention”, IIC 2013, 220, 224.

¹² see, e.g., European patent application 19 161 956.8, <https://register.epo.org/application?documentId=E22SY19Z0057DSU&number=EP19161956&lng=en&npl=false>

¹³ Please note that the languages of publication for international applications also include Arabic, Chinese, Japanese, Korean and Russian (Rule 48.3(a) PCT). The professional representative may be responsible only for the European phase of an international application and may not dispose of an alphanumeric version of the international application in the language as filed.

¹⁴ https://www.epo.org/law-practice/legal-texts/html/guidelines/e/f_iv_4_4.htm

¹⁵ Including a provision for filing by reference in Rule 36 EPC has already been proposed by Mulder, Visser, “Proposals for Streamlining the Filing Date Requirements of the European Patent Convention”, IIC 2013, 220, 224.

¹⁶ Enlarged Board of Appeal, G 1/05, Decision of June 28, 2007, Reasons 13.5.

¹⁷ Rule 38(4) EPC, RFees Art. 2(1)(1b).

proposed Rule 36(4) EPC avoids refiling of other documents already in the file of the earlier application.

Proposed Rule 36(5) EPC is provided as *lex specialis* to Rule 137(1) EPC to allow for the search to be performed on the basis of a set of amended claims. It seems to be justified to restrict the possibility to file amended documents to the date of filing of the divisional application, because the applicant knows sufficiently in advance how long the earlier application will be pending: In case of a granted European patent, the applicant receives the communication according to Rule 71(3) EPC sufficiently before the publication of the grant in the European Patent Bulletin;¹⁸ Should the application be refused, the applicant may still file the divisional application within the time limit for filing the appeal¹⁹ or a before final decision of the Board of Appeal.²⁰

18 Art. 97(3) EPC.

19 Enlarged Board of Appeal, Decision of September 27, 2010 - G 1/09, Headnote.

20 Enlarged Board of Appeal, Decision of September 27, 2010 - G 1/09, Reasons 4.2.2.

Moreover, the last sentence of proposed Rule 36(5) EPC ensures that third parties are informed on the content of the set of claims to be searched.

As the applicant has no possibility to reduce the number of description pages anymore due to the obligatory filing by reference of the divisional application, the additional fee if the application comprises more than 35 pages²¹ is abolished for the divisional application. This seems to be justified as the EPO benefits from the prescribed filing of the divisional application by reference, because the administrative burden for processing the divisional application documents is substantially reduced. In particular, the amendment ensures that the applicant already paid the respective additional fee for the earlier application where all the processing, type setting, etc. has been performed.

The proposed Rule 36 EPC could be applied to every pending application upon entry into force. Special transitional provisions seem not to be required.

21 RFees Art. 2 Nr. 1a.; Rule 38(2) EPC.

Regel 36 Europäische Teilanmeldungen	Rule 36 European divisional applications	Règle 36 Demandes divisionnaires européennes
(1) Der Anmelder kann eine Teilanmeldung zu jeder anhängigen früheren europäischen Patentanmeldung <u>durch Bezugnahme auf die europäische Patentanmeldung einreichen</u> . Der Hinweis nach Regel 41 (1) (e) ersetzt die Erklärungen nach Regel 40 (2). Die Bezugnahme auf die frühere europäische Patentanmeldung gilt als Bezugnahme auch auf eventuelle Ansprüche und/oder Zeichnungen der früheren europäischen Patentanmeldung.	(1) The applicant may file a divisional application relating to any pending earlier European patent application <u>by reference to the earlier European patent application</u> . The indication under Rule 41(1)(e) replaces the statements to be made under Rule 40(2). The reference to the earlier European patent application is deemed to include a reference to potential claims and/or drawings of the earlier European patent application.	(1) Le demandeur peut déposer une demande divisionnaire relative à toute demande de brevet européen antérieure encore en instance <u>par référence à la demande de brevet européen antérieure</u> . L'indication prévue à la règle 41, paragraphe 1, point e), remplace les <u>déclarations à faire en vertu de la règle 40, paragraphe 2</u> . La référence à la demande de brevet européen antérieure est réputée inclure une référence aux revendications et/ou dessins potentiels de la demande de brevet européen antérieure.
(2) Die Teilanmeldung ist beim Europäischen Patentamt in München, Den Haag oder Berlin einzureichen.	(2) The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.	(2) La demande divisionnaire doit être déposée auprès de l'Office européen des brevets à Munich, La Haye ou Berlin.
(23) Eine Teilanmeldung ist in der Verfahrenssprache der früheren Anmeldung einzureichen. Sie kann, wenn Letztere nicht in einer Amtssprache des Europäischen Patentamts abgefasst war, in der Sprache der früheren Anmeldung eingereicht werden; Sofern eine Übersetzung der früheren europäischen Patentanmeldung in eine Amtssprache noch nicht eingereicht worden ist, ist die	(23) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of	(23) Une demande divisionnaire doit être déposée dans la langue de la procédure de la demande antérieure. Elle peut être déposée dans la langue de la demande antérieure si cette dernière n'a pas été rédigée dans une langue officielle de l'Office européen des brevets; Si une traduction de la demande antérieure doit être produite dans la langue de la procédure dans une langue

Übersetzung der Verfahrenssprache der früheren Anmeldung ist innerhalb von zwei Monaten nach Einreichung der Teilanmeldung nachzureichen. Andernfalls wird die Verfahrenssprache der früheren europäischen Patentanmeldung die Verfahrenssprache der Teilanmeldung.

the divisional application. If a translation of the earlier European patent application into an official language has not yet been provided, said translation shall be filed within two months of the filing of the divisional application. Otherwise the language of the proceedings for the earlier European patent application becomes the language of the proceedings of the divisional application.

officielle de l'Office européen des brevets n'a pas encore été produite la demande antérieure cette traduction doit être produite dans un délai de deux mois à compter du dépôt de la demande divisionnaire. Dans le cas contraire, la langue de procédure de la demande de brevet européen antérieure devient la langue de procédure de la demande divisionnaire.

(4)
Der Inhalt der Akte der früheren europäischen Patentanmeldung bis zum und einschließlich des Tags des Antrags nach Regel 41 wird Teil der Akte der Teilanmeldung.

(4)
The content of the file of the earlier European patent application up to and including the date of the request according to Rule 41 becomes part of the file of the divisional application.

(4)
Le contenu du dossier de la demande de brevet européen antérieure jusqu'à la date de la requête selon la règle 41 incluse devient partie intégrante du dossier de la demande divisionnaire.

(5)
Vor dem Erhalt des europäischen Recherchenberichts darf der Anmelder die Beschreibung, Ansprüche oder Zeichnungen der Teilanmeldung nur am Tag der Einreichung der Teilanmeldung ändern. Der erweiterte europäische Recherchenbericht wird dann auf der Grundlage der geänderten Unterlagen erstellt. Regel 68 (4) gilt entsprechend.

(5)
Before receiving the European search report, the applicant may amend the description, claims or drawings of the divisional application only on the day the applicant files the divisional application. The extend European search report will then be established based on the amended documents. Rule 68(4) shall apply mutatis mutandis.

(5)
Avant de recevoir le rapport de recherche européenne, le demandeur ne peut modifier la description, les revendications ou les dessins de la demande divisionnaire que le jour du dépôt de la demande divisionnaire par le demandeur. Le rapport de recherche européenne étendu sera alors établi sur la base des documents modifiés. La règle 68, paragraphe 4, s'applique mutatis mutandis.

(36)
Die Anmeldegebühr und die Recherchegebühr sind für die Teilanmeldung innerhalb eines Monats nach ihrer Einreichung zu entrichten. Wird die Anmeldegebühr oder die Recherchegebühr nicht rechtzeitig entrichtet, so gilt die Anmeldung als zurückgenommen. Sofern die Anmeldegebühr für die frühere europäische Patentanmeldung wirksam entrichtet worden ist, ist Regel 38 (2) für die Teilanmeldung nicht anwendbar.

(36)
The filing fee and search fee shall be paid within one month of filing the divisional application. If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn. Provided that the filing fee of the earlier application has been validly paid, Rule 38(2) does not apply to the divisional application.

(36)
La taxe de dépôt et la taxe de recherche doivent être acquittées dans un délai d'un mois à compter du dépôt de la demande divisionnaire. Si la taxe de dépôt ou la taxe de recherche n'est pas acquittée dans les délais, la demande est réputée retirée. Pour autant que la taxe de dépôt de la demande antérieure ait été valablement payée, la règle 38(2) ne s'applique pas à la demande divisionnaire.

(47)
Die Benennungsgebühr ist innerhalb von sechs Monaten nach dem Tag zu entrichten, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts zu der Teilanmeldung hingewiesen worden ist. Regel 39 Absätze 2 und 3 ist anzuwenden.

(47)
The designation fee shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application. Rule 39, paragraphs 2 and 3, shall apply.

(47)
La taxe de désignation doit être acquittée dans un délai de six mois à compter de la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne établi pour la demande divisionnaire. La règle 39, paragraphes 2 et 3, est applicable.

An extension of periods and further measures taken to handle the Covid-19 situation

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To prevent consequences of the outbreak of Covid-19 for the users of the EPC and the PCT systems, the EPO took measures to extend deadlines. A first notice dated 15 March 2020 regarding extension under Rule 134 EPC was issued. Said notice was pre-released on 15 March 2020 and subsequently amended on 17 March 2020. The amended version was subsequently published in the Official Journal of March 2020. Subsequent notices were issued, extending the deadlines until 2 June 2020. Both versions of the initial notice defined extension in a different way leading to a different day of commencement of the extension.

This contribution analyses both versions of the initial notice in view of consequences for the users of the EPC and the PCT systems. A short summary of other extensions and remedies for missed time limits is also given. Also, an overview of measures taken by the EPO to handle the Covid-19 situation is presented. Finally, a short indication with references of measures taken by the WIPO, the USPTO and the JPO is also given.

1. Introduction

Covid-19 and measures taken to contain the virus caused a significant disruption in a calendar of the European Patent Office (EPO). The pre-EQE and the main EQE scheduled in March were cancelled. The Boards of Appeal of the EPO stopped from conducting oral proceedings from 16 March 2020 until 27 March 2020 and subsequently until 17 April 2020, then until 30 April 2020 and, finally, until 15 May 2020. All events organised in March, April and May were postponed.

Finally, due to an outbreak of Covid-19 in Germany, the EPO took measures within its power to extend any periods by operation of law. The EPO released a first notice dated 15 March 2020 which allowed for automatic extension of time limits.

2. The notice on extension of periods

On Sunday, 15 March 2020, a Notice from the European Patent Office dated 15 March 2020 concerning the dis-

ruptions due to the Covid-19 outbreak appeared on the EPO's website. The fact that the notice was made available on a weekend, i.e. when the EPO is closed for business, says something about the importance of this notice.

The notice released on 15th of March informed that periods under the EPC:

*"... expiring on or after the **date of the publication** of this notice are extended for all parties and their representatives to 17 April 2020".*

As the legal basis, Rule 134(2) and (5) were indicated.

By invoking Article 150(2) EPC, the notice indicated that the above-mentioned extension was applicable also for international applications made under the Patent Cooperation Treaty (PCT).

2.1. Legal principle

As explained in the Special Edition OJ EPO 5/2007:

*"In practice, the EPO has applied a liberal practice seeing interruption as equivalent with dislocations. Thus, if one means of transmission is interrupted, the EPO has accepted this as a dislocation and applied Rule 85 EPC 1973 (Rule 134 EPC 2000). **It is hardly conceivable that all means of communication fail at the same time. On the other hand, one has to consider that forcing an applicant to use alternative means of communication might imply higher fees for the applicant.**"*

Thereby, extension under Rule 134(2) EPC offers extension of periods effective not only for delays in filing made via mail service, but also made using other forms of communication, including electronic CMS system. For application of Rule 134(2) EPC no request is needed as the extension is granted by operation of law.¹

¹ As confirmed in J11/88, hn.2 (CLBA III.D.1.3.2) It follows that no motion is needed for obtaining extension and no decision is issued in this regard.

Indication that extension is applicable to, both, parties and their representatives is needed in view of the fact that either or both the party and its representative may be affected by a dislocation resulting from the Covid-19 pandemic.

Extension of a time limit leads to a legal situation in which all actions made during an extended time limit are considered to be made in time.² Therefore, extension under Rule 134(2)-(4) EPC should be applicable to payments since extension of periods under Rule 134(1) EPC is.³ Following principle established in J4/91⁴, due dates under Rule 51 are extendable to the first working day (under Rule 134(1) EPC) and, thus, extension under Rule 134(2) EPC should also be applicable to renewal fees.⁵

2.2. Date of commencement and the end of any dislocation

Under Rule 134(3) EPC, the EPO is obliged to publish, both, date of commencement of a dislocation of mail and the end of this dislocation.

Following usual practice, the notice was made available in advance (i.e. pre-released) on the EPO website

"...merely as a courtesy to the public. Only the text subsequently published in the officially certified PDF file of the OJ is authentic"

What is more, *"It cannot be guaranteed that this advance version accurately replicates that text."*

The end of dislocation was *expressis verbis* indicated in the notice and, hence, there was no room for wrong interpretation. However, the date of commencement was indicated as the date of publication of this notice and this date was not understood uniformly.

Specifically, there were many interpretations saying that the date of the notice or date of making this notice available on the website in a pre-released version is the date of commencement. This led to a conclusion that periods expiring between 15 March 2020 and 17 April 2020 were extended by the notice.

However, as indicated in the very beginning of the notice, the fact that this notice was made available on the website was a courtesy and only publication in the Official Journal is authentic.

² Term "time limit" in the context used herein is equivalent to "period" as defined in J18/04, CLBA III.D.1.

³ In view of principle established in J1/81, CLBA III.D.1.3.1, Guidelines for Examination in the EPO, edition November 2019, A-X, 6.1, despite that J1/81 refers to payment by cheques (i.e. a method of payment abolished by the EPO starting from 1 April 2008, OJ 2007, 11, p. 626).

⁴ CLBA III.D.1.4.1.

⁵ This interpretation is confirmed in OJ EPO 2020, A38 and is discussed further in this article.

It follows that a correct interpretation of the notice in its version made available on 15th of March should be that periods expiring between the publication date in the Official Journal in March and 17 April 2020 were extended under Rule 134(2) EPC. It should be noted that date of publication of the OJ was not known at the time when the pre-released version of the notice was made available on the website.

Within two days said notice was amended to:

"Periods expiring on or after the date of this Notice are thus extended for all parties and their representatives to 17 April 2020."

Said amendment cleared any discrepancies in interpretation of the date of commencement and actually extended applicability of extension made under Rule 134(2) EPC. Since the date of the Notice is 15th of March, period was specified as from 15 March to 17 April 2020. This version was published with the Official Journal on 31 March 2020.

2.3. Extension of periods for the payment of fees

The issue of due dates for renewals was addressed by a different notice dated 30 March.⁶ This notice was also made available in a pre-released version on EPO's website. This notice was not published in the Official Journal in March and appeared in the April issue of the Official Journal.

Said notice confirmed that extension under Rule 134 EPC applies *mutatis mutandis* to due dates for renewal fees under Rule 51 EPC. It follows that due dates falling due on 31 March 2020 were deferred to 20 April 2020. It should be noted that extension affecting due dates for payment of renewal fees under Rule 51(1) EPC will lead to aggregate periods in case of 6-month periods under Rule 51(2) EPC.

The EPO has also decided that the increase of fees entering force on 1 April 2020 would not apply to payments effected on or after 1 April 2020 in respect of fees with a due date on or before 31 March 2020 or for which the period for payment expired on that date.⁷

2.4. Patent applications and patents affected by the extension

There is no doubt that extension under Rule 134(2) EPC is applicable to European patent applications and

⁶ Notice from the European Patent Office dated 30 March 2020 concerning the extension of periods for the payment of fees, published in the Official Journal OJ EPO 2020, A38.

⁷ See point 7 in OJ EPO 2020, A38.

European patents. The matter is not so clear when it comes to the International applications filed under the PCT.

Interaction between the EPC and the PCT is covered by Article 150 EPC. Specifically, Article 150(2) EPC establishes three main principles and they are:

- PCT applications can be subject of the proceedings before the EPO,
- EPC provisions are to be used as a supplement to the PCT provisions, and
- PCT provisions prevail over EPC provisions in case of conflict.

The fact that PCT applications can be subject to the proceedings before the EPO grants the EPO the right to process PCT applications. In other words, this principle delimits the jurisdiction of the EPO. The second and third principles are delimiting the applicable law to these proceedings. Specifically, the EPC provisions can be used unless there is a conflict between the PCT and the EPC provisions as, in case of conflict, only PCT provisions can be applied.

In case of Rule 134(2) EPC there is a conflict with the PCT provisions. Specifically, Rule 80.5 PCT offers extension in cases when mail is not delivered.⁸ Thereby, this extension is not applicable to PCT applications in the international phase. However, since the PCT does not have procedural provisions for the regional phase, the extension applies to EURO-PCT applications.

3. Other extensions and remedies before the EPO

Irrespectively of the extension provided by the notice, the EPC offers various ways leading to extension of periods or to remedy periods which were missed.

One of ways is to invoke late receipt of documents by the EPO under Rule 133 EPC.

Another way is to file a motion for extension under Rule 134(5) EPC when it can be proven that within any of the then days preceding the date on which time limit expires there was a dislocation of mail. Extension under this rule is also applicable to payments. Although, in case of payments, remedy is possible only if a payment was ordered within five days following banks resumed business (see OJ EPO 2015, A61).

⁸ It seems that there is no conflict with other extensions / remedies available under the PCT. Specifically, Rule 82.1 PCT pertains to delay or loss in mail and requires evidence for substantiation of request for excuse of a missed time limit. Hence, Rule 82.1 PCT is not equivalent to Rule 134(2) EPC as Rule 134(2) EPC does not require filing of a request. Rule 82bis.2 PCT allows for the use of national remedies to missed time limits and so its provision is different than for Rule 134(2) EPC. Rule 82quater PCT allows excuse of delays in meeting time limits and also requires evidence. Thereby, Rule 82quater PCT does not allow a missed time limits to be excused by operation of law. Thus, Rule 82quater PCT is not equivalent to Rule 134(2) EPC.

One of the most reliable remedies is further processing under Art. 121 EPC as it requires making a suitable payment within a two-month period following notification of loss of rights. If further processing is not available then a request for re-establishment of rights under Art. 122 EPC can be made. For entry into the European phase under Rule 159(1) EPC, both, further processing and re-establishment can be available.

4. Further measures taken by the EPO to handle the Covid-19 situation

The EPO has not stopped with the above-mentioned extension and implemented a series of additional measures to ensure its continuous operation while still preventing further spreading of the virus.

4.1. Electronic filing

Use of electronic filing is continuously provided and encouraged as it is currently more reliable than the use of regular mail. Additionally, definition of "DOCX" was provided⁹ enabling users to benefit from further reduction of filing fee.¹⁰

4.2. Oral proceedings and introduction of videoconferences

Essential part of the procedure before the EPO is respecting parties right to be heard embodied *inter alia* by a possibility to have oral proceedings. In this regard, a further measure taken by the EPO to prevent spreading of Covid-19 is the possibility (requirement) to conduct oral proceedings by videoconference..

Oral proceedings at the EPO's premises are still possible upon request of the parties. During such oral proceedings strict sanitary measures will be put in place and include physical distancing and the requirement of wearing a face mask.

Oral proceedings by videoconference allow for remote connection of members of a division from different locations as well as participation of applicants and representatives from different locations. Oral proceedings held by a videoconference are equivalent to oral proceedings held at the EPO's premises. Submissions during oral proceedings and interviews preferably are to be made by e-mail. There are differences in manner of conducting of oral proceedings by videoconference at different stages of procedure. This will be summarised further below.

Examination

In examination, oral proceedings are to be held by videoconference unless there are serious reasons against it, e.g.

⁹ See OJ EPO 2020, A45 for the definition.

¹⁰ Reduction was envisaged in decision of the Administrative Council published in OJ EPO 2019, A3.

taking of evidence.¹¹ Since oral proceedings are not public, no special arrangements are needed for the members of the public.

Additionally, interviews in examination are also to be held by videoconference.

Opposition

The EPO initiated a pilot project for oral proceedings by videoconference before opposition divisions.¹² The pilot project will run until 30 April 2021. At the same time, regular oral proceedings were postponed until 14 September 2020.

The requirement for participation in this project is agreement of all parties and the opposition division. Admission of the public is possible upon giving prior notice to the EPO.

Similar to examination, taking of evidence may not be made during oral proceedings held by a videoconference. Although not specifically mentioned in the notice, it is also expected that simultaneous translations may not be possible. For these cases, oral proceedings will be held at the EPO's premises.

Appeal

Videoconferences were also introduced into appeal proceedings.¹³ Again, the requirement is consent of all parties for conducting oral proceedings by a videoconference.

Members of the public wishing to participate in oral proceedings held by a videoconference will, however, have to travel to the premises of the Boards of Appeal in Haar, where after passing screening questionnaire, they will be allowed to use a dedicated room equipped for participation in the videoconference. Also, members of the public will have to give a prior notice to the EPO that they are planning to attend as there will be a limited number of seats available.

There is no information on whether taking of evidence will be possible while conducting oral proceedings by videoconference in appeal proceedings.

5. Reference to information regarding postponement in the proceedings before the WIPO, the USPTO and the JPO

The Covid-19 situation affected not only proceedings before the EPO but also other major jurisdictions were affected.

The World Intellectual Property Office (WIPO) released a statement which suggests interpretation of Covid-19 disruption as equal to *force majeure* and also recommended receiving offices to waive late payment fees.¹⁴ The WIPO has also made available the COVID-19 IP Policy Tracker to inform about measures taken by IP offices around the world to prevent disruption caused by Covid-19.¹⁵ It is advisable to consult said tracker for information regarding payment of annuities in every country.¹⁶

The Japanese Patent Office (JPO) prepared information on handling of procedures affected by Covid-19 and provided certain measure to help applicants.¹⁷ The JPO offers a relief period of 14 day for completing of procedures affected by Covid-19 situation.¹⁸

The United States Patent and Trademark Office (USPTO) also released notices regarding Covid-19.¹⁹ Notice available at the USPTO webpage informs that extension covers period from 27 March 2020 to 31 May 2020.²⁰

6. Summary

The Notice from the European Patent Office dated 15 March 2020 concerning the disruptions due to the Covid-19 outbreak in its pre-released version had unclearly defined date of commencement of extension. On the other hand, the published and, thus, binding version was clear.

The extension provided by the notice is applicable to PCT applications but only in the regional phase before the EPO.

The EPO introduced the requirement to conduct oral proceedings by a videoconference in examination proceedings, and the possibility to do so in opposition and appeal proceedings. Electronic filing now supports "DOCX" files.

The WIPO offers the COVID-19 IP Policy Tracker for tracking measures taken in different countries to prevent disruption caused by the virus. The JPO announced a relief period for completing procedures and the USPTO announced extension of periods.

¹¹ See decision of the President of the EPO published in OJ EPO 2020, A39 and notice published in OJ EPO 2020, A40.

¹² See OJ EPO 2020, A41 and A42.

¹³ See communication Oral proceedings before the Boards of Appeal – restrictions due to the coronavirus (COVID-19) pandemic and introduction of video-conferencing technology in appeal proceedings dated 15 May 2020.

¹⁴ https://www.wipo.int/pct/en/news/2020/news_0009.html, accessed on 16 May 2020.

¹⁵ <https://www.wipo.int/covid19-policy-tracker/#/covid19-policy-tracker/ipo-operations>, accessed on 16 May 2020.

¹⁶ For example, deadlines for payment of annuities in Austria are not extended while said deadlines are extended in the UK.

¹⁷ https://www.jpo.go.jp/e/news/koho/saigai/covid19_procedures.html and https://www.jpo.go.jp/e/system/laws/rule/other/patent/hatumei_reigai.html, accessed on 16 May 2020.

¹⁸ For overseas residents this period is either 1 or 2 months, depending on type of procedure.

¹⁹ <https://www.uspto.gov/coronavirus>, accessed on 16 May 2020.

²⁰ <https://www.uspto.gov/sites/default/files/documents/Patents-Notice-CARES-Act-2020-04.pdf>, accessed on 17 May 2020.



Case Law

Admissibility of new arguments based on already on file prior art refused by Board of Appeal: Exception or the Rule?

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The following is a report on an appeal T1691/17-3.2.01 of 2019. The procedure may be indicative of a decision-making practice in relation to the application of the new Rules of Procedure of the Boards of Appeal (RPBA 2020) with regard to the admissibility of new arguments, namely Art. 12 (2) (4) RPBA. If such a procedure, as reported here, should be considered now as the rule then this could have tremendous consequences of the course for future oral proceedings in oppositions.

Im Folgenden wird über eine Beschwerde T1691/17-3.2.01 aus dem Jahr 2019 berichtet. Das Verfahren ist möglicherweise für eine Entscheidungspraxis kennzeichnend, wie die Beschwerdekammer die neue Verfahrensordnung der Beschwerdekammern (VOBK 2020) im Zusammenhang mit der Zulässigkeit von neuen Argumenten, nämlich Art. 12 (2) (4) VOBK, anwenden kann. Sollte nun ein solches Verfahren wie hier berichtet als Regel werden, könnte dies durchaus enorme Konsequenzen für den Verlauf von zukünftigen mündlichen Verhandlung in Einspruchssachen haben.

Ci-après est fait le rapport d'un recours T1691/17-3.2.01 décidé en 2019. La procédure est éventuellement caractéristique d'une manière typique dont la chambre de recours peut appliquer le nouveau Règlement de Procédure des Chambres de Recours (RPCR 2020) en ce qui concerne la recevabilité de nouveaux arguments, à savoir l'article 12 (2) (4) RPCR. Si une telle procédure devait être considérée maintenant comme la règle alors cela pourrait avoir d'énormes conséquences sur le cours de futures procédures orales en oppositions.

Present paper is focused on a specific procedural act, namely if some novelty and/or inventive step attacks based on prior art documents can be held inadmissible on appeal despite the fact that both the documents on which the attacks are based had already been submitted and those grounds had already been raised and held admissible in the procedure before the Opposition Division.

The relevant facts of the appeal T1691/17 can be summarized as follows. Two oppositions were filed against EP2459416B1.

- Opponent 1 submitted 7 prior art documents (D11 till D71) and raised several grounds for opposition including lack of novelty and inventive step.
- Opponent 2 submitted 6 prior art documents (D21 till D62) and also raised several grounds for opposition including lack of novelty and inventive step.
- Proprietor filed 14 auxiliary requests in time before oral proceeding and an auxiliary request 15 a week before the take place of the oral proceeding.
- At oral proceeding, the main request of the proprietor was considered as not fulfilling the EPC. The Proprietor filed a new auxiliary request 16, replacing auxiliary request 1 on file, based on a new claim 1 modified during oral proceeding by introducing some features from the description.
- Auxiliary request 16 was further modified in the course of the oral proceeding by adding more features from the description resulting in a further auxiliary request 17.
- Opponent 1 raised against that last auxiliary request 17 a novelty objection based on D11 and inventive step objections based on D11 alone or D11 + D21
- Opponent 2 raised against that last auxiliary request 17 a novelty objection based on D12 and inventive step objection based on D22 + D32.
- The European patent was finally maintained by the Opposition Division based on that auxiliary request 17.

An appeal was filed against the decision of the opposition division based on the following grounds.

- Novelty objection based on D32;
- Several inventive step objections based on D32 + D12, D32 + D21 and D21 alone.

At the oral proceedings, the Board of Appeal considered those attacks as “new alleged facts” and exercised its

discretion pursuant to Art. 12 (4) RPBA not to admit the novelty attack based on D32, as well as all inventive step attacks. The reason put forward by the Board was that those attacks against the last filed auxiliary request 17 had not been raised in the opposition proceedings. The decision was taken without analysing any of the new attacks in substance.

If the procedure as outlined above should become the rule for Boards of Appeal then this will inevitably have clear consequences on the way oral proceedings before the Opposition Division will be conducted. Indeed it is often difficult to well appreciate, in the rather very short time left at oral proceeding in oppositions, which of the attacks may be the best once the proprietor has filed a new auxiliary request – particularly when it is based on some amendment adding features taken from the description. And the opponent will then have no other choice than to raise all possible meaningful attacks prior to the closure of the proceedings before the Opposition Division. In the present case, it would have been simply safer if any possible novelty attacks as well as inventive step attacks would have been raised. This would mean here that up to 12 novelty attacks (one document was used by both opponents) and almost 80 inventive steps attacks would have had to be made! The duration of the oral proceeding would then have been extended by quite some more hours considering that each attack may take a minimum of 5 to 15 minutes! I highly doubt that this is in line with some procedural economy.

In this context it is instructive to have a look at the explanatory remarks to the new Art. 12 (2) RPBA 2020¹. There is explained how the word “objection” as used in Art. 12 (2) RPBA 2020 should be understood i.e. which objections should finally be admissible on appeal. It does not refer only to a ground for opposition but should also cover *what is sometimes referred to by Boards or parties as a “line of attack”*. Present reported case may be just an example how appeal can be “limited” by the Board of Appeal in line with those explanatory remarks to the new RPBA. All that raises also the question how new attacks have to be classified i.e. as new facts, objections, arguments or evidence. As we have seen, in present case the Board of Appeal has considered the new lines of attacks as new facts while it would seem more appropriate to treat them as new arguments. Such a distinction is not purely academic but may have a clear consequence if one follows case law T 668/16². There is clearly stated that Art. 114 (2) EPC (defining subject-matter the EPO may disregard) refers only to facts and evidence but not to arguments. It is the more astonishing that Art. 12 (4) RPBA 2020 does not make any such difference!

¹ [http://documents.epo.org/projects/babylon/eponet.nsf/0/A6E82330B5DC1C8BC12583320044C6D4/\\$FILE/RPBA_for_user_conference_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/A6E82330B5DC1C8BC12583320044C6D4/$FILE/RPBA_for_user_conference_en.pdf)

² Author thanks M. Thesen for the indication of that case law together with some discussion about the possible difference between arguments and facts or evidence the EPC still makes.

It seems to the author also important to keep in mind how appeals in the different member states are processed. It is understandable if some discrepancy is present between general procedures of the EPO Board of Appeal and those from corresponding Boards of Appeals of the member states. However, what if the evolution of the practice of the new rules of the EPO Board of Appeal goes in a clearly opposite direction from that of the Board of Appeals of some member states? This is particularly striking considering that the Bundespatentgericht acting as the appeal instance for opposition procedures in Germany is obliged to even admit new grounds of opposition³. By the way, a similar procedure seems to be applied by the Boards of Appeal of the EUIPO for *whom an appeal constitutes a second instance which is called upon to reassess the substance of a case, without any restriction*⁴. A stricter approach of the appeal procedure, as the EPO Board of Appeal may now possibly apply, allowing to diminish the time appeals may take is welcome. However, this should by no means be to the detriment of the quality of the appeal⁵.

- 3 BGH, X ZB 1/16, Ventileinrichtung; In this case law was decided by the Federal Court of Justice (Germany) that the appeal is a fully instance where the substance of the case should be reassessed, see paragraph 37.
 4 Judgement of 13 March 2007, OHIM v Kaul, C-29/05, EU:C:2005:29, see paragraph 36.
 5 See also „Get your Act Together“ from M. Thesen, **epi** Information 03/2019, 8.

For the sake of completeness, it should be added that in the explanatory remarks at Art. 12 (2) RPBA 2020 is also indicated that the Enlarged Board of Appeal decisions G9/91 and G10/91 continue to apply. If really so, then the Board of Appeal should nevertheless continue to consider already available information which *prima facie* would seem to prejudice the maintenance of the opposed European patent.

Finally, if the presented case is not an exception but really symptomatic of some very strict approach applied by the EPO Board of Appeal, and the author's assessment about *prima facie* relevancy of prior art already on file is correct, then it seems to the author legitimate to ask how the community may possibly react if patents are maintained on appeal despite *prima facie* relevant prior art on file at opposition not even being examined on appeal only based on some procedural reasons? This could eventually undermine the credibility of the whole EPC system.

Who is the notional business person?

M. Fischer (DE)

In the daily routine of a technology company, it is not an uncommon situation that engineers complain that their business managers lack an understanding of the technology but that their expectations, often expressed in form of requirements specifications, are quite high. Vice-versa, managers criticise that engineers do not have any understanding for the business aspects of the company. Interestingly enough and for a couple of years now, this situation also exists in the jurisprudence of the Boards of Appeal. There, however, the situation is purely fictitious and the lack of mutual understanding is explicitly desired since it is assumed that both live and act in completely different spheres. Since the concept of the notional business person has since then evolved in a series of decisions, it is worthwhile having a closer look at this fictitious person.

T1463/11: While the person skilled in the art has always been there, the notional business person now enters the stage for the first time

The COMVIK approach, which is commonly used by the Boards of Appeal when dealing with claims having a mix of technical and non-technical features, requires that the non-technical features must be disregarded in the assessment of inventive step. As a consequence, the non-technical features “may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met” (**T641/00**). In other words, the non-technical features may be used for the formulation of the objective technical problem that is given to the person skilled in the art in order to solve it. Maybe the wording “may legitimately appear” should be formulated as “should appear” or even “must

appear” because putting the non-technical features into the problem avoids that they can contribute to the solution. However, once the non-technical features are in the problem, the technical solution thereto may appear obvious, as it happened in **T641/00**. The question may arise whether a problem is still an “objective *technical* problem” since it contains nothing more than business requirements. The answer to this question is yes, since the precise problem is to implement the business requirements *with technical means*.

In decision **T1463/11** (CardinalCommerce) of 29 November 2016, Board 3.5.01 introduced for the first time an antagonist to the person skilled in the art, namely the “notional business person”. To come to a balanced assessment of the claims, the Board arguably held it expedient to reflect the interaction between technical and non-technical features also on a personal level. The purpose of this fictitious person is to be very cautious which requirements may be used in the formulation of the objective technical problem, i.e. “what requirements the business person can actually give to the technically skilled person.

Naturally, any requirement that is purely a business matter can be included. The business person can formulate requirements such as, “Move the money from the payer’s account to the payee’s account”, but in the normal course of things, the business person will not include any technical matter. In the real world, there might be circumstances under which a business person might require some particular technology be used. A real business person is not unaware of technology and might, for example, say “We should do this on the internet” or “Let’s do this by wireless”, or “We have a lot of XXXX processors, please use them to implement my business idea.”

However, in the assessment of inventive step, the business person is just as fictional as the skilled person of Article 56 EPC. The notion of the skilled person is an artificial one; that is the price paid for an objective assessment. So it is too with the business person, who represents an abstraction or shorthand for a separation of business considerations from technical aspects. A real business person, a real technically-skilled person, or a real inventor does not hold such considerations separately from one another.

Thus, the notional business person might not do things a real business person would. He would not require the use of the internet, wireless, or XXXX processors. This approach ensures that, in line with the COMVIK principle, all the technical matter, including known or even notorious matter, is considered for obviousness and can contribute to inventive step.

The Board went on to say that, on the other hand, in contrast to the real business person the notional business person is free of “business prejudices”, i.e. business prejudices can be incorporated into the problem so that they do not contribute in the assessment of inventive step.

Returning for a moment from the fictitious world of business person and skilled person back to the real world which offers a series of job pairs having a similar antagonistic relationship: Cook / Food Chemist, Fashion designer / Textile engineer, Architect / Construction engineer, Florist / Gardener, Florist / Plant geneticist. In each case, both deal with the same subject matter, but have a different view on it. Although they see the world through different glasses (or different filters), they have a certain knowledge of the other’s world and do not live in completely disjoint spheres such as person skilled in the art and the notional business person. While in the series of job pairs above the first deals with non-technical, mostly aesthetic aspects, the second deals with the technical aspects. Let us recall that according to Art. 52 (2) (b) EPC “aesthetic creations” are excluded from patentability and are considered to be non-technical. This means that also in this field, the COMVIK approach is to be applied, which again means that aesthetic features cannot contribute to the inventive step. Although the claims tend to be purely technically formulated and a mix of technical and non-technical features is less likely to be experienced or less problematic than in the field of business methods. For the next royal wedding, a florist providing floral arrangements may ask a plant geneticist to create a new genetically-modified flower having exactly the extravagant colour of the bride’s wedding dress. A cook may ask a food chemist to create pasta which tastes like cheesecake. A claim providing a solution to these problems will certainly have technical features. And should an aesthetic creation, for example a garment, simply look fancy but not provide a technical effect, it can still be protected by design models leading me to the conclusion that Art. 52 (2) (b) EPC is an interface between patent law and design model law.

T630/11: Applying the new caselaw but without success

In **T630/11** (Waterleaf) of 13.07.2017, the applicant wanted to make use of the relatively new notional business person caselaw and put forward that the non-technical requirements should not be formulated in such a way as to have “technical implications”. The patent application related to on-line gaming and proposed that, to reduce waiting times for gamblers seeking to join a game, waiting gamblers from several on-line casinos should be pooled to provide the minimum number necessary to make up a new game. The solution to this was to provide an additional

“gaming server” which operates the game amongst the pooled gamblers and distributes wins and losses to the gamblers’ accounts at their home casinos. According to the applicant the non-technical requirements are to be framed as “to find more gamblers to reduce waiting times” and not “to pool gamblers between casinos” because the latter would have technical implications because it would require modifications to the servers and networks implementing the on-line games.

By this argumentation, the applicant overstretched the argumentation of **T1463/11** and did not find the consent of the Board. Rather, the Board clarified that the notional business person may formulate a problem that requires something which has technical implications. It argued that the difference between requiring technical means on the one hand and requiring something which has technical implications on the other hand becomes clear when looking at the following example:

“A reader or author or publisher might form a desire to make a second copy of a particular book. Now, a book is certainly a technical artefact, but it is also an art object. The reader who wants to give the book as a gift is not concerned with technical issues. He can think of the book and formulate his desire purely in terms of the book as art object. To fulfill the desire, something technical will have to happen. Thus, he requires something which has technical implications. That is not an impediment under the CardinalCommerce approach.”

Put differently, non-technical requirements (which do not contribute to inventive step) can be formulated in such a way as to require technical implementation as long as they do not constrain how that technical implementation is achieved, as might be done, for example, if specific (even notoriously known) technical features are required.

T144/11: The implementation-type problem is not always the end. It may just be the beginning

It belongs to the COMVIK approach like a tank belongs to war and is equally powerful against and unpopular with applicants. The implementation-type problem, which is simply a problem of the type “implement [the business requirement]”, is the Examiner’s weapon of choice if he identifies some non-technical features, preferably business-related features, in the claim. In **T144/11** (SATO) of 14 August 2018 it was held that a problem of the type “implement [the business requirement]” will normally never lead to an allowable claim. Either the implementation will be obvious or have no technical effect, or if not, the implementation will have a technical effect that can be used to reformulate the problem essentially to “achieve [the effect of the implementation]”.

However, the implementation-type problem is just a starting point that might have to be modified when the implementation is considered. It helps when a technical problem is not apparent at the outset. Examining the business requirements carefully and correctly establishing what is to be implemented ensures that all technical matter arising from the idea of the invention and its implementation is taken into account for inventive step.

T1082/13: A small step back: the notional business person is not completely technically blind

In **T1082/13** (SAP) dated 31.01.2019 it was held that the notional business person knows all about the business related requirements specification and knows about the fact that such business related concepts can be implemented on a computer system. The choice of where to do a calculation in a distributed system is not necessarily technical, but can also be driven by administrative considerations. What the notional business person does not know, however, is how exactly it can be implemented on a computer system. This is in the sphere of the technical expert and subject to the assessment of inventive step.

When referring to prejudices, it has to be carefully analysed, whether it is actually a technical prejudice or, in fact, a business prejudice (e.g. just a new way of organising a business transaction that goes against traditional ways of organising it). As mentioned above, a business prejudice must not contribute to the assessment of inventive step.

T2455/13: Non-technically specified modules are not helpful

In the latest decision of sequel of decisions developing the concept of the notional business person, **T 2455/13** (Swiss Reinsurance) of 29 January 2020, Board 3.5.01 held that also the non-technical person has knowledge of the possibilities of a realisation of business-related concepts on network-based computer systems. He knew at the priority date a plurality of computer and network based business processes (e.g. in the domain of payment processes, materials logistics and also insurance business), to have an idea of what is feasible conceptually on an abstract meta level. What the non-technical person does not know is how exactly an implementation is done on the computer. This is within the sphere of the programmer and must be taken into account in the assessment of inventive step (cf. **T1082/13**, reason 4.8). If features are merely specified on an abstract meta level as modules and represent functions that the non-technical person would take as a basis in his concept, then this cannot be considered to anticipate any technical features. Only by the indication of real implementation steps in the claim, these modules qualify as technical features.

The Board found that neither claim 1 nor the application documents as a whole show how a technical implementation should be done which could form the basis for an inventive technical contribution. Filtering unit, weighting module, databases and analysis module are only specified on an abstract meta level as “modules”, without their technical structure being explained in detail. This means that even potentially technical features become void or empty unless they are sufficiently technically specified. Needless to say that a not further technically specified “module” evokes the impression that it is purely conventional making an argumentation in favour of inventive step difficult.

T1749/14: More than a straight-forward 1:1 programming of an abstract business idea

In this brandnew decision **T1749/14** (MAXIM) of 3 April 2020, the Board acknowledged that the invention required “a new infrastructure, new devices and a new protocol involving technical considerations linked to the modified devices and their capabilities as well as security relevant modifications to the previously known mobile POS (point of sale) infrastructure”. The notional business person would not know how to exactly implement that invention on a computer. The Board acknowledged that they cannot be sure that the features which have been considered to be non-technical or not contributing to inventive step have been searched which led the Board to the order to remit the case for further prosecution. The *ratio decidendi* stated that “the assessment of inventive step will have to consider all the technical features and their respective technical effects”. While the new Rules of Procedure (RPBA2020) aim at reducing the number of cases to be remitted, this case fell under the “special reasons” exception (Art. 11).

Outlook and Conclusion

Although the numbers of patent applications in the field of blockchain have increased a lot, to the authors knowledge no decisions by the Boards of Appeal relating to this technology have been issued so far. It is only a matter of time until they come and it will be interesting to see how the concept of COMVIK will be applied to this technology.

The author is sometimes asked what the concept of the notional business person is all about and whether or not the concept of the notional business person is something positive for the applicant. A diplomatic answer to this question is that this concept is neither positive nor negative for the applicant but simply tries to apply the highest level of objectivity and separation between technical and non-technical features in the assessment of inventive step. However, it is not a secret, and backed-up by statistics, that when we open the COMVIK discussion, analyse technical and non-technical features and the notional business person enters the stage, the chances of obtaining a patent are not the best before the Boards of Appeal. To avoid this discussion, the patent application should be drafted as technically as possible, non-technical and in particular business jargon is to be avoided or clearly characterised as an application domain of a technical solution. Once a claim has been drafted and potentially non-technical features are still in it, a patent attorney should strive to divest the claim of its non-technical features to bring to light its technicality.

Nächster Redaktionsschluss für epi Information	Next deadline for epi Information	Prochaine date limite pour epi Information
Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der epi Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse editorialcommittee@patentepi.org bis spätestens 13. Juli 2020 .	The Editorial Committee invites contributions for publication in the next issue of epi Information. Documents for publication or any enquiry should be sent by eMail to (editorialcommittee@patentepi.org) no later than 13 July 2020 .	La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d' epi Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (editorialcommittee@patentepi.org) au plus tard le 30 juillet 2020 .
Weitere Informationen finden Sie in unseren „Guidelines for Authors“ auf der epi Webseite: https://patentepi.org/r/guidelines-epi-info	Further information can be found in our “Guidelines for Authors” here: https://patentepi.org/r/guidelines-epi-info	De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse : https:// patentepi.org/r/guidelines-epi-info



Book Review

Topic-Related Index to the EPC and PCT Quick Reference for Daily Practice, EQE Paper D and Pre-Exam

Cees Mulder – Helze Publisher – 1st Edition, 307 pages, April 2020

N. Blokhuis (NL)

Every once in a while every European Patent Attorney is confronted with a legal issue which does not come up on a regular basis in his or her practice, either related to a particular case or invoked by questions of a trainee who is studying for the EQE. When looking into the respective legal issue, figuring out where to look for the information sometimes takes almost the same time as studying the issue itself.



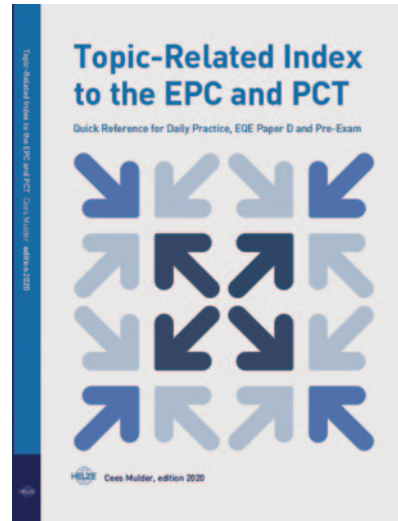
Nyske Blokhuis

This new book of Cees Mulder helps to significantly speed up this process, for EPC related issues as well as for PCT related issues.

In the *Topic-Related Index to the EPC and PCT*, he has brought all the relevant information together in a practical and accessible manner. The main body of the book contains tables with keywords followed by the legal provisions (EPC, PCT or Paris Convention) and the relevant finding place in the EPO Guidelines, PCT Applicant's Guide and other reference texts. In the book, twelve main topics have been chosen around which a detailed reference guide has been built. The tables follow the structure of the EPC in a logical manner from filing to grant and for post-grant proceedings. For each relevant PCT topic, it is indicated how the EPO acts as intergovernmental organisation in the international phase as well as after entry in the regional phase. In addition, the relevant decisions/opinions of the Enlarged Board of Appeal are indicated in the tables. Comprehensive keyword indexes provide an easy access to the relevant topics.

The book is not only helpful for the daily work of patent attorneys, it also is a complete study guide for preparing for the legal questions part of the Pre- Exam and Paper D of the European Qualifying Examination. The book helps the candidates to study topic-by-topic in a structured manner. In addition, the book contains a time schedule allowing a structured study of the topics in regular time intervals. And of course the book is also helpful as a quick reference index during the pre-exam and the main EQE.

All in all, in my opinion this is a useful tool for practising European Patent Attorneys as well as for trainees.



Proceedings Before the European Patent Office – A Practical Guide to Success in Opposition and Appeal

Marcus O. Müller and Cees A.M. Mulder – 2nd Edition April 2020

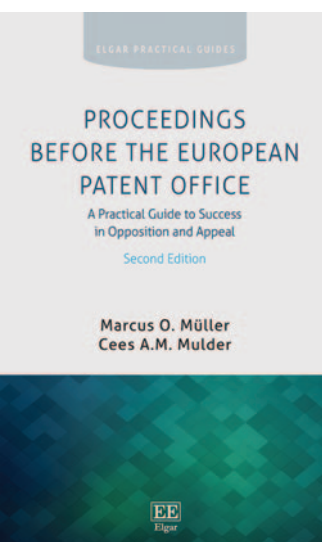
H. J. Brookhuis (NL), I. de Grave-Wolterink (NL)

The outcome of the new Rules of Procedure of the Boards of Appeal is one of the triggers for the second edition of this book. The book explains the rules and, more importantly, presents the practical consequences of these new rules. The reader learns that the impact goes well beyond the actual Appeal and Opposition Proceedings as it permeates into the process of drafting and prosecuting a patent application.

The authors have adopted an easy-to-read style that navigates between the legal framework and daily reality. Summarized practical examples serve to illustrate each issue. There is no need to read the entire book in one go. The book is well-structured and one can easily find information on a topic of interest.

The book clearly is not just a textbook on Opposition and Appeal. It

is highly informative on the entire process of obtaining enforceable patents, defending them, or attacking them effectively. This makes the book an interesting read not only for those patent attorneys that are or will be involved in future opposition and appeal proceedings, but for anyone having an interest in this field. We would not hesitate to include clients, outside counsel, attorneys-at-law, and even EPO staff as potential readers who could benefit from this book.



Hendrik Jan Brookhuis



Isabelle de Grave-Wolterink



Educational events

epi Training and Seminars during restrictions to due Coronavirus (COVID 19)

Epi has cancelled all **epi** educational events until August 2020. The **epi** is closely monitoring the present situation with the Coronavirus (COVID 19) and will continue to react quickly where and when necessary.

For the moment, we observe the situation for all events in September and beyond. As the situation is not predictable and it would be too early to speculate, we advise participants registered for these events to book travel and accommodation on flexible conditions. Should it become necessary to cancel further **epi** events, registration fees already paid for these events will be reimbursed.

We would like to offer trainings for our members also in this times and are working on the establishment of online trainings.

All **epi** Members and **epi** Students will be informed as soon as these offers are available.

epi Tutorial is continuing

EQE candidates can register for the **epi** Tutorial to prepare for the EQE.

During the **epi** Tutorial you get your individual feedback on papers Pre-Examination/A/B/C/D whenever you need it during your preparation for the EQE

- Sign up for a tutorial whenever you want
- Decide which paper you want to prepare
- Arrange individually with an experience **epi** Tutor:
- Discuss the result of your paper(s) with your **epi** Tutor online

All detailed information and registration is available on the **epi** website.

CEIPI

Kursangebot zur Europäischen Eignungsprüfung (EEP) 2021

Für die EEP 2021 organisiert das CEIPI ein umfassendes Kursprogramm auf der Basis von hochwertigem, exklusiv verwendetem Unterrichtsmaterial:

I Seminar zur Vorbereitung auf die EEP Vorprüfung 2021 vom 9. bis 13. November 2020 in Strasbourg
Anmeldung bis 25.09.2020
Gebühr: 1 700 €*

II. Intensivkurs „Probeproofung“ für die EEP Vorprüfung 2021 am 21. und 22. Januar 2021 in München
Gezielte Vorbereitung auf die Praxis der EEP durch zwei Probeproofungen
Anmeldung bis 09.12.2020
Gebühr: 750 €*

III. Einführende „Methodik“-Kurse für die Aufgaben A+B, C und D der EEP Hauptprüfung 2021 in Paris
Kurs A+B: 18. September 2020
Kurs C: 19. September 2020
Kurs D: 16. – 17. September 2020
Anmeldung bis 17.07.2020
Gebühr: Kurs A+B oder C: 600 €, Kurs D: 900 €. Jeder Kurs (A+B, C, D) kann einzeln besucht werden.

Einführende Methodikkurse werden in Paris zeitgleich auch in englischer und französischer Sprache angeboten.

IV. Seminare zur Vorbereitung auf die Aufgaben A+B, C und D der EEP Hauptprüfung 2021 in Strasbourg
Aufgaben A+B und C: 26. bis 30. Oktober 2020
Aufgabe D: 16. bis 20. November 2020
Anmeldung bis 11.09.2020
Gebühr: 1 700 € für Seminar ABC bzw. D*
Teil A+B oder C können einzeln belegt werden, Gebühr je 875 €*

V. Booster course: Aufgabe C bestehen am 26. und 27. Oktober 2020 in Strasbourg
Überwindung spezifischer Schwierigkeiten bei der Bearbeitung der Aufgabe C
Anmeldung bis 11.09.2020
Gebühr: 850 € (inklusive C-Book)

VI. Intensivkurse „Probeproofung“ für die Aufgaben A+B, C und D der EEP Hauptprüfung 2021 in München
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Gebühr pro Kurs: 750 €*

**Ein reduzierter Package-Preis gilt für Teilnehmer, die sich jeweils für das gesamte CEIPI-Kursangebot für eine oder mehrere Prüfungsaufgaben anmelden.*

Weitere Informationen im ABl. EPA 4/2020 bzw. unter www.ceipi.edu oder telefonisch unter: 0033 3 68 85 83 13



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Committee Reports

Notice from the Professional Conduct Committee

Oral Proceedings by videoconference during the Covid-19 pandemic and beyond

G. Checcacci (IT), Chair

Whether we like it or not, videoconferencing will be a very common format for Oral Proceedings (OPs), at least for a while.

When using this format, the usual provisions for OPs continue to apply. In particular Art. 116(3) EPC (OPs before the Receiving Section and the Examination Divisions are not public) as well as the Notices of the Vice-Presidents DG 2 & 3 dated 25 February 1986, OJ 1986 page 63, and dated 16 July 2007, OJ 2007 Special Edition no. 3, page 117 (no recording of Oral Proceedings is permitted) remain fully applicable.

Since the videoconferencing format allows limited possibilities of control by the Chairman or as a result of the technology used, it is more than ever our responsibility as professional representatives to ensure that these provisions are complied with, in line with the basic principle of our profession defined in the Regulation on Discipline, Art. 1,

and with the specific obligations vis-à-vis the EPO defined in the Code of Conduct, Art. 6.

Moreover it should be understood as a duty of any professional representative to arrange for internet connectivity and IT tools suitable to ensure that clients' interests are properly served (Art. 4 of the Code of Conduct) when OPs are held as videoconferences.

More generally in relation to the Covid-19 pandemic, it seems useful to remind Members that our duty towards clients includes having emergency plans ready to safeguard their interests in the event we are prevented from exercising our profession: this is provided by our Code of Conduct, at Art. 1(d). In view of the present pandemic, we recommend making sure that our emergency plans remain operative even under such challenging conditions. This is particularly important for those who work in very small businesses, or as sole practitioners.



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Next Board and Council Meetings

Board Meetings

109th Board Meeting on 29 May 2020 via Videoconferencing System

Council Meetings

88th e-Council meeting on 29 June 2020 via Videoconferencing System

89th Council meeting on 14 November 2020 in Ljubljana (SI) – to be confirmed

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