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Information

Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

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Report from the 90th Council Meeting

Cover:
Icon #9 Jimi Hendrix
This picture painted by
Mr. Hans-Rainer Jaenichen
(European Patent Attorney, DE)
was part of the **epi** Artists
Exhibition 2018 at the EPO, Munich

Dr. Hans-Rainer Jaenichen

Dr. Hans-Rainer Jaenichen is a molecular biologist; a German patent attorney; and a Professional Representative before the EPO. Since 1990, he has been a partner in the Munich law firm Vossius & Partner. In the course of his work as a patent attorney, he has prepared numerous lectures and publications on IP topics. He is a co-author of the book "From Clones to Claims"[1] which considers case law of the EPO Boards of Appeal in the field of genetic engineering and pharmaceutical inventions. Since he was a teenager, he has made pencil drawings, oil paintings, posters, photographs and, in later years, digital films and slide shows on varied subjects. In 2013, he started painting oil paintings again which are a reminiscence of his 1970s posters painted on cardboard with tempera colours and which show and depict pop and rock star idols. The painting shown on the cover of this issue of **epi** Information is entitled "Icon #9, Jimi Hendrix" and is part of a new series of paintings.

Dr. Hans-Rainer Jaenichen ist Molekularbiologe sowie deutscher Patentanwalt und zugelassener Vertreter beim EPA. Seit 1990 ist er Partner in der Kanzlei Vossius & Partner. Im Rahmen seiner Tätigkeit als Patentanwalt hat er zahlreiche Vorträge und Veröffentlichungen zu Themen des gewerblichen Rechtsschutzes gestaltet und ist Co-Autor des Buches „From Clones to Claims"[1] über die Rechtsprechung der Beschwerdekammern des EPA im Bereich der gentechnologischen und pharmazeutischen Erfindungen verfasst. Er hat seit seiner Jugend Bleistiftzeichnungen, Ölbilder, Plakate, Fotos und später digitale Filme und Diashows zu vielseitigen Themen angefertigt. Ab 2013 hat er wieder begonnen Ölbilder zu malen, die eine Reminiszenz sind an seine in den 70er Jahren auf Karton mit Temperafarben gemalten Plakate, die Pop- und Rockstar-Idole zeigten und zeigen. Das auf der Titelseite dieser Ausgabe gezeigte Bild hat den Titel „Icon #9, Jimi Hendrix" und ist Teil einer neuen Serie von Bildern, die ab 2013 entstanden sind.

Dr. Hans-Rainer Jaenichen est biologiste moléculaire, conseil en brevets allemand et mandataire en brevets européens. Il est associé du cabinet munichois Vossius & Partner depuis 1990. Dans le cadre de son activité de conseil en brevets, il a donné des conférences et publié de nombreux articles sur des questions de propriété intellectuelle. Il est l'un des auteurs du livre « From Clones to Claims »[1] qui concerne la jurisprudence des chambres de recours de l'OEB dans le domaine du génie génétique et des inventions pharmaceutiques. Depuis sa jeunesse, il a réalisé des dessins au crayon, des peintures à l'huile, des affiches, des photographies, puis des films numériques et des diaporamas sur des sujets variés. En 2013, il s'est remis à peindre des tableaux à l'huile, rappelant ses affiches des années 70, peintes sur carton avec des peintures à la détrempe, qui mettaient en scène et représentaient les stars de la pop et du rock qui étaient ses idoles. La peinture présentée en couverture de ce numéro s'intitule « Icône #9, Jimi Hendrix » et fait partie d'une nouvelle série de tableaux créés depuis de 2013.

1 "An Encyclopedia of the European Patent Office's Case Law on the Patentability of Biotechnology Inventions with a Comparison to the United States and Japanese Practice" published by Heymanns Verlag GmbH (ISBN-13: 978-3452279996)

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"Our house is burning and we are looking elsewhere"

M. Névant (FR), Editorial Committee

Former French President Jacques Chirac started his speech with these words during the 2002 Earth Summit in Johannesburg. Already fifteen years earlier, the Australian band "Midnight Oil" released a song called "Beds are burning", the chorus of which says "How can we dance when our earth is turning, How do we sleep while our beds are burning?".

Marc Névant

At a time when the pandemic has fostered digitalization and changed in many ways how we organize our daily life – including work – is it so clear cut that the "new normal" that is promised to us will have a beneficial impact on the environment? Nothing is less certain.

According to the think tank "The Shift Project"[1], the energy consumption of digital technologies represented 4% of global greenhouse gas emissions before the pandemic and was increasing at a rate of 9% a year. It is now expected that said energy consumption will have doubled by 2025.

The reduction in business travel will of course lead to a decrease in the overall carbon footprint, but this decrease will be at least partially offset by the increased use of digital tools. If remote working and meetings via videoconference become the new standard of life, the organization of work will have to be change substantially and state of the art equipment will have to be provided to meet the requirements of this new standard. In this respect it is interesting to note that the manufacture of a single laptop generates about 100 kg CO2 (i.e., about half the carbon footprint of a roundtrip flight from Paris to Munich), notwithstanding the fact that the components of computers are essentially manufactured and assembled in Asia using fossil fuel-sourced energy. It is generally recognized that the combustion of fossil fuels, especially coal, is a major source of CO2 emissions, and has repercussions on global warming and health. It is also worth bearing in mind that the increased use of digitalized tools implies using more and more servers to store data, each server consisting of thousands of computers which require a large amount of power to run and to keep cool.

The (seemingly unavoidable) forced march toward a quasi-fully digitalized world and its alleged beneficial impact on the environment (which is currently a good selling argument towards stakeholders or shareholders) must not however distract us from other, more important steps, that we, as a society, need to take to meet the objectives agreed upon during the COP21 by the 196 attending parties to the conference, i.e.:

- zero net anthropogenic greenhouse gas emissions to be reached during the second half of the 21st century;
- limit the temperature increase to 1.5°C by the end of the 21st century.

On these wishful thoughts, I hope that you will enjoy reading this issue of **epi** Information and wish you, on behalf of the Editorial Committee, a nice and relaxing summer.

1 https://theshiftproject.org/en/home

Report from the 90th Council Meeting held by videoconference on 8th May 2021

M. Névant (FR)

1/ Meeting opening

President Leyder opened the meeting at 9 am and welcomed all participants. Apologies for absence were noted, a test vote was conducted and scrutineers were appointed.

2/ Introduction of the Executive Director

President Leyder said a few words to introduce Ms. Tatjana Lissak who was recently appointed as Executive Director (see **epi** Information 1/21) and took her position on 1st February 2021. Ms. Lissak also shortly introduced herself: she is an economist by training, has 20 years of professional experience including experience as Executive Director in a subsidiary of the German automotive association.

3/ Adoption of the agenda

The agenda was adopted with two changes, namely the addition of two motions presented by the Dutch delegation. The first motion dealt with the availability, for Council members, of the audit report on the functioning of the Secretariat. The second motion dealt with the role of the Secretary General and the strategic plan of the Institute. Details on these motions are given below.

4/ Adoption of the minutes of the 89th Council meeting – matters arising from said minutes and all previous Council and Board meetings

The minutes of the last Council meeting (C89) were approved. The document listing the action points arising from previous meetings and their status (completed or still on-going) was noted.

5/ Report of the President and Vice-Presidents

President Leyder referred to his report in the accumulated file, which included the activity of both Vice-Presidents. President Leyder also indicated that since the last Council meeting he was informed of three new complaints filed with the Disciplinary Committee – this information being not mentioned in his report.

President Leyder also presented the draft strategic plan of **epi** which revolves around the following goals:

- collaborate with the European Patent Organisation on matters relating to the profession of professional representatives and in particular on disciplinary matters and on the European Qualifying Examination;
- aid in the dissemination of knowledge appertaining to the work of its members;
- promote compliance by its members with the Rules of Professional Conduct, inter alia through the formulation of recommendations;
- liaise as appropriate with the European Patent Organisation and other bodies on all matters relating to industrial property.

Midway through the presentation, Mr. Mulder (NL) raised the concern that the latest version of the By-Laws (BL) was, according to him, incorrect. Mr. Moutard (FR), the Chair of the By-Laws Committee (BLC), explained the sequence of preparation of the different versions of the BL. After a round of exchanges, President Leyder drew the conclusion that there seems to be no up-to-date consolidated version of the BL. The BLC will look into this matter.

Tatjana Lissak, epi Executive Director

Back to the presentation various topics were discussed in particular on the creation of a European Patent Administrator Certificate (EPAC) in collaboration with the EPO, on the grace period (Council members were reminded that **epi** has taken the position that we are against however we could agree if part of a harmonised package), and on diversity (one Council member reported that some US companies no longer work with patent firms which do not implement diversity measures).

6/ Second motion of the Dutch delegation

The second motion was discussed first. The Dutch delegation asked why the audit report on the functioning of the Secretariat was not available to Council members. This report seemed to be the basis for the change in the management of the Secretariat and therefore was a valuable piece of information for Council members. The Dutch delegation thus tabled a motion to have the report made available to Council members.

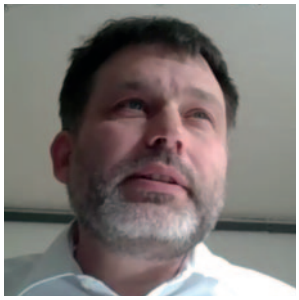
President Leyder, Vice-President Vogelsang-Wenke and Treasurer Thomsen pointed out that data within the report were protected under German law and GDPR. The Presidium asked the Dutch delegation to withdraw their motion otherwise the Presidium would recommend Council to deny it. There were several exchanges of view between Council members and Presidium members on this topic.

The vote on an amended motion took place after the lunch break (to allow the Dutch delegation to amend their motion in the light of the discussion, then to prepare and display the full text of the motion in all 3 official languages). The motion was approved (58 in favour, 53 against, 12 abstentions).

Heike Vogelsang-Wenke, epi Vice-President

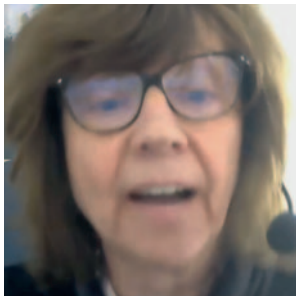
7/ Report of the Deputy Secretary General

The Deputy Secretary General, Ms. Augustyniak, referred to her report in the accumulated file, and briefly highlighted some key achievements in the context of the pandemic, such as the organization of **epi** webinars and of EQE preparation courses). The Deputy Secretary General then presented the 2020 annual report, the content and format of which was substantially changed compared to the report of previous years - with the help of a communication agency. The 2020 annual report was approved (114 in favour, 1 against, 5 abstentions). The Deputy Secretary General also confirmed that the next Council meeting (C91) would be held by videoconference on 13th November 2021, and that the following Council meeting (C92) would normally take place in Glasgow on 7th May 2022.



Peter Thomsen, epi Treasurer

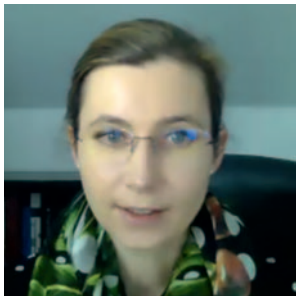
Francis Leyder, epi President



Olga Sirakova, Secretary General

John Gray, OCC Chair

Marc Nevant, Editorial Committee Chair



Magdalena Augustyniak, Deputy Secretary General

8/ First motion of the Dutch delegation

The Dutch delegation was of the opinion that the role of the Secretary General had to be clarified in view of the latest version of the By-Laws (BL) adopted by Council. The motion tabled by the Dutch delegation requested (i) that Article 15 BL be amended to revert back to the wording before the Lisbon Council meeting, and (ii) that the election of a new Secretary General be postponed.

A thorough exchange of views between Council members took place. At the end of the discussion the Dutch delegation withdrew its request.

9/ Presentation of candidates for the position of Secretary General and election of the Secretary General

Two applications were received for the position of Secretary General: Ms. Olga Sirakova (BG) and Mr. Lindsay Casey (IE). Before the presentation began, Mr. Casey announced that he withdrew his application. Ms. Sirakova briefly introduced herself then the vote took place. Ms. Sirakova was elected as new Secretary General (101 in favour, 7 against, 20 abstentions).

10/ Report on financial annual account for 2020

The Annual Financial Report for 2020 has been prepared and reviewed by the external and internal auditors and was discussed with the **epi**-Finances Committee. **epi** concluded 2020 with a positive result of +237 €. The budget as originally approved by Council in C87 was amended in C89 in order to take already into account the envisaged substantial changes that could be predicted because of the pandemic. The amended Budget C89 has a planned surplus of 150 € whereas the original budget C87 had a planned deficit of -91 €.

The Treasurer, Mr; Thomsen, highlighted the fact that Due to the canceled EQE2020, there were almost no new members and the overall income from annual subscription decreased, compared to 2019 by almost 52 €. Income from educational events also drastically went down from 212 € in 2019 to 75 € in 2020. Income from **epi** studentship was higher than expected, mostly due to the fact that the number of candidates for the 2021 EQE increased.

Representation expenses (roughly -143 €) included (i) sending to all members a hard copy of issue 4/20 of **epi** Information, and (ii) signing a contract with an external Communication agency with the aim to assist the Editorial Committee in their efforts to come up with a long-term communication plan and at the same time try to improve the quality of ongoing communication activities and tools.

11/ Report of the epi-Finances Committee

The Chair of the **epi**-Finances Committee, Mr. Quintelier, referred to his report in the accumulated file, in which notably the annual financial report 2020 and the cautious approach adopted by the Treasurer for the running 2021 budget was commended.

12/ Report of the Internal Auditors

The internal auditors, Mr. Conan and Mr. Kley, referred to their report in the accumulated file. The auditors noted that this year's process for preparing and finalizing the Audit was again not satisfactory caused by delays and by repeated necessary corrections on the requested data entries respectively bookings. The internal auditors made some suggestions on bookkeeping, procurement and compliance processes to ensure that invoices, orders and financial claims are practically and timely addressed.

The auditors finally noted that the annual financial accounts comply with the legal German regulation (HGB) and requested that Council agree in one vote:

- to approve of the accounts for 2020,
- to approve the administration of assets,
- the adherence to the planned budget,
- to release the Treasurer from liability for the accounting year 2020.

Council approved this motion (110 in favour, 2 against, 7 abstentions).

13/ Release of members of the Board, and in particular the Treasurer, from liability

The release was adopted by Council (104 in favour, 3 against, 11 abstentions).

14/ Report of the Treasurer

a) The Treasurer, Mr. Thomsen, presented a snapshot of the financial situation at the end of April 21. The situation seems to be in line with what was expected. The income side should normally be boosted in Q3 or Q4 when all candidates having passed the EQE enter the list of professional representatives and pay their subscription fee.

b) The Treasurer then provided an update on a number of topics and on-going projects, including:

- *Project New Accounting 22:* an external accounting expert has been contracted to investigate in detail all financial processes and come up with concrete

Gabriele Leißler-Gerstl, Friedrich Scheele, Scrutineers

proposals how to modernize, improve quality and make the accounting and controlling function more efficient. Results are expected in Q3/4 2021 and are going to be implemented towards 2022.

- *Professional liability insurance (PLI) for members:* The **epi** supported PLI is still available and all previous contracts are renewed upon request of the insured members. There is no minimum premium guarantee by **epi** anymore. However, in order to have a sustainable insurance product, it is necessary to bring down premiums particularly for larger firms to increase the attractiveness of the product.

c) The Treasurer presented a proposal for amendments of the Rules Governing the Annual Subscription (CoD 5.1.1) and Council Decision C70 regarding treatments of double payments (CoD 5.1.6). The proposal was:

- that not-paid annual subscriptions are only owed during 4 years following the year when they were due
- in analogy to R. 13 RRF providing similar terms for fees owed towards EPO
- Interruption in analogy to R. 13(3) RRF not necessary for open annual subscription.

No financial impact was expected as there are only a handful of cases concerned per year. The amended Rules will become effective from 2022 onwards.

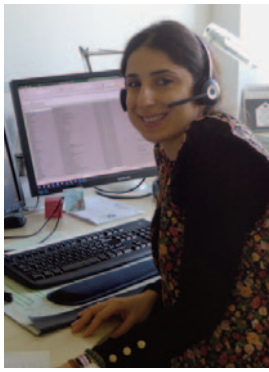
Council approved the proposal (109 in favour, 3 against, 7 abstentions).

Renate Schellenberg, General Manager epi Secretariat

15/ Presentation from the Executive Director

The Executive Director, Ms. Lissak, (i) shared insights on the current operating model of **epi**, and (ii) presented an action plan including objectives and projects.

Concerning (i) the Executive Director detailed all the activities that are currently performed within the Secretariat and the complexity of the operation model due notably to the interaction between the support to the business units (Presidium, Board, Committees) and the many IT tools used to provide said support and to run the functioning of the Institute.



Amélie Faivre, Avan Al Dabbagh, epi Secretariat

Concerning (ii) the Executive Director mentioned that processes and workflows need to be defined so that effectiveness and efficiency is achieved through process compliance, defined responsibilities, clear accountabilities, good cooperation and communication flow, and transparency. The projects for the period 2021-2022 are centered on organisational performance (new accounting system, IT assessment, compliance rules) whereas organisational health will be dealt with starting in 2022 (a RACI matrix will be implemented – RACI stands for Responsible/ Accountable/Consulted/Informed).

16/ Election of Committee Members

Full and/or substitute members of the following Committees were elected (in that order) for the remainder of the 3 year-term that will end in the fall of 2023: Professional Conduct Committee, Litigation Committee, Committee on Biotechnological Inventions, European Patent Practice Committee (main committee), Professional Education Committee, By-Laws Committee.

The detailed and up-to-date composition of these Committees is available on the **epi** website (https://patentepi. org/en/epi-bodies/epi-committees).

17/ Report from Committees

a) The Chair of the Professional Education Committee (PEC), Ms. Gwilt, reported on e-EQE that took place in March and presented the main points of the discussion paper on a possible format for the new, digitalized, EQE (this paper is available on the **epi** website). Since the "new" e-EQE will not be implemented until 2024, the PEC intends to build on the experience of this year's examination to discuss with the EPO what improvements

Susanne Ullmann, epi Secretariat

can be made, e.g. about the format of the papers and the platform/browser used, for next year and for 2023.

There was a discussion within Council on whether a larger consultation within **epi** and interested circles would be needed. The German delegation tabled a motion in this respect, requesting that a conference be organized within a short period of time to discuss the future of the EQE. This motion was approved (70 in favour, 36 against, 8 abstentions).

b) The Chair of the IP Commercialization Committee, Mr. Stöckle, presented draft comments **epi** intends to file on the European Commission's "Intellectual Property Action Plan to support the EU's recovery and resilience" (also known as the "IP Action Plan"). The presentation triggered many comments and suggestions that will be considered and; where appropriate, taken on board in a further draft.

c) The Chair of the Committee on EPO Finances, Mr. Boff, presented what he called a "non-paper" on the possible structural reform to fees, for discussion with the EPO. The aims of the possible reform include a simplification of fee structure, steering applicant behaviour through fee incentives/disincentives, aligning the structure of Euro-direct and (Euro)-PCT fees, improving the cost coverage of certain products and services, support for certain categories of applicants.

d) The Chair of the Studentship Admission Committee, Mr. Mercer, reported that 65 new applications had been approved since November 2020.

e) The Chair of the European Patent Practice Committee, Mr. Mercer, reported that the activity of the Committee essentially focused the past months on the G1/21 referral. Two amicus curiae briefs were prepared and filed on behalf of **epi**, one on the suspected partiality of members of the Enlarged Board of Appeal in its original composition, the other on the substance itself.

f) The Chair of the Professional Conduct Committee, Mr. Checcacci, reported that a final version of the proposed changes to the Code of Conduct should be ready for decision at the next Council meeting. The changes concern, amongst other things, UPC-related activities (see also below).

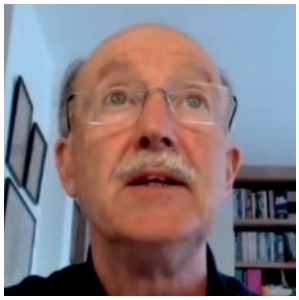
g) The Chair of the Litigation Committee, Mr. Thomsen, reported that discussions were still ongoing with the EPO about the amended version of the Code of Conduct in order to make it ready for a potential future UPC.

18/ Review of decisions and actions and closing of meeting

The Deputy Secretary General listed all decisions made and actions taken during the meeting. President Leyder then thanked the participants and the support team before closing the meeting at 5:45pm. Break-out rooms were opened so that the participants could continue discussing various topics on an informal basis.

Jim Boff,
EPO Finances Chair

Florian Stöckle,
IPCC Chair



Chris Mercer,
EPPC Chair

Giorgio Checcacci,
PCC Chair

Claude Quintelier, Chair
Nominations Committee

epi Artists Exhibition 2021

will take place in a virtual manner

The **epi** Artists Exhibition has become a tradition in the cultural life of **epi**. Opened for the first time in 1991, it was followed by further events in 1994, 1996, 1998, 2000, 2003, 2006, 2009, 2012, 2015 and 2018.

Throughout the years, the Exhibition has taken place in the foyer of the EPO which offered the possibility to present the artworks to a wide audience.

The interesting works on display have ranged from paintings to graphical and fine art works, such as ceramics, sophisticated watches and jewellery, and artistic textile creations.

2021 is the Exhibition's 30th anniversary and our desire is to continue this worthwhile and thought provoking artistic tradition.

Covid 19 restrictions required us to organize the Exhibition in a virtual manner on the **epi** website. We hope that we will be able to provide an adequate platform for all our artists to present their artwork to an even wider audience.

A prerequisite for each Exhibition is a large number of participating artists wishing to present their skills and artworks. Therefore, we hope that the virtual platform proposed this year will encourage even more participants from all the contracting member states.

Accordingly, all creative **epi** members are warmly invited to participate by submitting the application form which can be found here:

https://patentepi.org/r/epi-artists-exhibition-registration

Our intention is to present the artworks and the artists to enable us to appreciate their artistic creativity.

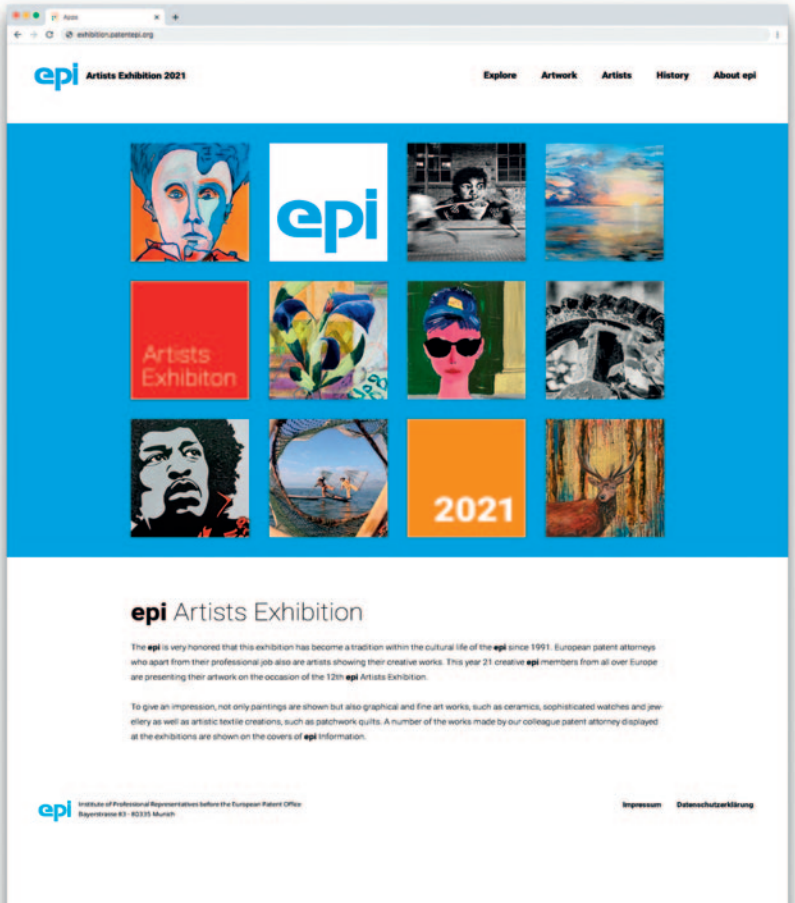
In addition, please submit your brief biography and a photograph together with some background information outlining your inspiration; history of the artwork; and/or the techniques used.

It is intended to have the Exhibition online in October 2021.

We are looking forward to receiving numerous applications to enable us to prepare this unique virtual **epi** Artists Exhibition on its 30th Anniversary.

Further information regarding the requirements for the provision of documents, pictures of artworks and information will follow in due course.

For further questions/information, please contact us at the **epi** Secretariat at info@patentepi.org



Interviews

Interview with John Gray, Chair of the Online Communications Committee

John Gray is a member of the **epi** Council and chair of the Online Communications Committee (OCC). He has over 30 years' experience in the patent attorney profession, working both in-house and in private practice firms of different sizes. Through his own consultancy in Scotland, John provides support to other European patent professionals.

What is the biggest issue for the OCC at present?
Probably the pace of change at the EPO. I've been involved for 3 terms of 3 years, and in that time we have moved from waiting for movement to happen on any issues to having to respond to new initiatives on many fronts. The problem we now have is contributing fast enough. The IT team at the EPO are keen to have user input so our challenge is to provide user feedback promptly – it's a good problem to have, rather than not being able to contribute, which was sometimes the case before.

How often do you get asked for input by the EPO?
There has been one major joint meeting each year of the OCC and the EPO IT and customer service teams. In addition, some of the OCC users are members of e-SACEPO, which meets at least once a year and has in its remit the electronic patent process, so effectively we have face-to-face input twice a year. These meet-

ings give an opportunity to discuss general issues and to check progress on specific topics. In between, we raise issues with the relevant people, especially issues brought to us by members. In the present EPO regime there are several different working parties, projects and pilots, and all **epi** members are encouraged to join these, but we make sure that OCC members are also involved. For example, there are groups directed to Online Filing 2.0, the "Front Office" software for the national offices coordinated with the EPO, and the "New User Area", an overarching platform for users to interact with their EPO mailbox and other services.

Have you had involvement with the increased use of ViCos in oral proceedings?

We provided input into the EPO's adoption of ViCos for oral proceedings at the technical level. Our responsibility is at the technical level, how it works, rather than the political/legal level, and making sure the experience for those taking part by ViCo is as good as it can be. We worked with our colleagues on the European Patent Practice Committee (EPPC) in carrying out the survey of **epi** members, as well as taking part in the mock hearings for EPO Academy. In past years users had trouble persuading the EPO to allow more oral proceedings to take place by ViCo, and the situation has now flipped from the EPO being reluctant to provide ViCo oral proceedings to the EPO now wanting all oral proceedings to be by ViCo, whether a party wants it or not.

John Gray, OCC Chair

How has the pandemic affected the OCC?

The internal processes of the **epi** had to go online, so we helped the **epi**'s own meetings and communications go on-line. I became a Zoom host for **epi** Council meetings! It's been great to work closely with the Secretariat.

How else have you been involved with epi matters?

A sideline has been supporting internal epi functions, for example by assisting the Secretariat in setting up the forums on the **epi** website. I am also a member of the Disciplinary Committee, but fortunately **epi** members are generally well-behaved!

Do you see any conflicts between how large firms and individuals communicate with the EPO?

My mantra, every time we meet with the EPO, is to remind them that they are a monolithic organisation, but that their user base is very diverse, and that all their systems have to work for the sole practitioner, the small firm, and the industrial department, as well as the large attorney firm. The users may include administrative staff as well as attorneys. The EPO often seems to imagine that the representative is sitting alone driving the machine, which is of course not the case. It follows that when a system changes, a large group of administrative staff may need to be trained in the changes.

What do you look for in the EPO's electronic tools?

The systems have to be able to cope with all aspects of the EPC and all the different user groups. We try to be constructive. Our job is to help the EPO do its job, and to help them resolve any problems where it does not work for a group of users, or does not implement some aspect of the EPC properly. If there is something that you cannot do in the online system but you can do legally, then the online system needs to be fixed.

Is there anything on your wish list for the future?

There are probably two things. Firstly, users are frustrated that a new system has not been developed to integrate the EPO and national filing systems, so that people don't have to be trained to use two systems. Secondly, there is still no adequate IT-based safety backup system if your card is not working or the system is down. Most users would prefer not to have to use fax as a back up.

Oh... and a long-felt want is for EPO communications to come to us in encoded form, so that they can be processed more easily and safely.

Any last words?

The role of the OCC chair is an enjoyable one. A lot of good things are happening and moving in the right direction. Our remit concerns the daily practical interactions between the users and the EPO, which promotes a co-operative relationship with our counterparts at the EPO. I never miss an opportunity to praise the EPO's information systems, including the EP register, espacenet and the translation tools, which are invaluable and improving all the time.

Natural language generation and patents: be ready!

Interview with François Veltz, Patent Attorney, Cofounder and C.E.O of qatent.com

Computational linguists and patent attorneys live in different worlds. Say "*hyperonym*", "*hyponym*" or "*meronym*" to a patent attorney, and you are likely to get a dazzled look. Recent news about Natural Language Processing (e.g. about GPT-3) now can raise concerns that the patent world (applicants, attorneys, Offices) is likely to be shaken by new text generation capabilities. Moving away from simple word processing applications, we are soon going to experience more advanced tools, providing a whole new experience for patent claim or application drafting.

What is the qatent project aiming for?

qatent aims at developing intelligent tools to help patent practitioners. The tools make use of the latest generation of Natural Language Processing technology. The project is endorsed and supported by INRIA, a leading research lab in computer science in France. The scientific board is composed of Kim Gerdes, Professor in computational linguistics at Paris-Saclay University, Jean-Marc Deltorn, former patent examiner at the EPO for A.I. inventions and myself, patent attorney with a track record at IBM, Roche, and law firms. Our developers come from China, India, Korea, Algeria, Spain, Germany, and France.

What is text generation?

Text Generation, also called Natural Language Generation (NLG) is a sub-domain of Natural Language Processing (NLP). It aims at producing computer-generated human-readable texts. Texts can be generated based on textual input (summarization, text-to-speech systems, automatic speech recognition (ASR), machine translation) or based on non-textual data such as data-base content, numerical measures, or images.

As a simple example, consider what a spell-checker does: it compares the user input to a dictionary and for an unknown word, proposes the closest variant from the dictionary. When the user accepts the proposed term, the text is in a sense co-written by a machine-encoded knowledge about the language, simple orthographic information in this case. Moving to grammar correction, the task is already more demanding: In order to propose "he *likes* patents" for "he like patents", the machine has to know the grammar and to understand the context in order to propose correct variants. The tool that analyzes the syntactic structure of a sentence is called a parser.

As many scientific domains, NLP has been changed profoundly by Big Data combined with Machine Learning, in particular Deep Learning. The availability of large amounts of electronic texts has allowed to train machines to understand the meaning of words and expressions. The popularization of distributed language representations, so-called word embeddings, in the early 2010s and, more recently, the advent of attention-based models and transformer architectures have opened new avenues for NLP. In this context, the release in open source of BERT by Google in 2018 has substantially accelerated the pace of change. In Natural Language Processing, BERT stands for *Bidirectional Encoder Representations from Transformers*. BERT models have been pre-trained on 800 million words from Google books and 2500 million words from the English *Wikipedia*.

What types of technologies are you using?

We use existing advanced NLP tools, from static word embeddings to contextual attention-based models that allow to exploit the specific structure of patent data. For example, we are using distributed language models that take – amongst other attributes – the technical contexts of occurrences of words into account. We compute CPC-class specific words embeddings which significantly improves the relevance and the precision of the generated language, an essential requirement to assist patent drafting.

How can text generation be used for patent handling?

Once you control or otherwise quantify natural language, a variety of services become possible, for example computer-assisted claim and patent drafting, including automated detection of unclaimed matter in applications (i.e. by comparing claims with the description), terminology suggestion based on general domain specific texts such as published patents or scientific texts, automatic classification, detection and quantification of similarities and plagiarism, various analytic services such as the detection of weak signals in textual time series (for example predicting booming terms or CPC classes), prosecution accelerators, etc. The list of possibilities is long.

At *qatent* we try to help patent attorneys draft their claims and applications.

Our process follows a principle of AI-assisted patent drafting, leaving the human in command. We start from

a first *handcrafted* draft of the claims, which we try to facilitate using different tools (e.g. display of word definitions , suggestions, etc). The generation of the patent application is then *continuously* guided by the patent attorney, based on said claims. You not only have direct access to metrics about the current state of the text, to domain specific dictionaries, to guidelines and case law, but you are also assisted when looking for more specific or more general reformulations of terms and phrases. The editor also helps renumbering and detecting incorrect references to claims and terms, and it allows to easily store and retrieve intermediate versions of the text.

The *qatent* tools encode the patent attorney's know-how and best practices acquired through our collective experience in drafting, in industry and law firms.

Is Natural Language Generation a threat for patents attorneys?
No, it's rather an opportunity.

Drafting claims is an art, it is a compromise between legal, scientific and also business parameters. It will be long before the advent of Artificial General Intelligence, and for any foreseeable future, only patent attorneys are capable of making such arbitrages.

In our perspective, it is very likely that the role of patent attorneys will evolve, but humans will not be replaced by machines, they will be *augmented* by machines, just like in many other domains. At each step of the iterative generation, patent attorneys guide the content generation process and are in full control of the outcome.

What would you envision as the possible new role(s) of patent attorneys?
Backed up by AI, helped by visualization tools and quantitative assessments, patent attorneys will be able to concentrate more on claims (the scope of protection) and less on routine work (copy or annotation of claims in the description, labeling check, etc).

The cognitive tasks are solicited differently. Energy is required and focused on tasks of higher values. Significant parts of the burden can now be outsourced to the machine. When drafting, you have to parse a tree of alternative words. You are continuously challenging your current ideas against parameters or alternatives computed by machine. The cognitive approach is more combinatorial. It's a new dialog between language and science, between humans and machines.

Can you detail more some of the functionalities?
While drafting your claims, you benefit from practical features, such as predictive typing (autocomplete), automatic renumbering of claims, or antecedence check, so that you can focus on higher value tasks.

Continuously, *qatent* suggests word and sentence variants when drafting claims (e.g. based on synonyms, more generic terms, more specific terms, alternatives, or other fallbacks). You are being proposed definitions of terms (extracted from different sources). The system also seamlessly checks for legal issues, as specified in the EPO guidelines or the MPEP (e.g. presence of relative terms, possible clarity objections, etc). As would also probably be useful for the e-EQE, a quick search allows you to search into the Convention at a first level, then in the Guidelines at a second level and then also in Case Law for G, T or J decisions. Prompts are on demand or automatically triggered, based on a set of user-customizable options.

Involving computers at the very heart of the drafting process is justified. Today's patent attorneys still draft applications with a word processing software, which has not evolved for decades. Tomorrow's drafters can take snapshots of intermediate versions, automatically import definitions, request the computer to reformulate a sentence or parts thereof, etc.

With AI-assisted drafting, we may see an increase in the density of content in a same draft. For example, in the generation process, we try to use what we call "*corporate sedimentation*". This can go beyond user-customized templates. For a given vertical, and in line with the 18 months windows, it is conceivable to manage "*evolutive boilerplates*", meaning that precedent inventions can be concisely and recurrently reincorporated. For example, suppose you work in the domain of Human-Machine Interfaces in avionics. Unless disruptive technologies occur (e.g. retina display), you may want to stack the different inventions you have been filing in recent years, and reuse them in combination in subsequent filings.

What about possible future functionalities?
Our roadmap remains open. Neural network technology in NLP is moving fast, and with them the possibilities to apply these technology to patent drafting. We work closely with patent attorneys from various domains and professional contexts.

Depending on the feedback, we may develop tools for patent prosecution, facilitating the answers to official communications. Yet, our main focus will remain on building an efficient assistant in the patent drafting process.

With respect to Wikipedia, can you detail what you are doing a bit more?
Wikipedia is one of many useful resources to build reference language models and to extract specific relationships between technical terms, but our focus is on building specialized language models based on technical texts

such as the corpus of patents itself. We envision to operate on a larger scale, in particular by taking into account scientific publications. What is at stakes is to capture humanity's scientific knowledge, in English and any other language.

What about inventorship, a hot topic in AI-generated inventions?

We have kept close tabs on the recent debates about AI-generated inventions. *qatent* is unaffected by these issues because in our approach the patent claims are *continuously* driven and controlled by human drafters assisted by machine. All generated text is parametrized by humans. *qatent* is a tool and inventors and authors are human beings, thus entitled to patent rights.

What are text generation limits? Can a generated text be novelty destroying or use for assessing inventive step?

The key principle to tackle this question is to know that computer-generated texts now hardly can be discriminated against handcrafted documents, provided texts are kept short. Controlled grammar and generation models can produce coherent texts, which until recently was not truly the case. In the case of long texts, there is no system able to produce semantically relevant texts. The risk of GPT3 producing semantically relevant inventions is low in our view. We bet on a different outcome: AI-assisted human drafting.

François Veltz

As any work produced by a man-machine collaboration, the result can be novelty destroying and used for inventive step attacks, of course.

What about drawings?

Simply put: we do not analyze, generate, interpret or handle drawings. We do not need them, at least for now. From a legal perspective, only words describing images are useful, and used. We do not deny possible advantages of drawings, in particular for readability or intelligibility of the invention, but at least for the time being we do not invest resources into image mining or generation.

What computations are you doing?

Our services are computationally intensive, even if some aspects are handcrafted. Our capital lies in part in computations we have done and continue performing. The substantial resources of the INRIA GPU clusters allow us to compute highly-specialized language models focusing on the specificities of the patent corpus. Computing a large-scale language model requires know-how and tuning.

What are the value propositions of using text generation in IP?

Language models extract deeply embedded insights from large amounts of texts and propose them to the patent attorney, who decides what to do with them. Before filing a patent, you may want to check our suggestions. In doing so, you make sure that you acknowledge relevant options and viable alternatives as identified by the machine and *in fine* optimize the scope of protection. We believe that this will become a *must-check* step.

Natural Language Processing may also lead to a certified *quality insurance system*. Today, both experienced attorneys and trainees are drafting patent applications. A number of errors can subsist, also because peer-review is not always feasible. With assistance systems, a higher level of quality control can be expected

Today's advanced language models not only assist patent attorneys at claim drafting, but provide them with lexical directions to *improve the scope of protection*.

Text generation may also lead to a higher level of "*standardization*" of drafts, which does not necessarily mean poorer or more focused drafts. With tight control on dictionaries and definitions, it may render patent production more homogeneous, or at least less dependent on the talent or the habits of the individual patent attorney. For a given company, the portfolio can also become more consistent for example.

Which impacts of NLP on patent laws can you foresee?

In our opinion, impacts will be numerous and diverse.

One positive consequence is that the "legalese", which is in fact a type of obfuscation, can now be "decoded" by machines. In other words, some parts of sentences that are currently justified by Case Law (such as "*... instructions which when executed by a processor cause said processor to perform the steps of*") may no longer be necessary. Some legalese may end up disappearing which is good news for accessibility to knowledge.

The "density" of prior art is likely to rise in our opinion, as machines will boost quantitative aspects (e.g., quantities of texts being produced). Whether search engines will follow the increase in quantity is an open (and critical) question.

Resorting to a wider range of language variants in the description may also allow to mitigate some of the stringent requirements of Article 123(2) EPC. Take the situation today: if the patent application has not described numerous adjacent developments (i.e. use of lists of words or individualized combinations), the strict "copy and paste" of legal support requirement can lead to a situation which is quite unfair: the inventor brought up something new and possibly inventive, but can hardly deviate from the initial wording. By using text generation, adjacent words can be captured and injected in drafts, thereby expanding the range of alternatives available in the original patent application. During prosecution, if need be, you have fallback options under the hood.

Likewise, claim construction can be objectivized (e.g. quantification of the quality of support, counts of occurrences, etc.)

What technical domains are you handling? Which ones are you not?

All patents are written in natural language and there is no inherent reason to believe that some technical domains will not be accessible to machines, at least to a certain extent. For now, we are generating texts in all IPC classes except C and D. Invention selections and chemical formulas diverge more from all-purpose texts and require specific pre-treatment. We plan to extent our team with a European Patent Attorney and an NLP specialist to handle inventions in the field of chemistry and biology.

What languages are you handling?

For now, we focus on English. If needed, high quality domain specific Neural Machine Translation can provide the final loop of the system, allowing us to ultimately offer our tools in any well-resourced language.

One of our objectives is to get our hands on the substance of technological insights. Most of the available patent and scientific corpora are in English, along Wikipedia dumps and other non-patent literature. We plan to ingest and possibly "digest" Asian scientific content, such as patent texts from China, Japan, and Korea. In other words, what matters is to catch the substance of the scientific ideas.

How do you train your models? Isn't it a risk of cross-learning (between cases)?

Our models are trained independently from any user input. This prevents any possibility of contamination. Each client's drafting experiment remains strictly confidential and does not affect in any way the construction of our models.

Do you intervene on patent claims?

We try to help practitioners writing better claims, by suggesting keywords, by flagging possible clarity issues, etc. The patent attorney has not less but more control over the text and there is no human intervention on our end. Part of our knowledge is hard-coded in generation rules. For the same software release, all users will have the same, user-configurable, experience.

What are your relations with patent offices?

The suite of tools we offer finds applications for patent offices as well as practitioners. In many ways, both parties face similar – or at least related – situations such as the identification of potential irregularities (e.g. in terms of clarity) or facilitating the drafting of communications.

We plan to develop our relationship with patent granting authorities to showcase our products and identify potential avenues for collaboration.

Access to open patent data is of prime importance to the NLP community. Patent granting authorities have already taken the initiative to share a significant portion of their corpora. This is a welcome trend and we would be delighted to cooperate with all the parties involved to be at the forefront this evolution.

What about NLP at the European level?

The computational linguistics community is currently booming everywhere, with some excellence clusters emerging in Europe, Paris being one of them, others are in Prague, Saarbrücken or Edinburgh. We have no doubt that Americans, Chinese and other AI superpowers will grasp the opportunities opened by NLP applied to patents, which in turn might be a game changer for entire industries (e.g. quantum physics, robotics, vaccines).

What are your challenges today?

At the moment, we are focusing on code developments. Challenges today are related to the developments of language models specific for patents and of a smooth user experience with the editor.

In the short term, we are constituting focus groups to test and orient software developments. We are open to investors, in order to accelerate in our roadmap. If you are a decision maker in your industry and are willing to meet us, you are welcome.

When your patent application becomes a "cause célèbre"

Q & A with Steve Howe

Steve Howe is a partner with Reddie & Grose in London. His area of expertise includes telecommunications, video and still image processing, satellite positioning systems, speech encoding and flash memory devices. When not representing clients at the UKIPO and EPO he can be found flying radio controlled model aircraft, riding his Triumph Bonneville motorbike and performing as a magician. He represents the patentee in the case which resulted in the pending referral G 1/21 "Oral proceedings by videoconference".

Many of us in the European patent profession were following the oral proceedings before the Enlarged Board of Appeal (EBA) on 28 May, to find out the answer to the question of whether oral proceedings by video conference can be appointed without the consent of the parties. As representative of the patentee, what were your thoughts about the decision to postpone the oral proceedings until July 2021?

The original request to refer the question to the EBA was first raised by the opponent at the oral proceedings held by video conference on 8 February 2021. The interlocutory decision setting out the question to be referred was issued in mid-March, with the EBA oral proceedings scheduled for 28 May. Around 50 amicus curiae, as well as the comments from the President, were filed in advance of the oral proceedings and whilst these were available from the online register, these were only notified to the parties shortly before the hearing. Although it means a further delay in the proceedings, I think it is right that the parties should have sufficient notice of submissions to be able to consider and respond to these properly. Postponing the oral proceedings by five weeks does appear to balance the rights of the parties to consider submissions without too much additional delay.

What was your reaction to the referral?

We had not expected a request to be made during the oral proceedings before the Board of Appeal to make a referral to the EBA, and we have not been involved actively in the referral. If the question had not been raised in these proceedings, it is almost certain that it would have been raised in some other proceedings instead.

What is your own view on holding oral proceedings by video conference?

There are cases for which holding the oral proceedings in person is more appropriate than holding these by ViCo. I have certainly taken part in oral proceedings where it is useful for the parties to be in the same room. However, for many cases, and especially where all the parties agree to ViCo proceedings, then it can be very useful and efficient. This is especially the case during the present pandemic when travel to attend oral proceedings in person difficult, and therefore ViCo oral proceedings can avoid delays in concluding proceedings.

Thank you. Let's speak again when the EBA gives its final answer.

Patent practice

The modern problem-solution approach

P. de Lange (NL), European patent attorney, V.O. Patents & Trademarks.

1. Introduction

Some forty years after the introduction of the problem-solution approach (PSA),[1] this article aims to provide a brief summary of the modern PSA; the application of which is now expected on the EQE.[2] In particular, whereas the EPO Guidelines describe the PSA as consisting of three steps (in chapter (G-VII, 5), EQE candidates are typically taught to use a PSA consisting of 10 or more steps when sitting Paper C of the EQE.[3] The individual steps of this 'exam-style' PSA or 'modern' PSA will probably be familiar to many European patent attorneys but the overall 10+-step approach cannot be found easily in either the Guidelines or the general literature. The present article aims to fill this gap by providing a concise step-by-step outline of the 10+-step PSA.

I leave open the question of whether the 'exam-style' PSA described herein is relevant for actual patent proceedings before the EPO. However, I note at the outset that the Exam Committee for Paper C consists of both EPO officers and European patent attorneys. Paper C is therefore neither an academic exam nor completely detached from daily practice.

2. The basic steps of the modern PSA

The three main stages of the PSA are A) determining the closest prior art, B) formulating the objective technical problem and C) assessing whether the claimed subject-matter is an obvious solution for that objective technical problem (Guidelines G-VII, 5).

The sub-steps of an inventive step attack as expected for Paper C of the EQE are described below. The steps are for-

1 T 1/80 hn.I of 06.04.1981 (OJ 7/1981 p.206); G. Szabo, '*The problem and solution approach to the inventive step*', EIPR 1986 8(10) p.293-303.
2 The EQE is the European Qualifying Examination for becoming a European patent attorney.
3 The course books for EQE Paper C (drafting an opposition) consulted for this article are: CEIPI course – Chandler and Meinders, *C-book*, 6th ed. 2019 (13 steps, p.137); DeltaPatents course – Hoekstra, *Methodology for Paper C*, 2020 edition (10 steps, p.295); Maastricht course – Blokhuis and Mulder, *Smart in C*, 4th ed. 2020 (12 steps, §13.2).

mulated from the viewpoint of an opponent because the candidate's task is to draft a Notice of opposition in Paper C of the EQE.

A) Identifying the closest prior art

A1) The first step is identifying the aim or purpose of the claimed invention, i.e., the aim (or object or field) of the subject-matter of the claim to be attacked;[4]

A2) Identifying the prior art document[5] having the same aim or purpose as the claimed subject-matter, or at least belonging to the same field. If there is only one such document, this document is the *closest prior art (CPA)*;

A3) If two or more documents are available which have the same aim as the claim to be attacked, the document which forms 'the most promising springboard' to arrive at the claimed subject-matter is selected as the CPA, for instance the document having the most features in common.[6]

Steps A1-A3 are based on Guidelines G-VII, 5.1, §1.

B) Formulating the objective technical problem

B1) Showing which features of the attacked claim are anticipated by the CPA. In other words, a partial novelty attack is presented against the attacked claim. More precisely, a novelty attack based is presented, using the CPA as novelty destroying for some but not all of the claim features. The 'remaining' features which provide for novelty of the claim are the distinguishing features of step B2;

B2) Identifying the feature of the claim which provides for novelty of the claim over the CPA as the *distinguishing feature* of the claim over the CPA (in case of two or more distinguishing features, see §3 below);

B3) Discussing whether the CPA simply lacks the distinguishing feature or if it uses some other feature instead (the latter is important for step B4);

B4) Identifying the *technical effect* that is (actually) achieved by the distinguishing feature (as identified under B2) in comparison to the CPA. This technical effect must also be derivable from the application as filed;[7]

B5) Formulating the *objective technical problem* as 'how to modify the closest prior art to achieve the technical effect' (or, if no technical effect is achieved over the CPA, as 'providing an alternative to the CPA', see §3).

Steps B1-B5 can be derived from Guidelines G-VII, 5.2, §1 and 3.[8]

C) Obviousness

In stage C, it is shown that modifying the CPA with the distinguishing feature is an obvious solution to the objective technical problem in view of a second document (referred to as D2), using the following steps:

C1) Showing that the skilled person trying to solve the objective technical problem would consult the second document D2;

C2) Showing that the second document D2 discloses a feature F which is the same as the distinguishing feature of the attacked claim or a more specific embodiment of the distinguishing feature;

C3) Showing that the second document D2 provides a motivation for the skilled person to apply feature F specifically for solving the objective technical problem, typically by showing that D2 teaches that the feature F solves the objective technical problem;

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C4) Explaining that there are no technical obstacles for applying feature F in the context of the CPA (e.g., no incompatibility of the teachings of D2 and the CPA)[9] and discussing that the skilled person would make any further modifications of the CPA that are required to arrive at the subject-matter of the claim (e.g., make any necessary workshop modifications);

C5) Concluding that the skilled person therefore (*not only could, but would* have modified the CPA with feature F to solve the objective technical problem, showing that the skilled person thereby would have arrived at something falling within the ambit (i.e., subject-matter) of the claim under consideration, and concluding that the claimed subject-matter is therefore obvious and does not involve an inventive step (Article 52 and 56 EPC).

4 DeltaPatents (see fn. 3) p.297, step 1A. See also Müller & Mulder, *Proceedings before the European Patent Office*, 2nd ed., p.43, §3.4.5.

5 I discuss only the case that documents are used as prior art and not, e.g., public prior use or oral disclosures.

6 The Examiner's Reports for 2018 and 2019 indicate that there is often only one prior art document in Paper C having precisely the same purpose as the claim to be attacked. See e.g. Examiner's Report C 2019, page 2, bottom, available in the Compendium for Paper C at https://www.epo.org/learning/eqe/compendium/C.html. The criterion 'having the most relevant technical features in common' is based on Case Law of the Boards of Appeal (CLBA), 9th ed., chapter I.D.3.1.

7 Some Boards prefer first identifying the problem solved by the patent and then identifying the distinguishing features. See e.g. Müller & Mulder (see fn. 4), p.43 and G. Raths, **epi** Information 2/2014 p.68.

8 See also Examiner's Report C 2019, page 3, first paragraph. Chandler states step B5 as follows at the 17th European Patent Judges' Symposium: 'This leads to the formulation of the objective problem that the invention can be considered to solve, which is usually "how to achieve (the effect)"' (OJ 2015, Supplementary Publication 5, p.76).

9 See e.g. Examiner's Report C 2019, page 3, third paragraph.

Step C1 can be derived from Guidelines G-VII, 3, fifth sentence and G-VII, 6, under item (ii).[10] Steps C2-C5 can be derived from Guidelines G-VII, 5.3, §1.

This gives in total 13 steps, each of which can be the subject of debate between parties during opposition proceedings. Step B4 (technical effect) in particular is often the subject of intense debate in chemistry, biotech and pharma cases.

3. Special cases

In the following, I briefly summarize the most important special cases for the PSA.

The PSA is applied in a slightly modified way in the following circumstances:

1) Alternatives. If the distinguishing features do not provide for a technical effect over the prior art, then the objective technical problem is formulated as 'providing an alternative'. Importantly, the claimed subject-matter may still involve an inventive step, namely if it is a non-obvious alternative.

2) Partial problems. If there are two or more distinguishing features, the first question is whether these features are functionally interdependent. If the features are, e.g., a mere aggregation and do not achieve a technical success over and above the sum of their respective individual effects, then the 'partial problem' approach can be used. This has the consequence that steps B4-C4 can be carried out for each distinguishing feature *separately.* If the distinguishing features functionally interact with each other (e.g., their combination provides for a synergistic technical effect), steps B4-C4 are carried out for the features in combination and obviousness must be shown for the features in combination. If the 'partial problems' approach can be applied, it is enough to show obviousness of the individual features, which typically is easier (Guidelines G-VII, 5.2, §8).

3) Comvik approach. It is established case law of the Boards that it is legitimate to have a mix of technical and 'non-technical' features in a claim. Inventive step, however, can be based only on technical features. Non-technical features[11] do not provide a technical contribution to the art and are thus to be ignored in assessing inventive step. This is done by including the non-technical elements in the statement of the objective technical problem (the so-called Comvik approach, T 641/00; G 1/19, r.30-34; Guidelines G-VII, 5.4). A typical case is a claim directed to a computer-implemented method specifying both (non-technical) features reflecting a business concept and (technical) feature pertaining to hardware and software (e.g., a server, a database). Only the latter features are taken into account for inventive step (even if the business concept is innovative). The objective technical problem is accordingly often to be formulated as 'how to implement the business concept' (T 144/11 hn.). Whether the claimed specific technical implementation would have been obvious to the skilled person is subsequently to be assessed in stage C (see also Guidelines G-VII, 5.4.1).

Furthermore, there are three exceptions (or corrections) to the PSA:

1) Problem inventions. The discovery of an unrecognised problem may give rise to patentable subject-matter in spite of the fact that the claimed solution is, retrospectively, trivial and in itself obvious (T 2/83). Since 2010, problem inventions are no longer discussed in Guidelines G-VII, 10 but examples can be found in recent case law at T 764/12 and T 2321/15.

Basically, in step B5, the patentee (or applicant) shows that the skilled person would not have recognized the objective technical problem and therefore would not have looked for a solution, such that the claimed subject-matter is inventive based on the identification of the problem.

2) Bonus effects. Even if the technical effect is unexpected, it might still be the case that it would have been obvious for a skilled person to arrive at something falling within the terms of a claim, having regard to the state of the art. This may occur, for example, due to a lack of alternatives, thereby creating a 'one-way street' situation. In such a case, the unexpected effect is merely a bonus effect that does not confer inventiveness on the claimed subject-matter (Guidelines G-VII, 10.2). To summarize the Guidelines, if the prior art already teaches applying the distinguishing feature F for obtaining advantage X, it is irrelevant when assessing inventive step that the patent teaches that the feature F (also) achieves a different effect Y, irrespective of how surprising effect Y might be. In summary, the 'bonus effect' exception may be invoked for negating inventive step.

3) Multiple starting points. The Guidelines state that in case inventive step is to be denied, 'it is sufficient to show on the basis of one relevant piece of prior art that the claimed subject-matter lacks an inventive step: there is no need to discuss which document is "closest" to the invention; the only relevant question is whether the document used is a feasible starting point for assessing inventive step' (Guidelines G-VII, 5.1). Hence, stage A can be essentially dispensed with if inventive step is to be denied, according to the Guidelines. Stages B and C are however inextricably linked.

10 See also Examiner's Report C 2019, page 3, second paragraph.
11 More precisely: "non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem" (G 1/19, r.30).

4. Concluding remarks

While the present article summarizes the 'modern' or 'exam-style' PSA and the main exceptions, it must be emphasized that further modifications and exceptions can be found in the case law.[12]

Furthermore, precise formulation of the steps is the subject of the ongoing development of the case law. For instance, what exactly constitutes a sufficient motivation to apply a feature in step C3 remains a subject of debate.[13] Accordingly, the present article provided a summary of the 13-step PSA instead of a comprehensive review.

The 13-step PSA may be considered 'modern', as stated in the title of the present article since it is currently used for the EQE. It is therefore at least the 'modern exam-style PSA'. In addition, the 13-step PSA appears to provide for a more structured step-by-step approach to stage B and a more systematic analysis in step C compared to some older applications of the PSA.[14]

Finally, practitioners might be reluctant to use the rather rigid 'exam-style' PSA in opposition proceedings with the EPO, let alone in national court proceedings. Nevertheless, both the EQE course books and the official model solutions[15] provided each year for Paper C show that a model inventive step attack is nowadays expected to include significantly more steps than the three steps discussed in the Guidelines, at least in the exam for becoming a European patent attorney.

12 For instance, a claim directed to a chemical product may derive inventive step from a preparation method described (and possibly also claimed) in the patent which is inventive and allows for preparing the claimed product for the first time, see T 595/90 hn.2. Product claims may also derive inventive step from what the patent teaches as the use of the claimed product (see, e.g., T 939/92 hn.2).

13 G. Wooden, M. Blaseby, D. Visser, *There is no hope in inventive step*, JIPLP, 15(1), p.2-3 (2020).

14 See e.g. Guidelines 2001 C-IV, 9.5 (available at epo.org). Many elements of the current PSA can already be found in G. Szabo, *The Problem and Solution Approach in the European Patent Office* (IIC 1995 p.457). See also R. Teschemacher in **epi** Information 3/1997 p.25; G. Knesch in **epi** Information 3/1994, p.95 and G. Szabo, EIPR 1986 8(10) p.293-303. However, in the modern 'exam-style' PSA, it is clarified that the objective technical problem is usually formulated as 'how to achieve the technical effect ' in step B5.

15 Available in the EPO's Compendium for Paper C (see fn. 6).

Erfinderische Tätigkeit und das Zett-Diagramm

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Die gesetzliche Grundlage

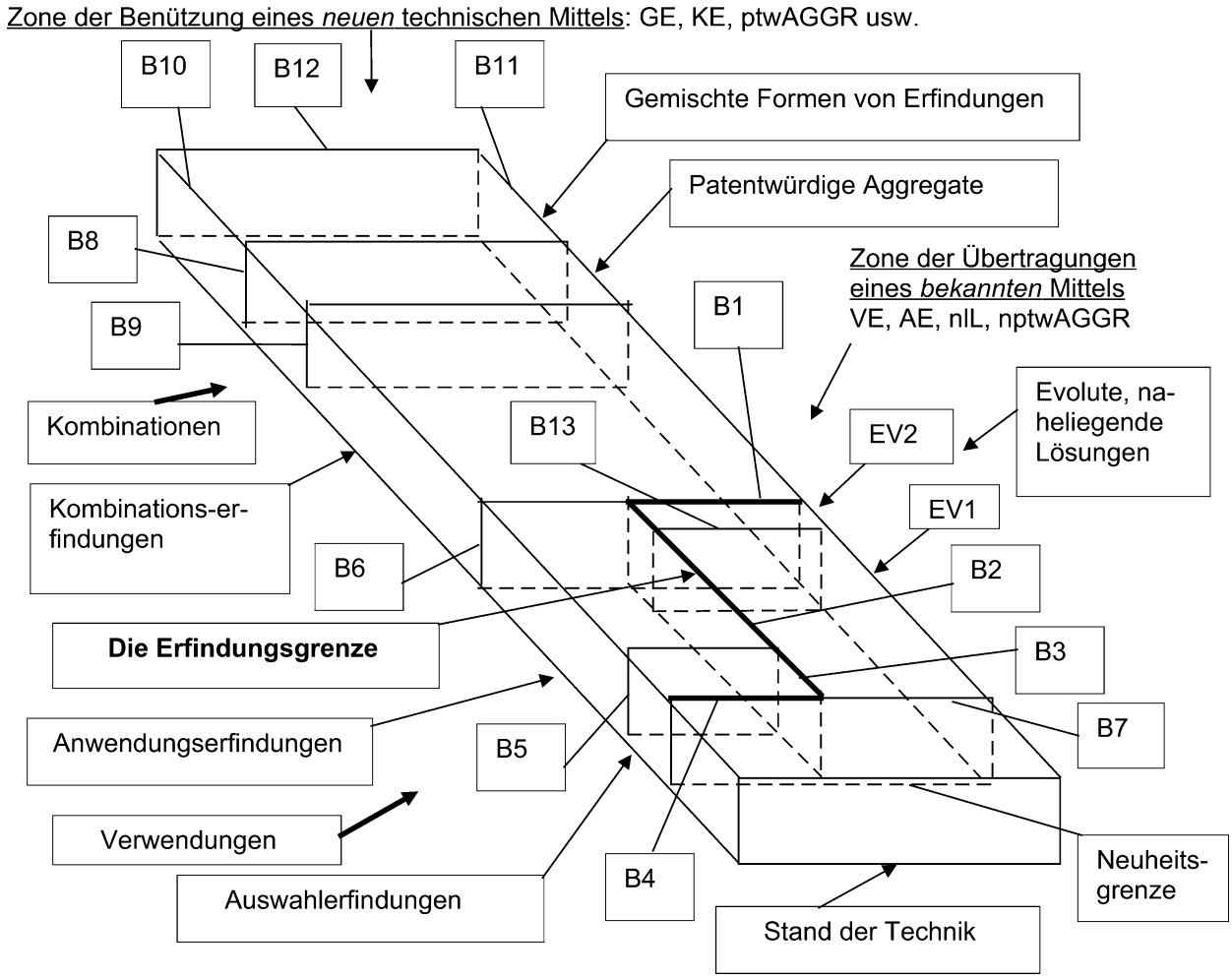
Art. 1, Abs. 2 CH-PatG lautet wie folgt: „Was sich in naheliegender Weise aus dem Stand der Technik ergibt, ist keine patentfähige Erfindung". Wenn man diesen negativen Teil einer Alternative in das Gegenteil umwandelt, bekommt man die folgende Aussage: „Was sich **nicht** in naheliegender Weise aus dem Stand der Technik ergibt, ist **eine** patentfähige Erfindung". Diese alternative Betrachtungsweise erweckt den Eindruck, als wenn die Grenze zwischen den naheliegenden und den nicht naheliegenden neuen Lösungen die Form einer geraden Linie bzw. einer planen Fläche hätte. Diese Ansicht trifft nicht zu.

Wenn die Erfindungen nur Kombinationserfindungen wären, dann könnte die Erfindungsgrenze tatsächlich die Form einer geraden Linie bzw. einer planen Fläche haben. Die Erfindungen könnten oberhalb einer solchen Grenze liegen. Die naheliegenden Lösungen würden unterhalb dieser Grenze liegen. Bei den Erfindungen würde das lösungsgemäss verwendete technische Mittel als neu gelten. Bei den naheliegenden Lösungen würde das lösungsgemäss verwendete technische Mittel als bekannt gelten.

Nur, es gibt auch Erfindungen, die sich eines an sich bekannten technischen Mittels bedienen. Bestimmte solcher Lösungen sind sogar patentwürdig! Sie werden zum Beispiel An- bzw. Verwendungserfindungen, Auswahlerfindungen, Erfindungen der 2. medizinischen Indikation usw. genannt. Unter solchen Umständen steht die lösungsgemässe Verwendung eines bekannten technischen Mittels in solchen Erfindungen und in den naheliegenden Lösungen nebeneinander. Man kann sich vorstellen, dass solche Erfindungen durch eine Linie bzw. durch eine plane Fläche von den naheliegenden Lösungen getrennt sind. Dies ergibt ein balkenartiges Diagramm in Abb. 1, in dem die Erfindungsgrenze eingetragen ist. Die Erfindungsgrenze besteht im dargestellten Fall aus flächenhaften Abschnitten B4 + B3 + B2 + B1. Der Verlauf der Erfindungsgrenze im Balken erinnert an

Das Zett-Diagramm

Lösungen technischer Aufgaben nach ihrer Struktur



Je grösser die Differenz zwischen dem Inhalt des beurteilten Falles und dem Inhalt des nächstliegenden Dokuments des Standes der Technik ist, umso grösser ist der Abstand der betreffenden Lösungsart von der Neuheitsgrenze.
EV1 – neue Verwendung aufgrund einer bekannten Auswirkungsfähigkeit;
EV2 – neue Verwendung aufgrund einer beim verwendeten technischen Mittel zwar neuen jedoch im Voraus kausal ableitbaren Auswirkungsfähigkeit;
GE - gemischte Formen von Erfindungen;
KE – Kombinationserfindungen;
VE - Verwendungserfindungen;
ptwAGGR - patentwürdige Aggregate.
AE - Auswahlerfindungen;
nIL – naheliegende neue Lösungen = Evolute
nptwAGGR - nicht patentwürdige Aggregate;

Die Definition einer naheliegenden Lösung, d. h. eines Evoluts:
„Eine gewerblich anwendbare Lösung einer Aufgabe ergab sich in naheliegender Weise aus dem Stand der Technik, wenn zur Lösung der Aufgabe ein bekanntes technisches Mittel aufgrund einer kausalen Auswirkungsfähigkeit neu verwendet wurde, die sich im Voraus kausal ableiten liess oder die bei diesem Mittel bereits bekannt war."

Abb. 1

den spiegelverkehrt geschriebenen Buchstaben Zett. Deswegen wird dieses Diagramm auch Zett-Diagramm genannt.

Der Stand der Technik

Die vorne bzw. rechts unten liegende Endpartie des Balkens beinhaltet Lösungen des Standes der Technik, der zu einem bestimmten Zeitpunkt bestand. Dieser Stand der Technik wird *relevanter Stand der Technik* genannt. Die genannte Endpartie reicht von der vorne liegenden Stirnfläche des Balkens bis zu einer ersten Querwand im Inneren des Balkens, welche als „Neuheitsgrenze" angeschrieben ist. Diese erste Querwand besteht aus den Teilwänden B4 + B7 und sie ist plan. Diese Querwand B4 + B7 erstreckt sich zwischen den länglichen Seitenwänden B10 und B11 des Balkens. Die Lösungen, die als identisch vorveröffentlicht gelten, liegen im Inneren dieser vorderen Endpartie des Grundkörpers des Balkens, weil sie zum Stand der Technik gehören.

Die erste Querwand B4 + B7 im vorderen Endabschnitt des Balkens stellt die äussere Grenze des Standes der Technik dar, wenn man diese Querwand B4 + B7 aus dem Stand der Technik heraus betrachtet. Wenn man diese erste Querwand B4 + B7 jedoch von der gegenüber liegenden, d. h. von der hinteren Seite derselben her betrachtet, dann stellt diese Querwand B4 + B7 die minimale Neuheitsgrenze für die dahinter liegenden neuen Lösungen von Aufgaben dar.

Lösungen, die sich im übrigen bzw. rückwärtigen Bereich des Balkens, d. h. hinter der Querwand B4 + B7 befinden, weisen eine *Differenz* gegenüber dem nächstliegenden Dokument des Standes der Technik auf. Deswegen gelten solche Lösungen als neu. Je inhaltlich reicher diese Differenz ist, umso grösser ist der Abstand der beurteilten Lösung von der Neuheitsgrenze B4 + B7 innerhalb der übrigen Länge des Balkens.

Die Benützung eines bekannten technischen Mittels

An der vom Stand der Technik abgewandten Seite der Neuheitsgrenze B4 + B7 liegt eine Zone, welche recht komplex gestaltet ist. Eines der kennzeichnenden Merkmale dieser Zone ist, dass die hier angesiedelten Lösungen ein bekanntes technisches Mittel **neu** verwenden. Neu bedeutet, dass das bekannte technische Mittel lösungsgemäss an einem Objekt neuerdings verwendet wird, an dem dieses Mittel bisher noch nicht verwendet wurde. Das bekannte technische Mittel wurde somit auf ein anderes Objekt übertragen und deswegen wird diese Zone hier *Zone der Übertragungen* genannt.

Innerhalb der Übertragungszone befindet sich der mittlere Teil der Erfindungsgrenze, der aus den Wandabschnitten B3 + B2 besteht. Diese Wandabschnitte B3 + B2 liegen in einer gemeinsamen Ebene, die zu den länglichen Seitenwänden B10 und B11 des Balkens parallel verläuft. Dieser Mittelteil B3 + B2 der Erfindungsgrenze erstreckt sich zwischen der Wand der Neuheitsgrenze B4 + B7 und der Stirnwand B1 + B6 dieser Übertragungszone. Der Mittelteil B3 + B2 der Erfindungsgrenze kann auch als eine Längsinnenwand des Balkens genannt werden. Das an der Neuheitsgrenze anliegende Ende der Längsinnenwand B3 + B2 teilt diese erste Querwand des Balkens in die zwei bereits genannten Abschnitte B4 und B7 auf. Der links von der Längsinnenwand B3 + B2 liegende Abschnitt B4 der Neuheitsgrenze endet an der linken länglichen Seitenwand B10 des Balkens. Der rechts liegende Abschnitt B7 der Neuheitsgrenze endet an der rechts liegenden länglichen Seitenwand B11 des Balkens.

Naheliegende Übertragungen = Evolute

Im von der Längsinnenwand B3 + B2 rechts liegenden Teil der Übertragungszone liegen jene neuen Lösungen, welche ein bekanntes technisches Mittel an einem *anderen* Objekt als bisher verwenden, und zwar aufgrund einer bei diesem technischen Mittel *bekannten* kausalen Auswirkungsfähigkeit. Kausale Auswirkungsfähigkeit bedeutet, dass ein technisches Mittel in der Lage ist, an einem Objekt eine Änderung des Zustandes desselben kausal zu bewirken. Solche neuen Lösungen fallen unter alle Merkmale der Definition einer naheliegenden, d. h. einer nicht patentwürdigen Lösung. Deswegen stellen solche Lösungen *keine* Erfindungen dar. Im vorliegenden Text werden solche Lösungen Evolute genannt.

Der Bereich der naheliegenden Lösungen ist vorne und hinten durch die hintereinander liegenden kurzen Querwände B1 und B7 begrenzt. Seitlich ist der Bereich der naheliegenden Lösungen begrenzt links durch die Längsinnenwand B2 + B3 und rechts durch den sich zwischen den kurzen Querwände B1 und B7 erstreckenden Abschnitt der rechts liegenden Seitenlängswand B11 des Balkens. Dieser Bereich der Evolute ist mittels einer kurzen Querwand B13 in zwei Teile unterteilt. Diese Teile heissen Evolut 1 und Evolut 2.

Beim Evolut 1 wird ein bereits bekanntes technisches Mittel auf ein anderes Objekt aufgrund einer bei diesem technischen Mittel bereits bekannten Auswirkungsfähigkeit übertragen. Bekannt im Zusammenhang mit der Auswirkungsfähigkeit bei Evolut 1 bedeutet, dass diese Auswirkungsfähigkeit bei diesem Mittel bereits publiziert wurde.

Beim Evolut 2 wird ein bereits bekanntes technisches Mittel auf ein anderes Objekt aufgrund einer *bei diesem* technischen Mittel noch nicht publizierten Auswirkungsfähigkeit übertragen. Beim Evolut 2 liess sich die Aus-

wirkung des lösungsgemäss benützten bekannten technischen Mittels am anderen Objekt jedoch im Voraus kausal ableiten. Ein solches Beispiel wird im Zusammenhang mit Abb. 2 (Garagenrasen) erläutert.

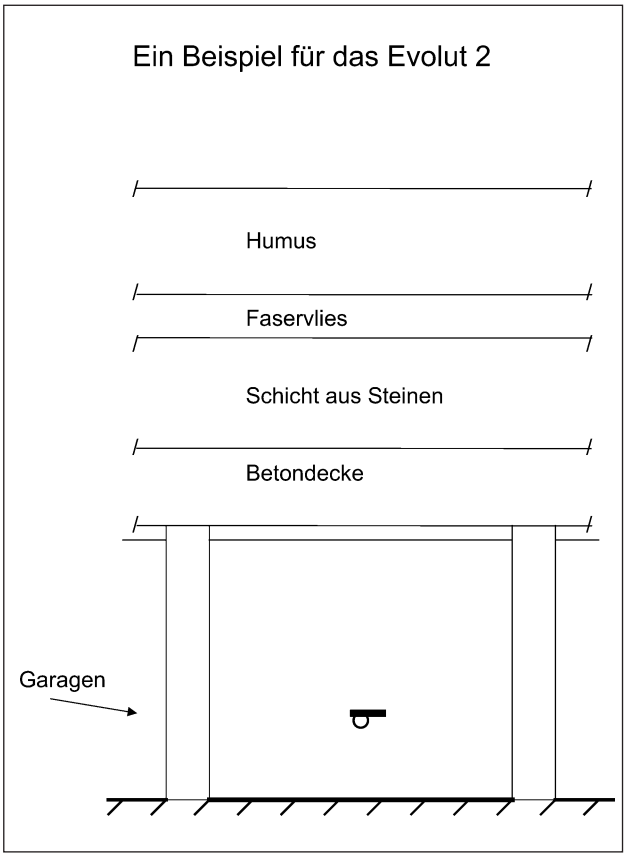


Abb. 2

Zu den Evoluten gehören auch die nicht patentwürdigen Aggregate. Bei nicht patentwürdigen Aggregaten besteht das in der Kennzeichnung eines zweiteiligen Patentanspruchs definierte „technische Mittel" in der Tat zum Beispiel aus zwei technischen Mitteln, von welchen jedes dieser zwei technischen Mittel eine andere Aufgabe löst und an sich ein Evolut ist.

Ein Evolut 2

Der Grundkörper beispielsweise von unterirdischen Garagen besteht normalerweise aus Beton. (Abb. 2) Die Oberfläche der Decke einer Garage kann als Rasenplatz ausgenützt werden. Normalerweise wird auf die Betondecke der Garage eine Schicht aus Steinen angebracht. Auf diese Steinschicht müsste eine Schicht aus Humus kommen, damit hier Gras wachsen kann. Der Rasen muss gesprengt werden und ausserdem regnet es auch. Man überlegte sich, dass Wasser Humus in die Spalte zwischen den Steinen mit der Zeit mitnehmen könnte. Daraus ergab sich die *Aufgabe*, wie verhindert werden kann, dass Wasser Humus in die Spalte zwischen den Steinen mit der Zeit mitnehmen könnte. Das mit einer Unannehmlichkeit behaftete *Objekt* war der Rasenplatz, der seine Humusschicht verlieren konnte.

Das *Unterbewusste* des Aufgabenlösers dachte darüber nach, wie verhindert werden könnte, dass das überschüssige Waser Humus in die Schicht aus Steinen bringen könnte, wobei es möglich sein sollte, dass Wasser durch die Steinschicht dennoch durchfliessen kann. Man erinnerte sich daran, dass Wasser von festen Stoffen mit Hilfe eines Siebes getrennt werden kann. Die ganze Oberfläche der Steinschicht mit einem Metallsieb zuzudecken, dies könnte eine teure Lösung dieser Aufgabe sein. Daraus ergab sich das *Problem*, wie man sich ein kostengünstigeres Trennmittel besorgen könnte. Man erinnerte sich daran, dass es Faservlies aus Kunststoff gibt. Die Abstände zwischen den benachbarten Fasern des Faservlieses sind so klein, dass das Vlies Humus zurückhalten kann, während Wasser durch das Vlies durchfliessen kann. So ist man auf die Idee gekommen, dass die Schicht aus den Kieselsteinen zunächst mit einer Schicht aus Faservlies bedeckt wird, und dass Humus erst auf diese Faservliesschicht gebracht wird.

Diese Lösung der genannten technischen Aufgabe liess sich im folgenden Patentanspruch definieren.
"Rasenplatz auf dem Dach eines Bauwerks, mit einer Schicht aus Steinen, die auf dem Dach des Bauwerkes angebracht ist, und mit einer Humusschicht, die sich über der Steinschicht befindet, dadurch gekennzeichnet, dass zwischen der Schicht aus den Steinen und der Schicht aus Humus Faservlies angeordnet ist."

Unter Faservlies versteht man verfestigte Vliesstoffe aus Stapelfasern und/oder Endlosfasern. Im vorliegenden Fall geht es um die Verwendung eines Glasfaservlieses. Faservlies gilt im vorliegenden Beispiel als das lösungsgemäss *eingesetzte technisches Mittel*. Die *Auswirkungsfähigkeit* dieses technischen Mittels besteht darin, dass das Faservlies Wasser durchfliessen lässt und Humus zurückhält.

Vliesstoffe hat man gemäss dem Stand der Technik mit grossem Erfolg zur Wärme- und Schallisolation in Gebäuden verwendet. In diesem Beispiel wurde Faservlies dagegen als ein Sieb verwendet. Es handelt sich somit um eine *neue* Verwendung eines bekannten technischen Mittels. Aufgrund der offensichtlichen kausalen Verhältnisse in diesem Lösungsganzen konnte man im Voraus ableiten bzw. konnte man sich im Voraus vorstellen, dass das Faservlies Humus von Wasser trennen wird. Deswegen war die Auswirkungsfähigkeit des Faservliesses in diesem neuen Anwendungsfall desselben im Voraus ableitbar. Das *bekannte* Faservlies wurde aufgrund einer bei diesem Vlies *im Voraus ableitbaren* Auswirkungsfähigkeit neu benutzt. Deswegen fällt diese Lösung unter die Definition einer naheliegenden Lösung und sie gilt daher nur als Evolut, und zwar als Evolut 2.

Anhand dieses einfachen Beispiels war es möglich, die Verwendung der Grundbegriffe der pragmatischen Beurteilungsweise der Erfindungen zu demonstrieren. Wenn in dieser Beschreibung die Redewendung „Man hat darüber nachgedacht" oder dgl. verwendet wurde, dann hat das *Unterbewusste* des Kreativen nachgedacht.

Erfinderische Übertragungen

Im von der Längsinnenwand B3 + B2 links liegenden Bereich der Übertragungszone liegen jene neuen Lösungen, welche sich zwar auch eines bekannten technischen Mittels bedienen, die Übertragung desselben erfolgt jedoch aufgrund einer beim bekannten technischen Mittel *entdeckten* kausalen Auswirkungsfähigkeit. Entdeckt bedeutet weder veröffentlicht noch im Voraus kausal ableitbar. Solche neuen Lösungen genügen jenem Merkmal der Definition einer naheliegenden Lösung *nicht*, in dem von der bekannten kausalen Auswirkungsfähigkeit die Rede ist. Aus diesem Grund ergaben sich solche neuen Lösungen aus dem Stand der Technik *nicht* in naheliegender Weise. Deswegen gelten solche Lösungen als patentwürdige Erfindungen. Alle Arten von Erfindungen, welche links von der Längsinnenwand B3 + B2 liegen, werden hier gesamthaft Erfindungen vom Typ Verwendung genannt. Der Bereich dieser erfinderischen Übertragungen ist begrenzt vorne und hinten durch die kurzen Querwände B4 und B6, rechts durch die Längsinnenwand B3 + B2 und links durch den sich zwischen den kurzen Querwänden B4 und B6 erstreckenden Abschnitt der links liegenden Seitenlängswand B10 des Balkens.

Die Anwendungserfindungen

An den Übergangsbereich zwischen den Abschnitten B2 und B3 der Längsinnenwand des Balkens schliesst sich eine kurze Querwand B5 einerends an. Das andere Ende dieser kurzen Querwand B5 liegt an der linken Seitenlängswand B10 des Balkens an. Der Bereich der Anwendungserfindungen ist begrenzt durch die zwei kurzen Querwände B5 und B6, gesehen in der Längsrichtung des Balkens, durch den oberen Abschnitt B2 der Längsinnenwand B3 + B2 sowie durch den Abschnitt der linken Seitenlängswand B10 des Balkens, welcher sich zwischen den kurzen Querwänden B5 und B6 erstreckt.

Die Auswahlerfindungen

Eine Auswahlerfindung ist erstens dadurch gekennzeichnet, dass sie nur einen Ausschnitt bzw. Bereich aus einem bekannten technischen Mittel lösungsgemäss ausnützt. Zweitens ist eine Auswahlerfindung dadurch gekennzeichnet, dass man beim genannten Ausschnitt eine kausale Wirkungsfähigkeit entdeckt hat, die bei diesem ausgenützten Ausschnitt noch nicht bekannt war. Solche neuen Lösungen genügen ebenfalls jenem Merkmal der Definition einer naheliegenden Lösung *nicht*, in welchem von der bekannten kausalen Auswirkungsfähigkeit des verwendeten bekannten technischen Mittels die Rede ist. Deswegen gilt die Auswahllösung als nicht naheliegend und daher als eine patentwürdige Erfindung. Ähnlich ist die Situation bei der 2. medizinische Indikation usw.

Der Bereich der Auswahlerfindungen ist begrenzt vorne und hinten durch die kurzen Querwände B4 und B5, rechts durch den vorderen Abschnitt B3 der Längsinnenwand B2 + B3 und links durch den sich zwischen den kurzen Querwänden B4 und B5 erstreckenden Abschnitt der links liegenden Seitenlängswand B10 des Balkens. Da die Differenz bei den Auswahlerfindungen „weniger an Neuheit" aufweist als die Differenz bei den Anwendungserfindungen, schliessen sich die Auswahlerfindungen an die Neuheitsgrenze B4 + B7 unmittelbar an.

Da die Auswahlerfindungen selten vorkommen, ist der Bereich derselben in der Längsrichtung des Balkens kürzer als der Bereich der Anwendungserfindungen.

Die Kombinationserfindungen

Die Kombinationserfindungen bedienen sich lösungsgemäss eines *neuen* technischen Mittels. Wegen diesem neuen technischen Mittel genügt eine Kombinationserfindung jenem Merkmal der Definition einer naheliegenden Lösung *nicht*, in welchem vom bekannten technischen Mittel die Rede ist. Deswegen fällt die Kombination **nicht** unter die Definition einer naheliegenden Lösung und sie gilt daher als patentwürdige Erfindung.

Während die Übertragungen sich eines bekannten technischen Mittels bedienen, verwenden die Kombinationserfindungen ein neues technisches Mittel. Es ist bereits gesagt worden, dass der Abstand eines bestimmten Typs von Erfindungen von der Neuheitsgrenze B4 + B7 umso grösser ist, je grösser die Differenz zwischen dem Inhalt der Erfindung und dem Stand der Technik ist. Deswegen liegt das Gebiet der Kombinationserfindungen erst hinter der Zone der Übertragungen, d. h. erst hinter der Querwand B1 + B6. Der Bereich der Kombinationserfindungen ist demnach begrenzt vorne durch die Querwand B1 + B6, hinten durch eine weitere Querwand B9 im Balken und seitlich durch die zwischen diesen Querwänden liegenden Abschnitte der Längswände B10 und B11 des Balkens.

Die patentwürdige Aggregation

Eine patentwürdige Aggregation besteht aus zumindest zwei Erfindungen von demselben Typ, die im kennzeichnenden Teil eines einzigen zweiteiligen Patentanspruchs definiert sind. Solche Aggregationen beinhalten beispielsweise zwei Erfindungen, welche unabhängig voneinan-

der existieren können und von welchen jede Erfindung eine andere Aufgabe löst. Die beiden Erfindungen sind im kennzeichnenden Teil eines einzigen zweiteiligen Patentanspruchs definiert. Solche Verbindungen zweier Erfindungen sind deswegen beliebt, weil eine solche Verbindung einen wortreichen Patentanspruch ergibt. Bei der bisherigen Beurteilungsweise von Erfindungen erweckte ein solcher Patentanspruch beim Beurteilenden den Eindruck, dass es unmöglich sei, dass sich eine so „komplexe" Lösung in naheliegender Weise aus dem Stand der Technik ergeben konnte.

Wegen der Verbindung von zwei Erfindungen in einem Patentanspruch, ist die Differenz zwischen dem Inhalt eines solchen Patentanspruchs und dem Stand der Technik bei einer patentwürdigen Aggregation noch grösser als bei einer Kombinationserfindung. Deswegen liegt der Bereich der patentwürdigen Aggregationen im Balken erst hinter den Kombinationserfindungen. Der Bereich der patentwürdigen Aggregationen ist vorne durch die Querwand B9, hinten durch eine noch weitere Querwand B8 und seitlich durch die zwischen diesen Querwänden B8 und B9 liegenden Abschnitte der Längswände B10 und B11 des Balkens begrenzt.

Gemischte Erfindungen

Am grössten ist die Neuheits-Differenz bei den *gemischten Erfindungen*. Diese sind Erfindungen, welche aus zumindest zwei Erfindungen unterschiedlicher Typen bestehen, wobei diese Erfindungen im kennzeichnenden Teil eines einzigen Patentanspruchs definiert sind. Bei gemischten Erfindungen kann beispielsweise eine Verwendungserfindung in einer Kombinationserfindung eingebettet sein, oder umgekehrt. Gemischte Typen von Erfindungen gelten deswegen als patentwürdig, weil weder der Kombinationsanteil noch der Anwendungsanteil des Patentanspruchs unter die Definition einer naheliegenden Lösung fällt.

Die gemischten Formen von Erfindungen sind in der hinteren Endpartie des Grundkörpers des Balkens deswegen angesiedelt, weil die Neuheits-Differenz bei solchen Erfindungen noch grösser ist als bei den patentfähigen Aggregationen. Der Abstand der gemischten Erfindungen von der Neuheitsgrenze B4 + B7 ist so gross, dass die Patentämter, falls die Unterlagen der betreffenden Patentanmeldung auch den übrigen Anforderung genügen, Patente problemlos erteilen.

Ungünstig sind solche Patentansprüche für den Patentinhaber. Dies deswegen, weil eine Verletzung eines Patentrechts nur dann erfolgt, wenn *alle* Merkmale aus der Kennzeichnung eines zweiteiligen Patentanspruchs beim Verletzungsgegenstand ausgenützt werden. Wenn ein Anderer nur eine der Erfindungen aus dem kennzeichnenden Teil des Patentanspruchs benützt, dann verletzt er das Patent nicht, weil er die übrigen beanspruchten Erfindungen nicht gleichzeitig benützt.

Der Bereich der gemischten Erfindungen ist begrenzt vorne durch die weitere Querwand B8, hinten durch die Balkenhinterwand B12 und seitlich durch die zwischen diesen Querwänden B8 und B12 liegenden Abschnitte der Längswände B10 und B11 des Balkens.

Dynamische Situationen während der Beurteilung von Erfindungen

Je nachdem, wie sich die Situation betreffend die Dokumente des Standes der Technik während dem Beurteilungsverfahren entwickelt, kann die Art der beurteilten Lösungen ändern. Es sind viele Übergänge dieser Art möglich. Beispielweise kann eine Lösung, welche man zunächst für eine Erfindung gehalten hat, als identisch vorveröffentlicht gelten, falls ein Dokument des Standes der Technik ermittelt wurde, in dem der gesamte Inhalt des beurteilten Patentanspruchs offenbart ist. Dieser Übergang erfolgt durch Wandabschnitte B4 oder B7.

Im rechts liegenden Abschnitt B1 der Stirnwand B1 + B6 der Übertragungen befindet sich die Übergangsmöglichkeit von den Kombinationserfindungen zu den naheliegenden neuen Lösungen (Evoluten) oder durch den Wandabschnitt B7 sogar bis in den Stand der Technik, wenn sich die Lösung als identisch vorveröffentlicht erweist. Im Bereich des Wandabschnittes B2 der Längsinnenwand B3 + B2 befinden sich die Möglichkeiten für die Übergänge von den Erfindungen vom Typ Anwendungen zu den naheliegenden neuen Lösungen (Evoluten).

Die Möglichkeiten des Übergangs von den Auswahlerfindungen zu den naheliegenden neuen Lösungen befinden sich im Bereich des vorne liegenden Abschnittes B3 der Längsinnenwand B3 + B2. Der links liegende Abschnitt B4 der Neuheitsgrenze bietet die Möglichkeit des Übergangs von den Auswahlerfindungen aber auch der Anwendungserfindungen (B5) bis zu den identisch veröffentlichten Lösungen des Standes der Technik. Der Übergang von den naheliegenden neuen Lösungen zu den Lösungen des Standes der Technik befindet sich im Bereich des rechts liegenden Abschnittes B7 der Neuheitsgrenze usw.

Im Bereich der Erfindungsgrenze liegen entweder die meisten oder zumindest sehr viele Erfindungen aus den Gebieten der Chemie, der Biotechnologie usw. An solche Erfindungen koppeln sich manchmal riesige Geldbeträge. Hieraus dürfte ersichtlich sein, wie wichtig und wertvoll es ist, wenn die Situation im Bereich der Erfindungsgrenze genau, d.h. wissenschaftlich dargelegt wird.

Die Möglichkeiten der Übergänge von den patentwürdigen Aggregationen und von den gemischten Formen

von Erfindungen bis in den Stand der Technik, d. h. bis zur identischen Vorveröffentlichung derselben, sind eher selten. Denn in solchen Fällen weist der jeweilige Patentanspruch so viele Merkmale auf, dass es eher als unwahrscheinlich erscheint, dass man im Stand der Technik ein einziges Dokument findet, welches alle Merkmale eines solchen Patentanspruchs neuheitsschädlich vorwegnehmen würde. Wenn ein relevantes Dokument im Stand der Technik gefunden wird, dann bleibt in solchen wortreichen Patentansprüchen meistens etwas übrig, was man immer noch für eine Erfindung halten kann.

Die drei Wege zu einer Erfindung

Zusammenfassend kann man sagen, dass es nur drei Wege zu einer Erfindung gibt:

1. Kombination bekannter Elemente
Zur Lösung eines Problems werden ganz bestimmte bekannte Elemente des Standes der Technik ausgewählt und diese Elemente werden in ganz bestimmte räumlich/zeitliche Beziehungen zueinander gebracht. Neue Lösungen technischer Probleme, wenn sie die Voraussetzungen für eine Erfindung erfüllen, werden Kombinationserfindungen genannt und sie können patentiert werden. Im Buch „Erfindungs - und Patentlehre" von S. Kulhavy, Carl Heymanns Verlag, 2010, gibt es dazu die Beispiele D und E.

2. Verwendung eines bekannten technischen Mittels
Wenn bei einem bereits bekannten technischen Mittel eine Eigenschaft (Auswirkungsfähigkeit) entdeckt wird, welche bei *diesem* bekannten technischen Mittel noch nicht bekannt war, und wenn zumindest eine technische Anwendbarkeit dieser Wirkungsfähigkeit genannt wird, dann kann es sich um die sogenannte Verwendungserfindung handeln. Ein typisches Beispiel für diese Art von Erfindungen stellt das weltberühmte Insektenvertilgungsmittel DDT dar. Als das bekannte technische Mittel diente in diesem Fall das Dichlor-Diphenyl-Trichloäthan.

Man hat entdeckt, dass dieser Stoff eine Auswirkungsfähigkeit besitzt, die bei diesem Stoff noch nicht bekannt war. Er kann als ein sehr wirksames Berührungsgift für Insekten aller Art (offenbar mit Ausnahme von Bienen) dienen. Dies war der Grund, warum DDT seinerzeit als Insektenvertilgungsmittel patentiert wurde, obwohl das Dichlor-Diphenyl-Trichloäthan zum damaligen Stand der Technik gehörte.

3. Verbindung der Wege 1 und 2
Es kann auch eine neue Lösung eines technischen Problems geben, in welcher die soeben genannten Typen von Erfindungen miteinander kombiniert, bzw. gemischt sind. Im genannten Buch „Erfindungs - und Patentlehre" von S. Kulhavy befindet sich das Beispiel R, das eine gemischte Erfindung darstellt.

Eine mögliche Zukunft dieser materiellen Prüfungsweise

Damit die Lösung einer Aufgabe als eine Erfindung gelten kann, muss die Lösung die folgenden drei Merkmale erfüllen: sie muss gewerblich anwendbar und neu sein und sie darf sich aus dem Stand der Technik nicht in naheliegender Weise ergeben. Eine Erfindung muss somit diese drei Merkmale bzw. Parameter erfüllen, damit sie patentiert werden kann. Das letzte dieser drei Merkmale wird auch „drittes Erfindungsmerkmal" genannt. In der Vergangenheit hat dieses dritte Erfindungsmerkmal eine Entwicklung durchgemacht.

Im 19. Jahrhundert gab es in Europa kein drittes Erfindungsmerkmal während der Prüfung von Erfindungen. Im Jahr 1906 kam der Patentanwalt Richard Wirth mit der Idee, ein drittes Erfindungsmerkmal einzuführen und er benannte dieses Merkmal Erfindungshöhe. Es gab dann einige Vorbehalte gegen das Wort Erfindungshöhe. Aber es war ein hübsches Wort und ausserdem gab es zur Durchführung der Prüfung auf das dritte Erfindungsmerkmal sonst nichts. Etwa von 1920 bis 1970 laborierte man mit dem Erfindungsmerkmal „technischer Fortschritt". Diesem Merkmal hafteten einige Probleme an und deswegen kam dieses Merkmal praktisch nicht grossflächig in Gebrauch.

Eine entscheidende Änderung der Situation brachte die Einführung des Europäischen Patentübereinkommens mit sich. Dieses fegte alle bisherigen dritten Merkmale in Europa einfach weg und es benannte das dritte Erfindungsmerkmal „erfinderische Tätigkeit". Die erfinderische Tätigkeit hat mit den früheren dritten Erfindungsmerkmalen etwas gemeinsam, nämlich, sie ist auch ein unbestimmter Rechtsbegriff. Das dritte Erfindungsmerkmal heisst im US-Patentgesetz „non obviousness". Dies kann mit „nicht naheliegend" übersetzt werden. Dieses Merkmal ist am Ende des 19. Jahrhunderts in den USA eingeführt worden. Auch „non obviousness" ist ein unbestimmter Rechtsbegriff.

Es ist sehr schwierig sich vorzustellen, was „non obviousness" bedeuten kann, wenn man es nicht genau weiss, was „obviousness" bedeutet. Probleme, die eine solche „Abgehobenheit" des Wortlauts des bisherigen dritten Erfindungsmerkmals verursacht, dürften sattsam bekannt sein. Die Definition einer naheliegenden *Lösung* lautet wie folgt: „Eine gewerblich anwendbare Lösung einer Aufgabe ergab sich in naheliegender Weise aus dem Stand der Technik, wenn zur Lösung der Aufgabe ein bekanntes technisches Mittel aufgrund einer kausalen Auswirkungsfähigkeit neu verwendet wurde, die

sich im Voraus kausal ableiten liess oder die bei diesem Mittel bereits bekannt war." Vorstehend wurde auch dargelegt, wie diese Definition so gehandhabt werden kann, dass Erfindungen beurteilt werden können, ohne Wertungsurteile anwenden zu müssen. Aus solchen Gründen könnte man annehmen, dass diese Beurteilungsweise der Erfindungen eine breite Anwendung finden wird.

Die scharfe Grenze zwischen den Erfindungen und den Evoluten

Der erste Grund dafür, dass die Grenze zwischen den Erfindungen und den Evoluten scharf ist, besteht darin, dass die Bedeutung aller Begriffe, die sich in der Definition einer naheliegenden Lösung befinden, anhand einer Recherche im Stand der Technik genau festgestellt werden kann.

Der Unterschied zwischen den Kombinationen und den Übertragungen ist dermassen deutlich, dass es keine Überschneidungen in den Ansichten über die Patentwürdigkeit bei diesen zwei Typen von Lösungen geben kann. Überschneidungen kann es innerhalb der Zone der Übertragungen geben. Hier kommt der Evolut 2 den patentwürdigen Verwendungen am nächsten. Die „Zauberformel" zur Unterscheidung zwischen diesen zwei Typen von Lösungen lautet wie folgt: „im Voraus kausal ableitbare neue Auswirkungsfähigkeit des lösungsgemäss verwendeten bekannten technischen Mittels".

Bei patentwürdigen Verwendungen (linke Seite der Übertragungszone in Abb. 1) ist die beim bekannten technischen Mittel entdeckte und in diesem Sinne bei diesem Mittel neue Auswirkungsfähigkeit kausal im Voraus nicht ableitbar. Bei Evoluten 2 (rechte Seite der Übertragungszone in Abb. 1) ist die neue Auswirkungsfähigkeit des bekannten technischen Mittels im Voraus kausal ableitbar. Bei den Evoluten 1 war die lösungsgemäss ausgenützte Auswirkungsfähigkeit des bekannten technischen Mittels dagegen bereits bekannt. Dies stellt einen deutlichen Unterschied zwischen den Evoluten 1 und den patentwürdigen Verwendungen dar.

Eine „Sieb"–Allegorie

In einem Patentamt stehen viele Patentanmeldungen zur Prüfung an. Die Inhalte der Patentanmeldungen können Erfindungen oder Evolute sein. Solche Patentmeldungen stellen ein Gemisch dar. Um welche Art des Inhaltes es sich in der jeweiligen Patentanmeldung handelt, zeigt sich erst am Ende der Prüfung des Inhaltes der Patentanmeldungen. Während dieser Prüfung müssen die Erfindungen und die Evolute voneinander getrennt werden. Dies geschieht anhand der Definition einer naheliegenden Lösung, d. h. eines Evoluts. *Eine Erfindung ist eine nicht naheliegende Lösung*. Erfindungen und Evolute stellen somit eine Alternative dar!

Wegen der Anwendung der Definition einer naheliegenden Lösung (d. h. eines Evoluts) während der Beurteilung von Erfindungen scheint ein logischer Widerspruch in dieser Prüfungsmethode zu bestehen. Interessant sind die Erfindungen und sie werden anhand der Definition einer naheliegenden Lösung aus der Menge der zu beurteilenden Patentanmeldungen, d. h. anhand des Gegenteiles derselben „ausgesiebt". Möglicherweise hat jemand Probleme mit dem Verständnis einer solchen Methode zur Unterscheidung zwischen den Erfindungen und den Evoluten aufgrund der Definition einer naheliegenden Lösung.

Man stelle sich vor, dass die Erfindungen und die Evolute Kugeln sind. Diese Kugeln bilden ein Gemisch. Die Aufgabe lautet, die Erfindungskugeln von den Evolutkugeln zu trennen. Dabei will man nur die Erfindungen behalten. Die Evolute können ad acta gelegt werden. Bekanntlich ist die Bedeutung der Erfindungen grösser als die der Evolute. Deswegen darf man annehmen, dass die Erfindungskugeln einen grösseren Durchmesser haben als die Evolutkugeln. Ferner soll man sich ein Sieb mit runden Löchern vorstellen. Der Durchmesser der Löcher in einem solchen Sieb entspricht dem Durchmesser der Evolutkugeln. Folglich können die Erfindungskugeln durch diese Sieblöcher nicht durchfallen.

Das Gemisch aus den beiden Sorten von Kugeln wird auf das obere Ende des Siebs geschüttet. Da die Grösse des Durchmessers der Löcher in der Siebplatte durch die Definition einer naheliegenden Lösung bestimmt ist, fallen nur die Evolutkugeln durch die Löcher in der Siebplatte hindurch. Die Erfindungskugeln, deren Durchmesser grösser ist als der Durchmesser der Sieblöcher ist, rollen entlang der Siebplatte weiter, bis sie am Ende der Siebplatte zwecks Patentierung zur Verfügung stehen. Die Erfindungskugeln, d. h. die Erfindungen gehen ja über den Wortlaut der Definition einer naheliegenden Lösung hinaus.

Erfindungen können unterschiedlich gewichtig sein. Dementsprechend könnten die Erfindungskugel unterschiedlich grosse Durchmesser haben. Diesen Durchmessern ist es jedoch gemeinsam, dass sie grösser sind als der Durchmesser der Evolutkugeln. Deswegen gelangen auch die unterschiedlich gewichtigen Erfindungskugeln bzw. Erfindungen bis an das rechts liegende Endes des Siebes. Hiernach werden für die Erfindungen, die unterschiedliche Wichtigkeiten aufweisen können, dennoch Patente mit gleicher rechtlicher Wirkung erteilt.

Education

e:EQE – Discussion Paper

To obtain broad stakeholder input, a Conference will be organised by PEC to discuss the e:EQE Discussion Paper. This Conference is to be held on 21 June 2021 by videoconference. In preparation, the Discussion Paper on a new format of the e:EQE is published.

Preamble

Due to the COVID-19 pandemic, the European Qualifying Examination was held online in March 2021. Although the e:EQE in 2021 was not perfect, the EQE of 2022 and 2023 will have more or less the same structure. The format of the EQE can only be changed from 2024 at the earliest because any changes have to be written into the Regulations and the candidates must be informed well in advance. If changes are to be effected from 2024, it is now time to propose a new structure of the EQE.

In April 2020, the Supervisory Board of the EQE created an e:EQE Working Group comprising of representatives from the Examination Secretariat of the EPO, representatives from **epi**, and ICT specialists. The two main tasks of the e:EQE Working Group are:

1) set up and implement an online EQE in 2021, and
2) prepare the groundwork for the e:EQE of the future.

To support the **epi** members in the e:EQE Working Group, **epi** has set up a Digitalisation Support Group (DSG) with members of the Professional Education Committee (PEC) supplemented by experts in the field of the EQE and in online Exams. There are regular meetings between the three **epi** members in the e:EQE Working Group and the Digitalisation Support Group. A first version of the Position Paper on the future of the e:EQE was also discussed at the

epi Council meeting held on 13-14 November 2020. The current version of the e:EQE Discussion Paper was discussed at the **epi** Council meeting held on 8 May 2021.

As **epi**, we are aware of the evolving role of the professional representative and according to Art. 4 of the Founding Regulations, it is an object of **epi** to "collaborate with the European Patent Organisation on matters relating to the profession of professional representatives and in particular … on the European Qualifying Examination".

Before presenting proposals for a new structure/format of the EQE, it is good to address some more fundamental questions.

This Discussion Paper provides a general concept of a new e:EQE, not a detailed exam setup. Where content examples are given, they are for illustration only, as there are many ways to set up a progressive modular exam.

Is the current EQE adequately testing the "fit to practice" criterion?

The testing of the "fit to practise" criterion in the EQE is limited to testing the general practice of a European patent attorney. The EQE does not test technical knowledge and, in particular, does not test the legal knowledge pertaining to a specific technical field.

There is a strong feeling among the tutors and some qualified European patent attorneys that some Exam Papers are too remote from reality, even considering the fact that the Exam Papers have necessarily been adapted to the specific exam needs. Some Exam Papers are perceived to have become jigsaw puzzles, constructed so that all pieces fit perfectly together to have a clearly defined 'correct' answer, rather than testing real skills of European patent attorneys. The proposed e:EQE should be suitable to conceptually test complex scenarios in a fixed time online exam format.

The current setup of the Exam Papers allows candidates to prepare for the EQE through methodology courses, where they learn how to prepare the answer expected by the Exam Committee. The Exam papers normally have a certain structure, and the candidates learn where and how the (easy) points can be scored. A future exam structure should be more easily adaptable to reduce reliance on methodologies(i.e. to test the fit-to-practise criterion rather than the candidate's ability to learn a methodology).

Despite all attempts to test whether candidates are "fit to practise" via the EQE, real-life experience is also a major contributor to a high base level of newly qualified professional representatives. It is felt that this point is normally not emphasized enough. The training, support and supervision of candidates must also be considered alongside the development of a new examination structure. The future e:EQE will have to safeguard that entry on the list is only possible once a minimum training period, as laid out in Art 11 REE and the provisions in the IPREE has been completed

General drivers and boundary values

Updating the EQE to a new model gives the possibility to make the exam fit for the future and more effective for both students and the profession.

When updating the EQE, it is important to maintain standard and avoid lowering the bar in an unacceptable way. Accordingly, candidates will still need to spend a lot of time studying for the EQE. However, the workload can be redistributed to better fit the candidates' development by introducing a progressive learning roadmap which builds in complexity towards the final exams and subsequent qualification.

There is a strong desire amongst different stakeholders to move towards a multi-level modular approach instead of the current pre-exam followed by a 20-hour main examination condensed in one week.

It is also desired that each module does not exceed 2 hours.

On-the-job training, support and supervision by a qualified professional representative is retained as an essential element of the proposed alternative e:EQE setup. Additionally, the current minimum training period is retained but not necessarily as a requirement to sit the final exams.

Proposal for a modular e:EQE setup

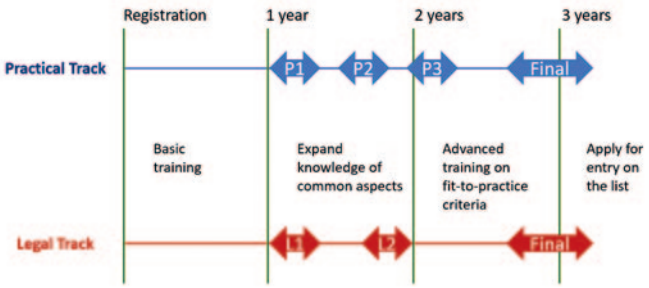
The e:EQE is a sit-anywhere exam (like the 2021 EQE). It is noted that the burden of creating the exam conditions is on the candidates. However, the flexibility and the avoidance of travel appear to balance this burden.

The proposed new e:EQE is split into two main examination tracks, the Practical track and the Legal track. Each track is modular, and each track requires different training, different preparation and – to an extent – different testing. Alongside the examination tracks, training also needs to be completed under the supervision of a qualified European patent attorney.

- The Practical Track tests the day-to-day activities of a professional representative, such as drafting, amendment and opposition. As explained below, there is some but not complete overlap with the familiar Papers A, B and C but additional topics are also introduced.

- The Legal Track tests the candidates' knowledge of the relevant legal provisions as defined in the syllabus, and their ability to apply that knowledge in solving a complex legal problem.

The respective modules in both tracks are progressive in level, preparation and experience that is required to pass.



Training and exam time schedule

A more detailed flowchart of progression through the different modules is shown in Annex A, and a mapping which shows the overlap between the current EQE and the proposed e:EQE is shown in Annex B. The proposed resitting policy is shown in Annex C. The Annexes can be found in the online version of the e:EQE Discussion Paper on www.epi-learning.org.

Practical Track (total 12 hrs)

The practical track consists of four (4) parts, combining the conceptual aspects of the claim analysis part of the former pre-examination and former papers A, B and C, converted into a modular progressive testing setup and extended to include aspects that are not tested in the pre-2020 EQE, but which have become a relevant part of the life of a patent attorney

Module P1 – Basic claim analysis

Module P1 is intended to be taken after at least one (1) year of experience. It shall be designed as a smart MCQ exam (not merely true/false questions; see below), which can be taken at any time during the year, while re-sitting can only be attempted after a pause of 4 months.

Duration: 2 hours.

Focus: Claim scope and basic concepts of claim drafting.

Module P1 should test the basic understanding of the fundamental concepts of claim drafting, without requiring detailed knowledge of the EPC or PCT. There should be no requirement to know case law, but a basic knowledge of a limited number of topics in the EPO Guidelines should be required. Merely as an example, Module P1 may include a straightforward analysis of whether an embodiment of client's invention or a competitor's product falls within a scope of a given claim. It may further include testing of other formal aspects of drafting, such as correct claim terminology, correct application of the two-part form, basic novelty, etc. The level should be aimed at a trainee with about one year of experience.

Module P2 – Intermediate claim analysis

Module P2 can be taken at the earliest 4 months after passing Module P1. Like Module P1, it shall be designed as a smart MCQ exam (not merely true/false questions), can be taken at any time during the year, and re-sitting can only be attempted after a pause of 4 months.

Duration: 2 hours.

Focus: Intermediate concepts of claim validity, including inventive step.

Module P2 builds on Module P1. Thus, Module P2 should test all of the topics in Module P1, but in a more complex setting. In addition, Module P2 may test more complex aspects of claim drafting, for example inventive step, clarity, extension of subject-matter and unity of invention. This is an intermediate level examination aimed at a patent attorney trainee who has been working for approximately two years. Complex or subtle problems (e.g. problems hinging on a precise meaning of a single word in a claim, claims that are borderline inventive, i.e. the argument may be had both ways etc.) shall be avoided.

Module P3 – Fundamentals of drafting and/or amending claims

Module P3 can be taken at the earliest 4 months after passing Module P2. It shall be designed as a (possibly machine correctable) open question exam, which is scheduled twice a year.

Duration: 2 hours.

Focus: Claim drafting and/or claim amendment; and related arguments.

Module P3 tests the core aspects of claim drafting or preparing claim amendments after an office action. Typically, the paper will also require the preparation of argumentation on patentability applying the problem-solution-approach and advising a client accordingly. In this paper, a variety of scenarios can be tested on a random basis.

For instance, the candidate:

- may be given a letter from the client and a limited set of prior art and be asked to draft appropriate claims to cover the client's invention;

- may be given a letter from the client and be asked to draft only a few (e.g. independent) claims and explain, in a letter to the client, the reasons for including (or not including) certain features;
- may be given a (first) office action citing a limited set of prior art and be asked to prepare a claim amendment and a draft response letter to the EPO;
- may be given the client's application and a limited set of prior art and be asked to prepare the independent claim(s) for a divisional application covering the client's second invention.

N.B.: the list above is not an exhaustive list.

This module should be technology specific (for example, chemical, mechanical and/or other technologies).

Final Practical Exam – Advanced practical skills

The Final Practical Exam can be taken after passing Module P3. It shall be designed as a free text computer written e-exam. This exam will be offered twice a year. If a candidate is unsuccessful on the first attempt, there will be no restrictions on the timing of the first resitting. However, if the candidate fails on their second (and subsequent) attempt, the candidate must wait for a year before resitting. In other words, there must be a one-year gap between sitting the two exams (it is not necessary to wait one year from obtaining the results).

Duration: 3 parts of 2 hours each. To be decided if this will be on a single day or spread over 3 days.

The parts are randomly selected from the following exemplary subjects:

- Prepare claim amendments and a response to the EPO after an Art. 123(2) objection.
- Prepare written submissions in response to a summons to oral proceedings in examination).
- Prepare amendments after receiving a Rule 71(3) communication and the client changing their mind on claim scope.
- File Art. 115 observations against a competitor's patent application (or patent).
- Prepare grounds of opposition against a competitor's patent.
- Write a written submission in opposition as a proprietor (response to a notice of opposition or against Art. 115 observations in opposition)
- Prepare an argument responding to the proprietor's response to a notice of opposition, based on client input and/or new technical evidence and/or new prima facie relevant prior art.
- Reply to a preliminary opinion of the opposition division
- Prepare grounds of appeal against a decision of the ED or OD, based on client input and/or technical evidence and/or new prima facie relevant prior art.
- Prepare a response to an opposition appeal filed by the "other party" (proprietor or opponent, as appropriate).
- Prepare a reply to a preliminary opinion of a board of appeal (examination or opposition, as appropriate).

N.B.: the list above is not an exhaustive list. The curriculum from the previous exams may also be tested.

The difficulty of the Final Practical Exam should be aimed at the level of a trainee with three years of experience and should test the fit-to-practise criterion (taking into account the two-hour time limit for each part). The candidates will not know in advance which subjects from the above list they will be tested on, so they will have to prepare for all combinations. Consequently, the complexity (difficulty) of the respective parts may be lowered to fit the two-hour time limit. While this is likely to simplify preparation of the respective question papers, as well as marking of the answers, it will bring the additional challenge to adequately test the candidate (fit-to-practise criterion) without making the paper predictable.

Legal Track (Total 7 hours)

In this track, the contents of the former Paper D (both part 1 and part 2) and the legal questions from the pre-exam are combined, converted into a modular progressive testing setup and extended to include aspects that are not tested in the pre-2020 EQE, but which have become a relevant part of the life of a patent attorney.

Module L1 – Basic legal concepts

Module L1 is intended to be taken after at least one year of experience. Like Modules P1 and P2, it shall be designed as a smart MCQ exam (not merely true/false questions), can be taken at any time during the year and re-sitting can only be attempted after pause of 4 months.

Duration: 2 hours.

Focus: Basic procedural matters relating to the EPC and PCT.

Syllabus: To be defined but may include for the procedural aspects: common provisions, languages, representation, basics of priority, calculation of periods, remedies, fees, the process from filing to grant, divisional applications, transfer, entitlement disputes, limitation, opposition, intervention, appeal, conversion.

Module L1 should test the basic legal concepts of the EPC and the PCT. As examples, Module L1 should test a candidates' understanding of the "life of a patent application" (EPC or PCT), understanding of the concept of priority including effective dates of claims, ability to correctly calculate simple EPC and PCT deadlines (10-day rule, 7-day rule, expiry of a time limit on a non-working day, applying an extension), etc. Module L1 should not test anything beyond the basics (for example complex issues such as the prior art effect of several 'interlocking' applications that are only partially entitled to priority or restoration of priority).

Module L2 – Advanced legal questions

Module L2 can be taken at least 4 months after passing Module L1. It shall be designed as a hybrid MCQ exam so that the candidate is also required to indicate the legal basis for their answer. Like Module M2, it can be taken at any time during the year, and re-sitting can only be attempted after a pause of 4 months.

Duration: 2 hours.

Focus: Advanced legal questions of the EPC and PCT and basic legal concepts from the IP5.

Syllabus: The whole of the EPC and PCT, which may include patentability (for example inventions, exceptions to patentability, medical uses, state of the art, European prior rights, non-prejudicial disclosures, novelty, inventive step, unity of invention, disclosure, claims, right of priority), interpretation of patent claims to assess infringement, analysing a scenario and identifying solutions (for example missing a procedural step), recent and landmark case law (currently e.g. G 3/14 or G 1/15, but not e.g. G 1/84), national law to the extent covered in National Law table and the PCT Applicant's Guide, simple commercial aspects of IP rights such as consequences of (not) acquiring IP rights or licensing, etc; and aspects of IP5 patent office practice defined in the syllabus of L2.Module L2 builds on Module L1. Thus, Module L2 should test all of the topics in Module L1, but in a more complex setting. In addition, Module L2 may test more complex legal aspects of the EPC and PCT and basic legal aspects of IP5 patent office practice as defined by the syllabus. This is an examination aimed at a patent attorney trainee who has been working for approximately two years.

Final Legal Exam – Advanced practical advice

The Final Legal Exam can be taken at least 4 months after passing Module L2. Like, the Final Practical Exam, it shall be designed as a free-text computer written e-exam and will be offered twice a year. There will be no restrictions on the timing of the first resit but subsequent resits must be spaced from the previous sitting by at least a year.

Focus: Analysing a scenario and preparing a legal opinion to a client based on the analysis.

Duration: 3 hours (alternatives may be considered in view of screen time).

Syllabus: The whole of the EPC and PCT. The aspects of IP5 patent office practice defined in the syllabus of L2. The difficulty of the Final Legal Exam should be aimed at the level of a trainee with three years of experience and should test the fit-to-practise criterion. A candidate may be asked to analyse a complex situation which includes a variety of topics, for example multiple missed deadlines or procedural steps, priority issues, multiple applications (both client and competitor), depending patent rights, and freedom to operate issues. The candidate must advise the client on the situation and provide suggestions for improving the client's position (e.g. considering licence agreements and other commercial aspects) In particular, the ability to provide clear advice to the client is considered key to being fit to practise as a European patent attorney.

Passing the new e:EQE

Varying pass-rates may be defined for each module and for the different tracks, in particular depending on the choice of MCQ setup. To encourage candidates to adequately prepare, it may be considered to raise the pass rate for resitters (e.g. requiring 75% to pass a resit instead of 70% for the first sitting).

Practical Track – Modules P1, P2 and P3
For the Modules P1 and P2, a progressive pass rate based on the type and setup of the Modules can be chosen, e.g. 70% for P1 and 80% for P2. The Pass mark for the free text Module P3 can be between 50-70%.

Legal Track – Modules L1 and L2
For the Modules L1 and L2, a similar approach can be taken, aiming for 70% for L1 and 80% for L2.

Final Exams
To pass the Final Practical and Legal Exam a Pass mark of 50 out of 100 has to be obtained for each of the four parts: i.e. the three parts of the Final Practical Exam and the Final Legal Exam.

It is proposed to abolish the current compensation scheme.

Transitional provisions are required for resitters in the current system. One suggestion is set out below.

Passed in current system	Exemptions	Required to sit
None	None	All modules
Pre-Exam (or pre-exam + any one of A, B or C)	P1, P2, L1	P3, L2 & Final Practical & Legal exams
Pre-exam & Paper D	L1, L2, Final Legal Exam, P1 & P2	P3 & Final Practical Exam
Pre-exam & Papers A & B	L1, P1, P2 & P3	L2, Final Legal and Practical Exams
Pre-exam & Papers A, B & C	L1, P1, P2, P3 & Final Practical Exam	L2 and Final Legal Exam

Although there are additional elements in each of the legal and practical tracks, there is a need to be fair to candidates who are part way through the qualification process. Accordingly, a pass (over 49%) in paper D will be considered equivalent to the successful completion of the Legal Track. Similarly, passes (over 49%) in each of the papers A, B and C will be considered equivalent to the successful completion of the Practical Track.

Further aspects and considerations

The above proposal may raise a number of questions, some of which are addressed herein below.

MCQ and auto-correction

Advice should be sought on a more sophisticated manner of posing multichoice questions and options for machine or AI correction of answers should be investigated (e.g. employing A.I.). By Smart MCQ is meant an advanced MCQ level that tests more than just true/false, such as "combined lists" to choose from (e.g. one for answers and one for relevance of legal basis; or multiple correct answers from a list) or the requirement to not only give an answer, but also indicate how certain the candidate is that the answer is correct, and weigh that into the number of marks that can be obtained. By hybrid MCQ is meant an exam containing both (smart) MCQ questions and auto-correctable free text. It will have to be decided how the question pool shall be maintained and updated.

On the job training

While the exam is a central assessment for testing candidates on the various aspects of being fit-to-practise, it is noted that the modular system may enable some candidates to pass before completion the 3-year period that is currently set by Art. 11(2)(a) REE. It is therefore recommended that a period of at least 3-years is maintained before entry on the list can be requested, even if the candidate has passed the Final Exams before the 3 years have been completed.

Level playing field

While the sit-anywhere approach creates a level playing field for those who would otherwise have to travel against those who live near a former exam centre, the level playing field in tutoring, variety of work and experience of candidates amongst all member states is not resolved. The above modular approach would enable a (distant) mentoring program for the EPC-area, including aspects currently covered by the EPO Academy and **epi** students, as well as new initiatives, such as an internship program (at least) for candidates across EPC Contracting States.

Conclusions

In view of the digitalisation of the European Qualifying Examination, we have an opportunity to reconsider the structure and content of the Exam.

In this Discussion Paper, **epi** presents a new e:EQE with a modular structure that safeguards the high quality of the current EQE. In the proposal, both the restrictions (e.g. maximum screen time) and the benefits of an electronic examination (e.g. MCQ and autocorrection) are combined to provide a proposal which lowers the burden of time-consuming correction work and spreads the workload for the candidates.

Although this e:EQE Discussion Paper presents a lot of detail related to the format of the EQE, a lot of other things are presently not considered, as they depend on the choice of testing. For many of these aspects professional advice needs to be sought, such smart MCQ setup and auto-marking of free text, the choice of open vs closed book, exam fees, or the frequency and timing of the exam modules.

Reaction to epi Discussion Paper on a new format of the e:EQE

N. Blokhuis (NL), Associate Partner, Dutch & European Patent Attorney, EQE Tutor at Maastricht University

Recently, **epi** published a paper with a proposal for a completely revised set-up of the EQE[1]. This paper was prepared by the Digitalisation Support Group (DSG) and the PEC EQE subcommittee of **epi**. It is labelled as a "discussion paper", which I regard as an invitation to **epi** members to discuss the future of the EQE, and in particular the proposal as formulated in the discussion paper.

In the 15 years that I have been a tutor for the EQE (first at CEIPI, currently at Maastricht University), there has always been criticism on the format of the EQE. Some found that the preparations are too much of a burden for candidates and the companies they work for, while others consider the EQE to be "just a trick" that has little relation to everyday practice. Although the EQE has evolved quite a bit over the years that I have been tutoring, these points of criticism have remained throughout the years.

Now that the EQE has made the big step into the digital world, again the question is raised whether the EQE in its current form is still fit for its purpose. In addition, the digital format of the exam and the rapid developments in the world of digital learning and digital exams offer many new possibilities that could improve the EQE.

It's my opinion that it is a good idea to re-think the set-up of the EQE and to make use of the possibilities new technologies have to offer. However, when doing so, in my opinion the main purpose of the EQE should be given absolute priority. A solid testing of the core competencies of a European patent attorney should be the starting point of any redesign of the EQE. Based on that, the proper tools for testing can be selected. As with any good design: form follows function.

Below you will find some of my thoughts on the proposal as formulated in the discussion paper.

1. "The EQE has become a puzzle"

1a. Methodologies are important, but should not be overrated

I agree that the current EQE papers have evolved towards exams that benefit significantly from insight in the respective methodologies for obtaining the correct solution.

However, this does not make them "easy" exams. Candidates still need to have true patent attorney skills in order to score sufficient marks to pass. This is something I observe in our courses at Maastricht University: knowing "the trick" is not sufficient to pass. Good skills in analysis and argumentation and good legal knowledge are required to score sufficient marks. I have met many re-sitters who said they identified all the correct attacks in paper C, but still failed the paper. This is generally due to a lack of argumentation skills at the level that the EQE requires for candidates to pass.

If the EQE were "just a trick", the pass rate of the EQE would be significantly higher than it currently is.

1b. Root cause for "the puzzle"

In my opinion, there is a distinct reason why the EQE has developed its current set-up in which methodology has become so relevant. This reason has to do with the technological knowledge (or lack thereof) that is expected and can be expected from the candidates.

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Currently, all practical papers (pre-exam claim analysis, A, B and C) are the same for all candidates. So, candidates from all technological backgrounds must be able to work with the invention that is presented. This makes that the drafters of the papers cannot rely on candidates to, for example, come up with their own words for formulating claims features in paper A or for judging whether feature X in the claim is the same as feature Y in the prior art in paper C.

This makes that literally all information needed to solve the case must be contained in the paper. Candidates who in a serious way prepare for the EQE understand this and will figure out what types of information, hints and clues to look for in the paper.

This issue has been aggravated over the years by the changes in technical education which have taken place on a broader level within society. I observe in my trainees (both my trainees within EP&C and the candidates in the

1 https://www.epi-learning.org/documents/20210408_DiscussionPaper_eEQE_wAnnexes.pdf

Maastricht courses) that, compared to earlier generations, they generally have received a less broad and significantly more specialized technical education. It used to be so that e.g. a mechanical engineer also had some basic knowledge about chemistry, electronics and physics, but nowadays that is no longer a given.

The effects of this situation can be seen in for example the C-paper. Roughly in the time frame of 2013–2016, no technical understanding of the invention was necessary to come to the right attacks. All words that were needed were given in the paper. For the first time in 2017, and also in 2019, some "technical considerations" were necessary to select the desired attacks ("the skilled person would not combine the teaching of X and Y because then this part would not fit", "combining these two documents would go against the general direction of development of the closest prior art"). Many candidates struggled with this. In 2021, the C paper contained technical terms like "gasket", "buckling resistance" and "tensioning tubes" – and quite some candidates did not understand these terms. There were a lot of complaints about this, as can been seen e.g. on the DeltaPatents blog.

The level of technical specialisation of our candidates has become very high, and candidates come from a wide area of technical backgrounds. In my opinion, this is something that should be taken into consideration when designing a "new EQE". If this would not be addressed in one way or another, the new EQE will become a "word game" just like the current EQE.

Therefore, I am of the opinion that it is highly important to define a level of *general* technical knowledge that *every* candidate, regardless of his or her technical specialization, needs to have to pass the EQE. This level could be for example "physics and chemistry high school level and understanding basic technical drawings". Of course, the required level should be clearly communicated to the candidates.

2. What are the skills that the practice requires?

A widely accepted educational principle is that of "constructive alignment". This means that there is coherence between:

- the intended learning outcomes,
- the teaching and learning activities,
- the forms of assessment (= testing whether the intended learning outcomes are obtained).

When designing an educational program, one starts by defining the intended learning outcomes. The teaching/learning activities and forms of assessment follow from the intended learning outcomes.

I would very much welcome a thorough discussion of the intended learning outcomes before discussing the format of the EQE. Such a discussion on the intended learning outcomes involves questions like:

- what skills does the profession require in daily practice?
- what knowledge does a European patent attorney need?
- which of these skills/what knowledge should be tested in the EQE?

The skills mentioned in the discussion paper are described in terms as "writing a reply to a communication" or "determining whether an embodiment is covered by a claim". However, underneath these skills lay more general patent attorney skills, as like "being able to formulate an inventive step attack", "being able to determine whether a claim is novel", or even at a deeper level "being able to analyse a complex situation".

When looking at the desired skills at this level, a differentiation between assessment/analysis skills (e.g. being able to determine whether a claim is novel) and formulation/argumentation skills (e.g. being able to construct an inventive step attack or defence from scratch) should be made. These are skills are very different in nature: being able to assess the novelty of a claim that somebody else has written is a very different skill from writing a novel claim yourself.

I think it would be helpful to explicitly identify such "deeper level skills" and then look for a suitable format to test these skills. By identifying such deeper level skills, one can also make sure that in the exam design all necessary deeper level skills are sufficiently tested, in all candidates. This also will offer insights that help to design the exam papers that form part of the EQE in a clever and creative way.

In the set-up as described in the discussion paper, as I understand it, in the final exam candidates in year A will be tested on e.g. patent application drafting, while in year B the candidates will be tested on writing an opposition instead. I think this is undesirable, as the final exam appears to be the only exam in which the candidates have to formulate arguments or e.g. write claims by themselves instead of assessing claims and/or arguments that are presented to them. In my opinion, to become a European patent attorney – and to safeguard the quality of the profession – all candidates should demonstrate in the EQE that they have all the "deeper level skills" that European patent attorney needs in daily practice.

3. Training on the job

With the proposed set-up of the practical track, candidates must be prepared to produce (one or some of) a significantly larger number of types of documents than in the current

EQE. However, in the current way in which candidates are trained on the job by their mentors, many candidates do not get the chance to practice writing all these kinds of documents in real life. I already see this when I'm tutoring candidates in particular for papers A and C: very, very few candidates have real life experience with writing an opposition, and some have even never or hardly ever written a patent application themselves (for example the candidates working at an IP department in industry which outsources writing patent applications to private practice firms).

In the current situation, this can largely be handled efficiently by good EQE-training, due to the more or less "fixed format" of the EQE-papers, and due to the fact that this only relates to patent applications and oppositions. However, it still requires a lot of time and effort to properly prepare a candidate who lacks hands-on experience with e.g. drafting patent applications.

This issue will be aggravated by the proposed set-up of in particular the final exam of the practical track. How many candidates will have practical, real life experience drafting grounds of appeal or a notice of Intervention? If they don't learn these things from their mentors in daily practice, they will have to learn this from their EQE-tutors.

This can be done of course, but it could place quite an additional burden on the tutors and on the firms/companies who have to pay for the training of the candidates by the EQE-tutors.

I do not think it is realistic to assume that firms/companies will solve this internally by giving their EQE-candidates a larger variation in tasks. Some tasks will simply not occur at all in the firm or company (e.g. drafting applications when this is outsourced, companies that simply never do oppositions, the types of cases in portfolio of a mentor, etc.). Other tasks will occur only very seldom, or the company/firm culture does not allow trainees to take part in more complex, high level cases.

This problem does not only occur in CSP-countries, but I also see it in companies/firms in the Netherlands and Belgium. For example, even large applicants in the Netherlands do not file oppositions.

In many ways, the EQE is of the utmost importance for our profession. Therefore, I would very much welcome an open and thorough discussion, in which colleagues from many different backgrounds get the opportunity to take part.

Previewing EQE 2022 and beyond, and how it will shape the profession

P. Pollard (NL)

Pete Pollard is European and Dutch patent attorney and EU design and trademark attorney. After working in industry and private practice, he founded Fireball Patents in Eindhoven, NL to better serve the IP needs of start-ups. Pete is also part of IP.DESIGN, a German-Swiss IP boutique. Since 2009, he has taught European patent law to patent attorneys and formalities officers, specialising in PCT and EQE Paper D. Pete is also the author of the PCT.App legal reference book.

After an enormous effort, the very first online EQE or e-EQE was held from 1 to 5 March 2021. Instead of 2000 candidates travelling across Europe to examination centers, they could take the exams digitally from their homes or offices. It was a major achievement during COVID-19, but it did strain and crack the EQE system as well as many candidates.

EQE success now also depends on being digital-savvy:- efficient at working digitally and at setting up reliable IT before the exam. Few candidates were familiar with: **WISEflow** (assessment and exam platform from UNIwise), the appropriately-named **LockDown Browser** (examination tool that severely limits computer functionality, while continuously monitoring audio and video using AI), and **Zendesk** (online helpdesk and exam invigilation).

Pete Pollard

Many candidates underestimated the IT part EQE failure is now possible if a webcam crashes or Windows reboots during an exam. **LockDown Browser** continuously detected "suspicious events" (such as accidentally pressing Alt-Tab twice or "suspicious mouse

movements") and kicked candidates out of the exam automatically. After a crash, you needed a password from **Zendesk** to get back in (which took at least 15 minutes). **LockDown Browser** also had to be installed and run with Administrator rights. Only one screen was allowed, and candidates were not allowed to move out of webcam-view for up to 90 minutes. Some less-sensitive pages could be printed before each part, but key exam pages were only available digitally during the exam.

1. Biggest bug fixes that the author thinks are needed for 2022

- Digital highlighting of exam pages was not available at all. This is essential when reading off a screen to keep your place or to note things you need to use.
- Copy/paste into the answer from the exam was possible, but formatting was often lost, especially with Apple computers. It should not be necessary to reformat after pasting.
- The parts of the exam which allowed copying were only available on different tabs. At least two side-by-side windows should be possible, allowing digital highlighting and copying.
- Limited digital external references (EPO website) were available during the exam. That must be extended to include WIPO to avoid each candidate printing out 2000 pages of the PCT Applicant's Guide.
- **Zendesk** automatically logged out every 20 minutes, so candidates had to keep checking and logging back in during the exam – this should not be necessary.
- Many candidates were interrupted by **Zendesk** during the exam because **LockDown Browser** had disabled their webcam. The camera tested during startup of **LockDown Browser** should not be disabled, and there should be an automatic warning if the camera and/or microphone is not working.

2. Other changes that the author thinks are needed for 2022

- Include a "digital exam desktop", so that candidates can prepare PDF's and upload them for use during the exam. Some EPC/PCT books are already digital and many recommended EPO / WIPO references are only available digitally.
- Allow searchable text of these PDF's, as you have in real-life, for all digital references. Being able to search broadly does not help as much as you think. Only with knowledge can you search quickly and precisely to pick out what you need.
- Find a more effective way of communicating with candidates than e-mail, where follow-up questions can be posted. For example, a forum, Twitter, or Telegram chat groups. Be more open about how the exams will be adapted to the format.
- Provide a technical helpdesk and forum to solve network and access problems well before the exam. This is especially important for company networks and laptops, where candidates will not have administrator rights.
- Run an early beta test using a large number of external candidates and/or tutors to iron out the bugs.
- Don't make it harder than it needs to be for those with En/Fr/Ge as a second language.
  - Since 2017, an extra 30 mins was added to each Main Exam so that mainly non-native speakers would have more time. But this is no longer enforced, and it is clear from the 2021 B and C papers that this time has just been absorbed by more material.
  - So, have a non-native review team for each exam from the countries who have a good language level, but not the highest. Sorry - no Dutch, Swedish or Danish etc. doing the English :-). They also need to test whether the exams can be made in time.
- For exams that are split, like Paper C, subject-matter must be properly separated between parts. The length of the current papers can be reduced by removing overlap and repetition. For example:
  - cut A in half by reducing subject-matter, focusing mainly on independent claims, and providing less prior art.
  - B is not realistic with client giving you claims. Go back to the old format, cut in half by reducing subject-matter, only including a few claims, and providing less prior art.
  - C has much repetition in attacks. Cut in half by including fewer claims, and providing a lot fewer documents.

3. Candidates should start thinking about EQE 2022

- The **WISEflow** platform will be used again, but no information yet about the other software needed. But based on 2021, it is likely to be:
  - An exam browser, such as **LockDown Browser**.
  - Continuous AI-assisted camera and sound invigilation, so you must be visible in the webcam field of view for long periods.
  - At least one mock is expected in Jan / Feb to allow systems to be tested. Reserve the time and take part - you must use these opportunities to check for individual problems with your hardware / software.
- So, candidates must think digital and keep an eye on the EPO's EQE pages for more details:
  - A key skill is now typing speed. Take an online typing course and get a comfortable keyboard /mouse.
  - Become less dependent on paper. Get comfortable reading work documents electronically, especially PDF.

- Look for resources or websites that allow questions to be viewed and answered digitally.
- Look for EPC and PCT books which are digital – a few can even be edited and annotated digitally.

4. Beyond 2024, the future is modular

The **epi** recently published their EQE working group discussion paper[1] addressing current issues and proposing changes to be implemented from 2024. Exams of more than 60-90 minutes are no longer compatible with the digital format, so changes have to be made to split the tests. Although many good ideas are presented, like taking modular exams earlier, the author thinks that the modularity could be exploited more to better define the qualification, and thus the future of the profession.

4.1 Is the current EQE adequately testing "fit to practice"?

The author agrees with the working group that the exams have drifted away from reality, but believes that this could be corrected by agreeing rules on how the exams are made and marked.

Don't make it too difficult for creative thinkers to pass

- Tutors give the same advice – don't be creative, don't think too much, just give the answer in the Guidelines, hand-in a lot, play it safe. Good tips for a temporary exam mindset, but we do not want to filter out those with the opposite skills. In real-life, your opinions on patentability will depend on which of the parties you are representing.
- Perhaps also have one or two open parts where alternative answers are encouraged. Paper D2 currently provides room for this – legal issues cannot always be fully resolved, so marks are awarded for considering both options. Also the advice to a client can accommodate personal preferences of candidates.
- The current Paper A also allows some variation in answers and alternatives are accepted. But the current Papers B and C are more like "one-way streets" looking for a golden solution. B and C are classed as "argumentation" exams, but support provided for alternative answers is almost never considered convincing enough for high marks.

Marking should always consider whether a mistake would be correctable in real-life

- Why penalize submitting a non-novel or non-inventive claim for Paper A? There is little room and time for argumentation, so the thinking of candidates is not always visible in their answers. Full marks should be awarded if a dependent claim is presented that would be considered novel and inventive. There should also be no marks lost for extending beyond the scope of the client's letter – that is what attorneys are supposed to do.
- For Paper B, where argumentation is required, the thoughts of a candidate can be judged. But again, full marks for the claims should be awarded if a dependent claim is presented that would be considered novel and inventive. Marks should also not be lost for keeping claim scope that the client suggests should be abandoned for commercial reasons – patent attorneys are supposed to do this.
- You would not write an opposition like the current Paper C expects. In real life, you concentrate on attacking all the claims at least once, getting all the documents in, and arguing the non-trivial aspects of the feature matching and inventive step. You can reformulate your arguments later. So, for Paper C, the marks should also be focused on non-trivial aspects requiring argumentation. Also remove the emphasis on finding the correct closest prior art - this is very difficult in real-life and highly case dependent. It is often determined by looking at the final version of the arguments.

Make a proper syllabus for each exam, and limit what can be asked

- Professional exams should define a syllabus so that candidates know what could realistically be tested, and on which paper. The REE is too vague, so candidates prepare based on unofficial study guides (like CEIPI[2] or EQE Guide for Preparation[3]) and doing old exams. For example, there is still no clear distinction between legal subjects tested at Pre-Exam and Main Exam level.
- Currently, new subjects are introduced without warning.
- Currently, not specifying which states could be tested on the legal papers means that every year thousands of pages per candidate need to be printed out, like National Law and PCT Applicant's Guide Annexes need to be printed in case there is a question.

Allow anyone to take the exam modules, not just those seeking to qualify

- For example, qualified European patent attorneys, lawyers, employees, formalities officers, national attorneys, technical assistants, and EPO examiners, can learn and stay up to date in a structured way.

1 https://www.epi-learning.org/documents/Discussion_Paper_eEQE.pdf

2 https://www.ceipi.edu/en/training-in-european-patent-law-and-preparation-for-the-eqe-eqf/basic-training-in-european-patent-law

3 https://www.epo.org/learning/materials/study-guide.html

This could already be done for the current Pre-Exam by just providing marks separately for legal questions and claim analysis.

- If you have well-defined modules that anyone can take, you will see that they will be used – it is difficult to make exams. The EPO had a successful pilot project (EPAC) a few years ago where formalities officers studied and passed the legal part of Pre-Exam and Paper D1.

4.2 Some Exam Papers have become jigsaw puzzles

The author agrees with the working group that some exams are more like jigsaw puzzles than a test of real skills, but thinks this is paper-dependent.

- Having small puzzles that fit together, like the current Pre-Exam - claim analysis and Paper D2, seems unavoidable. It has the advantage that you can feel when you are on the right path. Legal questions, particularly True/False, need to be designed to have one or few answers.
- The biggest current "puzzle" is Paper C – it keeps moving away from a real-life opposition. It is too long with too many documents. In real-life, you can find pieces where they are supposed to be, particular in structured patent applications and documents - you should not have to read every document before you start, looking for definitions that have been hidden.
- Paper B is rapidly becoming as artificial as Paper C.

This could be corrected by agreeing rules on how the exams are made and marked.

All papers should start with 0 marks, and award marks for correct parts.

- Current Papers A and B suffer the most as puzzles because they are negatively marked - you start with 100 marks, but lose marks for each deviation from the expected answer. By misreading or misunderstanding, you end up running out of material to use in the argumentation.
- There is a randomness to passing Papers A and B - many pass at a second attempt without preparing any differently. If you are on the same wavelength, you pass. If not, you fail.

Allow failed candidates access to their detailed marking schemes

- Few other exam operates like the EQE, where marking is a black box - candidates cannot get any feedback on what went wrong. Candidates have to reconstruct their own marking based on the Examiner's Report which is almost impossible in practice. If this feedback were implemented, fewer candidates would appeal and fewer appellants would pursue an appeal to the end.

5. Qualifying as Patent agent and/or Patent attorney

The **epi** working group did not mention a number of issues that the author believes should also be addressed.

Match the EQE difficulty to the status of the qualification

- The qualification is not highly regarded by many national patent attorneys, including many in Europe. Although the qualification is called "European Patent Attorney", many consider us "European patent agents".
- That does not match with the current effort to pass - more and more, the author hears from candidates that it is not worth the study effort and failing risk. - they could follow a national law degree and do all the work of a European Patent Attorney (and more).

The level of respect is based on the content of the study and the perceived knowledge of its practitioners, so these discussions will have a big impact on the future of the profession. In the author's view, major changes would be in our best interest, but that would require fundamental changes.

5.1 Raise the representative status to European Patent Attorney

Compulsory continuous (permanent) education for everyone on the list

- Those passing the EQE each year are at "peak knowledge", but that is only about 6% of the 12.400 practitioners currently on the list. The legal and specific substantive knowledge learned is forgotten very quickly if not used in practice – very few will keep it up voluntarily as they focus on learning more practical aspects. It does not make sense to make life very difficult for 6% of the profession to qualify when nothing is required of them (or the rest) after qualification to remain on the list.
- In real-life, knowledge level is even more varied and unregulated due to many others doing "patent attorney-like" tasks, such as national lawyers, employees, and formalities officers.

Include a "European infringement" EQE module with technical interpretation

- As a qualified European Patent Attorney, you are faced with this question regularly. And how are you supposed to write and amend infringeable claims if you have never studied it?
- Infringement is tested in those EPC states with national exams, and contributes to the higher regard for those national qualifications. So you cannot formally give legal advice on national infringement, but you are expected by clients to give informal opinions, and if necessary, work with national attorneys to decide.
- Also, novelty/inventive step are ultimately determined nationally. We currently have three exams just testing whether the EPO will grant or uphold a claim – so, there is room to include infringement. For example, the current Paper C could be split into an infringement part and a smaller opposition part.

Include a "European Trademarks" and "European Designs" module

- Registered designs are rapidly expanding in filings and case law, and the subject-matter is much closer related to patents than to trademarks.
- Recognition by EUIPO is based on national qualifications that include (and test) trademarks and designs. Those who pass this EQE module will be able to practice before the EUIPO.

Include a basic IP4 (US, JP, KR, CN) knowledge module and basic (DE / FR / UK) knowledge

- Expand foreign knowledge in the syllabus (JP, US) to include CN and KR. Clearly define what will be tested. Knowledge of DE, FR and UK systems would also be useful.

5.2 Create a new (intermediate) qualification of European Patent Agent

- Allow partly-qualified candidates to independently perform "patent agent"-like tasks before the EPO, such as first instance acts from filing to grant. This level of expertise would be similar to that of EPO examiners, and would allow candidates to gain more experience. This is already de-facto the case – experienced trainees work on cases under minimal supervision.
- For example, European Patent Agent could be obtained after passing modules equivalent to current Papers A, B and D1 (limited to 1st instance). Also, many happy with this level, and will not want to become a European Patent Attorney, or delay the decision to study further.
- European Patent Attorney would additionally require passing modules equivalent to Papers D1 (full), D2 and C, and an infringement module. They would be allowed to represent in any EPO proceedings, including appeals and oppositions.

Conclusions

- The first e-EQE in 2021 was a great success – by going for a digital exam that could be taken from any location, the EQE organization ensured it could go ahead in spite of Covid-19. Many of the IT problems are teething problems and will be improved.
- The flexibility of candidates was a major factor in that success – many just handled the unclear instructions, last-minute updates, and limitations in the software, to take the exam.
- For every candidate with issues, many others were very positive. They were happy to see the handwriting part of the EQE disappear, and they will have an advantage based on typing and copy/paste speed.
- As a profession, we should move towards a higher-regarded qualified European Patent Attorney by testing infringement, and introducing compulsory continuous education.
- Creating an intermediate qualification of European Patent Agent has many benefits.
- If more professionals can take the EQE modules, the knowledge available in the profession will be increased, and the subjects will stay relevant to real-life.

epi Learning Platform

The Professional Education Committee (PEC) of **epi** offers educational events for both qualified **epi** members and EQE candidates. Videos of some of these events may be accessed through the **epi** learning website (epi-learning.org) by **epi** members and students. Additionally, the discussion paper relating to the e:EQE which is published in full in this edition of **epi** information has been posted on the site. Everyone is invited to participate in the discussion forum[1] on this paper.

1 https://www.epi-learning.org/mod/forum/view.php?id=466

epi Learning Platform

epi student members have access to additional information on the **epi** learning website, including the student forum described below. Other benefits of student membership include receiving alerts about **epi** training courses, priority access to our educational events, and reductions on course fees for **epi** educational events, such as tutorials, Mock EQEs, seminars and webinars. Candidates for **epi** student membership may apply, at any stage of their training, to the **epi** Secretariat (epi.student@patentepi.org), simply by filling in the online application form[1], providing the necessary documents[2] and paying the fee.

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

epi Student Forum

epi has created a Student Forum on the **epi** Learning Platform (epi-learning.org) so that **epi** Students can ask questions regarding the exam papers of the EQE. Your questions can be posted anonymously in accordance with the Student Forum Rules. The questions will be reviewed by **epi** Tutors who will post appropriate replies.

The Student Forum is divided into the following sections: Pre-exam, Paper A, Paper B, Paper C, Paper DI and Paper DII. There is also a General section for questions not specifically related to individual exam papers Please use the appropriate section(s) for your questions. Unfortunately, we are not able to answer technical questions about the EQE format nor the browser that will be used for the exams; such questions should be directed to the Examination Secretariat at the EPO.

epi hopes that you will find the **epi** Student Forum helpful in your preparation for the EQE. If you do not already have access to the **epi** Learning Platform, please contact the Education Team (education@patentepi.org).

epi Students & EQE Candidates Subcommittee
Professional Education Committee

Committee Reports

Report of the epi-Finances Committee

C. Quintelier (BE), Chair , T. Powell (GB), Secretary

The 86th Meeting of the **epi**-Finances Committee took place by video conference on 20 April 2021. The Treasurer, Deputy Treasurer and Internal Auditors attended as invited guests. The Executive Director also attended.

Mr Quintelier was elected as the new Chair of the Committee in replacement of Dr Maikowski; and Mr Powell was elected as the Secretary.

The Committee received a report on the financial results for 2020 from the Treasurer. This was accepted with approbation. Based on the report the Committee is happy to endorse the wish of the Internal Auditors to discharge the Treasurer of responsibility for the finances of **epi** in the financial year 2020.

The Committee further received an update from the Treasurer on the financial position for the First Quarter of 2021. The Committee commends the cautious approach to operation of the budget revised at the 89th Meeting of Council that the Treasurer has adopted.

The Committee received a report from the Executive Director and noted with approval the plans for improvements in financial rigour that she intends to introduce in co-operation with the Treasurer. The Committee was pleased that the financial management issues raised in the Executive Director's report are being addressed as matters of high priority.

The Treasurer reported on certain initiatives and in particular the plans (a) to introduce charges for some types of online training webinar; (b) the appointment of communications consultants to assist with the preparation and effectiveness of internal and external communications; and (c) educational initiatives including one aimed at assisting examination candidates to prepare for online qualifying examinations. As regards the communications consultants the Committee recommends reviewing their performance and effectiveness after they have enjoyed a reasonable opportunity to bring about improvements.

Claude Quintelier

The Committee established a sub-committee for the purpose of progressing the professional indemnity insurance project that has been in existence for some time on a ad hoc basis.

The next meeting of the Committee will be on 27 Oct. 2021.

Report of the Committee on EPO Finances

J. Boff (GB), Chair

Since the 89th Council Meeting the Committee has been considering the paper CA/F27/20 (mentioned briefly in the Report to the 89th Council Meeting).

CA/F27/20 mentions the possibility of structural reforms to fees and is concerned about:

Jim Boff

- Sustainability of the EPO
- Increasing revenue for the EPO (which is not the same as increasing fees)
- Efficiency of the EPO

Some principles/aims of CA/F27/20 are:

- Simplification of the fee structure
- Steering applicant behaviour through fee incentives/disincentives
- Aligning the structure of Euro-direct and (Euro-)PCT fees
- Improving the cost coverage of certain products and services
- Support for certain categories of applicants

While without any proposal from the Office as yet, the Committee have prepared a non-paper for discussion with the Office, with a view to ascertaining which, if any, align with the aims of the Office and offer potential improvements in practice (which can be found on the **epi** website https://patentepi.org/r/info-2102-01).

Report of the Online Communications Committee

J. Gray (GB), Chair

Alert

At the time of writing, the EPO has just informed **epi** that the online filing system **CMS will be decommissioned at the end of 2021**. Users of CMS have just 8 months to complete their switch to the new Online Filing 2.0. (www.epo.org/applying/online-services/online-filing-20.html)

The other established online filing system e-OLF is not affected.

Members with concerns should please contact their EPO account managers, and copy epi Online Communications Committee at OCC@patentepi.org.

1. Introduction

OCC in its new composition continues the work detailed in my report to C89. Almost all of the existing OCC members stood and were re-elected to OCC for 2020-2023. I am pleased to have support of the Vice-chair David Brophy and Secretary Yannick Biron for the new session. Also I was pleased to invite the candidates who were not elected to the committee to serve as associate members, and they have made good contributions already.

OCC members and associates remain active in a number of collaborations with the EPO and other bodies in **epi**: I and other members participate in TOSC working groups on "Front Office" and "Search"; **epi** Board meetings; **epi** meetings with EPO President & Boards of Appeal;

e-EQE development; SACEPO working groups on Electronic Patent Process (eSACEPO) and Patent Documentation and Information (PDI); liaison with WIPO (ePCT, WIPO Proof); "New User Area" focus groups, etc., etc..

Links with non-**epi** user groups also prove beneficial, for example preparing to make the most of the eSACEPO.

The report of the eSACEPO meeting includes updates on most of the live topics and I will not repeat them in this report.

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

An online meeting of eSACEPO was held on 10 March 2021, with several members of OCC among the **epi** members appointed for the term 2021-2023 (Yannick Biron (OCC) and Marjut Honkasalo (EPPC) are nominated by **epi**; John Gray, David Brophy and Catherine Ménès among others are appointed by EPO "*ad personam*"). The membership of SACEPO and working groups has been radically altered and now includes participants from industry and private practice in China, Japan, Korea and USA, as well as representatives from **epi** and European business organisations.

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

- EPO Strategic Plan – Update
- Oral proceedings in examination and opposition by VICO
- New Online User Engagement programme
- Online filing 2.0
- IT cooperation projects
- E-business Patent Grant Process
- Central service for fee payments – Update and further steps
- Outages & legal certainty under Rule 134 EPC
- Patent Information systems (Register, Espacenet) (see slides TOP 10)
- User Enquiries & Intelligence (see slides TOP 11)

It may be noted that those overseas professionals are sometimes direct users of EPO services in the international phase of PCT applications, so their participation is not completely illogical. However the "demotion" of representatives from the major national professional bodies in Europe was notable in contrast. For example, several persons from Japan could attend, while I personally am the only member in the new session who is based I the UK. In the end, the participation by the Asian colleagues was limited but constructive, but the timing of the event has to be extended to accommodate the different time zones, with an extension for the US colleagues to join for a recap. The new format rather assumes that attendance will be by video, but members spoke for a return to in-person meetings.

3. Video conference for oral proceedings - Survey

The chair and other OCC members worked on the survey which was reported in **epi** Information 1/21, with additional information available on the website. Thanks to all involved.

4. "Online Filing 2.0" launched – CMS users try it now

"Online Filing 2.0" has moved from pilot to an official launch on 1 April 2021. User who are already familiar with CMS should find it rewarding to migrate to OLF 2.0 system and benefit from an improved user interface and better reliability. We are urging the EPO to continue adapting the "marketing" of the different systems on the website. It is too easy for people to be confused into thinking that CMS (coincidentally in "version 2.00" at the same time) is the new system they should be trying.

John Gray

ALERT– At the time of writing, the EPO has just informed **epi** that **CMS will be decommissioned at the end of 2021**. While the decommissioning was well expected, such a short notice as 8 months seems rather hasty and risky. OCC believes in general 2 years is a reasonable "sunset period" for any key online filing system. Members with concerns should please contact their EPO account managers, and copy me at OCC@patentepi.org.

5. DOCX filing

Filing of application documents in DOCX format is possible as a pilot only, within the OLF 2.0 system. Specific meetings with the EPO will be organized in the coming months to address numerous issues around this.

6. Interacting with the OCC

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

Annexes – Minute of eSACEPO 10/3/2021
(**epi** internal use only) & slide presentations

Report of the Professional Conduct Committee

G. Checcacci (IT) Chair

The newly elected PCC started its activity with a general meeting (by ViCo), on 07.12.2020. Giorgio Checcacci has been re-elected as Chair and several Working Groups have been defined.

Giorgio Checcacci

Among them, the already existing WG for the amendment of the Code of Conduct started immediately its activity, to complete the work done in the previous term. At the Council meeting in November 2020, PCC had presented (for information) a preliminary proposal to amend the CoC; that proposal was explicitly incomplete, lacking an article. The WG and PCC as a whole met several times (always by ViCo) between December 2020 and January 2021, and eventually agreed on the complete proposal that was presented to the Council for information on 8 May 2021. The proposal (possibly updated in the next months-) will be presented at the Council meeting in November 2021 for adoption.

Other WGs have also started activity, with the aim of improving knowledge and compliance with the Code of Conduct. A WG is collaborating with the Professional Education Committee (PEC), to prepare webinars on the provisions of the Code of Conduct. Another WG is preparing the background to publish among **epi** members the opinions delivered under Art. 7(d) of the Code of Conduct (obviously, in fully anonymized form).

Report of the European Patent Practice Committee

C. Mercer (GB), Chair

This report covers the period from the last virtual Council the virtual Council to be held on 8th May, 2021.

The EPPC is the largest committee of the epi, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT and (3) the future EU Patent Regulation, including any revision thereof, except all questions reserved for the Biotech committee.

The EPPC is presently organised with seven permanent Working Groups (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, Quality, Unitary Patent and Patent Documentation). Additionally, ad hoc working groups are set up when the need arises. Four Thematic Groups have also been set up (Mechanics, Pharma, ICT and Chemistry). Members of EPPC are also delegates to various meetings organised by the EPO, including meetings under the SACEPO banner. We also now have delegates on the two active Convergence Projects set up by the AC's Committee on Patent Law.

Membership

The members of EPPC and the Thematic Groups were elected at the last virtual Council meeting. Since then, the members of the Working Groups have been appointed. Also, associate members for all parts of EPPC have been appointed.

Meetings

Due to the Covid situation, there have been no face-to-face meetings of EPPC or its sub-parts. However, there

have been virtual meetings of EPPC and its sub-parts, as set out below.

A full meeting of EPPC took place on 23rd November, 2020. At this meeting, I was re-elected as Chair of EPPC. EPPC also decided on the Working Groups which would be reconstituted and suggestions as to membership were received. The minutes of the meeting will be published as soon as possible.

A meeting of the Pharma Thematic Group took place on 24th November, 2020 at which Martin Wilming was elected Chair. Our thanks go to the previous Chair, Ruurd Jorritsma, who was the first Chair and did sterling work for **epi**. The Group also discussed possible topics for discussion at the meeting with DG1 scheduled for 2021 (see below).

The members of the MSBA Working Group, led by Heike Vogelsang-Wenke, took place on 27th November, 2020. The first part of this meeting was taken over by the Board of Appeal Committee (BOAC) of the AC following the consultation on proposed Article 15a of the Rules of Procedure of the Boards of Appeal. The users present at the meeting, in particular **epi**, objected to the proposal and in particular objected to the fact that there was no time limitation on it. There were also objections against the wording.

Once the members of the BOAC left, the meeting turned into a normal MSBA meeting. The main feature of this was the report from the President of the BoA which showed the effect the Covid-19 pandemic was having on the work of the Boards.

A meeting of the ICT Thematic Group took place on 4th December, 2020 and Michael Fleuchaus was re-elected as Chair.

A meeting of the Chemistry Thematic Group took place on 8th December, 2020 and Jim Boff was re-elected as Chair.

A further meeting of the Pharma Thematic Group took place on 10th December, 2020 for further discussion of topics for the meeting with DG1 (see below).

A meeting of the M&M Thematic Group took place on 16th December, 2020 and Eva Carlsson was re-elected as Chair.

On 12th February, 2021, a meeting took place between the Thematic Groups of EPPC and delegates from Biotech Committee with DG1. This took place virtually with a plenary session in the morning and then three thematic sessions in the afternoon. The three thematic sessions were organised according to the divisions in DG1 and so the Biotech, Pharma and Chemistry groups were in one session. Although the meeting was good, it was not as good as in previous years where each Thematic Group and the Biotech Committee have met the relevant directors of DG1 separately. We will need to consider whether the arrangements should revert to those used previously once the Covid-19 pandemic is over.

A meeting of the M&M Thematic Group took place on 2nd March, 2021.

A meeting of the SACEPO Working Party on e-Patent Process took place on 10th March, 2021 and is reported on by OCC.

A meeting of the SACEPO Working Party on Patent Documentation and Information took place on 18th March, 2021.

A meeting of the SACEPO Working Party on Rules took place on 25th March, 2021.

Brief reports on some of these meetings are set out below. If anyone would like further information about them, please send an email to eppc@patentepi.org.
During this period, the Chair of EPPC or a deputy attended Board and Presidium meetings and meetings with the President of the EPO.

Chris Mercer

EPPC also co-operated with the Presidium and OCC in the design and analysis of a survey on oral proceedings. The results have been published in **epi** Information and are available on the **epi** website.

G 1/21

On the matter of Article 15a of the Rules of Procedure of the Boards of Appeal, this was followed up before the meeting of the AC at which it was approved. EPPC co-operated with the Presidium to send a letter to the AC suggesting that approval of Article 15a should be postponed until after a decision on G 1/21 was given.

The issue of the decision which gave rise to G 1/21 and the announcement of a short deadline for filing an amicus brief on G 1/21 led to the formation of an ad hoc Working Group. This group prepared two briefs, the first (Annex 1*) of which was filed as quickly as possible as it related to the composition of the Enlarged Board and, in particular, suggested that Mr. Josefsson should not be on the panel. The second (Annex 2*) related to the question referred by the Technical Board to the Enlarged Board. Copies of the briefs are attached.

REPORTS

SACEPO PDI

epi intervened on the following:

- undue delay for the publication of divisional applications;
- lack of significance of statistical analysis based on inventor addresses (and objection to allegation of applicants deliberately hiding information);
- need for a more simple basic search in the new Espacenet;
- need for a printed EPC until the EQE allows use of a digital EPC annotated by candidates;

and

- wish to keep existing bookmarks when the new website is launched.

SACEPO WPR

The three year nomination period ended 2021, but **epi** representatives will be the same for the ongoing period of 2021-2023.

In the Convergence of Practice (in National Offices and EPO) project first meetings on common practices on priority date (formal and administrative practices) and on re-establishment of rights (formal requirements and how to reassess merits) have taken place. **epi** is participating directly as an observer.

As to **epi** questions what happens when the ViCo in opposition pilot ends in Autumn, we were told that a report on the pilot is being prepared and the aim is to publish it in early July but no one knows what will happen.

epi's paper on Streamlining of Opposition Proceedings sparked a lively debate. It was agreed that an updated version should be prepared for the next meeting in October 2021.

CNIPA-EPO Pilot on ISA files had many comments on the closed EPPC forum and **epi** promised to send them, after anonymising them, to EPO. (This has been done.)

UP

The UP/UPC system is once again delayed. Previously, entry into force of the new system was – although ratified by France, the U.K. and many European states – prevented by a first constitutional complaint against the UPC Agreement, which was finally largely dismissed. In the meantime, the UK announced that they will no longer participate.

On 26th November, 2020 the German parliament approved the legislation required to ratify the Unified Patent Court Agreement, further approved by the German government on 18th December, 2020. Since then, the German Constitutional Court has received two new constitutional complaints in relation to the legality of the Agreement under German national law. These cases are not listed on the 2021 annual preview ('important cases') published by the court.

Pharma Working Group

See Minutes (Annex 3*)

Chemistry Working Group

A meeting was held 8th December to appoint a Chairman and Secretary to the committee.

The sub-Committee had previously prepared for the meeting with the EPO 12th February, and had proposed various topics for discussion.

Relevant subjects that reached the agenda were:-

- Multiple convergent/non-convergent lists, selection inventions, and ranges;
- Assessment of inventive step, where the problem was merely providing an alternative solutions.

Although some discussion took place, as the Pharma, Biotech and Chemistry matters were considered in one session, time constraints limited the scope for in depth treatment of these issues.

Mechanics Thematic Group

Internal report (of dates 17 + 22 February 2021) with notes from the 12 February 2021 meeting with DG 1 directors (Annex 4*);

Minutes from meeting 2 March 2021, with participants including extended Mechanics group including associate members (Annex 5*);

Proposal of 3 November 2021 re **epi** webinars to Mr. Paolo Rambelli, the Chair of Professional Education Committee (Annex 6*).

Quality Working Group

Quality Working Group formed itself and after brief e-mail discussion provided input for the Board to prepare a draft of the feedback to EPO's "Towards a new normal" orientation document (hence: veni and vidi only).

Convergence Group 4 – Re-establishment of Rights

Update on Convergence Group 4 meeting on Re-establishment of rights.

The Chairlady (Teodora Kandeva) presented slides representing a selection and summary of the responses collected on the questionnaire. We did not finish the whole presentation and had to stop after the two hours at the beginning of the "due care" discussion. This will be continued at the next WG meeting. This time Laurence Brüning-Petit (EPO, DG5) made part of the presentation.

We touched the following topics in some detail:

- Noting of Loss of Rights;
- EPO explained EPO's practice;
- Re-establishment into further processing possible at EPO;
- No further processing for annuities;
- Discussion of local practices;
- Short contributions from DE, UK, NL, HR, BE, LT, TR, giving some supplementary comments to the written comments; and
- TR: two-step procedure for annuities: first Notification regarding payment with surcharge, then Loss of rights, then another opportunity to pay with "compensation fee"; only then re-establishmet of rights.

Conclusion: this is a topic that will be elaborated further in this WG.

Fee(s) for re-establishment

- EPO explained the practice of "unitary procedural act", e.g. regional phase entry;
- Short comments provided by LT, PL, ES and CZ.

To be elaborated further.

Guidelines / Templates available for users?

- EPO referred to the section on re-establishment in Part E of the Guidelines;
- NL: very much interested in Guidelines / templates (for single inventors);
- CZ offers a template (not mandatory);
- UK offers (mandatory) template);
- LT: "free form style" required by law;

Templates for issuing decisions?

- No real in-depth discussion, merely presentation of content of slides.

Do same requirements apply to all "actors"?

- Explanation of EPO approach;
- NL and UK: yes, because requirement is only "unintentional";

We were then running out of time; DE delegate pointed out that there might be not much room for harmonization in some Contracting States with regard to the actual due care requirement in general, as this is determined by established case law. PL agreed.

To be continued during next meeting

epi suggested to the Chairlady a topic that the WG might also look into a bit more in detail and noted the remarks in the summary at item 1.4 regarding the question who is entitled to file a request for re-establishment of rights. The answer looks simple (applicant or patentee) but might in practice a bit more complicated if, for example, a EP patent is transferred to a new owner at around the time annuities need to be paid. The previous owner fails to pay and the new owner realizes that. Requests for re-establishment need to be filed in many Contracting States. It would be interesting to know whether in all States it is the registered previous owner who is entitled to file the request or whether some States also allow the new owner to do this.

The next meeting is planned for June 17.

Convergence Group 3 – Priority

Brief update on Convergence meeting on accordance of a priority date.

The Chairman (Pierre Treichel) presented the summary of collected responses on the questionnaire. **epi** started taking notes, but it was a lot of information per slide, and he rushed through the numbers so that **epi** taking notes, trying to concentrate on what he said. **epi** has asked him for the ppt, but he may refuse, as several delegates corrected statements concerning their jurisdiction after the presentation. Anyway, this was the start, and for the next meeting (April 27) it is planned to focus on those areas where a widespread agreement among the EPC countries became apparent by the answers of the delegates. Once **epi** knows these areas, **epi** will ask for EPPC's opinion on the intended harmonization (which mostly will be along the lines of the EPC).

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* Annex 1: Preliminary amicus curiae brief of epi (composition of the Enlarged Board)
Annex 2: Amicus curiae of epi (question refereed by the Technical Board to the Enlarged Board)
Annex 3: Minutes of the EPPC "Pharmaceuticals" subcommittee
Annex 4: Notes in preparation to Mechanics Group e-meeting on 02.03. 2021
Annex 5: Minutes of EPPC Mechanics & Mechatronics Group meeting on 02.03.2021
Annex 6: EPPC_Proposals for epi webinars_EPPC MMGroup_03NOV2020
Annex 7: Summary of meeting_Convergence of Practice on 24.05.2021
Annex 8: WG4_Re-establishment of rights_ Second meeting
All Annexes are available at: https://patentepi.org/r/report-eppc-0221

Report of the Nominations Committee

Q. Quintelier (BE), Chair

After the Committee election, which took place during the C89 Council meeting, there were still some open positions left in different Committees. Consequently, a further election round had to be organized at the C90 Council meeting. As the open positions were limited to a restricted number of EPC Contracting States, the Nominations Committee has sent an invitation to the full members of the **epi** Council of those Contracting States inviting them to look among the members of their Contracting States for candidates. The invitation was generally well responded so that there were candidates for election.

Claude Quintelier

The Secretary General, elected at the C88 Council meeting, resigned making it necessary to organize a new election for the function of Secretary General. Since the Executive Director had started her work at the **epi** Secretariat and since the amended By Laws had caused some changes in the function of the Secretary General, the Nominations Committee was of the opinion that presenting a profile of a candidate for the function of Secretary General could help the full Council members in their decision to stand or not for this function. So, such a profile was drafted and sent to all full Council members. The draft was made with the contribution of the Presidium members and of the Executive Director. The Nominations Committee wants to thank at this occasion the Presidium members and the Executive Director for their kind and constructive cooperation.

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Next Council Meetings

Council Meetings
91th e-Council meeting on November 2021
92th Council meeting on 7 May 2022 in Glasgow (GB)

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