



## New Rule 56a and amendments to Rule 56 EPC

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| <b>6</b> For discussion: Has the requirement that claims be "supported by the description" been perverted over time? by M. Wilming | <b>22</b> Reimbursement of Appeal Fees due to a violation of right to be heard – Board of Appeal decision T 2610/19 by T. Schürmann and M. Wachenhausen |
| <b>18</b> J 8/20: DABUS or artificial intelligence as inventor by M. Köllner   | <b>31</b> Results of the 2022 European Qualifying Examination   |



Cover:

### **Sunset Cottage**

This picture, photographed by Charles Robert Clark (European Patent Attorney, GB) was part of the **epi** Artists Exhibition 2021



## Charles Robert Clark

Charles Robert Clark entered the IP profession as a trainee patent attorney in the UK in 1999. Having spent the last 15 years in leadership position of industrial departments, he now runs his own IP-strategy consultancy (IP-Arkitek.com) focusing on building IP awareness in high-growth tech businesses. Art is an important aspect of Charles' work/life blend. He has recently discovered fine art photography that provides a modern mix to both his passions, painting and photography.

Charles Robert Clark begann 1999 als Patentanwaltsanwärter im Vereinigten Königreich mit dem Beruf im gewerblichen Rechtsschutz. Nachdem er die letzten 15 Jahre in leitenden Positionen von Industrieabteilungen gearbeitet hat, leitet er nun seine eigene IP-Strategieberatung (IP-Arkitek.com), die sich auf den Aufbau eines IP-Bewusstseins in wachstumsstarken Technologieunternehmen konzentriert. Die Kunst ist ein wichtiger Aspekt von Charles' Work-Life-Mix. Vor kurzem hat er die Kunstfotografie entdeckt, die eine moderne Mischung aus seinen beiden Leidenschaften, der Malerei und der Fotografie, darstellt.

Charles Robert Clark est entré dans la profession de la propriété intellectuelle en tant que conseil en brevets stagiaire au Royaume-Uni en 1999. Après avoir passé les 15 dernières années à la tête de départements industriels, il dirige aujourd'hui sa propre société de conseil en stratégie de PI (IP-Arkitek.com), qui se concentre sur la sensibilisation à la PI dans les entreprises technologiques à forte croissance. L'art est un aspect important de l'équilibre entre vie professionnelle et vie privée de Charles. Il a récemment découvert la photographie d'art qui apporte un mélange moderne à ses deux passions, la peinture et la photographie.



# Table of Contents

## Introduction

- 4 Editorial
  - 5 Election to Council 2023
- 

## Patent Practice

- 6 For discussion: Has the requirement that claims be “supported by the description” been perverted over time?  
by M. Wilming
  - 10 New Rule 56a and amendments to Rule 56 EPC – Background, requirements and consequences  
by C. Mulder and R. van Woudenberg
- 

## Case Law

### CONTRIBUTIONS FROM epi MEMBERS AND OTHER CONTRIBUTIONS

- 18 J 8/20: DABUS or artificial intelligence as inventor by M. Köllner
- 22 Reimbursement of Appeal Fees due to a violation of right to be heard – Board of Appeal decision T 2610/19  
by T. Schürmann and M. Wachenhausen
- 25 Treatment of Interim Injunctions in Patent Disputes – Decision of the ECJ in case C-44/21  
by V. Töpert



## Education

- 28 Preparation for the 2023 EQE on the epi-learning platform
  - 30 epi Student membership
  - 30 epi-learning
  - 31 Results of the 2022 European Qualifying Examination
  - 32 List of Professional Representatives
- 

## Committee Reports

- 33 Report of the Committee on Biotechnological Inventions  
by A. De Clercq
  - 34 Report of the Professional Conduct Committee  
by G. Checcacci
  - 35 Report of the Litigation Committee  
by T. Walshe
- 

## General Information

- 37 epi Board
- 37 Next Board and Council Meetings
- 38 epi Disciplinary Bodies and Committees
- 42 Contact Data of Legal and Unitary Patent Division

# Editorial

## Exceptional circumstances?

M. Névant (FR), Editorial Committee

**T**he reform of the Rules of Procedure of the Boards of Appeal (RPBA) was supposed to bring harmonization of the hitherto sometimes divergent practices of the EPO Boards of Appeal (BoA) and, by way of consequence, more certainty for users of the EPO and for third parties. That is, as far as I can remember, how the reform was in particular presented to stakeholders.



**Marc Névant**

Quite sadly, it has to be said that almost three years after the entry into force of the new Rules, harmonization of the practice of the Boards of Appeal is still wishful thinking.

A blatant example of lack of harmonization is the issue of whether deleting one or more claims in a request during appeal proceedings is an amendment in the sense of Article 12(4) RPBA 2000. According to some BoAs the deletion of a claim is not an amendment of a party's case (see T1480/16, T1857/19, T2201/19), whereas other BoAs have decided otherwise (see T494/18, T2091/18, T2920/18).<sup>1</sup>

<sup>1</sup> Acknowledgement is given to Laurent Teyssèdre for his review in "Le Blog du Droit Européen des Brevets"

In the same vein, Article 12(2) RPBA 2000 makes it quite clear in my view that the primary object of the appeal proceedings is to review the decision under appeal. Yet, it is not uncommon for BoAs to raise objections, in the Communication sent in preparation for oral proceedings, which have not been addressed in the appealed decision (e.g. if a patent (application) has been revoked (refused) on the sole ground of lack of novelty, the BoA raises an additional objection under e.g. Article 83 or 123(2) EPC).

Another example is whether the description needs to be adapted to the claims. While some BoAs seem to be of the view that this is required under Article 84 EPC, other BoAs tend to dissent. In this respect it is noted that the BoAs have long ruled that interpreting the extent of protection was a matter for national courts dealing with infringement cases (Case Law of the Boards of Appeal 10<sup>th</sup> Edition 2022, part II 6.3.6). This might add fuel to those who believe that adapting the description to the claims is not a requirement of the EPC.

While it is arguably understandable that BoAs may have a different view on how to assess substantive matters (e.g. sufficiency of disclosure or added subject-matter), this should not be the case for more "procedural" matters as set forth in the RPBA 2020. On the latter point, let's hope that the BoAs will deliver the promised harmonisation before the next reform takes place!

# Introduction

## Election to Council 2023

**Members of the Institute are invited to stand for election to the epi Council. Being a Council member means formally representing and championing the interests of the members of your constituency as well as bringing your passions and interests to the fore. You can actively shape the work and services of the Institute and have the opportunity to elect the Board of epi, being also eligible to become one of its members. It also allows you to be part of the body that is leading the epi task forces that address issues relevant to the Profession and your own constituency.**

**T**he responsibilities of a Council member are described in the By-Laws, and include attending the Council meetings, one in Spring and one in Autumn.

At the beginning of next year, the Council of the Institute is due to be elected for its new term. You can declare from 4<sup>th</sup> October 2022 – 2<sup>nd</sup> November 2022 according to the Rules for Election to Council that you are ready to stand for election or for re-election to the Council. Your nomination can be done online through the **epi** website. The instructions how to log-in on the **epi** website can be found here:

<https://patentepi.org/en/login>

Alternatively, if the online nomination is impossible for you, you can use the nomination paper form that will be sent to you by 4<sup>th</sup> October 2022.

The usual case is that you stand for election in your own constituency, corresponding to your address registered at

the EPO. Your constituency is the State party to the EPC in which you have your place of business or employment. Depending on the number of **epi** members in each constituency, 2, 4, or 6 council members are elected to represent the constituency, and the same number of substitute council members.

The election shall be by remote e-voting. You shall receive on 16 January 2023 at the latest, a web address for a secure website, and a personal password from our independent voting service provider.

If remote e-voting is impossible for you, the **epi** Secretariat will send you a ballot paper by post. You can request the ballot paper by returning a corresponding form that you will receive together with the paper nomination form mentioned above. The form must be received by the **epi** Secretariat at the latest on 2<sup>nd</sup> November 2022.



If you have any questions, please contact the **epi** Secretariat as follows: Tel +49 89 242052 0 or email: [info@patentepi.org](mailto:info@patentepi.org)





# Patent practice

For discussion:

## Has the requirement that claims be “supported by the description” been perverted over time?<sup>1</sup>

M. Wilming, European Patent Attorney, Hepp Wenger Ryffel AG

Objections with respect to alleged violations of **Art. 84 EPC** have become more and more cumbersome in recent times. I cannot really tell why. The law has not changed ever since enactment of the **EPC 1973** in this respect. But the Guidelines for Examination in the EPO were tightened substantially, purportedly merely reflecting long-standing practice. My experience is different. Back in the days, I had occasionally been required to make features of independent claims also mandatory in the specification, e.g., after combination of claims during prosecution. A no-brainer that did no harm, so I complied. Nowadays, users are regularly facing extensive objections to tidy up the specification to large extent, causing anything but minimally invasive changes.

The 2021 revision of the Guidelines caused an outcry amongst users, and the EPO made certain minor amendments in the next revision cycle of the Guidelines.<sup>2</sup> The most controversially discussed sections of the Guidelines are **F-IV, 4.3** (inconsistencies), **F-IV, 4.4** (claim-like clauses).

However, the more general question is still unresolved: *Why do we have to adapt the specification at all?*

In my view, there is just no sound legal basis for it. I am fully aware that this position is controversial, running against the gist of some rather old decisions of Boards of Appeal of the EPO.<sup>3</sup> Still, my line of thinking is as follows.

<sup>1</sup> The essentials of this discussion paper has first been published online on the blog [www.patentlitigation.ch](http://www.patentlitigation.ch) on 24 May 2022.

<sup>2</sup> The current version of the Guidelines is available online, <https://www.epo.org/law-practice/legal-texts/guidelines.html>; don't miss to tick the 'show modifications' checkbox on the right side.

<sup>3</sup> E.g., T 977/94 and those referred to in T 1989/18, r. 10.

## Article 84 at a glance

The mere wording of Art. 84 EPC is plain and simple (emphasis added):

### Art. 84 — Claims

*The claims shall define the matter for which protection is sought. They shall be **clear and concise** and be **supported by the description**.*

The second sentence of **Art. 84 EPC** requires the claims to be i) clear; ii) concise; and iii) supported by the description.

## The travaux préparatoires

It is evident from the travaux préparatoires (TP) that the first two criteria, i.e. clarity and conciseness were meant to reflect Art. 6 PCT in the new legal framework of the EPC.<sup>4</sup> The same holds true for the “support by the description” requirement, with an initially pretty different (but much clearer) wording:<sup>5</sup>

*No patent claim shall contain subject matter that is not listed in the description.*

The TP are silent about the reasons why the initially very clear wording of the third criterion had not been further pursued but rather been amended to exactly match the wording of **Art. 6 PCT**. In my view, the most likely reason is an attempt of harmonization of the wording. There is nothing in the TP that could suggest an intent of the legislator to change the substance of the initial draft. In my understanding, the third criterion was simply meant to exclude subject-matter from the claims that is not listed in the description.

In the first place, all requirements of this provision had been included in the draft Implementing Regulations. Later, the sub-committee proposed (1) to adopt the exact same wording of Art. 6 PCT, and (2) to move it to the Convention itself (emphasis added):<sup>6</sup>

*The sub-Committee decided to provide in paragraph 1 that the claims must be clear and concise and that they must be **fully** supported by the description. This provision seemed so important – particularly from the point of view of infringement actions – that the sub-Committee felt inserting this provision in the Convention itself should be considered.*

4 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p41/a2108538>.  
5 In original German language: “Kein Patentanspruch darf einen Gegenstand enthalten, der nicht in der Beschreibung aufgeführt ist.” See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p38/a2108537>.  
6 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p36/a2107495>.

In the first place, the draft article read exactly as **Art. 6 PCT**.<sup>7</sup> However, the Conference did not like the wording “fully supported by the description” and asked the responsible Working Party to examine deletion of “fully” and the replacement by a less restrictive wording.<sup>8</sup> And, indeed, the term “fully” was deleted:<sup>9</sup>

*The Working Party decided to comply with the request of a number of non-governmental international organisations by the deleting the word “fully” (cf. BR/168/72, point 92).*

Even though the term “fully” was not replaced by a less restrictive wording, the TP leave no doubt about the legislator’s intent to prevent the third criterion from being interpreted in the sense of the initial draft, i.e. that the claims shall be “fully” supported by the description.

The Conference then agreed with the transfer of the provision to the Convention itself.<sup>10</sup> This is the brief history of how we ended up with the wording of what finally became Art. 84 which has never been changed ever since.<sup>11</sup>

For sake of completeness, I have reviewed the records of the Washington Conference on the PCT — which in my assessment do not provide any further insight.

## T 1989/18 — 3.3.04: Shaking the current practice to the very foundations

Applicants rarely risk a refusal merely for non-compliance with a formalistic objection concerning the “necessary” adaptation of the description once allowability of a set of claims has been indicated by the ED. Not so in the case underlying **T 1989/18 — 3.3.04 (EP 2 794 651)**. Accordingly, the Board of Appeal had to investigate whether there was any legal basis for demanding an adaptation of the specification at all. The Board took an approach similar to what I take from the TP, i.e. the “supported by the description” simply means (r. 5):<sup>12</sup>

*[T]he subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described.*

This must not be confused with the first requirement of clarity, in this Board’s view:

7 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p22/a2107496>.  
8 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p20/a2107497>.  
9 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p16/a2107498>.  
10 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p9/a2108540>.  
11 See <https://www.documentcloud.org/documents/22014976-art84etpepc1973#document/p7/a2108539>.  
12 See <https://www.documentcloud.org/documents/22014979-t181989eu1#document/p8/a2108556>.

*When assessing clarity, the description cannot be relied upon to resolve a clarity issue in a claim, nor can it give rise to any such issue if the definition of the subject-matter in a claim is clear per se.*

Accordingly, it is held (r. 7) that Art. 84 cannot serve as a legal basis for the refusal. The Board did not find any legal basis in **R. 42(1) lit. c EPC** (in the absence of a non-unity objection; r. 8) and **R. 48(1) lit. c EPC** (only pertaining to patent applications, not patents — opposed to R. 42 EPC; r9-12), either. In sum, the Board allowed the appeal and remitted the case to the Examining Division with an order to grant the patent — with an unamended description.

### The aftermath of T 1989/18 — 3.3.04

To the best of my knowledge at the time of writing, one further Board of Appeal has explicitly adopted the approach of **T 1989/18 — 3.3.04**, i.e. in the matter **T 1444/20 — 3.3.01** (r. 2 et seqq.). On the other hand, I am aware of five recent decisions of other Boards of Appeal that dissent with **T 1989/18 — 3.3.04**. I will address them below.

Decision **T 1024/18 — 3.2.06** concurs with **T 1989/18 — 3.3.04** in that the claims must be clear in themselves; criterion i) of **Art. 84 EPC**. However, with respect to the third criterion, this Board holds that “supported by the description” cannot mean support in only a part of the description, because this would be at odds with the wording “supported by the description” (apparently understood with an emphasis on the word ‘the’).<sup>13</sup> In my view, this is a somewhat circular reasoning. The claims are only supported by the description when they are supported throughout the description; otherwise, they are not supported(?).

What is more, the TP are clear in that a less restrictive understanding than “fully” supported by the description was intended by the legislator. Against this background, I am having a hard time to accept a reasoning according to which support by (only) “part” of the description is not sufficient. If a partial support is not sufficient anymore, then how is that different from requiring the “full” support that the legislator wanted to dispense with?

Further, the Board mentions that the provision (the substance of Art. 84 EPC) had been moved from the Implementing Regulations to the Convention itself, because of its importance for national infringement proceedings; r. 3.1.9. The Board draws from this that also the requirement of «supported by the description» serves this purpose.<sup>14</sup>

I cannot deduce this from the TP. The TP refer to the importance of *the provision*, but they are silent about which criteria thereof were considered to be of so much importance for national infringement proceedings. In my view, there is no reason to assume that all three criteria were equally meant. For instance, I fail to see that the legislator had conciseness of the claims in mind with respect to the outstanding importance in infringement litigation. In my experience, conciseness of a claim is rarely an issue in litigation (if at all). So, why would one assume that “supported by the description” was meant to be of outstanding importance?

This decision holds, with reference to **T 409/91** (r. 3.3-3.5), that «supported by the description» requires that the claimed subject-matter has a basis in the description, which is to make sure that the claims only extend to subject-matter which, after reading the description, are at the disposal of the skilled person; r. 3.3.5.

Further, with reference to **T 659/93** (r. 3.4), this decision holds that “supported by the description” is to assure that the scope corresponds with the actual contribution to the art, and that the claims can be worked over the entire scope; r. 3.3.5. .

All this is not really controversial. But does it help to answer the question of why we are required to adapt the specification?

The decision goes on to hold that “it follows” that claims and description must not contradict each other, as part of a single document (r. 3.3.5, fourth paragraph).<sup>15</sup> I wonder: Why is this a necessary consequence? I feel that the claims may well be workable over their entire scope, and they may well correspond to the actual contribution to the art, without the need to perfectly match with the description (“übereinstimmen”). In any event, I feel requiring a perfect match puts the bar at the wrong level: “Full” support was clearly not intended by the legislator.

This decision concurs with the reasons of **T 1024/18 — 3.2.06** (which I do not find very convincing; see above), without adding anything in substance; r. 10.2.

This decision is from the same Board as **T 0121/20**, and it again merely refers to and consents with **T 1024/18 — 3.2.06**; r. 5.

This decision agrees with **T 1989/18** in that the description cannot be relied upon to resolve a clarity issue in the claim,

<sup>13</sup> See r. 3.1.8, <https://www.documentcloud.org/documents/22014978-t181024eu1#document/p18/a2110204>.

<sup>14</sup> See <https://www.documentcloud.org/documents/22014978-t181024eu1#document/p19/a2107603>.

<sup>15</sup> See <https://www.documentcloud.org/documents/22014980-t182293du1#document/p27/a2110359>.



but it does not follow the a contrario reasoning (r. 6, fourth paragraph):<sup>16</sup>

*[T]his does not imply that, a contrario, clarity of the claim cannot be affected if the description contains statements contradicting the plain wording of the claim.*

The decision illustrates the unitary character of a patent with the example that terms may be given a special meaning in the description, i.e. that a patent specification can become its own dictionary. In conclusion, this decision holds that statements in the description contradicting the plain claim wording may cause doubts as to the intended meaning of this wording (r. 6, penultimate paragraph).<sup>17</sup> I am not convinced. Primacy of the claims is the overriding principle of any claim construction. If parts of the description really contradict the plain wording of the claim, I fail to see the clarity issue. These parts are irrelevant / overridden by the claims and can simply be ignored.

### Practice under the PCT

The PCT International Search and Preliminary Examination Guidelines (**PCT/GL/ISPE/11**) are meant to reflect the practice under Art. 6 PCT, i.e. under the more restrictive wording “fully supported by the description.” The following is noted therein:<sup>18</sup>

*Where there is any serious inconsistency between claims and description, amendments to remove this should be invited from the applicant. [...] However, inconsistencies which do not cause doubts as to the meaning of the claims may be overlooked.*

Notably, not each and every inconsistency has to be removed even under **Art. 6 PCT**. I feel the example given in the PCT Guidelines is telling:<sup>19</sup>

*Another form of inconsistency is that in which the description and drawings include one or more embodiments of the invention which appear to fall outside the subject-matter covered by the claims (for example, the claims all specify an electric circuit employing electronic tubes and one of the embodiments employs semiconductors as an alternative).*

First, I cannot see how a semiconductor in one «embodiment» of the description could cause doubt

as to the meaning of the plain wording «electronic tube» in a claim. A tube is a tube, not a semiconductor. Period. The disclosed (non-)embodiment is simply not literally covered by the claimed invention — and we all know what that means for a patentee when trying to assert infringement under the Doctrine of Equivalents (DoE):<sup>20</sup> The semiconductors cannot infringe; what is described but not claimed is effectively disclaimed.

Secondly, if this (non-)embodiment is deleted before grant in order to meet the “supported by the description” requirement, a semiconductor may easily be asserted as infringement under the DoE again. The result of requiring applicants to remove the non-embodiment from the specification is the exact opposite of legal certainty and serves no public interest at all.

### Comparative study of national practices

WIPO has conducted a comparative study on the relationship of the claims and the disclosure back in 2002; **SCP/7/6**. The practice of the EPO is extensively reviewed, and summarized as follows:<sup>21</sup>

*[T]he support requirement under Article 84 requires that the subject matter of every claim must have its basis in the description so that a person skilled in the art is able to extend the particular teaching of the description to the whole scope of the claimed invention.*

No mentioning of amendments to the description at all. Essential features must be taken up in the claims (p. 5, first paragraph), but that is it. The same holds true for the other jurisdictions assessed.

In any event, no national practice in a major jurisdiction that I am aware of requires applicants to adapt the description, and in particular not in the way the EPO currently does. Against this background, it appears far-fetched to assume that the PCT contracting states really intended to require substantial amendments to the description by way of **Art. 6 PCT** (and even less so under the less restrictive wording of **Art. 84 EPC**).



Martin Wilming

<sup>16</sup> See <https://www.documentcloud.org/documents/22035249-t172766eu1#document/p13/a2110362>.

<sup>17</sup> See <https://www.documentcloud.org/documents/22035249-t172766eu1#document/p14/a2110374>.

<sup>18</sup> See <https://www.documentcloud.org/documents/22019319-ispe#document/p43/a2110381>.

<sup>19</sup> See fn. 18, above

<sup>20</sup> BGH X ZR 16/09 of 10 May 2011 — Okklusionsvorrichtung

<sup>21</sup> See [https://www.documentcloud.org/documents/22035692-scp\\_7\\_6-1#document/p4/a2110426](https://www.documentcloud.org/documents/22035692-scp_7_6-1#document/p4/a2110426).

Yet another WIPO document gets it right, in my view. **SCP/22/4** holds:<sup>22</sup>

*The meaning of the term “the claims shall be fully supported by the description” is largely similar in most jurisdictions. In general, the term means that there must be a basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than is justified by the description and drawings.*

Why can't we just leave it at this? No touching of the description is necessary towards this end.

<sup>22</sup> See [https://www.documentcloud.org/documents/22019686-scp\\_22\\_4#document/p14/a2110427](https://www.documentcloud.org/documents/22019686-scp_22_4#document/p14/a2110427).

## Where are we going from here

Within a time frame of only a few months, we have seen (at least) six decisions on the issue of “supported by the description” and its implications under **Art. 84 EPC. T 1989/18 — 3.3.04** cannot simply be ignored anymore since its approach is explicitly supported by yet another Board in **T 1444/20 — 3.3.01**. Four other Boards dissented. I feel it is only a matter of time until a Board decides to refer the issue to the Enlarged Board of Appeal; **Art. 112(1) lit. a EPC**. The sooner the better, to finally get things straight. A referral by the President of the EPO under **Art. 112(1) lit. b EPC** is not to be expected, in my opinion.

# New Rule 56a and amendments to Rule 56 EPC

## Background, requirements and consequences

C. Mulder (NL) and R. van Woudenberg (NL)

On 1 November 2022, Rule 56a EPC will be inserted into the EPC. This Rule will allow the correction of erroneously filed application documents or parts thereof. Rule 56a EPC corresponds to a similar provision in PCT Rule 20.5bis which entered into force on 1 July 2020. With the introduction of Rule 56a EPC, the EPO will withdraw its notice of incompatibility that it, currently, does not apply (parts of) PCT Rule 20.5bis.

Also on 1 November 2022, Rule 56(3) EPC will be amended to require that the priority must already be claimed on the initially accorded date of filing in order to maintain the date of filing. Rule 56(3) EPC relates to the filing of missing parts of the description or missing drawings which are completely contained in the application.

Under amended Rule 56 and new Rule 56a EPC, there is less flexibility for applicants because priority may no longer be added when filing missing parts or correct application documents.

## Introduction

The Patent Law Treaty (PLT) was adopted in 2000.<sup>1</sup> The aim of this Treaty is “to harmonise and streamline”, on a world-wide basis, formal procedures relating to national and regional patent applications and maintenance of patents. The PLT does not establish a uniform procedure for all parties to the PLT but leaves parties free to require fewer or more user-friendly requirements than those provided in the PLT. In an article written by one of the current authors, it was concluded that the goals of the PLT were not achieved due to ambiguities in the Treaty.<sup>3</sup>

<sup>1</sup> The Patent Law Treaty (PLT) was adopted on 01.06.2000 at a Diplomatic Conference in Geneva and entered into force on 28.04.2005. Currently (August 2022), there are 43 member States. See <https://www.wipo.int/treaties/en/ip/plt> (accessed 25.08.2022).

<sup>2</sup> Although open to intergovernmental organization (Art. 20(3) PLT) and despite the European Patent Organisation indicating its wish to become a party to the PLT (Document MR/2/00 of the *Travaux Préparatoires to the EPC 2000*), the Organisation never ratified the PLT.

<sup>3</sup> Cees Mulder: “Patent Law Treaty: Promises Not Delivered – How the Negotiations Resulted in Ambiguities in the Treaty” in *The Journal of World Intellectual Property* 17 (2014) pp.160-190.

During the Revision of the European Patent Convention (EPC) adopted in 2000,<sup>4</sup> the main features of the PLT were implemented in an exemplary manner into the EPC. Amongst others, the following items were adopted in the Implementing Regulations to the EPC:

- Requirements for according a date of filing to a European patent application<sup>5</sup> including relief with respect to language requirements implying that a European patent application may be filed in any language;<sup>6</sup>
- Filing a description and/or drawings by reference to another application;<sup>7</sup>
- Filing missing parts of the description or missing drawings;<sup>8</sup>
- Addition or correction of a priority claim;<sup>9</sup>
- Restoration of right to priority.<sup>10</sup>

Apart from the above alignment with the PLT, the EPO co-develops and aligns with other international developments, in particular with the Patent Cooperation Treaty (PCT).

## New Rule 56a EPC

On 1 July 2020 PCT Rule 20.5bis was inserted into the PCT.<sup>11</sup> The Rule lays down a procedure for the correction of “erroneously filed” application documents. PCT Rule 20.5bis allows an applicant of an international application – in limited circumstances – to replace any erroneously filed claims and/or the description of the application (or any part thereof), or any erroneously filed drawings with the equivalent “correct” version of the claims, the description or the drawings (or any part thereof) as contained in the priority application.<sup>12</sup>

The introduction of PCT Rule 20.5bis was aimed at aligning the practices of receiving Offices and designated/elected Offices in the special case where an applicant had erroneously filed a wrong element or part of the international application. In particular, the European Patent Office (EPO) acting as receiving Office under the PCT applied a different interpretation relating to what can be filed as a “missing part” under existing PCT Rule 20.5.<sup>13</sup> The EPO argued that

– by definition – the term “missing part” of the claims or the description indicates that some part of the claims or the description was missing but other parts of the claims or the description had been filed.<sup>14-15</sup> Incorporation by reference<sup>16</sup> of a “missing part” would – in the interpretation of the EPO – thus require that the “missing part” of the claims or the description that was to be incorporated by reference indeed “completes” that (incomplete) element as contained in the international application on the international filing date, rather than adding a new element.<sup>17</sup>

To overcome the divergent interpretations on existing PCT Rule 20.5, PCT Rule 20.5bis was introduced to ensure that PCT Rule 20.5 would only cover “truly” missing parts or missing elements. As PCT Rule 20.5bis was incompatible with the practice under the EPC, the EPO notified the International Bureau of WIPO of its incompatibility.<sup>18</sup>

New Rule 56a EPC aims at aligning the practice under the EPC with PCT Rule 20.5bis.<sup>19</sup> The new Rule is constructed in the same way as current Rule 56 EPC but includes additional provisions in Rule 56a(2) and (8) EPC, as will be explained below.

After receipt of a European patent application, the EPO will first examine whether the application is entitled to a date of filing in accordance with Rule 40 EPC. If during this check, the EPO notes that the description, claims or drawings or a part thereof, appear to have been filed erroneously (i.e. unintentionally) the applicant will be invited pursuant to Rule 56a(1) EPC to file the correct document (or part thereof).<sup>20-21</sup> A request for correction must be filed within two months of that invitation.<sup>22</sup>

Under Rule 56a(2) EPC a provision has been added that formalises the EPO’s practice with regard to corrections of application documents received *on the date of filing*.<sup>23</sup> It allows the *correction and exchange* of application

4 The revised European Patent Convention (also referred to as “EPC 2000”) was adopted on 29.11.2000 at a Diplomatic Conference in Munich and entered into force on 13.12.2007. See <https://www.epo.org/law-practice/legal-texts/epc.html> (accessed 25.08.2022).

5 Art. 5(1) PLT; Rule 40 EPC.

6 Art. 5(2)(b) PLT; Art. 14(2) EPC.

7 Art. 5(7) PLT; Rule 40(1)(c) EPC.

8 Art. 5(6) PLT; Rule 56 EPC.

9 Art. 13(1) PLT; Rule 52(2) and (3) EPC.

10 Art. 13(2) PLT; Rule 136(1) EPC.

11 PCT Rule 20.5bis was adopted by the PCT Union Assembly on 09.10.2019 and entered into force on 01.07.2020. See [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=52258](https://www.wipo.int/meetings/en/details.jsp?meeting_id=52258) (accessed 25.08.2022).

12 See e.g., documents PCT/WG/12/9 (29.04.2019) and PCT/WG/12/24 (14.06.2019) of the PCT Working Group.

13 According to PCT Rule 20.5(a) a “missing part” refers to the situation where a part of the description, a part of the claims, a part or all of the drawings is or appears to be missing; whereas a “missing element” refers to the situation where all of the description or all of the claims is or appears to be missing.

14 Also see Document CA 4/21 (President EPO; 07.09.2021) item 12 referring to J 27/10, reason 12. See

[https://www.epo.org/modules/epoweb/accdocument/epoweb2/524/en/CA-4-21\\_en.pdf](https://www.epo.org/modules/epoweb/accdocument/epoweb2/524/en/CA-4-21_en.pdf) (accessed 25.08.2022).

15 Document PCT/WG/6/20, items 5-6. See [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=28622](https://www.wipo.int/meetings/en/details.jsp?meeting_id=28622) (accessed 25.08.2022).

16 See PCT Rules 4.18 and 20.6.

17 See e.g., Practical Advice in PCT Newsletter No. 07-08/2015. See [https://www.wipo.int/edocs/pctndocs/en/2015/pct\\_news\\_2015\\_07\\_08.pdf](https://www.wipo.int/edocs/pctndocs/en/2015/pct_news_2015_07_08.pdf) (accessed 25.08.2022).

18 The EPO as receiving Office and designated Office did not apply PCT Rules 20.5bis(a)(ii) and (d) as of 01.07.2020. This reservation will be withdrawn when Rule 56a EPC enters into force on 01.11.2022.

Also see Official Notices (PCT Gazette) issued by WIPO (20.01.2020).

19 “Notice from the EPO dated 23 June 2022 concerning the correction of erroneous filings in proceedings before the EPO”, OJ EPO 2022, A71, in particular items 1-4.

20 Similar to Rule 56(1) EPC, the applicant may not invoke the omission of the invitation by the EPO.

21 If the applicant does not reply to the invitation of the EPO in due time, any filing of the correct application documents (or parts) will be deemed not to have been made and the erroneously filed application documents (or parts) will remain in the application or be restored to the application (Rule 56a(5) EPC).

22 Rule 56a(1), last sentence, EPC.

23 PCT Rule 20.5bis(b) PCT contains a corresponding provision.



documents *before* or on the date of filing without changing the date of filing. Rule 56a(2) EPC applies to the unlikely and rare case that the applicant has already paid the fees on filing for the first-filed application on the date of filing.<sup>24</sup> Anyhow, Rule 56a(2) EPC avoids that the applicant needs to file a second application and pay the corresponding fees again, if the applicant recognises on the date of filing (or earlier if the date of filing cannot yet be accorded) that erroneously filed incorrect application documents have been filed.<sup>25</sup> Note that when filing correct application documents under Rule 56a(2) EPC, the erroneously filed application documents are “deemed not to have been filed”.<sup>26</sup>

Rule 56a(3) EPC allows an applicant to correct of own volition the description, claims and drawings (or parts thereof) *after the date of filing*, if they were filed “erroneously”.<sup>27</sup> The erroneously filed application documents will be deemed not to have been filed,<sup>28</sup> and the correct documents will be added. As a consequence, the date of filing will be shifted to the date of receipt of the correct application documents or parts thereof. The applicant has to realise that a change of the date of filing may result in a loss of the right of priority.

Note that in Rule 56a(3) EPC, apart from a reference to an invitation from the EPO under Rule 56a(1) EPC, a reference to an invitation from the EPO under Rule 56(1) has been added.<sup>29</sup> This allows an applicant to file correct application documents or missing parts following either invitation of the EPO.

The requirements for meeting the “completely contained” criterion in Rule 56(3) EPC have been taken over in Rule 56a(4) EPC.<sup>30</sup> If the correct application documents (or

parts thereof) are completely contained in the priority document, Rule 56a(4) EPC allows an applicant to maintain the initial date of filing when adding those documents or parts.<sup>31</sup> The erroneously filed application documents will *remain* in the European patent application and may only be *removed* by amending the application during the proceedings up to grant.<sup>32</sup> Any removal of the erroneously filed documents during grant proceedings will be subject to the requirements for amending a European patent application under Art. 123(2) EPC.<sup>33</sup>

Note that the wording in Rule 56a(4) EPC (emphasis added) “within *the period* under paragraph 3” is not correct, because two (concurrent) periods may be applicable either two months from an invitation from the EPO under Rule 56a(1) EPC and/or two months from an invitation from the EPO under Rule 56(1) EPC. It would have been better to use a formulation like (emphasis added) “within *the applicable period* under paragraph 3”.<sup>34</sup>

If the applicant fails to comply with the requirements referred to in Rule 56a(4) EPC within the applicable period,<sup>35</sup> the European patent application pursuant to Rule 56a(6) EPC will be re-dated to the date on which the correct application documents or parts were filed. In addition, the filing of the erroneously filed application documents or parts will be deemed not to have been made.<sup>36</sup>

Like under current Rule 56(4) and (6) EPC, in cases where the date of filing has been shifted, the applicant may withdraw the correct application documents in order to maintain the initial date of filing (Rule 56a(5) and (7) EPC).<sup>37-38</sup>

Last but not least, a new provision has been inserted into Rule 56a EPC relating to the search of the European patent application. If the applicant files correct application documents or parts under Rule 56a(3) or (4) *after* the EPO has already begun to draw up the search report, the EPO will invite the applicant pursuant to new Rule 56a(8) EPC to pay a further search fee within a non-

24 The argument of the fees is weak, because if the applicant withdraws the first-filed application, the search fee will be refunded. The EPO will only retain the filing fee.

25 A similar provision can be found in PCT Rule 20.5bis(b).

26 Note that the wording in Rule 56a(2) EPC: “*the erroneously filed application documents or parts shall be deemed not to have been filed*” is different from the wording in corresponding PCT Rule 20.5bis(b) where it is written “*the erroneously filed element or part concerned shall be removed from the application*”.

According to OJ EPO 2022, A71, item 15: all application documents (and parts) are considered part of the file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application (Art. 128(4) and Rule 144 EPC). Upon reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be excluded from file inspection.

27 The correct application documents may be filed within a non-extendable period of two months of the date of filing (Rule 56a(3) EPC).

28 Note that the wording in Rule 56a(2) EPC: “*the erroneously filed application documents or parts shall be deemed not to have been filed*” is different from the wording in corresponding PCT Rule 20.5bis(b) where it is written “*the erroneously filed element or part concerned shall be removed from the application*”.

According to OJ EPO 2022, A71, item 15: all application documents (and parts) are considered part of the file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application (Art. 128(4) and Rule 144 EPC). Upon reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be excluded from file inspection.

29 The same applies to amended Rule 56 EPC where a reference to the communication under Rule 56a(1) was added to Rule 56(2) EPC.

30 The formal requirements in Rule 56a(4) EPC correspond to those in Rule 56(3) EPC.

31 The priority of the earlier application must be claimed on the initial date of filing. This requirement has also been added in Rule 56(3) EPC as amended.

32 The same procedure is provided for in PCT Rule 20.5bis(d).

33 OJ EPO 2022, A71, items 10 and 16.

34 See the next part of this article “Amended Rule 56 EPC” for a more detailed discussion on the two concurrent periods.

35 Similar to Rule 56a(4) EPC, the wording of Rule 56a(6) EPC (emphasis added) “within the period under paragraph 3” is not correct. Like in Rule 56a(4) EPC, it would have been better to use a formulation in Rule 56a(6) EPC like (emphasis added) “within the applicable period under paragraph 3”.

36 The EPO will inform the applicant accordingly (Rule 56a(6), last sentence, EPC).

37 Rule 56a(5) EPC also applies to the situation where the applicant fails to file the correct application documents or parts within the period under Rule 56a(1) or (3).

38 In each of the situations in Rule 56a(5) EPC, (6) and (7) EPC, the EPO will inform the applicant on the outcome of the request to withdraw the correct application documents (or parts) or the re-dating of the application.

extendable period of one month.<sup>39-40</sup> Note that a corresponding invitation to pay a further search fee has not been included in Rule 56 EPC.<sup>41</sup>

The originally proposed version of Rule 56a(8) EPC included the wording (emphasis added): "... the European Patent Office *may* invite the applicant to pay a further search fee ....". In the final version of the Rule, this was changed into (emphasis added): "the European Patent Office *shall* invite the applicant to pay a further search fee ...".<sup>42</sup> As far as we are aware, no reduction schemes have been discussed in case the final search could benefit in part or in full from the search that was already underway. Charging a full further search fee if only a small change resulted from "late" correction seems disproportional.

Rule 56a EPC will enter into force on 1 November 2022.<sup>43</sup> Similar to Rule 56 EPC, further processing is excluded for the periods in Rule 56a EPC,<sup>44</sup> with the exception of Rule 56a(8) EPC.<sup>45</sup>

Following the entry into force of new Rule 56a EPC on 1 November 2022, the incompatibility of PCT Rule 20.5bis with the EPC legal framework will cease. Note, however, that in the period between 1 July 2020 and 31 October 2022, international applications relying on incorporation by reference by the receiving Office under Rule 20.5bis(d) PCT, i.e. without changing the filing date, will not be effective before the EPO. For international applications filed on or after 1 November 2022, the EPO as receiving Office will start processing requests for incorporation by reference of the correct element or part under PCT Rule 20.5bis(d).<sup>46</sup> If the requirements are fulfilled,<sup>47</sup> the correct element or part will be considered to have been contained in the purported international application on the date on which one or more elements referred to in PCT Article 11(1)(iii) were

first received by the receiving Office *without* shifting the international filing date. It is noted that in this case the wrong element or part will also remain in the application.

## Amendment of Rule 56 EPC

The requirements set out in Art. 5(6) PLT<sup>48</sup> have to a large extent been taken over in Rule 56 EPC, allowing an applicant to include a missing part of the description or missing drawings after filing a European patent application. After receipt of the application, the EPO will first examine whether the application is entitled to a date of filing in accordance with Rule 40 EPC. If during this check, the EPO notes that a part or parts of the description or that drawings are or appear to be missing, the applicant will be invited to file the missing items within a non-extendable period of two months from the invitation (Rule 56(1) EPC).<sup>49-50</sup>

According to Rule 56(2) EPC, the applicant may also file missing parts of the description or file missing drawings of own motion.<sup>51</sup> If the applicant files a missing part of the description or a missing drawing of own motion or upon invitation of the EPO, the application will normally be re-dated to the date on which the missing item is received by the EPO.<sup>52</sup>

Under the amendment of Rule 56 EPC, a reference to the EPO issuing a communication under Rule 56a(1) EPC has been added to Rule 56(2) EPC.<sup>53</sup> This allows an applicant to file missing parts or correct application documents following either invitation of the EPO.

Rule 56(3) EPC allows an applicant to file missing parts of the description or missing drawings without loss of the date of filing initially accorded by the EPO. Redating is avoided if the missing items are completely contained in an application from which priority is claimed.

Note that the wording of Rule 56(3) EPC (emphasis added) "*within the period* under paragraph 2" is not correct. Due to the addition in Rule 56(2) EPC to an invitation from the EPO under Rule 56a(1) EPC, there are now two (concurrent) periods that may be applicable:

39 In Rules relating to Fees Art. 2(1), item 2, a reference to Rule 56a(8) EPC has been added (effective 01.11.2022). If the search fee is not paid in due time, the application will be deemed to be withdrawn (Rule 56a(8), last sentence, EPC).

40 This is similar to the provision in PCT Rule 40bis, where the International Searching Authority (ISA) may request the applicant to pay an additional (search) fee if a missing part of a correct element or part is filed after the ISA has begun to draw up the international search report. Also see the reference to PCT Rule 40bis in Rules relating to Fees Art. 2(1), item 2.

41 The same applies where an applicant files missing parts or elements pursuant to PCT Rule 20.5. Although asking for a further (search) fee under PCT Rule 40bis applies to both the situations of PCT Rule 20.5 and 20.5bis, the EPO acting as ISA has chosen to ask for an additional (search) fee *only* in the situation where the applicant files correct elements or parts under PCT Rule 20.5bis, but not when the applicant files missing parts or elements under PCT Rule 20.5. This can be inferred from Art. 2(1), item 2 of the Rules relating to Fees where reference is made to PCT Rule 20.5bis but not to PCT Rule 20.5. Also see OJ EPO 2020 A36 and A81.

42 Note that PCT Rule 40bis.1 it is written (emphasis added): "The International Searching Authority *may* invite the applicant to pay additional fees where the fact that a missing part or a correct element or part ... is notified to that Authority only after it has begun to draw up the international search report."

43 See OJ EPO 2022, A3, Art. 3.

44 See OJ EPO 2022, A3, Art. 1(3): Amendment of Rule 135(3) EPC ruling out the periods in Rule 56a(1) and (3)-(7) EPC from further processing.

45 If the time limit for paying the further search fee under Rule 56a(8) EPC is missed, further processing is available (not ruled out in Rule 135(3) EPC).

46 OJ EPO 2022, A71, item 23.

47 PCT Rules 20.6(b) and 4.18.

48 Also see Rule 2(3) and (4) PLT.

49 If the applicant does not reply to the invitation of the EPO in due time, all references to the missing items are deemed to be deleted (Rule 56(4)(a) EPC).

50 The last sentence of Rule 56(1) EPC stipulates that the applicant may not invoke the omission of a communication from the EPO under Rule 56(1) EPC.

51 The missing parts may be filed within a non-extendable period of two months of the date of filing (Rule 56(2) EPC).

52 If re-dating is undesirable, e.g., in view of priority, the applicant can retract the effect of the re-dating by withdrawing the missing item(s) within one month from the communication of Rule 56(2) or (5) EPC, in which case the re-dating is deemed not to have occurred (Rule 56(6) EPC). This can also be effected when later the examining division concludes that the missing parts are not "completely contained" in the priority document, contrary to the original finding of the Receiving Section (see GL/EPO (2022) C-III 1.1.1).

53 OJ EPO 2022, A71, item 7.

- 1) two months from an invitation from the EPO under Rule 56(1) EPC, and/or
- 2) two months from an invitation from the EPO under Rule 56a(1) EPC.

In principle, there even is a third period running, i.e., when the applicant files missing parts of own volition, but this one normally expires first. Upon amending Rule 56(3) EPC, it would have been better to use a formulation like (emphasis added) “within the applicable period under paragraph 2”.<sup>54</sup> A solution could be that the EPO in stead of issuing a communication under Rule 56 EPC and a separate communication under Rule 56a EPC (as the case may be), would issue a single communication combined for Rule 56 and 56a EPC. In that case, there would be “a period under paragraph 3” for the combined communication. It may be wise to clarify this in the Guidelines. Note that the same remark applies to Rule 56(4)(a) and 56(5) EPC: following the amendment of Rule 56(2) EPC, the word “applicable” should have been added where reference is made to “the period” in this provision.



Cees Mulder

The version of Rule 56 EPC as in force before 1 November 2022 specifies as one of the requirements for the completely contained criterion in Rule 56(3) EPC that “the application claims priority of an earlier application”. This formulation does not specify when the application must claim priority in order to avoid the re-dating when filing a missing part of

the description or a missing drawing. The requirements that should be met are clear from Art. 5(6)(b) PLT which stipulates that in order for a missing part of the description or a missing drawing to be retrieved from the priority application, the application:

*“... at the date on which one or more elements ... were first received by the Office, claims the priority of an earlier application ...”*

Although Rule 56(3) EPC does not specify when the priority must be claimed, the Guidelines could have specified that the priority of the earlier application must be claimed on the date on which the application was filed. However, the Guidelines allowed the applicant “to insert a new priority claim not present when the application was filed” with the proviso that “the priority claim in question must have been in existence no later than the filing” of the request under Rule 56(3) EPC.<sup>55</sup>

<sup>54</sup> Note that the wording “within the period under paragraph 2” appears twice in Rule 56(3) EPC.

<sup>55</sup> See GL/EPO (2022) A-II 5.4.1 (this applies to the version of Rule 56(3) EPC as in force until 1 November 2022).

Apart from deviating from a mandatory requirement in the PLT, this “leniency” in the Guidelines with respect to the later insertion of a priority claim carries the risk of a direct violation of Article 123(2) EPC providing that the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the *application as filed*. This has been extensively discussed (with examples) in an article by one of the current authors in this Journal in 2010.<sup>56</sup>

Note that the PCT when allowing the filing of missing parts or missing elements in PCT Rule 20.5 or the correction of erroneously filed elements or parts in PCT Rule 20.5bis, also requires that the international application must claim priority “on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office”.<sup>57</sup>

With the amendment of Rule 56 EPC, the ambiguity in Rule 56(3) EPC (as in force until 1 November 2022) has been repaired by stipulating in this paragraph that the priority claim must be made when the applicant files the European patent application (emphasis added):<sup>58</sup>

*“If the missing parts of the description or missing drawings are filed within the period under paragraph 2, and the application claims priority of an earlier application on the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, within the period under paragraph 2: ...”*

This amendment means that Rule 56(3) EPC as in force from 1 November 2022 explicitly provides that it is no longer possible to add the claim to priority after the initial date of filing, e.g. together with the request to add a missing part of the description or a missing drawing.

Rule 56(2) and (3) EPC as amended will enter into force on 1 November 2022.<sup>59</sup> Adding a provision to Rule 56 EPC similar to Rule 56a(8) EPC (invitation to pay a further search fee) was not regarded necessary, because under Rule 56 EPC, missing claims cannot be added (see the discussion below).

<sup>56</sup> Cees Mulder and Derk Visser: “Filing date requirements under the EPO – An option to extend subject-matter?” in *epi* Information 2|2010 pages 44-48.

<sup>57</sup> This requirement is enshrined in PCT Rule 4.18.

<sup>58</sup> In Document 5/20 issued by SACEPO – Working Group on Rules (21.02.2020), it is mentioned that the addition is made “for the sake of legal certainty and following a request by users”.

<sup>59</sup> See OJ EPO 2022, A3, Art. 3.



## Discussion

The introduction of Rule 56a EPC is not only aimed at aligning the EPO's practice with that of the PCT, but also the result of users of the European patent system desiring to have a safety net for the rare case where an error was made when filing an application, such as when a set of claims foreseen for a different application was erroneously filed. New Rule 56a EPC allows the correction of erroneously filed application documents in the initial phase of the patent grant procedure. The introduction of Rule 56a EPC brings the EPO in a position to withdraw its reservation under PCT Rule 20.5bis and fully apply the PCT procedure as receiving Office and as designated/elected Office.<sup>60</sup>

Rule 56 EPC and 56a EPC will only be used in rare cases but when it happens it is good that applicants can add a missing part of the description or a missing drawing, or can correct erroneously filed application documents or parts thereof.

According to statistics, Rule 56 EPC is rarely used by the EPO and the applicants.<sup>61</sup> In the last four years, an average of 50 requests under Rule 56 EPC were received per year (< 0.1% of the total number of filed direct European patent applications). It is expected that the use of Rule 56a EPC will be on a similar level. With regard to the statistics on the use of corresponding PCT Rule 20.5bis, the International Bureau (IB) of WIPO recorded approx. 120 cases since the entry into force of the Rule on 1 July 2020.<sup>62</sup> With respect to the number of cases where the applicant will be invited to pay a further search fee (Rule 56a(8) EPC), it is expected that this will happen in less than 10% of the requests under Rule 56a EPC.

The whole purpose of introducing Rule 56a EPC and amending Rule 56 EPC as described in SACEPO WPR Document 5/20<sup>63</sup> is *"to align the EPC with the new PCT provision (see the propose wording of Rule 56 and Rule 56a EPC)".* However, the alignment with the PCT was not extended to allow the filing of "missing claims" as missing parts under Rule 56 EPC. The filing of missing claims is allowed under corresponding PCT Rule 20.3 (all claims missing) and Rule 20.5 (missing part of the claims).

The argument that Rule 56 EPC is related to Rule 40 EPC, implementing Art. 80 EPC, and claims are not mandatory for according a date of filing, is true but then it is strange

that the applicant can also file missing drawings under Rule 56 EPC whereas drawings are (also) not a requirement for the accordance of a date of filing. It seems incongruous that Rule 56a EPC, also implementing Rule 40 EPC, allows the correction of an erroneously filed set of claims. On the other hand, one may argue that Art. 5(6) PLT only addresses the topic of where "a missing part of the description or a missing drawing is filed" and "hence" there is no need to allow for the filing of missing claims under Rule 56 EPC. However, the vast majority of applicants files European patent applications together with a set of claims because when claims are filed after the date of filing, they must have a basis in the application as filed.<sup>64</sup> Furthermore, the preparatory documents emphasise even stronger the wish for alignment with the PCT<sup>65</sup> (rather than just with the PLT), but Rule 56 EPC fails to achieve that alignment in relation to the claims. We also observed that the preparatory documents for new Rule 56a EPC repeatedly provide that "The application documents, namely the description, drawings and claims, as filed on the date of filing establish the disclosure of a European patent application"<sup>66</sup> and that "The application with the disclosure determined under proposed Rule 56a EPC would be considered the application as filed and would form the basis for any amendments under Article 123(2) EPC".<sup>67</sup> That this importance of the claims is reflected in the new provision for erroneous/corrected claims but not in those for missing claims is hard to understand.

If Rule 56a(4) EPC is used, the correct documents will be added to the application as filed and the erroneously filed application documents will remain in the application as filed, as in PCT Rule 20.5bis(d). However, the reason for PCT Rule 20.5bis(d) to keep both versions lies in the incompatibility with some national law/reservations of designated Offices: it aims to allow, after incorporation by the rO, to proceed with the relevant version in the national phases of Offices without and with reservations.<sup>68</sup> In the EPC, there is no such phase, no reservations, and no need for keeping two versions of the application documents "active". Therefore, in our view, Rule 56a(4) EPC should be amended to provide that the correct part replaces the erroneously filed part, as in Rule 56a(3) EPC, so that there is also no need for any amendment to delete the erroneous part in Rule 56a(4) EPC, as there is not in Rule 56a(3) EPC.

Further, after using Rule 56a(4) EPC the erroneously filed application documents have to be removed by amending the application during the proceedings up to grant, the

60 See "Withdrawal of Notification of Incompatibility of Certain PCT Rules with National Laws – European Patent Office" in PCT Newsletter No. 07-08/2022. See [https://www.wipo.int/edocs/pctndocs/en/2022/pct\\_news\\_2022\\_7\\_8.pdf](https://www.wipo.int/edocs/pctndocs/en/2022/pct_news_2022_7_8.pdf) (accessed 25.08.2022)

61 Private communication with the EPO.

62 Private communication with the International Bureau of WIPO.

About 70 cases related to removal/correction of erroneously filed elements and parts and about 50 cases to the incorporation of erroneously filed elements and parts.

63 "Draft Rule 56a EPC regarding correction of erroneous filings", Document 5/20 issued by SACEPO – Working Group on Rules (21.02.2020).

64 Art. 123(2) EPC. See e.g., GL/EPO (2022) A-III 15, B-XI 2.2, C-III 1.1.2 and H-IV 2.2.3.

65 Document CA 4/21 (President EPO; 07.09.2021) items 6, 14 and 34 for new Rule 56a EPC; CA 4/21 items 17 and 35 for the amendment to Rule 56 EPC.

66 Document CA 4/21 (President EPO; 07.09.2021) item 8; OJ EPO 2022, A71, item 6.

67 Document CA 4/21 (President EPO; 07.09.2021) item 18.

68 Document PCT/WG/12/9 Comments on page 11 (comment to Rule 20.5bis(d)).

amendment being subject to the standard high bar of Art. 123(2) EPC.<sup>69</sup> Hence, Rule 56a(4) EPC specifies that the erroneous documents and the corrected documents together form the application as filed (in case of correction without a change of the date of filing in the “completely contained” situation), which is different from Rule 56a(3) EPC where the correction is done with a change of the date of filing and where the erroneously filed application documents will be deemed not to have been filed.<sup>70</sup> However, the erroneous parts may be so erroneous that they cannot be “amended out” when they are considered to also be part of the application as filed. For example, consider a patent application relating to improvements to vehicles, such as cars. The erroneous description says, “in all embodiments of the invention, the vehicle is a car”, whereas it should have read “in an embodiment of the invention, the vehicle is a car”. In that case, the erroneous description, being part of the application as filed, would require to limit the whole application to cars, whereas the intention clearly was to cover all types of vehicles with cars just being one explicit embodiment. This cannot be the intention of filing corrected parts! Further, if both the erroneously filed documents and well as the correct documents are part of the application as filed, a divisional could be directed to the erroneous embodiments – which may, at least theoretically, happen to be also valid and even more preferred embodiments. (E.g., where the erroneous embodiment was a moped, and the corrected one was a motor, and where the applicant later finds that his invention would also work for a moped). In our view, Rule 56a(4) EPC should, as Rule 56a(3) EPC, specify that the erroneously filed application documents will be deemed not to have been filed and the correct documents will be added so as to replace the erroneously filed application documents, and the application as filed shall comprise the correct documents but not the erroneous ones.

New Rule 56a EPC<sup>71</sup> does not describe the effect of erroneous/corrected parts on the filing fee (especially the additional fee, often referred to as page fee) and the claims fees. We believe that clarification is necessary. For example, under R.56a(3) EPC the correct parts replace the erroneously filed parts, so that it may be assumed that any page fees and claims fees are based on the application documents after correction. However, the period for paying the page fees runs from the filing of the first set of claims,<sup>72</sup> i.e., the erroneous claims, while this period for the corrected application documents expires later (2 months), so that the correction may be filed after the page fees were already paid (albeit for the erroneously filed documents). Under Rule 56a(4) EPC, the correct parts are *added* to the erroneously filed parts, so that it may be assumed that

any page fees as well as claims fees are based on the erroneous and corrected application documents *together*. However, if the erroneously filed set of claims set would, for example, have 17 claims and the correct claim set 14, one would need to pay  $17 + 14 - 15 = 16$  claims fees,<sup>73</sup> while only the 14 correct claims will in the end be maintained. Further, if no claims fees would be paid, all claims above 15 would be deemed to be abandoned,<sup>74</sup> i.e., none of the correct claims would be part of the procedure. It may be doubted whether this is the intention of the new provisions.<sup>75</sup> Also, the same period complication as for Rule 56a(3) arises for Rule 56a(4) EPC.

The effect of erroneous/corrections on Rule 159 EPC, Rule 161(1)/162 EPC and Rule 161(2)/162 EPC is not addressed in new Rule 56a EPC,<sup>76</sup> nor in the Notice<sup>77</sup> clarifying its introduction.<sup>78</sup> In our interpretation, the applicant is likely expected to amend the Euro-PCT application by removing the erroneously filed part and to limit to the correct parts at entry under Rule 159(1)(b) EPC after a PCT Rule 20.5bis(d) situation. If not done at that time, it seems likely that the applicant will be invited thereto in the communication under Rule 161(1)/(2) EPC.

New Rule 56a EPC<sup>79</sup> does also not address the effect of erroneous/corrected parts on the Art. 54(3) “prior right” effect that the European patent application may provide against later filings. In our interpretation, Rule 56a(3) EPC suggests that only the correct documents will provide an Art. 54(3) effect, as the erroneously filed application documents will be deemed not to have been filed and the correct documents will be added to the application and considered to be part of the application as filed. This seems to be in line with the intention of the provision. However, Rule 56a(4) EPC suggests that the erroneously filed and the correct documents *together* will provide an Art.54(3) effect, as the correct application documents or parts are included in the application and the erroneously filed parts remain in the application as filed. So, it appears that both the erroneously filed and the correct application documents are considered to be part of the application as filed

69 OJ EPO 2022, A71, item 6.

70 Rule 56a(3) EPC, OJ EPO 2022, A71, item 9.

71 Nor any other amendment to the EPC Rules and RFees in OJ EPO 2022, A3.

72 Rule 45(2), first sentence EPC.

73 Rule 45(1) EPC.

74 Rule 45(3) EPC.

75 Note that GL/EPO (2022) A-III 9 provides: “If an application contains more than one set of claims, Rule 45 is only applicable for the set of claims containing the highest number of claims.” If this would also apply to current Rule 56a(4) EPC situation, the situation above would require the application to pay  $17 - 15 = 2$  claims fees, which corresponds to the erroneously filed set of claims and not to the correct set. It may also be doubted whether this is the intention of the provision, as the erroneously filed set of claims will not be part of the procedure.

76 Nor any other amendment to the EPC Rules and RFees in OJ EPO 2022, A3.

77 OJ EPO 2022, A71, item 21-23.

78 Nor in the former “Notice from the European Patent Office dated 14 June 2020 concerning the applicability of new PCT Rule 20.5bis on the correction of erroneous filings in proceedings before the EPO”, OJ EPO 2020, A81, as the latter applied to the situation where the EPO as dO/eO had a reservation. Also note that under the old Notice, the EPO “will consider the application as filed to include the correct application documents but not the erroneously filed ones” (item 10). The entry procedure described therein largely relied on the incompatibility provisions of PCT Rule 20.8.

79 Nor any other amendment to the EPC Rules and RFees in OJ EPO 2022, A3.

and, hence, provide the Art. 54(3) effect.<sup>80</sup> On the other hand, one could argue that the skilled person can directly and unambiguously derive that there is an error and what the correction should be when considering the complete application as filed, i.e. from the combined erroneously filed and correct application documents, so that the disclosure of the erroneously filed parts is not taken into account.<sup>81</sup> However, it may be doubted whether this applies if the erroneous disclosure is technically a sound disclosure and where the skilled person would need to take secondary, non-technical indications into account, i.e., when the skilled person needs to consider the procedural aspects of PCT Rule 20.5*bis*(d) rather than mere technical knowledge.

Another issue with Rule 56a EPC is that it does not address the situation where under Rule 56a(4) EPC, the erroneously filed application documents are filed in one official EPO language and the correct application documents in another official EPO language: as both the application documents “remain” in the application, which filing will determine the language of the proceedings?<sup>82</sup>

A question that can be asked, do Rule 56 and Rule 56a EPC also apply when filing a divisional application? It could apply

to the situation where a divisional application has been filed, but a page of the description is missing or the wrong drawing(s) have been filed, and where this missing or correct part is present in the direct parent application. Under the current formulation of Rule 56/56a EPC, this cannot be done, because the parent application is not the priority application.<sup>83</sup>

An important issue when filing correct application documents under Rule 56a EPC is that even if the erroneously filed application documents are withdrawn under Rule 56a(5) or (7) EPC (e.g. to maintain the priority claim), these erroneously filed application documents are part of the file, irrespective of whether or not they are considered to form part of the application as filed. As such they will be open to file inspection from publication of the application.<sup>84</sup> Upon a reasoned request of the applicant, erroneously filed documents which are not considered to form part of the application as filed may be *excluded* from file inspection.<sup>85</sup>

80 GL/EPO (2022) G-IV 5.1: “It is important to note that it is the content of the earlier application as filed which is to be considered when applying Art. 54(3).”

81 Following the principles set out in GL/EPO (2022) G-IV 9 “Errors in prior-art documents”.

82 Cf. Decision of the Enlarged Board of Appeal G 4/08, OJ EPO 2010, pp. 572-597.

83 A solution could be to introduce Rule 56b EPC specifying that Rules 56 and 56a EPC apply *mutatis mutandis* to divisional applications with the proviso that “the date of filing” is replaced by “the date on which the divisional application is filed” and references to claiming priority from an earlier application as well as to Rule 40(1) EPC are deleted. The missing parts or the correct application documents should be completely contained in the (immediate) parent application. Filing a copy and/or a translation of the parent application as required by Rule 56(3) and Rule 56a(4) EPC are not necessary.

84 Art. 128(4) and Rule 144 EPC.

85 Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3.

86 And, preferably, in a further Notice of the EPO as such Notices can be published before the entry into force of the new provisions on 1 November 2022, whereas the Guidelines are only updated one every year, i.e., at the earliest per 1 March 2023.

## Conclusions

On 1 November 2022, Rule 56a EPC will be inserted into the EPC allowing the correction of erroneously filed application documents or parts thereof. Rule 56a EPC corresponds to a similar provision in PCT Rule 20.5*bis* which entered into force on 1 July 2020.

Also on 1 November 2022, Rule 56(3) EPC will be amended improving the alignment with the requirements of the Patent Law Treaty and those of the PCT. Both Rules require that in order to retain the initially accorded date of filing due to the filing of missing parts or correct application documents being “completely contained” in the earlier application, priority must have been claimed from this earlier application on the initial date of filing of the application. With the amendment of Rule 56 EPC and the introduction of Rule 56a EPC, the situation will be less flexible for applicants because priority may no longer be added e.g. when missing parts or correct application documents are filed.

Rule 56 and 56a EPC emphasise the importance of declaring priority of any relevant earlier applications on the initial date of filing.

In its striving to improve alignment of the EPO’s practice with the PCT, it is a missed opportunity not to allow an applicant under Rule 56 EPC to also file missing claims so that those can become part of the application as filed. There is no logic in allowing the correction of erroneously filed claims under Rule 56a EPC whereas filing of missing claims is not allowed under Rule 56 EPC.

Last but not least, upon amending Rule 56 EPC and inserting Rule 56a EPC, some inconsistent wording has been introduced in both Rules and the effect on some other aspects (e.g. calculation of page fees and claims fees, language of the proceedings, effect of Art. 54(3) EPC and Euro-PCT applications) are missing. It is suggested to clarify these ambiguities and unclarities in the Guidelines.<sup>86</sup>





# Case Law

## J 8/20: DABUS or artificial intelligence as inventor

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**T**he advent of more and more powerful computers and software tools, namely the creation of so-called artificial intelligence (AI), has brought computer technology to a point where some of these tools are able to devise inventions.<sup>1</sup>

Inventions by definition are technical teachings.<sup>2</sup> If an AI is able to devise a technical teaching, this AI is able to devise an invention.

Is the AI also the inventor? By way of example in national law, § 7 of the UK Patent Act of 1977 reads:

*§ 7 Right to apply for and obtain a patent.*

*(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention [...].*

So, if an AI devised the invention, the AI is the actual deviser of the invention and might qualify as inventor.

This was purportedly the case in the patent application underlying the decision J 8/20, EP 18 275 163: "Food Container" (better known as the "fractal container"). The decision was published on July 5, 2022.<sup>3</sup> Oral proceedings had taken place on December 21, 2021.<sup>4</sup>

The fractal container is depicted in Fig. 1. It shows a food

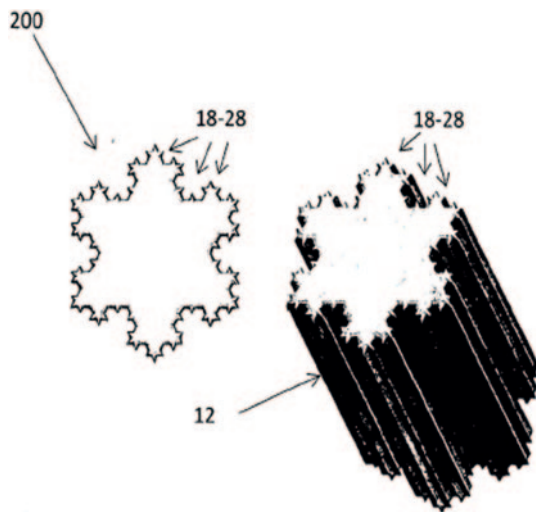
<sup>1</sup> Some examples can be found in Köllner: "DABUS oder die künstliche Intelligenz als Erfinder?", Mitt. 2022, 193

<sup>2</sup> See, for example, the third paragraph of reason 6.4.2.1 of the decision G 2/07 of the Enlarged Board of Appeal, according to which the definition of the term in the "Rote Taube" decision of the Federal Court of Justice "set a standard which still holds good today and can be said to be in conformity with the concept of "invention" within the meaning of the EPC."

<sup>3</sup> <https://www.epo.org/law-practice/case-law-appeals/recent/j200008eu1.html>, last accessed on July 13, 2022.

<sup>4</sup> The case was represented by European patent attorneys Robert Jehan (Williams Powell, London), Markus Rieck (Fuchs Patentanwälte, Frankfurt am Main) and the author.

container, e.g. a beverage container, with a fractal wall. Those familiar with fractals will recognise a Koch snowflake in the form of the wall.<sup>5</sup>



**Fig. 1: Fractal container**

The invention was supposedly devised by an artificial intelligence named DABUS.<sup>6</sup> DABUS was created by Stephen L. Thaler<sup>7</sup>, the applicant. DABUS was named as inventor in the designation of the inventor acc. to Article 81 and Rule 19 EPC.

The receiving section rejected the application after oral proceedings.<sup>8</sup> The designation of the inventor was allegedly deficient. Article 81 and Rule 19 EPC require the applicant to name a natural person as inventor, which the applicant had failed to do.

The applicant filed appeal against this decision.

## Open questions

The advent of artificial intelligence raises a number of fundamental issues in patent law. What does it mean for patent law if an invention is no longer devised by a human being?

The overarching open question can be seen in how the patent system can or should cope with AI generated inventions. Is the patent system made or fit for AI generated inventions? Do we need any changes?

This overarching question can – in a first step – be differentiated into the following three major questions:

- A) Are AI generated inventions patent eligible? Can there be patent protection for an AI generated invention? Or should there rather be exclusion of AI generated inventions from patentability? Is the patent system only here to protect human inventions? Is it here to primarily protect the interests of the inventor?
- B) Who is to be named as inventor for an AI generated invention? Can the artificial intelligence be named as inventor?
- C) How to access inventive merit for an AI generated invention?<sup>9</sup>

## The answer given in J 8/20 to question B)

The reasons given by the receiving section for the rejection of the application, namely that the designation of the inventor needs to name a natural person, weren't fully convincing for the present case.<sup>10</sup> The inventor needs to be named so that his or her name can be published on the patent specification acc. to Rule 20 EPC. This is part of the moral rights of the inventor. It serves i.a. their honour.

The moral rights of the inventor may, however, not make any sense for an artificial intelligence. The formal requirement to name the inventor might, therefore, be disposed of for an AI generated invention like in the present case.<sup>11</sup>

The board, however, pointed out that Article 81 and Rule 19 EPC cannot be read in an isolated manner.<sup>12</sup> Namely the term “inventor” appears in other Articles and only a unitary, common interpretation of the term can lead to an understanding of the term inventor “within the meaning of the EPC”.<sup>13</sup>



**Malte Köllner**

The purpose of Article 81 is not restricted to collecting the name of the inventor to publish it on the patent specification acc. to Rule 20 EPC. As can be deduced from Article 81 EPC second sentence, the purpose of the designation of the inventor is also to indicate the origin of the right to the European patent. Article 81 EPC second sentence reads:

*Article 81 Designation of the inventor  
If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent.*

<sup>5</sup> [https://en.wikipedia.org/wiki/Koch\\_snowflake](https://en.wikipedia.org/wiki/Koch_snowflake), last accessed on July 13, 2022.

<sup>6</sup> <https://imagination-engines.com/dabus.html>, last accessed on July 14, 2022

<sup>7</sup> <https://imagination-engines.com/founder.html>, last accessed on July 14, 2022

<sup>8</sup> <https://register.epo.org/application?documentId=E4B63SD62191498&number=EP18275163&lng=en&npl=false>, last accessed on July 14, 2022

<sup>9</sup> Question C) was not relevant in the present case.

<sup>10</sup> Sec. 4.4.1 of J 8/20

<sup>11</sup> Sec. 4.4.1 of J 8/20

<sup>12</sup> Sec. 4.2.2 of J 8/20

<sup>13</sup> Sec. 4.2.2 forth paragraph of J 8/20

In the words of the Board, the purpose of the designation of the inventor is also

*to identify a legal basis for entitlement to the application (sec. 4.3.3)*

The origin of the right to the European patent is defined in Article 60 EPC:

*Article 60 Right to a European patent  
(1) The right to a European patent shall belong to the inventor or his successor in title.*

The interpretation of Article 60 given by the Board is as follows:

*Article 60(1) EPC is a stand-alone substantive provision of the EPC and fulfils three functions.*

*Firstly, it creates the right to the European patent;*

*secondly, it vests this right in the inventor;*

*finally, it provides for the separate transferability of the right even before a European application is filed. (sec. 4.2.2)*

Any patent act in the world defines property in technical inventions. Without a patent act, technical inventions are free to be copied by any third party. With a patent law, property is defined. Any definition of property has two components:

- a) What can be owned?
- b) Who can own it?

Examples are numerous in human history. I don't want to dwell on this.

In patent law, the object that can be owned is a technical invention. More precisely, the right to exclude others from using the technical invention.

The interesting point in the present case is item b): who can own the patent right?

The answer is given in Article 60 EPC. The inventor – and only the inventor – can be the initial owner of the right to the patent. This is a decision by the law maker which we find in many jurisdictions around the world. The decision by the law maker of the EPC might have picked the applicant but they didn't. Only the inventor is entitled.

As a consequence, the inventor needs to have legal capacity. In the words of the Board:

*Under the EPC the designated inventor has to be a person with legal capacity. (sec. 4.3.1)*

*Article 60(1) EPC vests the rights to the European patent in the inventor; thus, it postulates a person with legal capacity. (sec. 4.3.2)*

Legal capacity can be found in either natural or legal persons. There can, however, not be any doubt that the term "inventor" "within the meaning of the EPC" implies a natural person and not a legal person.<sup>14</sup>

As a machine is neither a natural person nor has any legal capacity, naming an AI as inventor will not vest the rights to the invention in question, here the fractal container, in any person with legal capacity. The rights in the invention will not come into existence and the invention remains free. Furthermore, the designation of the inventor is deficient as it did not name "an inventor within the meaning of the EPC".<sup>15</sup>

Hence the catchword:

*A machine is not an inventor within the meaning of the EPC. (sec. 4.3.9)*

### **Stephen L. Thaler as successor in title to DABUS**

A side issue arose because applicant and inventor were not identical. The applicant was Stephen L. Thaler while the named inventor was DABUS. For this constellation, Article 81 second sentence stipulates:

*Article 81 Designation of the inventor  
If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent.*

As the board observed:

*This provision remains applicable whether an invention was made by a person or by a device. (sec. 4.4.1)*

The applicant had argued that he owned the right in the invention by accession, because he owned DABUS. Alternatively, he was DABUS successor in title. He was the creator of DABUS, and some more attempts.

Such a transfer from DABUS to Stephen L. Thaler will not so much fail because DABUS cannot own anything or sign an assignment. The point is rather: there is no right to transfer. The right to the patent hasn't come into existence. The right only gets into existence if it can be vested in a natural person with legal capacity who is named as inventor.<sup>16</sup>

This was another reason, why the designation of the inventor was deficient.

<sup>14</sup> Sec. 4.7.3 of J 8/20

<sup>15</sup> Sec. 4.3.9 of J 8/20

<sup>16</sup> Sec. 4.4.2 of J 8/20



## What can be done in case of an AI generated invention?

Historically, you would look for the actual deviser of the invention and vest the rights to the patent in exactly this person. The two roles – inventor and initial owner – coincided in the identical natural person.

This is not possible for an AI generated invention. You can identify the AI as actual deviser of the invention, but this machine cannot own the right to the patent. You have to find someone else – or give up the right to the patent.

Luckily, the Board suggests to name Stephen L. Thaler as inventor:

*The Board is not aware of any case law which would prevent the user or the owner of a device involved in an inventive activity to designate himself as inventor under European patent law. (sec. 4.6.6)*

So, we would have DABUS as inventor within the meaning of the actual deviser, and Stephen L. Thaler as “inventor within the meaning of the EPC”.

Can we mention the role of the machine in the generation of the invention?

*Applicants can explain how the invention was made elsewhere, and in particular in the description. This is not required, but also not prohibited by the EPC. (sec. 4.3.7)*

I assume this is what will happen in the divisional application that the applicant filed in the meantime.

## The answer given in J 8/20 to question A): patentability of AI generated inventions

Quite satisfactory so far. But what about patentability of AI generated inventions?

The question was not in pole position on the table but nevertheless lurked in the background. Luckily, the Board took the time to drop a hint:

*The appellant has argued that the scope of this provision [Article 52(1) EPC] is not limited to human-made inventions. The Board agrees. How the invention was made apparently plays no role in the European patent system. (sec. 4.6.2)*

I take this as a statement in favour of patentability of AI generated inventions. Also, why else would they suggest

a solution and indicate that you can mention the role of the AI in the description?

I would, however, suggest a small caveat here, as it seems like some persons within the EPO tend to prefer limiting the patent system to human-made inventions.<sup>17</sup> I would, in this situation, remind the reader that the European Parliament:

*“15. Takes the view that technical creations generated by AI technology must be protected under the IPR legal framework in order to encourage investment in this form of creation and improve legal certainty for citizens, businesses and, since they are among the main users of AI technologies for the time being, inventors;”<sup>18</sup>*

The last confrontation between the European Parliament and the EPO ended with the European Parliament setting the rules.<sup>19</sup> So let's hope for the best – provided we actually have a controversy here.

Maybe we will have a more unambiguous answer to question A) in the divisional application.

## Miscellaneous

The rest of the decision is of no particular interest:

- The receiving section has the right to check whether the designation of the inventor is in conformity with Article 81 and Rule 19 EPC, namely whether a natural person was named.<sup>20</sup>
- The numerous procedural deficiencies objected to by the appellant have no effect.<sup>21</sup>
- The auxiliary request named no one: not the AI and not a natural person, because no natural person qualified as actual deviser of the invention. This request failed for the same reasons as the main request: without naming a natural person, there is no right to the patent.

The answer to the raised questions is so clear from the mere wording of the EPC that it is not necessary to take recourse to the Travaux Préparatoires or to refer the issue to the Enlarged Board of Appeal.<sup>22</sup>

<sup>17</sup> This could be witnessed during the Conference “Inventorship in patent law” on May 16, 2022, see <https://www.epo.org/news-events/events/conferences/inventorshipconference2022/programme.html>, last accessed on July 14, 2022

<sup>18</sup> European Parliament resolution of 20 October 2020 on intellectual property rights for the development of Artificial intelligence technologies (2020/2015(INI)) Resolution No. P9\_TA(2020)0277

<sup>19</sup> G 3/19

<sup>20</sup> Sec. 4.2.3 of J 8/20

<sup>21</sup> Sec. 4.7 of J 8/20

<sup>22</sup> Sec. 4.3.2 and 4.5.3 of J 8/20

# Reimbursement of Appeal Fees due to a violation of right to be heard

## Board of Appeal decision T 2610/19

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### ABSTRACT

T 2610/19 confirms that it is within the discretion of the Opposition Division to limit the number of inventive step attacks to a reasonable amount. However, the Opposition Division at least needs to allow a discussion of which documents are suitable starting points in oral proceedings to meet the right to be heard. In particular, this is the case if the Opposition Division intends to address an inventive step attack based on a different starting point in its decision besides those discussed in the oral proceedings. Further, such a discussion is also necessary in case the Opposition Division has identified a more suitable starting point in its preliminary opinion.

Representatives are advised to prepare a discussion of which prior art documents should be considered as suitable starting points for an inventive step attack so that each inventive step attack based on such documents is fully discussed in the oral proceedings. Further, representatives should consider the order in which valid starting points for lack of inventive step should be discussed.

### ZUSAMMENFASSUNG

T 2610/19 bestätigt, dass es im Ermessen der Einspruchsabteilung liegt, die Zahl der Angriffe wegen fehlender erfinderischer Tätigkeit auf eine angemessene Anzahl zu beschränken. Die Einspruchsabteilung muss in der mündlichen Verhandlung jedoch mindestens eine Diskussion darüber zulassen, welche Dokumente als Ausgangspunkt geeignet sind, um nicht das rechtliche Gehör zu verletzen. Dies ist insbesondere dann der Fall, wenn die Einspruchsabteilung beabsichtigt, in ihrer Entscheidung auf einen Angriff wegen fehlender erfinderischer Tätigkeit einzugehen, welcher auf einem anderen Ausgangspunkt beruht als die in der mündlichen Verhandlung erörterten Angriffe. Eine solche Diskussion erscheint auch dann erforderlich, wenn die Einspruchsabteilung in ihrer vorläufigen Stellungnahme einen geeigneteren Ausgangspunkt ermittelt hat.

Vertretern wird empfohlen, eine Diskussion darüber vorzubereiten, welcher Stand der Technik als Ausgangspunkte für einen Angriff auf die erfinderische Tätigkeit als geeignet anzusehen ist, damit jeder Angriff auf die erfinderische Tätigkeit, der sich auf solche Dokumente stützt, in der mündlichen Verhandlung umfassend erörtert wird. Außerdem sollten die Vertreter erwägen, in welcher Reihenfolge stichhaltige Ausgangspunkte für fehlende erfinderische Tätigkeit diskutiert werden sollten.

### RÉSUMÉ

La décision T 2610/19 confirme qu'il est à la discrétion de la division d'opposition de limiter le nombre d'attaques pour absence d'activité inventive à un nombre raisonnable. Toutefois, la division d'opposition doit au moins permettre une discussion lors de la procédure orale sur les documents qui sont appropriés comme point de départ pour satisfaire au droit d'être entendu. C'est notamment le cas si la division d'opposition a l'intention de traiter dans sa décision un recours à l'activité inventive basé sur un point de départ différent de ceux discutés dans la procédure orale. En outre, une telle discussion est également nécessaire dans le cas où la division d'opposition a identifié un point de départ plus approprié dans son avis préliminaire.

Il est conseillé aux mandataires de préparer une discussion sur les documents de l'état de la technique qui devraient être considérés comme des points de départ appropriés pour une attaque de l'activité inventive, de sorte que chaque attaque de l'activité inventive basée sur ces documents soit pleinement discutée dans la procédure orale. En outre, les mandataires devraient considérer l'ordre dans lequel les points de départ valables pour le manque d'activité inventive devraient être discutés.

\* Disclaimer: The authors of this article have been involved in the discussed appeal decision as representatives for the appellant after the opposition was rejected in the first instance.

## I. Legal background

**R**ule 103 (1) a) EPC, second option, stipulates the possibility that the appeal fee shall be reimbursed in full where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of substantial procedural violation. For reimbursement of appeal fees, a first requirement is that the Board of Appeal at least partially grants the requests of the appellant<sup>1</sup>. A second requirement requires some form of fundamental flaw in process management by the Opposition Division<sup>2</sup>.

The first requirement is self-explanatory and, at least in case of overturning the decision, evident goal of any appeal. The second requirement is less straightforward, as substantial procedural violations are not explicitly specified in the EPC. Hence, substantial procedural violations are rather defined by case law. As a baseline, the violation must be of a procedural nature rather than relate to an error of judgment on substantive issues<sup>3</sup>. Moreover, the violation must also adversely affect the rights of the parties to be considered serious<sup>4</sup>. Further, the procedural violation must be committed by the department whose decision is under appeal – usually the opposition division rather than the examining division<sup>5</sup> or any other party involved in the proceedings<sup>6</sup>. Noteworthy, the Guidelines are not legally binding and failure to follow them is not a procedural violation in itself<sup>7</sup>.

Probable partiality of a member of an opposition division<sup>8</sup>, generally erroneous communications by the EPO<sup>9</sup>, failure to summon for oral proceedings<sup>10</sup>, failing to provide reasons for a decision<sup>11</sup> or a wrong composition of an opposition division<sup>12</sup> are some of the substantial procedural violations defined by the case law.

Further, the right to be heard<sup>13</sup> is one of the principles of procedural law generally recognized in the Contracting states<sup>14</sup>, which needs to be observed in all proceedings before the EPO<sup>15</sup>. A violation of the right to be heard is uncontestedly considered as a substantial procedural violation.

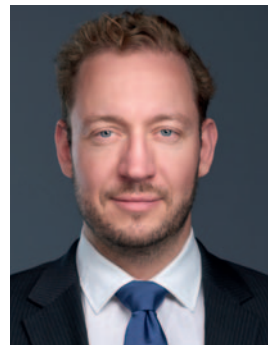
However, the need for procedural efficiency and the right to be heard are conflicting objectives both legally and in practice when managing a case. The EPO regularly strives

to improve procedural efficiency while avoiding adversely affecting the right to be heard. An approach to resolve this conflict is to front-load the proceedings by forcing each party to present their facts and arguments as early in the proceedings as possible and limit the oral discussion and late filing of documents. The latest iteration of this approach are the rules of Procedure of the Boards of Appeal of 2020 – stipulations of which are also discussed in the present decision of the Boards of Appeal. However, while an Opposition Division is free to focus the oral proceedings on certain arguments and attacks, the right to be heard is not already met in case a party requested oral proceedings according to Art. 116 EPC when only allowed to present the arguments in writing<sup>16</sup>.

The balancing of the right to be heard versus the need for procedural efficiency has been developed further in the present subject T 2610/19 dated July 14, 2022.

## II. Relevant facts of the case

T 2610/19 relates to an appeal against the interlocutory decision in the first instance opposition proceedings. The interlocutory decision refuses the opposition and maintains patent EP 2158095 B1. Generally speaking, said patent was directed to a plate with several layers, a method of producing such a plate and a use of such a plate. Opponent argued during the proceedings in the first instance that the independent claims are not novel over two prior art documents (F2 and D4, noting that F2 was considered as novelty destroying for the independent claims in the decision by the Boards of Appeal) and not based on an inventive step over a combination of two pairs of other prior art documents (F3+F4 and F5+D7, respectively).



**Thomas Schürmann**



**Marc Wachenhausen**

In the preliminary opinion, the Opposition Division was of the opinion that none of these attacks were deemed to be sufficient for revocation of the patent. However, based on its own motion, the Opposition Division considered F4 as the closest prior art. Further, the Opposition Division considered the subject-matter not to be based on an inventive step in view of F4 and F5.

1 see J 37/89 and J 18/84 as well as the Case Law of the Boards of Appeal, V.A.9.4  
 2 see the Case Law of the Boards of Appeal, V.A.9.5  
 3 see T 12/03, T 690/06 and T 860/93 as well as Case Law of the Boards of Appeal, V.A.9.5.1  
 4 see T 682/91 as well as Case Law of the Boards of Appeal, V.A.9.5.2  
 5 see T 469/92  
 6 see also Case Law of the Boards of Appeal, V.A.9.5.3  
 7 see T 42/84  
 8 see T 900/02 and T 1647/15  
 9 see Case Law of the Boards of Appeal, V.A.9.5.17  
 10 see Case Law of the Boards of Appeal, V.A.9.5.7  
 11 J 18/16  
 12 see T 2546/17 and Case Law of the Boards of Appeal, V.A.7.7.2  
 13 see Art. 113 (1) EPC  
 14 see Art. 125 EPC  
 15 for more details, refer to Case Law of the Boards of Appeal, III.B

16 see sections 10 and 14 of T 1077/06, also cited in the present decision



In the oral proceedings, the Opposition Division forced the Opponent to “pick” just a single closest prior art as starting point. Opponent selected F5 as the closest prior art for the discussion of inventive step. Starting from F5, the Opposition Division came to the conclusion that the subject-matter of the independent claims is based on an inventive step. No further starting point for inventive step attacks was allowed by the Opposition Division in the oral proceedings despite Opponent expressing his intention to argue for other documents as potential closest prior art. This was documented both in the minutes of the oral proceedings under Rule 124 EPC as well as in the interlocutory decision.

The Opposition Division referred to the Guidelines, G-VII, 5.1 to justify this limitation of the inventive step discussion. Said section of the Guidelines generally states that the problem-solution approach may be based on different documents if showing that they can be considered as equally promising starting points. Further, said section of the Guidelines states that the problem-solution approach does not provide a forum for freely developing as many inventive step attacks as desired in the hope of having success<sup>17</sup>. Based on said section of the Guidelines, the Opposition Division considered the right to be heard to be met if a party has been notified that only a single starting point for inventive step attacks will be allowed and if other starting points (in the present case: only F3) raised by Opponent in writing are addressed in the interlocutory decision by the Opposition Division.

### III. Reasons for refund of appeal fees

In its decision, the Boards of Appeal confirms that it is within the discretion of an Opposition Division to limit the number of inventive step attacks to discuss, as a reasonable number is dependent on the particulars of the case and procedural efficiency needs to be maintained. An Opponent is thus required to carefully select the most promising attacks.

However, if an Opposition Division intends to limit the number of inventive step attacks, a discussion about the relevance of additional prior art documents as a starting point is required to not violate an Opponent's right to be heard. In particular, this needs to be the case if a different prior art document will also be considered as a starting point in the written interlocutory decision (in the present case: F3). Additionally, this also applies if the Opposition Division already considers a different prior art as closer than the starting point(s) discussed in the oral proceedings. In this context, the Board of Appeal agrees with the consideration that the Opposition Division itself does not need to select such a document for

discussion in the oral proceedings since examination of the facts on its own motion is to be applied restrictively in opposition proceedings (see also section 7.2 of the presently discussed decision T 2610/19).

The Board of Appeal considers the above to follow from sections 10 and 14 of T 1077/06, stipulating that only allowing written arguments are insufficient to meet the right to be heard when oral proceedings are requested.

### VI. Conclusions

Decision T 2610/19 is not to be misunderstood as allowing an Opponent as many inventive step attacks as desired in the hope of having success. Careful selection of suitable starting points for inventive step attacks is still required. However, an Opponent needs to at least be allowed a discussion of the merits of different prior art documents as starting points for an inventive step attack in oral proceedings in view of the right to be heard.

Some Chairpersons of Opposition Divisions allow an Opponent to decide about the order of inventive step attacks to be discussed. There is no clear case for a strategy regarding which documents should be discussed first as the closest prior art in oral proceedings in case an Opponent considers a different starting point as more promising than the Opposition Division in its preliminary opinion. Starting from the closest prior art considered as most promising by the Opposition Division may offer the highest chance of achieving revocation and may also be the most efficient approach. Subsequently convincing the Opposition Division that a different document is an equally valid starting point for a full inventive step attack discussion may be difficult in this case, though. Starting from the closest prior art considered as most promising by the Opponent may offer the chance to allocate more time of the oral proceedings to a discussion for convincing the Opposition Division while still allowing full discussion of an inventive step attack based on the prior art document considered as most promising by the Opposition Division. An adaptation based on how strict the Opposition Division is with generally allowing discussions and different inventive step strategies in the oral proceedings may be advisable.

Further, representatives of an Opponent should be prepared to discuss why different prior art documents should be considered as valid starting points besides just being prepared to discuss inventive step attacks based on different documents. In particular, such preparations are advisable in case the Opponent considers a different document as a more suitable starting point than the Opposition Division in its preliminary opinion or even just additional documents as an equally suitable starting point. Likewise, a representative of a Patentee should

<sup>17</sup> see also T 320/15, Reasons 1.1.2

be prepared to discuss why a different document is not a valid starting point that the Opposition Division should, as a consequence, not allow further discussion of the complete inventive step attack for the sake of procedural efficiency.

Finally, if an Opposition Division is unwilling to discuss even the merits of different starting points for inventive step attacks, it should be referred to the presently discussed decision T 2610/19. If nevertheless no such discussion is allowed, representatives should ensure that the restriction to certain attacks and discussions is doc-

umented appropriately in the minutes to provide a basis for a potential refund of fees in the subsequent instance. We note that refund of fees may be granted ex officio by the Board of Appeal without a request by appellant<sup>18</sup>. However, rejection of an appeal fee refund request will not result in any adverse legal effects. For example, unlike in civil procedures in at least some national jurisdictions (such as Germany), rejection of such a request will not result in having to at least partially reimburse the other party.

<sup>18</sup> see Case Law of the Boards of Appeal, V.A.9.2.

Decision T2610-19 - EPO Form 3032  
Abschrift der Entscheidung:  
<https://patentepi.org/r/info-2203-01>

Minutes of the oral proceedings  
<https://patentepi.org/r/info-2203-02>

## Treatment of Interim Injunctions in Patent Disputes – Decision of the ECJ in case C-44/21

V. Töpert

### Background

Under German law, the following prerequisites must be met for an interim injunction in a patent infringement to be issued: (i) existence of a claim for injunction (infringement of the injunction patent), (ii) valid reason for interim measure (urgency), (iii) sufficiently secure patent validity, and (iv) interest of the patentee prevails when weighting the interests of the patentee and defendant.

With regards to prerequisite (iii) “sufficiently secure patent validity”, higher regional courts (*OLG München – U4009/19 – Elektrische Anschlussklemme; Düsseldorf – I-2 U 126/09 – Harnkatheterset; Karlsruhe – 6U 52/15 – Ausrüstungssatz*) usually require that confirmation of patentability is to be provided, going beyond mere examination proceedings before the respective grant authorities, i.e. before the European Patent Office (EPO) or the German Patent and Trade-mark Office (GPTO). According to current case law of the higher regional courts, “sufficiently secure patent validity” can only be assumed if the patent has already proven to be legally valid in contradictory proceedings, i.e. in opposition/appeal proceedings before the EPO, or in invalidity proceedings before the Federal Patent Court.

A reason for such strict interpretation of the “sufficiently secure patent validity” prerequisite may be seen in the fact that a significant proportion of patents (~70%) are at least partially revoked in post grant opposition or nullity proceedings.

The 21<sup>st</sup> Civil Chamber of Munich I Regional Court is, however, of the opinion that such interpretation of the “sufficiently secure patent validity” prerequisite conflicts with European law. By order of 19. January 2021, the Munich I Regional Court referred a request to the European Court of Justice (ECJ) for a preliminary ruling on the treatment of interim injunctions in patent disputes.

### Referral Question to the ECJ

The following question on the interpretation of Article 9(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (‘Directive 2004/48/EC’) was referred to the European Court of Justice for a preliminary ruling under Article 267 TFEU:



Verena Töpert

***Is it compatible with Article 9(1) of Directive 2004/48/EC that, in proceedings for interim relief, higher regional courts with jurisdiction at last instance refuse in principle to adopt interim measures on grounds of infringement of patents if the patent in suit has not survived opposition or nullity proceedings at first instance?***

Directive 2004/48/EC (Enforcement Directive) provides:

Article 9(1) - **Provisional and precautionary measures**

*1. Member States shall ensure that the judicial authorities may, at the request of the applicant:*

*(a) issue against the alleged infringer an **interlocutory injunction intended to prevent any imminent infringement** of an intellectual property right, or to forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, the **continuation of the alleged infringements** of that right, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the right holder; an interlocutory injunction may also be issued, under the same conditions, against an intermediary whose services are being used by a third party to infringe an intellectual property right; injunctions against intermediaries whose services are used by a third party to infringe a copyright or a related right are covered by Directive 2001/29/EC;*

*(b) **order the seizure or delivery up of the goods** suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.*

### **Key Arguments brought forward by Munich I Regional Court**

Under Article 9(1) of the Enforcement Directive, it is to be ensured that an interim measure may be ordered against a patent infringer in order to prohibit continuation of a patent infringement. However, this is not possible according to the case-law submitted for review by this order for reference, because a patent that has just been granted cannot have undergone confirmation of validity beyond mere examination as opposition and invalidity proceedings can only be initiated after the patent has been granted.

Also, many patents, granted in the past, have not undergone opposition or invalidity proceedings, and the patent proprietor has no influence on whether his patent is challenged after grant. Furthermore, under current legal practice provisional measures can only be initiated in response to concrete infringement after opposition or invalidity pro-

ceedings have been concluded at first instance, which can take many months or even years. Continuation of patent infringement must be accepted during this period under current practice despite the fact that patents – unlike other intellectual property rights – have undergone detailed technical examination before grant.

The referring court is obliged to refuse ordering interim measures in the event of patent infringement where the infringed patent has not yet undergone adversarial preservation proceedings, contrary to its understanding of the provision of Article 9(1) of the Enforcement Directive.

### **Judgement of 28.04.2022**

With judgement of 28.04.2022 the ECJ found that – although legal regulations in Germany are in compliance with the Enforcement Directive – current case law of the higher regional courts is not in alignment with the systematics of the Enforcement Directive. The courts have to ensure that Art. 9(1) of the Enforcement Directive is given full effect, if necessary, by refusing of its own motion to apply national case law where that case law is not compatible with that provision (see no. 52 and 53 of the decision). The ruling:

***“Article 9(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as precluding national case-law under which applications for interim relief for patent infringement must, in principle, be dismissed where the validity of the patent in question has not been confirmed, at the very least, by a decision given at first instance in opposition or invalidity proceedings.”***

Key arguments in the decision of the ECJ: According to the Enforcement Directive – laying down minimum standards concerning the enforcement of IP rights – the member states have to ensure that an imminent patent infringement is to be prevented, or a continuation of a patent infringement to be prohibited by means of interim relief. The central objective of the Enforcement Directive is to ensure a high level of IP protection. In this context, the “time” factor is of particular importance for the purpose of effective enforcement. The presumption of patent validity applies as of the date of publication of grant of the patent (§58 PatG/Art. 97(3) EPC), and as of that date, patents enjoy the full scope of protection. In other words, preliminary measures have to be made available as of the date a patent grants in order to effectively enable immediate patent infringement prevention. The case law under review requiring that a patent subject to preliminary proceedings has to be proven to be legally valid in contradictory proceedings is in contradiction with the provisions of Art. 9 of the Enforcement Directive.



To ensure adequate protection of the defendant against an unjustified preliminary injunction, legal instruments are provided by Art. 9 (5)-(7) of the Enforcement Directive: First, provisional measures granted can be revoked if no proceedings on the merits are initiated within a reasonable period. Secondly, the infringement court can order the patentee to lodge adequate securities (as a priori measure) to ensure compensation for any prejudice suffered by the defendant. Thirdly, damages (as a posteriori measure) can be ordered by the court granting the provisional measures in the event that the preliminary measures were unjustified and subsequently revoked.

## Watchouts

The relatively patentee-friendly decision of the ECJ is considered to be of high importance, not only for German legal practice pertaining to interim measures, but also for the future practice of the Unified Patent Court which is bound by EU legal provisions, as well.

It has now to be seen to which extent German regional and higher regional courts will amend current case law, and if case law will diverge (between the different regional and higher regional courts) in the future. Also, it has to be seen which standards for patent validity in interim proceedings will be applied by the courts. In any case, at present, requests for preliminary measures on the basis of patents which have not undergone contradictory invalidity proceedings may have the highest chance to get granted by the Regional Court of Munich I. However, it remains to be seen how the Higher Regional Court of Munich will interpret the judgement of the ECJ, in particular in the light of the high invalidity rates of patents, at least partially revoked in post-grant proceedings (~70% of all patents are at least partially revoked), and already existing exemptions from the case law under review. Both, the high invalidity rates and already existing exemptions from current case law practice have not been fully discussed in the referral. Although the ECJ lifted the requirement of contradictory validity reviews of patents sub-

ject to preliminary measures, courts can still refuse to grant interim measures on the basis of other considerations as they weight the interests of the parties involved.

Going forward, as a defence strategy, it does not seem advisable for potential patent infringers to merely rely on the fact that a patent under consideration has not (yet) passed contradictory validity proceedings, and that an infringement court will, thus, dismiss a request for preliminary measures. As the bar for obtaining a preliminary injunction might be lowered after the recent decisions of the ECJ, defendants are advised to commence prior art searches immediately after receipt of a warning letter, or after a request for a preliminary injunction has been served by the court. Further, defendants should consider filing a protective brief (to mitigate the risk of a potential ex parte preliminary injunction), and/or requesting adequate security payments to raise the hurdle for the patentee.

From the perspective of the patentee, when filing a request of a preliminary injunction, the applicant may not be able to benefit from a "revival" of the urgency deadline anymore, which "revival" was generally triggered by the 1st instance validity decision. The revival of the urgency deadline is/was established practice, applied by the courts to compensate for the case law under consideration according to which the patentee had to await the 1<sup>st</sup> instance validity decision. Instead, going forward, the patentee is advised to follow the urgency deadline of one to two months as of knowledge of the patent infringement. Also, patentees should be ready and prepared to deal with invalidity attacks in the course of interim proceedings.

## Annex

*Judgment of 28 Apr 2022, C-44/21 (Phoenix Contact)*

<https://patentepi.org/r/info-2203-09>

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Next deadline for epi Information	Nächster Redaktionsschluss für epi Information	Prochaine date limite pour epi Information
<p>The Editorial Committee invites contributions for publication in the next issue of <b>epi</b> Information. Documents for publication or any enquiry should be sent by eMail to (<a href="mailto:editorialcommittee@patentepi.org">editorialcommittee@patentepi.org</a>) no later than <b>19 November 2022</b>.</p> <p>Further information can be found in our "Guidelines for Authors" here: <a href="https://patentepi.org/r/guidelines-epi-info">https://patentepi.org/r/guidelines-epi-info</a></p>	<p>Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der <b>epi</b> Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse <a href="mailto:editorialcommittee@patentepi.org">editorialcommittee@patentepi.org</a> bis spätestens <b>19. November 2022</b>. Weitere Informationen finden Sie in unseren „Guidelines for Authors“ auf der <b>epi</b> Webseite: <a href="https://patentepi.org/r/guidelines-epi-info">https://patentepi.org/r/guidelines-epi-info</a></p>	<p>La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d'<b>epi</b> Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (<a href="mailto:editorialcommittee@patentepi.org">editorialcommittee@patentepi.org</a>) au plus tard le <b>19 novembre 2022</b>. De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse : <a href="https://patentepi.org/r/guidelines-epi-info">https://patentepi.org/r/guidelines-epi-info</a></p>



# Education

## Preparation for the 2023 EQE on the epi-learning platform

In order to support EQE candidates and **epi** Students on their way to the European Qualifying Examination, the **epi** currently offers a number of training courses:

- **epi** Students' forum
- EQE Online Workshops
- **epi** Tutorials
- **epi** Tutor consultation hour
- DI Advanced Questions

In addition, **epi** Students

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- can enrol for webinars (and access recordings thereof) offered to **epi** members (such as UP/UPC) at a reduced fee.

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In this forum, **epi** Students have the opportunity to ask questions and to discuss topics related to the European

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### **Session Calendar**

All sessions will be held from 16:00 to 18:00 CEST (and then CET after the end of October) on Monday and Thursday.

Paper A:  
15 September to 03 October 2022  
4 November to 01 December 2022

Paper B:  
19 September to 06 October 2022  
21 November to 08 December 2022

Paper C:  
03 October to 27 October 2022  
21 November to 15 December 2022 (will be held twice)

Paper A:  
31 October to 17 November 2022

## epi Tutorials

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In addition, candidates also have the opportunity to submit scripts for the “Mock January 2021” and “Mock December 2021” available on Wiseflow. Here, candidates can write these scripts as timed papers on Wiseflow, submit them on the system and download them for submission as part of the **epi** tutorials.

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### Session Calendar

All sessions will be held from 16:00 to 17:00, CEST (and then CET after the end of October).

Paper D:  
12 October 2022

16 November 2022  
04 January 2023  
08 February 2023

Paper A:  
19 October 2022  
23 November 2022  
11 January 2023  
15 February 2023

Paper B:  
26 October 2022  
30 November 2022  
18 January 2023  
22 February 2023

Paper C:  
02 November 2022  
07 December 2022  
25 January 2023  
01 March 2023

Pre-Examination:  
09 November 2022  
14 December 2022  
01 February 2023  
08 March 2023

## DI Advanced Questions

A set of 60 advanced legal questions has been prepared to help candidates preparing for Part I of the 2023 EQE Paper D. The questions relate to various topics of the EPC and the PCT.

Every Monday, for 20 weeks, starting on 10 October 2022, three new questions will be posted on the platform. One week later, ‘model answers’ will be published, where necessary with comments. In addition, there will be a kick-off virtual classroom (VC) on 4 October 2022 and monthly VCs where Mr Cees Mulder will explain the difficulties in the questions from the preceding weeks and answer questions from participants. **epi** Students must register for this training on [epi-learning.org](https://epi-learning.org) but no fee is involved.

### Session Calendar

60 DI Questions:  
10 October 2022 to 21 February 2023

Virtual Classrooms (VCs):  
4 October 2022  
15 November 2022  
20 December 2022  
24 January 2023  
21 February 2023



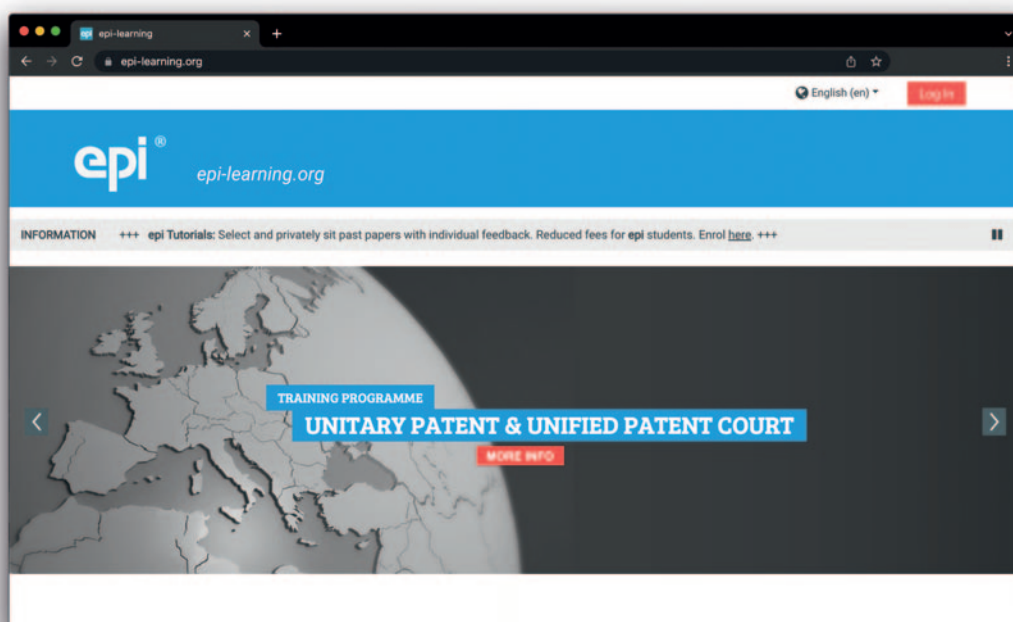
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- 1 <https://patentepi.org/en/epi/form/47/registration>
- 2 <https://patentepi.org/en/epi-students/epi-studentship/rules-governing-the-epi-student-membership.html>

## epi-learning



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- Collaboration with overseas patent colleagues
- Conflicts of Interest
- Diversity and Inclusion
- Essential training on UP/UPC
- New Rules of the Procedure of the BoA and further developments
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1 <https://www.epi-learning.org>  
2 [https://www.surveymonkey.de/r/epi-learning\\_platform](https://www.surveymonkey.de/r/epi-learning_platform)

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

# Results of the 2022 European Qualifying Examination

Statistics on the results of the 2022 EQE

Number of candidates per country and passes pursuant to Article 14 (1) of the Regulation on the European qualifying examination (REE)

Place of residence	Total number of candidates	Pass
AL	0	0
AT	23	17
BE	33	18
BG	3	0
CH	58	31
CY	0	0
CZ	9	6
DE	694	327
DK	47	23
EE	2	0
ES	69	19
FI	31	9
FR	164	85
GB	308	179
GR	6	2
HR	0	0
HU	8	3
IE	10	6
IS	0	0
IT	112	43
LI	0	0

Place of residence	Total number of candidates	Pass
LT	1	0
LU	5	4
LV	4	0
MC	0	0
MK	0	0
MT	0	0
NL	138	59
NO	18	8
PL	38	6
PT	16	7
RO	6	1
RS	0	0
SE	57	17
SI	0	0
SK	1	1
SM	0	0
TR	54	13
IL	1	1
JP	1	
SG	1	
<b>Grand Total :</b>	<b>1918</b>	<b>885</b>

Information source: <https://www.epo.org/learning-events/eqe/statistics.html>

Candidates are free to choose which paper(s) they wish to sit. Candidates who have only sat a sub-set of papers cannot fulfill the conditions of Article 14(1) REE (i.e. have obtained the minimum grades for all four papers) and thus cannot be included in this table.

*Example: A candidate has only sat papers A and B and passed both papers. Nonetheless the conditions of Article 14(1) REE are not yet fulfilled and this candidate is not included in this table.*

This table includes all candidates who fulfill the conditions of Article 14(1) REE.

# List of Professional Representatives

by their place of business or employment in the Contracting states  
and their entry according to A134(2) (EQE) or A134(3) (Grandfathers)  
as at 15.09.2022

Contr. State	Number Total	% of Total Repr.
AL	11	0,08%
AT	187	1,35%
BE	297	2,14%
BG	49	0,35%
CH	633	4,56%
CY	9	0,06%
CZ	86	0,62%
DE	5152	37,09%
DK	314	2,26%
EE	20	0,14%
ES	253	1,82%
FI	198	1,43%
FR	1327	9,55%
GB	2747	19,77%
GR	27	0,19%
HR	24	0,17%
HU	71	0,51%
IE	86	0,62%
IS	18	0,13%
IT	581	4,18%

Contr. State	Number Total	% of Total Repr.
LI	25	0,18%
LT	23	0,17%
LU	27	0,19%
LV	15	0,11%
MC	8	0,06%
MK	21	0,15%
MT	6	0,04%
NL	565	4,07%
NO	106	0,76%
PL	247	1,78%
PT	44	0,32%
RO	43	0,31%
RS	43	0,31%
SE	464	3,34%
SI	29	0,21%
SK	30	0,22%
SM	17	0,12%
TR	89	0,64%
<b>Total :</b>	<b>13892</b>	<b>100,00%</b>



# Committee Reports

## Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

**B**elow is a summary of discussion points since our last report in **epi** information issue 2-2022. An online committee meeting was held on 22 September 2022. We will report in more detail on that meeting in a future issue.

### 1. ST26 standard for Sequence listings

A position paper<sup>1</sup> setting out **epi**'s concerns on the implementation of the new ST.26 WIPO Standard for Sequence Listings which came into force on 1 July 2022<sup>2</sup> was passed to the EPO and published on the **epi** website and in **epi** Information 2-2022<sup>3</sup>. The EPO replied<sup>3</sup> on 28 July 2022. This reply was also published on the **epi** website. The committee finds this reply unsatisfactory. It has also been commented on in IP Kat blog posts of 1 August 2022<sup>4</sup> and 9 August 2022<sup>5</sup>.

**epi** will keep on stressing to the EPO that it would like its concerns to be considered, both in relation to added matter in case of EP divisional applications when the parent EP application has an ST.25 Sequence Listing, and in relation to loss of priority right if the priority application has an ST.25 Sequence Listing to be considered (see also discussion in our last report in **epi** information 2-2022<sup>6</sup>).

We do not think these concerns should for example be avoided by having to file an ST. 26 Sequence Listing for search purposes only. We think the added matter problems need to be explained clearly to practitioners and applicants. At the upcoming SACEPO GLs meeting on 11 October 2022 we intend to pose further questions about this matter to the EPO.

We also prepared comments to parts of the new (still confidential) draft EPC GLs (A-IV, 5, 5.3-5.4) relating to sequence listings that appear unclear. These comments



Ann De Clercq

<sup>1</sup> <https://patentepi.org/r/info-2203-03>

<sup>2</sup> On the legal side a decision of the President (<https://www.epo.org/law-practice/legal-texts/official-journal/2021/12/a96.html>) and Notice of the EPO (<https://www.epo.org/law-practice/legal-texts/official-journal/2021/12/a97.html>) were published on 9 December 2021. Future publications will follow on this topic.

<sup>3</sup> <https://patentepi.org/r/info-2203-04>

<sup>4</sup> <https://patentepi.org/r/info-2203-10>

<sup>5</sup> <https://patentepi.org/r/info-2203-05>

<sup>6</sup> <https://patentepi.org/r/info-2203-06>



will also be discussed at the upcoming SACEPO WP GLs meeting. An additional member from the **epi** Biotech Committee will attend that meeting.

The UK Patent Office has already indicated on 28 February 2022 in an update of their Guidelines for examination<sup>7</sup> that they will allow transitional measures. The UK mentions that for new divisional patent applications filed on or after 1 July 2022, the sequence listing should be supplied in the format required for the parent application. For a parent application filed on or after 1 July 2022, this must be ST.26. For a parent application filed before 1 July 2022 this should be ST.25. This is a change compared to the original plan of the UK and this change was made in response to feedback from their stakeholders. We strongly continue to request that the EPO would adopt the same practice as the UK Patent Office for EP applications.

Further communications/training webinars by the EPO may be very useful and needed to further inform patent attorneys and paralegal assistants dealing with the matter and allow questions to be addressed. Also further communications/statements from the EPO on this matter were requested to inform the public on how to avoid adding matter for conversions of sequence listings from the ST.25 to the ST.26 format Sequence Listing.

## 2. Plant patenting

We refer to our earlier discussion on plant patenting in our last report in **epi** Information 2-2022<sup>8</sup>.

In preparation of the next SACEPO WP GLs meeting of 11 October 2022, we reiterated our concerns about amongst others the need for **plant disclaimers** for which we held there is no legal basis. We regret at this moment no changes are being considered in the GLs. We are eager to discuss these matters at the SACEPO WP GLs meeting of 11 October 2022 or in a separate meeting on this topic with the EPO. We would like our comments to be heard and hope the EPO takes the necessary time to listen to our comments.

<sup>7</sup> <https://patentepi.org/r/info-2203-07>

<sup>8</sup> <https://patentepi.org/r/info-2203-06>

## 3. Antibodies

We refer to our earlier discussion on antibodies in our last report in **epi** Information 2-2022<sup>9</sup>.

With respect to antibodies we will inform the EPO again via our comments as prepared for the SACEPO WP GLs meeting on Guidelines of 11 October 2022 on the new (still confidential) draft EPC GLs (G-II, 5.6) which unfortunately still do not address some of our concerns on the inventive step requirements for antibodies. We would like the Guidelines not to be more strict than the Case Law on antibodies. We also request that individual Examiners would not insist on including framework region sequences in the claims in addition to CDR sequences when the surprising effect does not involve the binding affinity (this is not what the Case Law reflects). The GLs need to be very carefully drafted and reflect the Case Law, since they also may be referred to in national Court cases. We would like our comments to be heard and hope the EPO takes the necessary time to listen to our comments. We would like to see a process wherein there is more interaction with the **epi** practitioners when draft GLs are made (also in the other Biotech areas). We deem it important that the EPO also seeks to be continuously updated by practitioners in the field regarding the commercial importance of antibody inventions. Antibody patenting should receive prime importance.

## 4. TCR

We wonder whether a section on T cell receptors (TCRs) could be introduced into the GLs in the future.

We also look forward to a new date for discussing Biotech Issues with DG1 of the EPO and with other EPO circles, as in general we think this is of prime importance to obtain strong IP protection in the Biotech sector.

<sup>9</sup> <https://patentepi.org/r/info-2203-06>

# Report of Professional Conduct Committee

G. Checcacci (IT), Chair

**P**CC had its annual general meeting on 12 September. Unfortunately, the meeting had to be once more by ViCo, as the pandemic conditions were uncertain at the time the organization had to be finalized.

After the approval by the Council in May of the amendments that have made the **epi** Code of Conduct ready for the entry into force of UPC, whenever it happens, PCC has decided to re-open the process to bring to the Council also other amendments to the Code of Conduct, namely

those already presented at the meeting of the Council in autumn 2021. These amendments address some aspects of the Code of Conduct and include a general updating of the wording.

The specific Working Group of PCC will resume its activity, in order to prepare the proposals for amending the Code of Conduct for submission to the Council.

The other working groups are also working actively. After the successful experience of 2021, the WG dealing with training has proposed new topics for future webinars or presentations; it is however expected that UP/UPC training takes precedence in the training offer of **epi**. Another WG will meet soon to finalize the project of making available outside PCC the relevant content of at least some of the opinions issued under Art. 7(d) of the Code of Conduct.

PCC also decided to work to arrive at a Recommendation by the Council regarding the use of a specific title for the **epi** members who will be entitled to represent clients before the UPC, under Art. 48(2, 3) of the UPC agreement.

PCC also noted the improper use of the title “European Patent Attorney” by people who are not professional representatives under Art. 134 EPC. Of particular concern is the improper use of that title by trainees who are actually trying to become European Patent Attorneys, by sitting

the European Qualifying Examination. That title, alone or in combination with other expressions (e.g. partially qualified European Patent Attorney) cannot be used by those who are not **epi** members. It is also worth noting that this is true also for trainees who participate in the **epi** student program.

**Thus, PCC reminds those (hopefully) future members of epi that they are not allowed to use the title “European Patent Attorney” – even in combination with other expressions – until they have actually become epi members.**

The chair of PCC has also been active to alert – personally and informally – **epi** members who do not comply with **epi** provisions in their presentations in social networks or webpages, when it is evident that the lack of compliance is simply due to a lack of care and not to a deliberate intention to violate **epi** provisions. A typical case is the indication of having passed the EQE

in a way that goes against the Council decision 4.2.3 of 1986 regarding non-discrimination between representatives. These alerts have been generally welcome by the alerted members, who reacted promptly and solved the issue.



Giorgio Checcacci

## Report of the Litigation Committee

T. Walshe (IE) , Secretary

**T**he Litigation Committee held its third virtual meeting of the year on 1<sup>st</sup> September 2022. The main topics discussed at this meeting are presented below.

### The UP and the UPC:

Preparations for commencement of the Unitary Patent and the Unified Patent Court are under way with an expected start date in early 2023.

The Litigation Committee is pleased to report that **epi** has been awarded observer status at the Administrative Committee of the Unified Patent Court. As observers, **epi** is able to attend those parts of the meeting that are not designated as confidential. A newly formed Administrative Committee UPC Advisory Group, has been estab-

lished to prepare for the meetings of the Administrative Committee. Peter Thomsen and Kim Finnilä, the Chair and Vice-Chair of the Litigation Committee respectively, have been selected as representatives of **epi** at the UPC Administrative Committee meetings.

An amended version of the 18<sup>th</sup> draft of the Rules of Procedure of Unitary Patent Court (RoP) together with the table of fees of the UPC were adopted at the Administrative Committee meeting of 8th July 2022. The adopted amended version of the 18th draft of the RoP and the fees came into force on 1<sup>st</sup> September 2022. Other decisions including the ‘setting up of local and regional divisions of the Court of First Instance of the UPC’ and decisions relating to organizational rules and human resource matters were also adopted at this meeting. The RoP and Case Management System (CMS) Sub-Committee together with

the Virtual Proceeding Sub-Committee, the OCC and the newly formed AC UPC Advisory Group of the **epi** are currently studying the adopted RoP.

A consolidated version of the RoP together with the fees can be found on the Unified Patent Court website<sup>1</sup>.

The RoP and CMS Sub-Committee reported that they had received a positive response from the Administrative Committee of the UPC in reply to the letter, which was prepared in cooperation with the Virtual Proceeding Sub-Committee, concerning the use of video conferencing for oral hearings. Rule 112.3 RoP now includes the possibility of video conferences for oral hearings.

The RoP and CMS Sub-Committee also reported that a letter concerning the accessibility of orders and decisions (Rule 262 RoP – Public Access to the Register) has been amended so that orders and decisions made by the Court will be published.

It was noted that the UPC Implementation Team announced on the 25<sup>th</sup> August 2022 that a major milestone in the implementation of the CMS had been achieved namely, the use of a strong authentication scheme to access and use the CMS. The strong authentication system requires that an electronic identification system which is compliant with EU regulation No. 910/2014 ('eIDAS' regulation) is used instead of the



Triona Walshe

current account and password system. It is expected that implementation of the strong authentication scheme will be activated in the next release of the UPC CMS V0.65 in mid/end September 2022. The RoP and CMS Sub-Committee together with the OCC are studying the impact and requirements of the strong authentication scheme.

The Representation and Privilege Sub-Committee reported that an amended version of the **epi** Code of Conduct referring to the UPC was approved in May at the 92nd **epi** Council meeting in Munich. An agreement has been reached with the EPO whereby the present Regulation on

Discipline would remain unchanged and an interpretative note would be issued by the Administrative Council (AC) of the EPO. It is proposed that this matter will be raised at the next meeting of the AC of the EPO due to be held in October 2022.

The Litigation Committee continues to maintain the overview on ratification of the UPCA, which is publicly available on the **epi** website<sup>2</sup>.

### Further Topics Discussed:

In addition to the Code of Conduct discussed above in the context of the UP/UPC, the Representation and Privilege Sub-Committee continues its work with the Harmonisation Committee on behalf of the Litigation Committee in relation to the Group B+ discussion on the draft proposal for an international "Agreement on Cross-Border aspects of Client-Patent Attorney Privilege". It was noted that this work is progressing slowly.

The Enforcement and Jurisdiction Sub-Committee provided an interesting report on the Complaint (DS611) by the European Union against China before the WTO Disputes Settlement System in relation to enforcement of Intellectual Property Rights. It was noted that Canada, Japan and the United States have requested to join the consultation.

Activities of the UK Government that are relevant to litigation and are as a consequence of Brexit continue to be monitored by the Brexit Implications on Patent Litigation Sub-Committee. Some of the major topics under discussion include the implications of the difficulties that hinder the UK to accede to the Lugano Convention and the UK Governments public consultation on 'Exhaustion of IP rights in the UK'.

### C-44/21 – Judgement of the ECJ (28th April 2022):

Ms. Verena Topert provided a summary report of the recent judgement of the ECJ in answer to the question addressed to the Munich 1 Regional Court in relation to interpretation of Article 9(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of Intellectual Property Rights.

<sup>1</sup> <https://patentepi.org/r/info-2203-08>

<sup>2</sup> <https://patentepi.org/r/info-2203-09>



# General Information

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HU – SZENTPÉTERI Zsolt

## Next Board and Council Meetings

### Board Meetings

123<sup>rd</sup> Board Meeting in Copenhagen on 28 November 2022

124<sup>th</sup> Board Meeting in Skopje on 24 March 2023

### Council Meetings

93<sup>rd</sup> Council meeting in Malaga (Spain) on 22 October 2022

94<sup>th</sup> Council meeting in Copenhagen (Denmark) from 1-3 May 2023



# Disciplinary Bodies, Committees and Audit

Disziplinarorgane, Ausschüsse und Rechnungsprüfung · Organes de discipline, Commissions et Vérification des comptes

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de Discipline (epi)
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CY – ROUSOUNIDOU Vasiliki	IE – SMYTH Shane	PT – DIAS MACHADO António J.
CZ – FISCHER Michael	IS – HARDARSON Gunnar Örn	RO – FIERASCU Cosmina
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DK – KUHN Oliver Wolfgang	LI – ROSENICH Paul*	SE – KARLSTRÖM Lennart
EE – KAHU Sirje	LT – GERASIMOVIC Jelena	SI – JAPELJ Bostjan
ES – STIEBE Lars Magnus	LU – KIHN Pierre	SK – LITVÁKOVÁ Lenka
FI – WESTERHOLM Christian	LV – SERGEJEVA Valentina	SM – MARTINI Riccardo
	MC – HAUTIER Nicolas	TR – YURTSEVEN Tuna**

Disziplinarausschuss (EPA/epi)	Disciplinary Board (EPO/epi)	Conseil de Discipline (OEB/epi)
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	FR – QUANTIN Bruno	

Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)	Disciplinary Board of Appeal (EPO/epi)	Chambre de Recours en Matière Disciplinaire (OEB/epi)
<b>epi Mitglieder</b>	<b>epi Members</b>	<b>Membres de l'epi</b>
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Ausschuss für Berufliche Bildung	Professional Education Committee	Commission de Formation Professionnelle
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
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BG – KOSSEVA Radislava Andreeva	HU – TEPFENHÁRT Dóra Andrea	PL – DARGIEWICZ Joanna
CH – KAPIC Tarik	IE – SKRBA Sinéad	PT – CARVALHO FRANCO Isabel
CY – THEODOULOU Christos A.	IS – GUDMUNDSDÓTTIR Anna Valborg	RO – TEODORESCU Mihaela
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