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Information

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

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Report from the 89th Council Meeting

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The **epi** Board and **epi** Secretariat join in sending Season's Greetings with our best wishes for a prosperous and healthy 2021

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European Patent Institute · Bayerstrasse 83 · 80335 Munich · Germany

30th November 2020

Dear colleagues,

2020 has been a very special year in all respects. I hope that you and yours are keeping safe in these trying times. When wishing a 'happy New Year', few of us thought that the pandemic would make it a difficult year for all of us.

Thanks to the dedication of many colleagues and of our Secretariat, who deserve our gratitude, it has proven possible for our Institute to adapt to the situation and to ensure continuity.

The spring and autumn Council meetings had been planned to take place respectively in Glasgow (GB) and Ljubljana (SI). They have been successfully converted to online meetings. Reports of these meetings can be found in **epi** Information, respectively in issue 3|20 and in the present issue. During these meetings, all matters regarding the life of our Institute could be dealt with, including the election of a new Board, of new committees and new auditors, and the adoption of a 2021 budget; time was also reserved for discussions on topics such as oral proceedings by videoconference, the European Patent Administration Certificate planned for Formalities Officers at the EPO and paralegal personnel, and a new structure of the e-EQE.

Last year, Mr Campinos, President of the EPO, was the guest of our Council meeting in Lisbon. He promised to join us one year later, and we had indeed the pleasure to welcome him for a presentation followed by a question and answer session.

The Presidium, the Board and the committees have also met by videoconference.

Whilst meetings by videoconference may contribute in ensuring business continuity, they are inherently not designed to allow the networking that is possible on the fringe of face-to-face meetings. We are all missing these enriching exchanges with our colleagues. At the last Council meeting, thanks to recent developments in the software, it was possible to use breakout rooms for chatting with colleagues; we are always on the lookout for new ideas.

Let us wish that 2021 would allow us to resume with social contacts. Social distancing is incompatible with the deep-seated human nature to connect with others.

Season's greetings to you and yours,

Francis Leyder

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Editorial

Don’t worry, be epi

M. Névant (FR), Editorial Committee

“Today is a great day for science and humanity”. These are the very words used by the CEO of a pharmaceutical company when announcing the first set of results from Phase 3 COVID-19 vaccine trials. These results, which since then have been followed by promising announcements from other pharmaceutical companies, give us some light of hope that we might be able to return to a “normal” life within 9 to 12 months. As we go to press, the UK has announced the approval of the Pfizer/BioNTech COVID-19 vaccine with a mid-December rollout.

In a previous Editorial (**epi** Information 2/20), I wondered whether The World After (the Pandemic) would be business as usual. It seems at first glance, that from the perspective of worldwide firms, little will change and that lessons have not been learnt. However, the lives of millions of people have been changed, sometimes dramatically, and our vision of society has, no doubt, been altered as a result of this pandemic ordeal.

In this context where social contacts are the exception rather than the rule, **epi** is preparing its Strategic Plan for the next three years. Communication will play an important role in the success of this plan, not only to gain more visibility vis-à-vis outside stakeholders, but first and foremost to reinforce the engagement with all members of the Institute. The Editorial Committee is committed to supporting the Presidium and the Board in order to achieve this goal.

The present issue of **epi** Information is a special one: a print version is being dispatched to all our members! I thank the Presidium and in particular the Treasurer for making this possible.

This issue features a report of the last Council meeting during which the question of oral proceedings by video-conference (ViCo) was extensively discussed. It is understandable that representatives wish to benefit from advances in technology enabling remote attendance at oral proceedings. However, when the pandemic is over, we should be careful to not completely de-humanise oral proceedings by extensively resorting to ViCo.

Marc Névant

This issue also features reports from various Committees the members of which have been elected or re-elected during the last Council meeting. The importance of the Committees, and their contribution to the image and reputation of the Institute, cannot be emphasized enough. We can be proud of the work they do, and especially of the time and effort spent by Committee members during this very particular year. I also extend our thanks to all the staff of the Secretariat for the outstanding support they have provided to the various **epi** bodies during the pandemic.

On behalf of the Editorial Committee, I sincerely wish all our readers a Merry Christmas and a Happy New Year 2021.

Introduction

Report from the 89th Council Meeting
held by videoconference on 13th and 14th November 2020

M. Névant (FR)

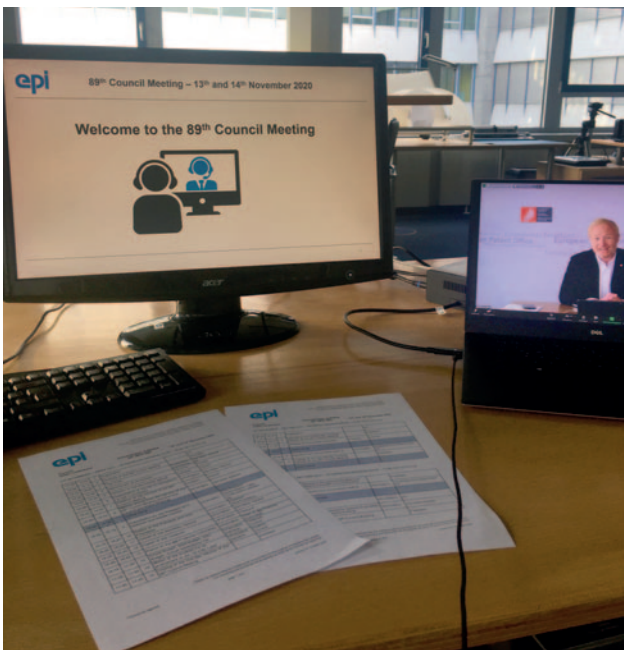
Initially scheduled to take place in Ljubljana, the 89th Council meeting (C89) was held on 13th and 14th November 2020 by videoconference.

DAY 1

1/ Meeting opening and appointment of scrutineers
President Leyder opened the meeting at 2 pm and welcomed all participants. Separate scrutineers were appointed for 13th November and 14th November.

2/ Adoption of the provisional agenda
The agenda was adopted with one change, namely a discussion, as part of the report of the EPPC Chair, of the recent decision of the EPO to impose oral proceedings in opposition by videoconference until mid-September of next year.

3/ Confirmation of the list of nominations for the Committees
The Secretary General reminded Council members of the rules (and time limits) set forth in the By-Laws to apply for a position within a Committee, and indicated that late filed applications (including those potentially filed on the first day of the meeting) would have to be reviewed and decided on a case-by-case basis.



4/ Adoption of the minutes of the 88th Council meeting – matters arising from said minutes and all previous Council and Board meetings
The minutes of the last Council meeting were approved. The Secretary General had prepared a document in tabulated form (included in the accumulated file distributed in advance to Council members) listing the action points arising from previous meetings and their status (completed or still on-going). This proved to be a very efficient manner to review the actions taken.

Heike Vogelsang-Wenke, epi Vice-President

5/ Report of the President and Vice-Presidents
The President referred to his report in the accumulated file, which included the activity of both Vice-Presidents. Some members raised the question of the length of the accumulated file, and asked whether the annexes – if any- to the various reports or information documents could be grouped at the end of the accumulated file or else available as an internet link. These suggestions will be studied and action will be taken to make the accumulated file for the next Council meeting more reader-friendly. It was also pointed out by some members that a few reports were not included in the accumulated file but were made available only one or two days before the meeting, which made it harder to fully consider the content of these reports.

After a break, the President of the EPO addressed Council members and participated in a Q&A session.

Susanne Ullmann, Katharina Jung, epi Secretariat

6/ Speech of Mr Campinos and Q&A session

Mr Campinos stressed that the **epi** Council meeting provides a unique opportunity for the EPO to reach out to a wider audience of **epi** members attending from different parts of Europe, and for patent professionals to hear from and engage with the EPO President on topics of interest to them, and provide their direct feedback.

Mr Campinos spoke about recent measures taken to ensure business continuity and support users during the pandemic, the importance of close co-operation with stakeholders and their involvement in Office initiatives: "*We're very grateful for the role that the **epi** plays in the quality process. Because frequent and in-depth exchanges with our users...that's how we can deliver* even better products and services."

Mr Campinos updated Council members on progress with the pilot project on opposition proceedings by videoconference, following the publication of a progress report[1]. Mr Campinos explained the latest changes, and called on Council members, and more generally **epi** members, to provide their feedback so that the EPO can further finetune its systems and tools according to their needs and safeguard their rights.

Mr Campinos informed Council members that as of mid-November the number of applications filed with the EPO was roughly 4% below expectations, and highlighted the fact that the EPO had just signed a two-year pilot program with CNIPA, effective as of December 1, 2020, whereby Chinese nationals or residents will be able to select the EPO as International Searching Authority (ISA), under the PCT, for PCT applications filed in English with CNIPA or the International Bureau.

In the ensuing Q&A session, moderated by our Vice-President Vogelsang-Wenke, Council members addressed a wide range of issues such as the EPO's financial situation, especially in light of COVID-19, what's in store for procedural fees, the EPO's quality management system, plans for a European Patent Administration Certificate, convergence of practices, and special fast-track services for appli-

1 https://patentepi.org/r/info-2004-01

António Campinos, EPO President

cations related to COVID-19. On the question of the reason for signing a pilot program with CNIPA, Mr Campinos indicated that it was the EPO's aim to become the first ISA in the world. On the question of fast-track services for applications related to COVID-19, Mr Campinos indicated that no such services had been implemented, but noted that search and examination can be accelerated if needed via the PACE program.

Finally, Mr Campinos stressed the importance of seeking user involvement in all of our future initiatives, and expressed the EPO's commitment to close co-operation with **epi** through frequent regular bilateral meetings with the **epi** Presidium. Mr Campinos promised to address the **epi** Council meeting again next year.

7/ Report of the Secretary General

The Secretary General referred to his report in the accumulated file. The Secretary General also indicated that the webinars organized at the end of June and beginning of July attracted as many as 760 participants, and that the recruitment of an Executive Director, as decided by Council, was on-going. The Secretary General also confirmed that the next Council meeting will be held the week-end of 8th and 9th May 2021. It is likely that the meeting will have to be held by videoconference rather than in person in Glasgow as originally planned.

8/ Report of the Treasurer

a) The Treasurer informed Council members that the SARS-CoV2 pandemic had a substantial influence on the operations and finances of **epi**. Various positions in the budget have been affected by the pandemic, both on the income and expense sides. For example, the cancellation of EQE 2020 resulted in no new additional members and therefore less income from the annual subscription, but also less turnover on expenses of EQE Committees. Higher expenses than originally expected became necessary on IT and **epi** administration due to the technical measures to be taken to make virtual Council meetings and Committee meetings possible. This year personnel and related expenses will also be slightly higher than planned due to over-hours and necessary infection protection measures.

The Treasurer also informed Council members that after discussion with the Editorial Committee, it was agreed to exceptionally have the last 2020 issue of **epi** Information printed and distributed as a hard-copy to all members which will represent an expense of ca.35-40 k EUR.

Due to the overall changed financial situation mentioned above, the 2020 budget should result in a surplus of +149950 EUR compared to an originally planned deficit of -90500 EUR.

Vernessa Pröll, epi Secretariat

b) Regarding the status of **epi**, the Treasurer informed Council members that **epi** has received a legal opinion on **epi**'s situation under the newly enacted German national Host State Law (Gaststaatgesetz), by which the German government intends to be attractive as a host state for newly located international institutions.

Renate Schellenberg, General Manager epi Secretariat

c) Concerning the Professional Liability Insurance (PLI) the Treasurer informed Council members that the **epi**-supported PLI is still available and all previous contracts have been renewed upon request of the insured members. Although the insurance is currently used by more than 200 members, the annual premium amount could not yet reach 200 k EUR which would be important for a long-term sustainable product. The Treasurer also noted that the current scheme proposed might not be so interesting for large firms.

9/ Report of the epi-Finances Committee

The Chair of the **epi**-Finances Committee referred to his report in the accumulated file, and expressed his thanks to the Treasurer for all the work done during the pandemic. He also expressed the view that at least some of the webinars organized by **epi** should not offered for free.

10/ Details and vote on the 2021 Budget

The Budget proposed by the Treasurer contains a high level of uncertainties mainly because of the unknown duration of the current restrictions in connection with the SARS-CoV2 pandemic. For the purpose of the budget 2021, it was assumed that physical meetings may become possible again from around May/June 2021. The Treasurer explained that in case **epi** cannot use the bookings for a Council meeting in Glasgow, there may be the risk of a financial loss (up to ca. 70 k EUR). Tne Treasurer also noted that, as the recruitment process for an Executive Director is ongoing, it is expected that such position can be filled in early 2021 leading to an increased budget for personnel. The Treasurer further indicated that several heavy software projects are planned to be implemented in 2021 (e.g. selecting and implementing a Document Management Software with an electronic ledger, digital reimbursement process) leading to increased expenses on the support/IT side. The Treasurer proposed to keep the amount of the annual subscription for 2021 at 190 EUR if paid before April 1 and 240 EUR if paid after April 1. The annual subscription for **epi** studentship would still amount to 95 EUR. Overall, it was proposed to adopt a budget for 2021 with a planned deficit of -197060 EUR.

Council approved at a large majority (>95%) the amount of the subscription fee for members and students. Council also unanimously approved the proposed budget for 2021.

11/ Report of the Internal Auditors

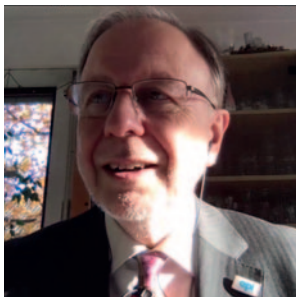
The internal proposed to amend article 16.3 of the By-Laws to read as follows:

"He (the Treasurer) shall have the duty of reporting to Board any substantial departure from the budget as soon as he foresees such a substantial departure".

The reasons given for the proposed amendment include the wish to remove an excessive burden for the Treasurer (per to the current wording of the article) and to be more aligned with current practice.

Council approved the proposed amendment at a large majority (>98%).

Peter Thomsen, epi Treasurer

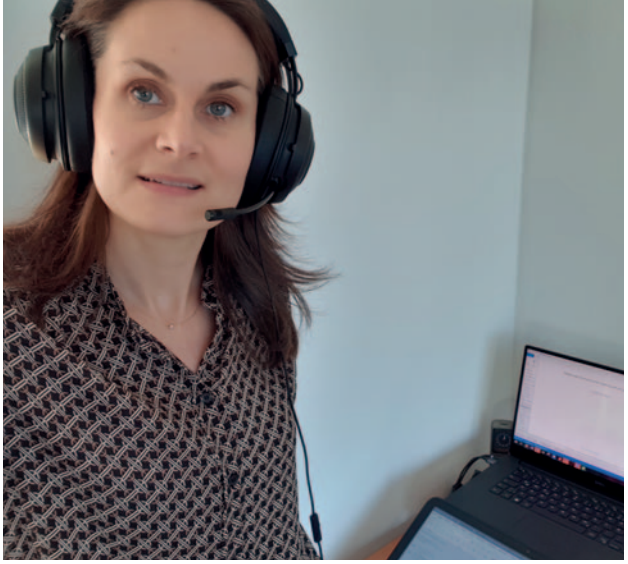


Francis Leyder, epi President

Chris Mercer, EPPC Chair

Cees Mulder, Secretary General epi

The meeting was suspended at 5pm. Three break-out rooms were then open, which allowed participants to renew social contacts, even virtually.



Amélie Faivre, epi Secretariat

DAY 2

The meeting resumed at 9.30 am. Most of the day was devoted to the election of Committee members. Before the vote started, the Secretary General informed Council members that 5 late nominations were received on 13 November and would not be taken into consideration.

12/ Election of Committee Members

Members of the following Committees were elected for a term of 3 years: By-Laws Committee, Editorial Committee, EPO Finances Committee, **epi**-Finances Committee, Online Communications Committee, Harmonisation Committee, Committee on Biotechnological Inventions, Professional Conduct Committee, European Patent Practice Committee (main committee and its technological groups), Professional Education Committee, Litigation Committee, IP Commercialization Committee and **epi** Studentship Admissions Committee.

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

13/ Report from the European Patent Practice Committee

The Chair of the EPPC presented the consultation which had just been launched by the EPO on the proposed amendment of the RPBA 2020 by the insertion of new Article 15a clarifying that the Boards of Appeal may hold oral proceedings pursuant to Article 116 EPC by video-conference. This gave rise to discussion on the matter of oral proceedings in general. As a result of the discussion a Resolution was passed by a large majority. The wording of the Resolution is as follows:

> *Council considers that, after the Covid-19 pandemic is over, oral proceedings should as a rule be held face-to-face but any party should be free to attend oral proceedings by videoconference, even if the other parties are attending in person.*

14/ Report from the Committee on Biotechnological inventions

The Chair of the Biotech Committee informed Council members that discussion with the EPO was on-going after the decision in case G3/19 in order to clarify a number of outstanding issues (e.g. random mutagenesis or mandatory disclaimers). Il was also noted with interest that the number of applications for plant varieties was on the rise following G3/19.

15/ European Qualifying Examination

A draft position paper was presented to Council members with proposals to restructure the format and content of the EQE. It must be borne in mind that any changes to the content of the papers requires that the IPREE be amended (in particular rules 10 and 23 to 26) sufficiently in advance so that candidates can be trained for the new format (and papers can be prepared of course!). It seems possible that a new format or a hybrid format (changes to some but not all papers) could be implemented as early as 2023.

The strengths and weaknesses of all papers were discussed, and proposed changes to the content and format were reviewed. It is quite obvious that since the EQE will from now on be organized as a virtual examination, the papers will have to be split in different parts so that candidates can take breaks.

Suggestions and thoughts from all **epi** members are of course welcome and can be sent to the PEC.

16/ Report from the Professional Education Committee

The Chair of the PEC provided Council members information on the issue relating to **epi** involvement in establishing a European Patent Administration Certificate (EPAC) in cooperation with the EPO. The possibility of having an examination as early as in 2022 was discussed.

This was the last report of the meeting, which was then closed by President Leyder at 6pm. The participants could then again meet in break-out rooms.

Preparation of the election process in the epi Secretariat

Patent Practice

Novelty, added subject-matter, and the 'gold standard'

P. de Lange (NL)

The relation between novelty (Art. 54), added subject-matter (Art. 123(2)), and the 'gold standard' of G 2/10 is not entirely straightforward. The test for added subject-matter was historically seen as 'basically a novelty test'. Currently, this test is both discussed in the Guidelines (H-V) and, at the same time, 'no longer used' (T 1525/15). In this article, I propose using a three-step framework for novelty and added subject-matter, with the 'gold standard' being one of the three steps. The differences and similarities between the two tests can be analysed more precisely using this framework and various strands of case law can be easily accommodated, such as the case law about selection inventions, disclaimers, and inherent features.

1 Introduction

According to the landmark decision T 201/83, r.3, the rule for examining amended claims under Art. 123(2) is the same as for novelty, namely whether the document at issue (the application as filed or the prior art document) provides 'sufficient information so that the person skilled in the art could derive the subject-matter in question from it directly and unambiguously, including any features implicit therein.'[1] The Board reasoned that 'the test for compliance with Art. 123(2) is basically a novelty test.'[2] The phrase 'directly and unambiguously' as used in T 201/83 still applies and is nowadays part of the 'gold standard' (G 2/10, r.4.3): the subject-matter disclosed by a document (implicitly or explicitly) is the subject-matter that 'a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the [relevant date], from the whole of [the document].'[3]

1 All references to legal provisions are to the European Patent Convention (EPC).
2 Guidelines C-IV, 7.2 (first edition 1978) provided that 'a document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document' (currently in G-VI, 2).
3 Case Law of the Boards of Appeal, 9th edition (CLBA), II.E.1.3.1.

Although G 2/10 firmly established the 'gold standard', the precise relation between the tests for novelty and added subject-matter remains unclear and the case law of the Boards appears somewhat inconsistent. For instance, according to T 1525/15, the 'novelty test' is no longer used for Art. 123(2). In contrast, T 906/12 held that 'the test for compliance with Article 123(2) is essentially a novelty test' and this 'novelty test' is still discussed in the Guidelines (H-V 3.2; 2019) for amendments which involve adding features. Indeed, G 2/10 confirmed that an amendment 'may not create novel subject-matter' (r.4.6).

In this article, I aim to shed some light on the relation between the two tests. I start from the principle that the European patent system uses the 'gold standard' as a 'uniform concept of disclosure' which is (by definition) exactly the same for Art. 54 and 123(2) (G 2/10, r.4.6; G 1/03, r.2.2.2). I propose a framework wherein each test consists of three steps, with the 'gold standard' forming the second step of both tests. The first step (which is also identical for both tests) is claim interpretation. The third step involves comparing the disclosed subject-matter and the claimed subject-matter. Importantly, the precise manner of comparing differs between Art. 54 and Art. 123(2). The third step entails assessing whether the disclosed subject-matter *falls within* the claimed subject-matter for novelty, whereas the question is whether the application as filed discloses subject-matter that is identical to the claimed subject-matter (neither narrower nor broader) for Art. 123(2). I will discuss the three steps in more detail hereinafter.

Such a three-step framework has been suggested earlier by Keukenschrijver for novelty.[4] Here I propose that the framework is also useful for Art. 123(2). In particular, the 'gold standard' becomes more clearly an independent concept by using the three-step framework, as it is only one of the three steps of the Art. 123(2) test. In this way, the differences and similarities with the novelty test can be more easily accounted for.

The framework can be schematically illustrated as follows (Table 1):

2. Overview of the three-step framework

The first step of the three-step framework is interpreting the claim under examination.[5] In this way, the subject-matter defined by the claim is abstracted from the precise claim wording, such that the subject-matter is not affected by a mere rephrasing of the claim, e.g. by using synonyms. The basic rule to be applied in the first step is that expressions in claims are given their broadest technically sensible meaning in EPO proceedings.[6] On the other hand, the EPO generally does not assess the scope of protection of claims.[7] Hence, the EPO does not interpret claims as embracing equivalent embodiments in the claimed subject-matter. Accordingly, for the assessment of novelty, it is not relevant whether a prior art document discloses something which falls under the scope of protection of the claim by way of equivalency.[8]

The second step involves identifying the subject-matter that is disclosed by the source document (a prior art document[9] or the application as filed). The disclosed subject-matter is hence abstracted from the precise wording of the source document, similarly as in the first step. In this step, the subject-matter that is disclosed by the document is identified by applying the specific test of G 2/10, namely the 'gold standard' test: a document discloses subject-matter (implicitly or explicitly) if the skilled person directly and unambiguously derives that subject-matter from the document, using common general knowledge and seen objectively and relative to the relevant date.[10] In other

4 Keukenschrijver in Busse/Keukenschrijver, PatG, 8th ed., §3 note 83 (7th ed.: §3 note 78). See also Melullis in Benkard, EPÜ, 3rd ed., Art. 54 note 23; Lindner in Singer/Stauder/Luginbühl, EPÜ, 8th ed., Art. 54 note 83 and 85 *in fine*.
5 I refrain from discussing the case wherein the test under Art. 123(2) is applied to amendments of the description.
6 E.g. T 79/96, r.2.1.3; CLBA I.C.4.1.
7 T 223/05, r.3.5: 'the extent of the protection of a patent is examined by the EPO in the opposition proceedings only within the framework of Article 123(3) EPC.'
8 This rule about the interpretation of the claim under examination is distinct from the rule that 'the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed' (CLBA I.C.4.5) which pertains to the second step.
9 Public prior use (G 1/92) is not considered in this article.
10 See G 1/16, r.51 describing the gold standard as the 'relevant disclosure test' (see also CLBA II.E.1.3.1). In principle, the Boards could also have set a different threshold for disclosure, such as 'fairly based' or 'expressly, implicitly, or inherently supported'. See also S. Adams, *Evaluation of Claim Amendments*, **epi** Information 3/2016.

Novelty Art. 54	Added subject-matter Art. 123(2)
(1) Claim interpretation	(1) Claim interpretation
(2) Applying the 'gold standard' to the prior art document	(2) Applying the 'gold standard' to the application as filed
(3A) Does the disclosed subject-matter fall within the claimed subject-matter? + enablement + specific case law	(3B) Is the disclosed subject-matter identical to the claimed subject-matter? + specific case law

Table 1: Three-step framework for novelty and added subject-matter

words, "the disclosure content of [a document] is (…) the information that the skilled person derives - explicitly or implicitly - directly and unambiguously from the document as a whole" (T 2003/08, r.2).

The first and second step can also be carried out in reverse order. These steps together provide that a mere difference in wording between a claim and a prior art document is insufficient to establish novelty (T 114/86 hn.2), similarly a mere rephrasing is not problematic under Article 123(2) (e.g. T 119/91).

The third step involves a comparison of the claimed subject-matter and the disclosed subject-matter (these having been established in the first and second step). The precise manner of comparing differs between the tests for novelty and added subject-matter.

To be novelty-destroying, the subject-matter disclosed in the prior art document must be something 'falling within' the ambit of the claimed subject-matter (e.g. T 890/17, r.1.2).[11] The phrase 'falling within' reflects the rule that a specific disclosure takes away the novelty of a generic claim embracing that disclosure (Guidelines G-VI, 5). It also reflects the principle that all embodiments within the claims must be examined for novelty in order to exclude from patenting subject-matter which is not novel (G 1/98, r.3.3).

For assessing compliance with Art. 123(2), the application as filed must disclose subject-matter that is identical to the claimed subject-matter, i.e. neither broader nor narrower (T 201/83, r.2).[12] The test is hence met neither by a more general disclosure nor by a more specific disclosure. This 'identical' test may seem trivial, but expressly discussing it as the third step of the Art. 123(2) test appears to be useful in order to allow for a precise comparison with the third step of the Art. 54 test. For instance, as a result of the differences between the two tests in their third step, an (intermediate) generalization does not provide for novelty but may still cause an amended claim to involve added subject-matter[13].

I note that a prior art document must not merely disclose the subject-matter in order to be novelty destroying, but must do so in an enabling way. I will discuss this in more detail hereinafter in §6.
I will first apply the three-step framework to a few topics that frequently turn up in the case law of the Boards, namely inherent features, selection inventions, and disclaimers.

11 See also T 508/91, r.2.4; T 793/93, r.2.1; T 137/15, r.6.1; T 308/17, r.14; T 641/99 r.4; and further Guidelines G-VII, 4 (about Art. 56).
12 The phrases that amended claims must have 'basis in the application as filed', may not involve 'added subject-matter' and 'may not extend beyond the content of the application as filed' can be used to refer to the entire three-step test of Art. 123(2); the terms 'disclosed' and 'gold standard' on the other hand can be understood as referring specifically to the second step of the proposed three-step framework.
13 This is the main reason why the 'novelty test' is no longer used, see CLBA II.E.1.3.7 and T 194/84).

3. Inherent features

Features which are inherent in a prior art disclosure are relevant for novelty, because it is established case law that the 'falling within' test for lack of novelty can be satisfied based on inherent features of the prior art subject-matter.[14] Such inherent features are, however, not relevant under Art. 123(2). For example, if a prior art document D1 provides an enabling disclosure of a compound X and a method of preparing it, and this compound X inherently has a property Y, then a claim directed to 'a compound with property Y' is not novel (even if document D1 is silent about property Y and even if the compound X could not be predicted to have the property Y). On the other hand, the fact that compound X has property Y is technical information and may therefore not be added to a patent application by way of amendment (G 2/10, r.4.5.1). Hence, a claim directed to 'a substance with property Y, wherein the substance is compound X' likely lacks basis under Art. 123(2) if the application as filed merely discloses compound X without giving any information (neither implicitly nor explicitly) about whether it has property Y.[15]


Peter de Lange

4. Selection inventions: selecting from lists and from ranges

The case law about selection inventions in fact deals with two topics: selections of items from lists and claims specifying ranges which are sub-ranges of broad ranges in the prior art.

According to established case law, novelty of a claimed sub-range over prior art teaching a broader range requires that the sub-range is both narrow compared to the broad range and sufficiently far removed from the end-points of the broad range (Guidelines G-VI, 8.ii and T 279/89). This case law logically pertains to the third step since it is a special manner of comparing the claimed subject-matter

14 T 12/81 hn.1, see e.g. also T 680/00, r.3. The exceptions are, of course, the special rules for first and second medical uses of Art. 54(4) and (5) EPC 2000, and the special rule for second non-medical use claims of G 2/88; however, these exceptions could also be seen as special rules for claim interpretation (cf. T 308/17, r.7). The remark in G 2/88, r.10.1 that 'the question of "inherency" does not arise as such under Article 54 EPC' is probably restricted to use claims as considered therein.
15 See e.g. T 1487/16, r.1.4.2, last paragraph. The question under Art. 54(3) was whether Example II of D9 benefited from the priority date of D9a. Example II of D9a gave specific values for two properties of the material prepared therein (BET value of 116 and Sears number of 22). Example II of D9 included a sentence mentioning that the material had a ratio Sears/BET of 0.19, this sentence was added compared to D9a. The Board found that this added information about the ratio made the priority invalid because the corresponding amendment would contravene Art. 123(2) (which is the relevant point for the present article), such that Example II of D9 could not be cited under Art. 54(3).

and the subject-matter disclosed in the prior art.[16] Because this rule pertains to the third step, the factors of 'narrowness' and 'sufficiently far removed' do not pertain to the second step and hence are irrelevant for the question whether or not the prior art document *discloses* the narrow range in the sense of G 2/10. Accordingly, there is no need for arguing that a prior art document teaching a broad range somehow also discloses the (non-novel) narrow range in order for T 279/89 to be consistent with G 2/10, let alone for arguing that the skilled person would derive the narrow range (directly and) unambiguously merely from the mentioned broad range. In other words, even though a claimed range of 2-99 is not novel over a prior art document mentioning a broad range of 1-100, an amended claim specifying the same range of 2-99 still lacks basis under Art. 123(2) if the application as filed only mentions a range of 1-100.

On the other hand, the rule that a selection from two or more lists basically provides for novelty of a claim (T 12/81, r.13, Guidelines G-VI, 8.i) belongs to the 'disclosure' question (i.e. the second step) and is (hence) applied equally in the context of Art. 123(2).[17]

5. Undisclosed and disclosed disclaimers

Similarly, case law concerning undisclosed disclaimers (e.g. disclaimers added to restore novelty over Art. 54(3) prior rights; G 2/03) can be brought under the third step of the Art. 123(2) test. In other words, the third step for Art. 123(2) involves not only the 'identical test', but also an additional rule that undisclosed disclaimers are disregarded in the third step of the Art. 123(2) test if they are allowable under G 2/03.[18] On the other hand, in order to determine whether a claim amended by the introduction of a 'disclosed disclaimer'[19] has basis in the application as filed, the 'gold standard' must be applied to 'the subject-matter remaining in the claim' (G 2/10, hn.1a; G 1/16, r.51). Accordingly, G 2/10 pertains to the second step. G 2/03 (about undisclosed disclaimers) and G 2/10 (about disclosed disclaimers) accordingly pertain to different steps of the three-step framework (namely, respectively the third and second step) and there is hence no contradiction between these two decisions (cf. G 1/16).

16 The same applies to the (possibly still valid) third requirement that the narrow range must involve a purposive selection in order to be novel (T 279/89).

17 See e.g. CLBA II.E.1.6.2 and T 1621/16. The title 'Novelty' of the chapter G-VI in the Guidelines where this rule can be found therefore does not fully reflect the scope of the rule.

18 The undisclosed disclaimer is taken into account for novelty, as it is used precisely to make the claim novel. Because of this different treatment of the disclaimer under Art. 54 and Art. 123(2), the rules about undisclosed disclaimers pertain to the third step of the three-step framework.

19 A 'disclosed disclaimer' is a disclaimer that excludes embodiments from the claim that are disclosed in the application as filed (see G 2/10, hn.1a). G 2/10 clarified that a claim amended with such a disclaimer may still infringe Art. 123(2) if 'the subject-matter remaining in the claim after the introduction of the disclaimer is not […] directly and unambiguously disclosed […] in the application as filed' (hn.1a). In the presently proposed framework, the phrase 'would derive directly and unambiguously' is used as the threshold for whether subject-matter is disclosed (cf. G 3/89, hn.1).

6. Enablement: novelty and priority

The third step can also be used to accommodate the rule that for lack of novelty, the prior art document must not merely provide a disclosure of something falling within the claimed subject-matter, but must do so in an enabling way (T 206/83, r.12). The case law under Art. 123(2) does not appear to require that the application as filed provides an enabling disclosure for subject-matter to have basis of the application as filed. The additional enablement requirement for lack of novelty hence appears to pertain to the third step of the three-step framework.

Similarly as for lack of novelty, validly claiming priority requires that the priority document provides an enabling disclosure (at the priority date; CLBA II.D.3.1.6). Hence, if the three-step framework is used for the requirement of 'the same invention' for priority (Art. 87), the third step is in principle the same as the 'identical' test for Art. 123(2), in view of G 2/98, but with the additional requirement that the priority document discloses the subject-matter in an enabling way.

7. Inventive step

Finally, the three-step framework can also be used for the 'novelty analysis' that is comprised in the problem-solution approach (PSA) for inventive step (Art. 56). The fact that an inventive step attack involves a novelty analysis might be familiar to practitioners but is not described in the Guidelines (G-VII, 5.2). A brief explanation therefore seems useful. A novelty analysis is part of the PSA, because the PSA involves three steps after the initial stage of identifying the closest prior art (CPA) document (or starting point document): 1) identifying the distinguishing features of the claim over the CPA document, 2) formulating the objective technical problem solved by those features in view of the CPA document and 3) assessing whether the distinguishing features are obvious as a solution to that objective technical problem (Guidelines G-VII, 5.2). The first step of identifying the distinguishing features normally involves showing that the other features of the claim do not provide for novelty in view of the CPA document. In other words, it is shown that the claim under examination modified by omitting the distinguishing features is not novel over the CPA document, i.e. a novelty analysis for a modified claim. This novelty analysis under Art. 56 should be done in exactly the same way as a normal novelty attack.[20] The proposed three-step framework is therefore also relevant for Art. 56.

20 N. Blokhuis and C. Mulder, 'Smart in C', 3rd ed. 2019, Helze B.V, p.68, §13.5. See e.g. also T 973/15, r.3.1, last para; T 1698/07 r.2.1.

Conclusion

A three-step framework for the tests under Art. 54 and Art. 123(2) was described and used for analysing the similarities and differences between these two tests. The three-step framework involves as the first step of claim interpretation and as the second step applying the 'gold standard' of G 2/10. These steps are the same for the tests for novelty and for added subject-matter. The differences between the two tests are accommodated in the third step. That step involves comparing the claimed subject-matter and the disclosed subject-matter in a manner that is specific for each test. Various strands of case law that pertain only to novelty (such as sub-ranges) or only to added subject-matter (such as intermediate generalisation) concern the third step. In this way the uniform character of the 'disclosure' concept (as recognized in G 2/10) can be reconciled with the various differences between the test for Art. 54 and the test for Art. 123(2) as can be found in the case law of the Boards.

Admissibility of referrals before the Enlarged Board of Appeal of the European Patent Office

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Conclusion of referrals to the Enlarged Board of Appeal (EBoA) have a major impact on proceedings before the European Patent Office (EPO). At the time of preparation of this contribution, there are two pending referrals to the EBoA of the EPO, i.e. G1/19 and G4/19. Due to pendency, there is no certainty that the EBoA will consider every referred question to be admissible.

In view of these pending referrals, it is considered to be appropriate to review the current understanding of premises of admissibility of referrals to the EBoA. Procedural aspects and a function of referrals to the EBoA will also be discussed.

1. Introduction

The purpose of proceedings before the first instance (i.e. the Receiving Section, the Examining Divisions and the Opposition Divisions) is to perform formal and substantive examinations of requests of the parties to the proceedings.[1] During grant proceedings, the Receiving Section and the Examining Divisions, in principle, examine requests to grant patents. On the other hand, the Opposition Divisions examine requests to revoke granted patents. From the first instance decisions, an adversely affected party to the proceedings may file an appeal and request re-examination of a decision in a judicial manner. The Boards of Appeal (BoA) are responsible for handling appeals and they have the power to alter decisions of the first instance.[2] Additionally, rulings of the BoA are binding on the first instance in situation where the case is remitted to the first instance for further prosecution.[3]

In view of the above, one might think that the function of the EBoA is to re-examine rulings of the BoA in the same manner as the BoA re-examines decisions of the first instance. However, that is not the case.

Specifically, it was underlined in G3/08 (Point 7.2.5 of the Reasons) that the EBoA are not a further instance above the BoA. This reasoning originates from the Travaux Préparatoires of the EPC where it was noted that there will be no further

1 In view of Art. 16, 18(1) and 19(1) EPC.

2 As indicated in Art. 21(1) EPC.

3 In view of Art. 111(2) EPC.

appeal from the BoA decisions.[4] However, the Travaux Préparatoires mentions that for uniform application of the law there will be an EBoA. In addition, it was noted in Decision G2301/16 (Point 42 of the Reasons) that the EBoA is *"the highest judicial authority of the EPO"*. In this regard, the Referral G3/08 noted that the specific function of the EBoA flows from the admissibility criteria of referrals. Thus, said criteria will be discussed in depth in this contribution.

In other words, while the EBoA are not a further instance, their rulings will affect the proceedings before the BoA and, hence, the proceedings before the first instance. The manner in which the proceedings before the BoA are affected will be described further below.

The function of the EBoA requires the highest level of autonomy. Specifically, it was mentioned that a ruling of the EBoA will affect the first and the second instance. However, the EBoA is not bound by a ruling of another EBoA as there is nothing in the EPC to support it. In practice, the EBoA can and will overrule any previous decision or opinion of the EBoA due to e.g. development of law.[5]

2. The Proceedings before the Enlarged Board of Appeal

The proceedings before the EBoA can be initiated either by referrals under Art. 112 EPC or by a petition for review under Art. 112a EPC.[6]

The purpose of a petition for review is to provide a judicial review of a decision of the BoA where said decision adversely affected a party to the proceedings. Petition proceedings will not be discussed further in this contribution. Under EPC2000, there are two possible referrals namely: Art. 112(1)(a) and Art. 112(1)(b) EPC. In essence, both of them are to ensure uniform application of law or to address a point of law of fundamental importance. Both types of referrals will be described in terms of procedure and their impact on the proceedings before the EPO. Each of these types of referrals is discussed below.

2.1. Referral under Art. 112(1)(a) EPC

Initiation and conduct of proceedings

A referral under Art. 112(1)(a) EPC may be initiated by the BoA or by a request from a party to the appeal proceedings. In the former case, the BoA has to provide reasoning behind a referred question.[7] In the latter case, the BoA has discretion to refuse to refer a question to the EBoA and such refusal requires providing grounds (see Art. 112(1)(a) EPC, second sentence).[8] A decision to refuse making a referral cannot be challenged.[9] A decision to initiate a referral is issued as an interlocutory decision.[10]

When an interlocutory decision is made to refer a question, the proceedings before the BoA which referred the question are stayed.[11] Once the EBoA reaches a decision, said proceedings are resumed.

Parties to the appeal proceedings are also parties to the proceedings before the EBoA and, hence, have a right to present their arguments and observations on the Boards findings.[12] Composition of the EBoA is different when compared with the composition of the BoA that referred a question. Specifically, while a composition of the EBoA consists of five legally and two technically qualified members (in view of Art. 22(1)(a) EPC), four members of the EBoA must not have taken part in the proceedings before the BoA that referred the question.[13]

During the proceedings before the EBoA, any person may file a written statement pertaining to a referred question. The EBoA may publish an invitation to this end in the Official Journal of the EPO (OJ EPO).[14] Following invitation, the President of the EPO may also file his/her observations in view of Art. 9 RPEBA. Although there is nothing that prohibits filing of third party observations under Art. 115 EPC during proceedings before the EBoA, said observations do not fit the purpose of said proceedings as observations may only pertain to patentability in a broadest sense and not to a point of law.[15] Therefore,

4 *"The Granting of European Patents: Introduction to the Convention on the Grant of European Patents"*, Martijn van Empel, Munich, 5 October 1973, p. 239.

5 Example of overruling of previous decision can be found in referral G2/08 which overruled referral G5/83. This change of practice made so-called Swiss-type claims obsolete.

6 There are also proceedings under Art. 23(1) EPC, but said proceedings pertain to the removal from office, or suspension of, members of the BoA. Thus, they are not pertaining to a point of law or uniform application of law.

7 Said requirement is mentioned in Art. 22(2) the Rules of Procedure of the Boards of Appeal 2020, OJ EPO 2019, A63 (RPBA2020). Case law also invoked this requirement in referral G1/14, Headnote. 1: *"If a board of appeal refers a point of law to the Enlarged Board under Article 112(1)(a) EPC, it is primarily up to the former to explain, in its referral decision, that and why it believes it needs an Enlarged Board ruling on the point arising in the case before it. This is also clear from Article 22(2), second sentence, RPBA, requiring the referring board to state the context in which the point originated."*

8 It is explained in Travaux Préparatoires EPC 1973 at p. 31 (BR/177) that reasoning is to provide "certain guarantee" to the parties and *"a certain degree of standardisation of the jurisprudence"* to the BoA.

9 Lack of possibility to challenge the decision of the BoA to refuse a referral was explicitly stated in the Travaux Préparatoires EPC 1973. Specifically, at p. 51 of document BR/168 it is stated that *"the parties should only have the right to ask"* and that the BoA is *"free either to accept or to reject that request"*.

10 The form of an interlocutory decision diverges from the form defined in R. 102 EPC. Specifically, an interlocutory decision does not require reasoning or, as expected, the order of the BoA. However, in practice, the BoA still uses order in their interlocutory decision. Additionally, such a decision requires to provide the referred question and a context in which the question arose. See Art. 22(2) RPBA2020.

11 Stay of the proceedings before the BoA has no legal basis and originates from case law. See e.g. T1145/09 Point 3 of the Reasons.

12 This flows from Art. 112(2) EPC.

13 This requirement is introduced by Art. 2(4) of the Rules of Procedure of the Enlarged Board of Appeal, CA/D 3/15, published in OJ EPO 2015, A35 (RPEBA).

14 In view of Art. 10 RPEBA.

15 Article 115 EPC mentions patentability and, hence, covers Art. 52-57 EPC. However, in the Guidelines for Examination before the EPO (version November 2019) in chapter E-VI, 3 it is pointed that observations may pertain also to Art. 76(1), 83, 84, 123(3) and 123(3) EPC. Hence, the GL are pointing to the broadest interpretation of the word "patentability" and also include deficiencies in the application documents or unallowable amendments.

observations under Art. 115 EPC should not be taken into the account until after the proceedings before the EBoA have terminated.

Proceedings before the EBoA ends with a decision which contains reasoning.[16] Said reasoning contains deliberations on admissibility (which will be discussed further) and, if any part of the referral is consider to be admissible, a decision on merits, i.e. an answer to any question that is consider to be admissible. The decision should be issued at the end of oral proceedings following Art. 14(7) RPEBA. However, this rarely happens, and, in practice, a decision is issued typically two months after oral proceedings.[17]

Binding effect of the referral

The decision issued by the EBoA is binding on the BoA in the proceedings under appeal (Art. 112(3) EPC). This is so called "direct binding" of the decision of the EBoA. Any decision of the EBoA is also binding indirectly as any BoA which would like to diverge from a previous decision of the EBoA must make a referral to the EBoA following Art. 21 RPBA2020.[18] It follows that although the first instance is not directly bound by any decision of the EBoA, the first instance will follow the decisions of the EBoA as otherwise any decision of the first instance will be set aside by the BoA.

It seems that the binding effect of a decision is not only restricted to order or reasoning behind a decision, but also to its *obiter dictum*. Examples of that effect are decisions G1/05 and G1/06 which led to the establishment of a practice to refuse European patents due to double patenting despite the fact that the EPC does not deal with double patenting in examination.[19] Additionally, an opinion issued in referral G3/08 (Headnote 5) explicitly noted that the grounds of a decision are also relevant and binding and, hence, *obiter dictum* is also relevant and binding.

2.2. Referral under Art. 112(1)(b) EPC

Initiation and conduct of proceedings

The referral under Art. 112(1)(b) EPC may only be initiated by the President of the EPO in a situation where two BoAs have issued different decisions on the same question. Since only the President can make a referral under Art. 112(1)(b) EPC, it is up to the President to provide reasoning behind the referral.

16 As required by Art. 22(1)(a) EPC and by Art. 18(2) RPEBA.
17 Said pattern was kept in referrals G2/19 and G1/16. However, in G1/15 it took ca. eight months to deliver a decision.
18 There is nothing about diverging from an earlier petition for review and thus the BoA is free to diverge from any earlier petition for review under Art. 112a EPC. This interpretation was also confirmed in Supplementary publication 2 in OJ EPO 2020.
19 CLBA II.F.5.

There are no parties to the proceedings and there are no restrictions on composition of the EBoA similar to the ones present for referrals under Art. 112(1)(a) EPC. Other than that, the composition is identical to the one under Art. 112(1)(a) EPC.

Similar to the proceedings under Art. 112(1)(a) EPC, under Art. 112(1)(b) EPC there is also a possibility to file written statements. Interestingly, the President may also be invited to comment following Art. 9 RPEBA despite that the proceedings being initiated by him. However, there is no purpose in the filing of third-party observations under Art. 115 EPC.

The EBoA concludes the proceedings with an opinion (Art. 22(1)(b) EPC). The opinion (similar to the decision under Art. 112(1)(a) EPC) contains admissibility deliberations and, if applicable, a discussion on merits.

Binding effect of the referral

The binding effect of a decision under Art. 112(1)(a) EPC is different when compared with an opinion under Art. 112(1)(b) EPC. For instance, the binding effect mentioned in Art. 112(3) EPC is only about decisions under Art. 112(1)(a) EPC and not about opinions under Art. 112(1)(b) EPC. An opinion of the EBoA indicates which case law should be endorsed and, if appropriate, which should be abandoned. Any future case pertaining to the same topic should fall under the teachings of an opinion issued under Art. 112(1)(b) EPC. If a BoA wishes to deviate from an earlier opinion of the EBoA, said Board must make a referral under Art. 112(1)(a) EPC (in line with Art. 21 RPBA).

Grzegorz Wesela-Bauman

2.3. Stay of the proceedings in the first instance due to a referral under Art. 112(1)(a) and (b)

According to the Guidelines for Examination in the EPO (GL) (November 2019 edition (GL, E-VII, 3)) during a pending referral before the EBoA, examination or opposition proceedings may be stayed if said proceedings depend entirely on an answer to this referral. A motion for stay of the proceedings can be filed by a party to the proceedings or the proceedings may be stayed on the Opposition Division's or the Examining Division's own motion.

Since the decision to stay the proceedings is ultimately within the discretion of the first instance that is currently responsible for the case, the stay of the proceedings is not mandatory according to the GL.

In this regard, case law presents a much stronger position on stay of proceedings and notes that, when the outcome of the proceedings depends on a referral and that an Examining Division is aware of it, the examination must be stayed (see T166/84, Headnote).[20] In other words, while the GL indicate that a given instance may stay the proceedings, case law indicates that the proceedings must be stayed. It seems that the teachings of T166/84 should apply to the proceedings before the Opposition Divisions *mutatis mutandis*.

In line with Art. 113 EPC, a party will have an opportunity to comment on an upcoming stay of the proceedings. It is worth to underline that the party cannot effectively prevent the upcoming stay of the proceedings as a decision to stay is within a discretion of the EPO.

Additionally, the President of the EPO may decide *ex officio* to stay all proceedings before the first instance (i.e. before the Examining and the Opposition Divisions) which may be affected by the outcome of the referral. This was the case for a decision in referral G4/19[21] and that was the case for an opinion in referral G3/19.[22]

3. Admissibility of referrals under Art. 112(1)(a) EPC

In case of referral under Art. 112(1)(a) EPC, every referral must be made for uniform application of the law or if a point of fundamental importance arises, during pending proceedings, and the BoA must consider that a decision is required. It is worth noticing that the EBoA will independently examine the premises of admissibility as soon as the case is transferred to it.[23] Moreover, the EBoA is not bound by the results of examination of admissibility made by the BoA that referred the question to it.[24]

Said premises will be discussed in detail in the following sections.

3.1. Uniform application of the law or point of law of fundamental importance

The principle of uniform application of the law is to ensure that two or more BoAs will give the same ruling for the same state of facts. Alternatively, a referral to ensure uniform application of the law is needed if a BoA considers a need to deviate from an earlier decision or opinion of the EBoA.

A point of law of fundamental importance arises when a Board considers that the question cannot be answered directly and unambiguously by reference to the EPC. Alternatively, a point of law is also fundamental if the impact of answers to the referred questions will extend beyond the specific case and may affect a large number of cases.[25] In this regard, there is no need to provide an estimated number of cases that may be affected as established in referral G2/19.[26]

3.2. Pending proceedings

Pending proceedings means that an application has to be pending and there has to be pending appeal proceedings.

Pendency of an application means, for example, that an application deemed withdrawn due to lack of payment of renewal fee will result in closing of referral proceedings. That was the case in application 01989207.4 where the lack of payment led to closure of appeal proceedings and termination of referral proceedings in G2/14 regarding appeal deemed inadmissible or deemed not to have been filed.[27] As the result, the question about admissibility of appeal pursued in referral G2/14 was abandoned and we had to wait until decision G1/18 to obtain explanations on the topic.[28]

Consequences of withdrawal of an appeal were exemplified in referral G3/06 (regarding the possibility in opposition proceedings of amending a patent granted for a divisional application violating Art. 76(1) EPC) where withdrawal led to termination of referral proceedings.[29]

3.3. A decision is required

A decision is required only for a legal question and, hence, any referral aimed at establishing the state of facts does not satisfy the premise of a need for a decision.[30] Case law indicates that interpretation of description for the purpose of inventive step analysis is not a matter of referral.[31] On the other hand, it seems that a referral made when a Board considers to deviate from an earlier decision or opinion of the EBoA satisfies this premise.[32]

Case law notes that reasons for referral should be made on objective criteria and should be plausible. Specifically, the referring BoA should explain how different answers

20 See CLBA V.A.9.5.15 and V.B.2.5.3. where it is explicitly stated that lack of stay results in substantial procedural violation and, hence, may result in reimbursement of the appeal fee under R. 103 EPC.
21 See OJ EPO 2020, A20.
22 See OJ EPO 2019, A34.
23 This is actually a requirement imposed by the case law. See referral G1/14 hn.2.
24 See referral G2/19, r. A.II., OJ EPO 2020 A87.
25 In line with the teachings of referral G1/12 r.10: *"A point of law is also to be regarded as of fundamental importance if its impact extends beyond the specific case at hand. Such importance is established if it could be relevant to a large number of similar cases."*
26 See reasons A.III.3.
27 See OJ EPO 2015, A13 and appeal no. T2017/12.
28 For an English communication regarding G1/18 see https://www.epo.org/law-practice/case-law-appeals/communications/2019/20190718.html
29 See OJ EPO 2007, 312 and appeal no. T1040/04.
30 The fact that the EBoA has to deal only with question of legal nature was already envisaged in Travaux Préparatoires EPC 1973 at p. 32 (BR/177). Subsequent case law confirmed this approach (see e.g. appeal T287/11 r.3.3 or T181/82 r.14, CLBA V.B.2.3.4).
31 See appeal no. T2136/16 r.8.2 and 8.3, CLBA V.B.2.3.3.
32 Following Art. 21 RPBA2020.

to the referred question would influence proceedings before the referring BoA.[33]

Lack of a need for a decision was, in my opinion, present in referral G1/14 where it was clearly stated that a referral is inadmissible if it is as a result of misapplying the law (Headnote 3). Similarly, there is no need for a decision when the question can be answered by reference to the EPC even if the question itself pertains to an important point of law (see J5/81, Headnote 2).[34] Therefore, lack of application of law or misapplication of law results in inadmissible referrals. This indicates that the EBoA should provide guidance where there is an ambiguity in law.

Another aspect of a need for a decision is the relevance of a referred question to the case under the appeal. Case law seems not to be so restrictive when it comes to this aspect. For example, when it was not clear on whether a question was relevant or not to the appeal, the EBoA nevertheless considered the question to be admissible for the reasons of procedural efficiency (see referral G3/98 Point 1.2.4 of the Reasons). At the same time, referral G3/98 noted that a referred question cannot be theoretical and that would be the case *"if the referring board were to reach the same decision on the basis of the file regardless of the answer to the referred question"*.[35] This requirement was followed in T154/04 (Point 2 of the Reasons) where there was specified that a referred question must be essential in order to reach a decision on the appeal in question. As a result, the fact that a question is quite interesting is not relevant for its admissibility. On the other hand, in referral G2/19 (Point A.III.5 of the Reasons), the EBoA considered one of the questions to be admissible despite that the answer to it could only be relevant in a certain scenario.

3.4. Further aspects of admissibility

A further aspect of admissibility was raised in referral G1/12 under Art. 112(1)(a) EPC. Specifically, the EBoA re-formulated one of the questions in view of what the Board considered to be the true intention of the BoA that referred the question. It seems that the EBoA established the "true intention" on the basis of detailed analysis of the current case law. While this was not stated in the grounds of the decision, it seems that the EBoA considered that reformulation is needed for the question to meet the criterion of *"a decision is required"*.

Rewording was also mentioned in referral G2/19 where the Board noted that rewording was necessary to provide a more precise answer to the referred question. Interestingly, the same Board noted that even the reworded question may be left unanswered in part where it extends beyond what needs to be clarified. As a sidenote, this referral separated admissibility of an appeal from admissibility of a referral. Specifically, in this referral, the EBoA decided that the referred questions were admissible even though the appeal was not admissible.

4. Admissibility of referrals under Art. 112(1)(b) EPC

4.1. Uniform application of the law or point of law of fundamental importance

Similar to referrals under Art. 112(1)(a) EPC, referrals under Art. 112(1)(b) EPC require a point of law of fundamental importance, or concern a lack of uniform application of the law by the Boards. Therefore, comments on said premises are the same (as in Section 3.1 above).

4.2. Motion from the President

The discretion to refer a point of law rests with the President of the EPO.

Said discretion cannot be taken away from the President merely because the President changed his/hers view with respect to a need to make a referral in a relatively short period of time. Also, change of presidency cannot be viewed as a pointer to consider a referral inadmissible.[36]

Despite the fact that the referral proceedings are initiated by the President of the EPO, it is up to the EBoA to rule on the admissibility of the referral.

4.3. Two Board of Appeal and two different decisions

The requirement of two BoAs is interpreted broadly in case law. In particular, in referral G3/08, it was stated that the same BoA in two different compositions is treated as two separate BoAs (see Headnote 2). This allows for admissible referrals from the same technical field. Additionally, this interpretation supports admissibility of a referral from the Legal Board of Appeal.[37]

On the other hand, two different decisions are interpreted narrowly. Specifically, the two different decisions should be read as two conflicting decisions (as pointed in referral G3/08, Headnote 3). In this regard, conflict should be separated from a natural development of law (see referral G3/08, Headnote 4 and Headnote 6). In particular, the

33 See referral G3/98 r.1.2.3.
34 CLBA V.B.2.3.7.
35 See G3/98 r. 1.2.3.

36 During the proceedings in referral G3/08, a matter of inadmissibility was raised since Alain Pompidou (at that time the former President of the EPO) refused to refer a point of law on computer-implemented inventions (CIIs) and Alison Brimelow (at that time the President of the EPO) decided to refer said point to the EBoA. Change of views between the former and the current President did not render the referral inadmissible.
37 Admissibility of such a referral was already endorsed in referral G4/98. See reasons point 1.1 in referral G4/98 and CLBA V.B.2.4.4.

questions referred in G3/08 were inadmissible due to lack of divergent case law and any case law cited in support of the admissibility of the referral was considered a natural development of law which occurred over a period of time.

Lack of admissibility of a referral does not prevent the EBoA to present its views on the referred questions. Reference is made to referral G3/08 where the Board considered all questions to be inadmissible, but, nevertheless, provided valuable comments.

4.4. Further aspects of admissibility

A recent opinion of the EBoA in referral G3/19 invoked another aspect of admissibility which concerned the reformulation of the referred questions. The grounds of G3/19 present different reasons behind reformulation of each question.

The first question in this referral was considered to be too general and directed to an abstract legal concept. In the EBoA's view, that concept should be pursued by the legislator. As a result, the answer to this question as originally formulated would have been a violation of the separation of powers endorsed in the EPC as the EBoA would have acted as the legislator. It seems that the EBoA followed the principle of separation of powers as explained in an earlier referral G3/08.[38]

The second question was considered to contain an answer to it. Therefore, the EBoA reformulated the question so as to ensure that it was unencumbered by the opinion of the former President of the EPO.

The above-mentioned aspects of admissibility are of systemic nature and, hence, do not originate from Art. 112(1)(b) EPC, but, rather, from general principles of procedural law recognized in the Contracting States.

5. Currently pending referrals

At the time of writing this contribution, there are two referrals under Art. 112(1)(a) EPC pending before the EBoA. Specifically, a referral regarding patentability of computer implemented simulations (G1/19[39]) and a referral regarding double patenting (G4/19[40]).

During oral proceedings in referral G1/19, the Board indicated doubts regarding admissibility of one of the referred questions. So far, there are no oral proceedings in G4/19. It follows that the Board has not yet presented any views on admissibility of the referred questions in that referral.

6. Summary

Referrals to the Enlarged Board of Appeal shape the jurisprudence of the EPO.
The referral proceedings before the EBoA can be initiated under Art. 112(1)(a) EPC by the BoA's own motion or following a motion from a party to the appeal proceedings. Additionally, said proceedings can be initiated under Art. 112(1)(b) EPC under the discretion of the President of the EPO.
Proceedings under Art. 112(1)(a) EPC involve parties to the appeal proceedings in which the referral was made. A decision concluding the proceedings before the EboA directly binds the BoA that referred the question to the EBoA.
Proceedings under Art. 112(1)(b) EPC do not involve parties and are concluded with an opinion of the EBoA.
Both decisions and opinions of the EBoA indirectly bind the first and the second instance of the EPO since ultimately any divergence from any decision or any opinion of the EBoA needs to be referred to the EBoA.
Pending referrals will generally put a stay on proceedings before the first and the second instance in which decisions are to be affected by conclusions of said referrals.
Admissibility of a referral under Art. 112(1)(a) EPC requires a need for uniform application of law or point of law of fundamental importance. Further it requires that the application is pending and that the appeal proceedings are pending. Also, there is a requirement for a need to have a decision on the referred question. Further aspects of admissibility may involve a reformulation of the referred questions in order to meet the true intention of the referral.

Admissibility of a referral under Art. 112(1)(b) EPC also requires a need for uniform application of law or point of law of fundamental importance. Further, there is a need for a motion from the President and that two BoA arrived at two conflicting decisions on the same matter. Further aspects of admissibility may involve reformulation of the referred questions in order to meet general principles of procedural law recognized in the Contracting States such as separation of powers.
Examination of admissibility of a referral is ultimately done by the EBoA that handles the referral.

There are currently two pending referrals before the EPO, i.e. G1/19 and G4/19. Conclusion in these referrals will shed more light on the development of requirements of admissibility of referrals to the EBoA.

38 See reasons 7.2.1 of G3/08: *"The European Patent Organisation is an international, intergovernmental organisation, modelled on a modern state order and based on the separation of powers principle, which the sovereign contracting states have entrusted with the exercise of some of their national powers in the field of patents. Thus the EPC assigns executive power to the Office to grant patents and to its President to manage the Office in organisational respects (Articles 4(3) and 10 ff. EPC), while to the Administrative Council it assigns limited legislative powers restricted to lower-ranking rules (Article 33 EPC), along with financial and supervisory powers."*

39 Proceedings relating to application 03793825.5 entitled *"Simulation of the movement of an autonomous entity through an environment"* and initially filed by The Maia Institute. The application has been transferred to another applicant, i.e. Bentley Systems (UK) Limited.

40 Proceedings relating to application 10718590.2 entitled *"Prevention and Treatment of Allergic Diarrhoea"* and filed by NESTEC S.A.

EPO fees – how much and what for?

J. Boff (GB)

The EPO's Strategic Plan 2023 published in 2019 included among its goals to harmonise and simplify patent procedures and processes, and stated

> *The EPO's fees, payments and refund methods will also be reviewed and streamlined. There will be a focus on items that are perceived as particularly burdensome by both users and the Office. A number of small and rarely-used fees could be abolished entirely or merged with other fees.*
>
> *There is also potential to further align the fees for European and PCT applications. The fee structure will also be reviewed to create incentives for applicants to further enhance the quality and efficiency of the patent granting process.*

The present fee structure is complex [far more complex than necessary] and simplifying will result in changes of practice.

Recent paper **CA/F 27/20** indicates that a review of the structure of fees will take place during 2021.

Apart from the major changes in procedure that have taken place since 1978, one of the reasons behind the review is the progressive reduction in the number of countries in which patentees validate their European patents, leading to a relative decrease in the EPO post-grant income per patent. The unitary patent would mitigate this trend if it ever comes into force.

James Boff

It is of the essence of the European system that there is an adequate flow of post-grant renewal fees to be shared with national offices, but also to fund the office, and to keep entry costs low. As said in CA/124/96, shortly before the EPO reduced search, examination, and designation fees,

> *"it is a traditional and common feature of patent systems in Europe that patent office expenses be covered **predominantly** by income from annual maintenance fees as opposed to procedural fees".*

In consultation with the Office, we should aim to preserve this balance, while ensuring that changes to the structure of fees are beneficial changes, and do not have adverse unintended consequences to users, or to the Office.

Nächster Redaktionsschluss für **epi** Information	Next deadline for **epi** Information	Prochaine date limite pour **epi** Information
Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der **epi** Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse editorialcommittee@patentepi.org bis spätestens **5. Februar 2021**. Weitere Informationen finden Sie in unseren „Guidelines for Authors" auf der **epi** Webseite: https://patentepi.org/r/guidelines-epi-info	The Editorial Committee invites contributions for publication in the next issue of **epi** Information. Documents for publication or any enquiry should be sent by eMail to (editorialcommittee @patentepi.org) no later than **5 February 2021**. Further information can be found in our "Guidelines for Authors" here: https://patentepi.org/r/guidelines-epi-info	La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d'**epi** Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (editorialcommittee@patentepi.org) au plus tard le **5 février 2021**. De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse : https:// patentepi.org/r/guidelines-epi-info

Case Law

T 0161/18 brings to the fore the requirement of disclosing training data in AI case

F. Hagel (FR)

1. Introduction

The EPO Technical Board of Appeal 3.5.05 has issued on May 12, 2020 a decision T0161/18 Äquivalenter Aortendruck/ARC SEIBERSDORF which relates to a method involving an artificial neural network and deserves great attention. This decision upholds a rejection from the Examining Division for lack of inventive step under Article 56 EPC but more importantly, adds a rejection for lack of sufficient disclosure of training data under Article 83 EPC.

2. The decision

Claim 1 of the application relates to a method for determining cardiac output from an arterial blood pressure curve measured at the periphery, in which such curve is transformed into the central blood pressure curve by the aid of an artificial neural network whose weighting values are determined by learning, and the cardiac output is calculated from the central blood pressure curve.

We will focus this comment on reason 2 of the decision which holds that the application is rejected for lack of sufficient disclosure under Article 83 EPC. Reason 3 upholds the rejection of the Examining Division under Article 56 EPC on the basis of prior art documents.

The Board in reason 2.2 asserts that the application fails to disclose the input data to be used for training the neuronal network or at least a dataset enabling

the technical problem to be solved. The Board specifically notes that the application only mentions that the input data must cover a broad spectrum of patients of different ages, sexes, constitutional types, health conditions and the like to avoid specialisation of the network. The Board states on the basis of this lack of disclosure of the input data that the skilled person cannot carry out the training of the network and concludes in reason 2.4 that the application does not meet the requirement of Article 83 EPC. The rejection applies to the application as a whole, not to specific claims.

The Board's focus on the requirement of Article 83 EPC must be considered meaningful from a policy perspective in that it keeps away from relating the disclosure requirement to the patentability conditions of Articles 52-57 EPC, especially the prerequisite of "technical content" established by the jurisprudence of the Boards of Appeal or the inventive step condition of article 56 EPC, as it has been the case in some Board of Appeal decisions[1]. This is important because a sufficient disclosure enabling the invention to be carried out is a *quid pro quo* for the award of an exclusive right to an invention meeting the patentability conditions and thus fulfills a public policy objective, the diffusion of information and knowledge to the public. to be distinguished from that of the patentability conditions.

3. Background regarding review of Article 83 EPC at the EPO – General

Decision T 0161/18 appears as a milestone in that it is to our knowledge the first Board of Appel decision to reject an application for lack of disclosure of training data in an AI case. In addition, it is unusual in that the Board has raised the ground of insufficient disclosure under article 83 EPC of its own motion.

The decision comes out against the contrasted background of review by the EPO Examining Divisions of compliance with Art 83 EPC. There is a marked difference on this issue between the pharmaceutical & chemical sectors and the other sectors.

In the pharmaceutical & chemical sectors, the claimed invention frequently encompasses a broad family of species for which a desirable effect is to be attained, and because there is no logical reasoning linking the structure of a given species (such as a molecule or a value of a parameter within a range) and the effect, it must be assessed whether it is *plausible* (or credible) for the desired effect to be achieved across the entire family recited in the claim. The review is based on detailed examples and relies on compliance with Articles 83 and/or 84 EPC.

In other sectors (mechanical/physical/telecom & computer technology), compliance with Article 83 EPC is generally given scant attention by the Examining Divisions. We had mentioned this situation back in 2008[2] and stressed that a sufficient disclosure is a key ingredient of patent quality. Frequently, Article 83 issues when they occur are raised by third parties in opposition proceedings or observations under Article 115 EPC, for which Article 83 EPC issues are explicitly encouraged by Guidelines E-VI, 3[3]. A rationale here is that third parties engaged in the field of the invention typically possess highly specific expertise, which allow them to spot insufficient disclosures not easily detected by Examiners. The result anyhow is that patents may sometimes be granted in spite of a total lack of relevant disclosure on a critical component, favouring speculative patenting.

Previous commenters have consistently emphasised[4,5,6] that the plausibility issue which is common in the pharmaceutical & chemical sectors as recalled above also arises in AI cases. This is because the dynamic and unpredictable behaviour and blackbox character of an AI tool once trained by means of training data open up the question of the reproducibility and reliability of the purported effect.

4. Review of Article 83 EPC at the EPO in AI cases

A statement of the EPO alongside the other IP5 Offices[7] regarding disclosure requirements in AI cases can be found in the European Patent Office

Report from the IP5 expert round table on artificial intelligence, Munich, 31 October 2018.

1 Hagel, F. Bombshell Decision T 2101/12 (Vasco) questions the technical/non-technical distinction – **epi** information 2/19

2 Hagel, F. Quality of patents : a matter of information inputs – **epi** information 2/2008

3 Guidelines E-VI, 3 states : *"Although lack of novelty and/or inventive step are the most common observations, third-party observations may also be directed to clarity (**Art. 84**), sufficiency of disclosure (**Art. 83**), patentability (**Art. 52(2)** and **Art. 52(3)**, **Art. 53** or **Art. 57**) and unallowable amendments (**Art. 76(1)**, **Art. 123(2)** and Art. **123(3)**)."* It is of note that the 2019 issue of the case law of the Boards of Appeal contains a narrower, literal interpretation of Article 115 EPC which only refers to patentability conditions of Articles 52-57 EPC.

4 Jones, S. Patentability of AI and machine learning at the EPO – Kluwer Patent Blog December 21, 2018 at http://patentblog.kluweriplaw.com/2018/12/21/patentability-of-ai-and-machine-learning-at-the-epo

5 Read, H. Artificial intelligence and machine learning : sufficiency and plausibility – June 12, 2019 at https://www.appleyardlees.com/artificial-intelligence-and-machine-learning-sufficiency-and-plausibility

6 AIPPI 2019 Resolution plausibility, Background #2 at https://aippi.org/wp-content/uploads/2020/05/Resolution_Patents_Plausibility_English.pdf

7 IP5 is a forum of the five largest intellectual property offices in the world. The five patent offices are the US Patent and Trademark Office (USPTO), the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the National Intellectual Property Administration (CNIPA formerly SIPO) in China.

It reads as follows:

> *9. The requirement of sufficiency of disclosure remains fully applicable in all IP5 jurisdictions and can be met, for example, when the applicant discloses how the model was trained and provides the data used for training. Elements which can be expected to be known to a skilled person (e.g. how a computer works) may not need to be disclosed.*
>
> *10. The applicant is required to fully disclose the claimed invention. If the inventive contribution is in the algorithm, the latter must be disclosed. If the contribution lies in the use of data and the algorithm is not part of the invention, then the algorithm may not need to be disclosed.*
>
> *11. All IP5 Offices have strict disclosure requirements, including reproducibility and repeatability. However, the application of the requirement of sufficiency of disclosure allows for some flexibility.*

This statement affirming "strict disclosure requirements" strongly departs from a benign neglect attitude. However, this is easier said than done. The latest update of the Guidelines (November 2019) sheds no light on the disclosure requirement in AI cases, it only includes in G-II 3.3.1 an addition regarding the presence of "technical character" in an AI invention.

Francis Hagel

The statement refers to algorithms and training data, but there are numerous areas in AI inventions requiring sufficient disclosure, inter alia, the structure of the AI model, the training process, the setting of the model's coefficients, and the disclosure regarding the input data (selection of sources, classification, labelling of data) raises difficult questions[8].

It is to be mentioned in this respect that the preliminary communication dated January 24, 2020 issued by the Board in the case of decision T0161/18 referred in point 4.2 to other features than training data (configuration of the layers of the neural network, activation functions, adjustment of weighing coefficients of the network). While the decision did not retain these aspects, this must be kept in mind.

8 Van der Heijden, H. AI inventions and sufficiency of disclosure – when enough is enough NLO – IAM Yearbook 2020 at https://www.iam-media.com/ai-inventions-and-sufficiency-disclosure-when-enough-enough

It is also noteworthy that the Resolution 2020 "Inventorship of inventions made using Artificial Intelligence" adopted by AIPPI World Congress on October, 2020 lists in points 4.a to 4.e the following contributions the author of which is to be considered inventor : use of an AI algorithm to design a particular type of product or process, design of an AI algorithm, selection of a data source for training an AI algorithm, selection or generation of data or data source for input to a trained AI algorithm, recognition that an output of an AI algorithm constitutes an invention. Such contributions since inventive are by definition beyond the purview of a person skilled in the art and raise a need for a sufficient disclosure.

The future development of the Boards of Appeal jurisprudence is certain to provide guidance as to which disclosure passes muster for compliance with the sufficiency requirement of Article 83 EPC. It can be expected that future updates of the Guidelines will incorporate the Board's reasoning and hopefully provide additional insights. This will be especially helpful to practitioners who need to satisfy the requirement of Article 83 EPC as to training data without providing public access to the data, such public access being generally both impractical and undesirable to applicants for confidentiality concerns. This would meet the objective of flexibility as set out in the IP5 Offices statement cited above.

In the past, a similar question arose for inventions using software. The insertion of the source code of the software was sometimes used but then it was considered sufficient to disclose the architecture of the software and the sequence of operations in such detail that a programmer could write the source code. In the case of training data for AI, the sufficiency requirement could be considered met if the application discloses the methodologies for the selection of data sources and processing of data which are specifically adapted to enable the skilled person to prepare training data relevant to the objective – following the ancient Chinese saying: "give a man a fish you feed him for a day. Teach a man to fish and you feed him for a lifetime".

Meantime, it is up to the EPO management to enhance the expertise of Examiners in AI technology. As explained above, this is critical for a proper assessment of the disclosure requirement and it is all the more necessary as AI technology has been moving quickly and it is implemented in constantly broadening fields of technology.

5. Training data: GIGO — or "garbage in, garbage out"

The significance of the disclosure requirement of training data for AI emphasised by decision T0161/18 cannot be overstated.

As stated by an AI expert[9], « GIGO — or 'garbage in, garbage out' — has been the programmer's mantra since the dawn of computing, with meaning that computers and systems are only as good as the information that is fed into them.

It's no secret that machine learning methods are highly dependent on the quality of the data they receive as input. If you think of machine learning as a manufacturing process, the higher the quality of the input data, the more likely it is that the final product is of high quality as well. This relationship presents a big challenge to analytics teams when it comes to figuring out the right data for helping to solve business problems. It is necessary for those teams to prepare all datasets to achieve a machine learning process free of errors. This involves setting up quality standards and fixing data issues like missing values or columns with low statistical variance, as well as selecting the right data types, removing duplicate data, and more. Automated machine learning can assist with this.

According to the CrowdFlower survey[10], data preparation and cleaning take roughly 60% of the time of data scientists and analytics professionals. This does not take into account the time needed to first collect and aggregate the required data for the problem at hand. However, data preparation is critical, as the efficacy of machine learning algorithms directly depends on the quality of the inputs as well as their relevance to the use case."

Other AI experts tellingly depict training data as "the Achilles' heel of AI"[11] or "the lifeblood of AI"[12].

Conclusion

Decision T0161/18 deserves great attention from practitioners as the Board has raised of its own motion the requirement of Article 83 EPC for the lack of disclosure of training data in an AI case. Future decisions will no doubt provide guidance as to how satisfy this requirement, a prominent issue in AI cases given the criticality of training data for the efficient operation of an AI tool and it can be expected that future revisions of the Guidelines will incorporate insights on this issue.

9 ODSC Open Data Source October 24, 2019 Garbage In, Garbage Out : Automated Machine Learning Begins with Quality Data at https://medium.com/@ODSC/garbage-in-garbage-out-automated-machine-learning-begins-with-quality-data-70471cb33748

10 https://visit.figure-eight.com/rs/416-ZBE-142/images/ CrowdFlower_DataScienceReport.pdf

11 Schmelzer, R. The Achilles' heel of AI, March 7, 2019 at https://www.forbes.com/sites/cognitiveworld/2019/03/07/the-achilles-heel-of-ai/#273c53927be7. The author provides a detailed analysis of the tasks involved in the preparation of training data.

12 Menendez, C. Data is the lifeblood of AI, but how do you collect it? Infoworld August 8, 2018 at https://www.infoworld.com/article/3296044/data-is-the-lifeblood-of-ai-but-how-do-you-collect-it.html.

PhD thesis review

The Lawfulness of Using Competitors' Trade Marks in Keyword Advertising

N. van der Laan, Legal Advisor **epi** Secretariat

Introduction by Francis Leyder, epi President

When Nicole joined **epi** as our first Legal Advisor, I was chairing the EPPC, and started cooperating with her for the committee I was chairing. Then I learned that her story was the same as mine: she had pretty much done her PhD thesis but needed to write it (for me, it was the practical work finalised just before my military service). Since then, I have been encouraging Nicole to finish, because I know how hard it is when you have a new job (and a family). I was so sad that the sanitary situation prevented me from attending and congratulating her in person, as I had promised. In the Netherlands, PhD candidates defend their dissertations during a traditional public ceremony, called promotion. Luckily, the defence was organised in mixed mode, with three members of the Doctoral Examination Committee and one of her promoters attending remotely, and the ceremony was transmitted on YouTube. As I watched the defence online (the recording is available), I was surprised to see two persons sitting on either side of Nicole, with no apparent role. Later, she explained that these were the paranymphs, in this case her sister and brother-in-law. I researched a little, and found the explanation: the word paranymph comes from Greek, literally 'person beside the bride'; using paranymphs during a PhD defence is a typical Dutch ceremonial tradition. Then, I also found out that in some Dutch universities it is a tradition to give to the attendees (who usually attend out of sympathy rather than for the topic) a booklet explaining the thesis in language accessible to lay persons. This was the idea for an article. I thank Nicole for having accepted to draft it, and the Editorial Committee for having accepted to publish it; we know that many of our members are also trade mark practitioners. I hope your will enjoy reading it.

Introduction by the Author

As mentioned by our President, when I joined **epi** in 2012 as Legal Advisor, I was trying to finish my PhD thesis on "The Use of Trade Marks in Keyword Advertising". I had performed my research at the Max Planck Institute for Intellectual Property and Competition Law (MPI) in Munich. At that time, keyword advertising was one of the most controversial issues in IP law and still a rather new phenomenon.

Now, many years later, the topic of keyword advertising is still highly relevant. In fact, its importance has recently grown. The principles developed with regard to search engine advertising are currently being applied by courts with respect to online market places. An example of such a court case will be provided below.

What is Keyword Advertising?

Keyword advertising is a commercially successful online business model. The most familiar example is "Google Ads". Through an online procedure, advertisers can select keywords that are relevant to their product. If a search query by an Internet user matches the selected keyword, the advertisement appears. The search engine (usually Google) receives a payment from the advertiser for each click on the ad.

This context-sensitive form of advertising enables advertisers to target a specific group of consumers. By choosing the trade mark of a competitor as a keyword, an advertiser can attract the attention of consumers with an interest in that mark.

Nicole with paranymphs during PhD defence

Relevance

The use of trade marks in keyword advertising touches the interests of advertisers, search engines, trade mark owners, consumers and the public interest. It involves a substantial number of policy concerns and fundamental rights, such as the freedom of competition, the freedom of expression and information, fairness of market behaviour, promotion of e-commerce, protection of intellectual property and consumer protection.

Applying trade marks as internal, invisible keywords differs from the classical use of trade marks on products, on packaging or in conventional advertising. The existing trade mark laws had not anticipated this kind of trade mark use. It was unclear whether European trade mark law was applicable at all with regard to keyword advertising and, if yes, how the infringement criteria were to be interpreted in this respect.

The main question in the discussion on keyword advertising has been whether, and to what extent, trade mark law should prohibit or allow the use of competitors' trade marks as keywords. This has given rise to a more fundamental discussion on the scope of trade mark protection.

The Case *Google v. Louis Vuitton*

Keyword advertising became widely known among IP experts at the latest by 2010, when the CJEU rendered its famous judgment in the case *Google v. Louis Vuitton*.[1] The case was referred by the French Supreme Court (Cour de cassation) in a dispute between Google, on the one side, and Louis Vuitton and other trade mark owners, on the other side. Imitators of Louis Vuitton products had chosen Louis Vuitton trade marks as keywords. The trade marks of the other trade mark owners had been selected as keywords by competitors.

The Cour de cassation basically asked whether the trade mark owners were entitled to prohibit the search engine from selling the keywords and the advertisers from buying the keywords. The relevant legal provisions to be interpreted concerned the infringement provisions of Article 5 Trade Mark Directive (now: Article 10) and Article 9 Community Trade Mark Regulation (now: EU Trade Mark Regulation). A further relevant provision regarding Google's liability was Article 14 of the E-Commerce Directive, which exempts hosting providers under certain circumstances from liability.

In *Google v. Louis Vuitton*, the CJEU clarified that the use of trade mark keywords by advertisers falls within the meaning of the harmonised infringement provisions of the Trade Mark Directive, thus avoiding fragmented approaches under national unfair competition laws. The

1 ECLI:EU:C:2010:159 (CJEU case C-236-238/08 Mar 23, 2010).

CJEU also clarified that the use of competitors' trade marks as keywords is, under certain conditions, allowed. Decisive is mainly whether the text of the ad is sufficiently transparent for the Internet user to determine whether the advertised products originate from the trade mark owner or from a third party. The CJEU left it to the national courts to assess this issue based on the particular facts of the case.

The CJEU did not regard the use of the trade mark keywords by Google as being relevant under trade mark law. Since Google does not use the marks in its own commercial communication, the CJEU suggested to rather assess Google's role under national rules on liability of intermediaries in conjunction with the liability exemptions in the E-Commerce Directive. In this regard, the CJEU ruled that the hosting exemption only applies to intermediary service providers with a neutral role, which needs to be assessed by the national courts.

Further Case Law

In a number of further referrals,[2] the CJEU elaborated its guidance provided in *Google v. Louis Vuitton*. In these cases, the CJEU confirmed its earlier findings while providing more detailed considerations for specific circumstances. These decisions also shed light on the scope of protection of the advertising and investment functions of a trade mark in keyword advertising cases. In this regard, the CJEU explicitly gave weight to the interest of competition, which is served by offering alternatives to consumers.

The principles developed by the CJEU were then applied by the national courts of the EU Member States in a vast number of cases. In my dissertation, case law from the Netherlands, Germany, the UK, France and Austria is analysed. In addition, a comparison with keyword advertising decisions from the US is made.

The analysis of national jurisprudence demonstrates a certain level of conformity among the national courts in the interpretation of the CJEU's guidance. Divergences remain to some extent inevitable due the particular circumstances of each case before the national court. However, certain national courts have wrongly interpreted the CJEU guidance with negative consequences in terms of legal certainty, free movement, competition, consumer information, e-commerce and freedom of expression.

The Cases *Ortlieb v. Amazon*

As mentioned above, the principles developed in the keyword advertising cases have proven to reach beyond their original context, for example, in cases regarding the use of keywords to generate product listings on online market places, such as eBay or Amazon.

The German BGH (Bundesgerichtshof = Federal Supreme Court) recently applied the lessons learnt from the keyword advertising jurisprudence in disputes between the owner of the trade mark "Ortlieb" (for bicycle bags) and the online marketplace Amazon.

In *Ortlieb I*,[3] a search on Amazon for the trade mark in question resulted in offers for the products of the trade mark owner and products of competitors. The trade mark owner did not itself sell its products through Amazon. The Court of Appeal had decided in favour of the trade mark owner, but the BGH reversed and remanded the case. An adverse effect on the origin function had not been established. The BGH explicitly declared the principles regarding keyword advertising to be applicable with respect to the use made of the trade mark by Amazon to generate product listings. Hence, the decisive factor was whether it was impossible or difficult for an average Internet user to know whether the advertised products originated from the trade mark owner or from a third party.

The case *Ortlieb II*[4] concerned ads by Amazon on the Google website with links to listings of products on the Amazon website. Besides offers of Ortlieb bicycle bags, offers of bicycle bags from other brands were shown in the linked results list. The BGH confirmed the Court of Appeal's finding of infringement due to the specific design of the ads in conjunction with the mixed list of results. The origin function of the trade mark was adversely affected because the relevant public expected to only be shown offers from Ortlieb when clicking on the ads.

Main Findings

Based on an analysis of years of literature and jurisprudence in this area, the dissertation reveals the considerable impact of the keyword advertising judgments on the infringement conditions under European trade mark law. The CJEU has moved from a rigid interpretation of

2 See *Bergspechte v. trekking.at*, ECLI:EU:C:2010:163 (CJEU case C-278/08 Mar 25, 2010); *Eis.de* v. BBY, ECLI:EU:C:2010:174 (CJEU case C-91/09 Mar 26, 2010); *Portakabin v. Primakabin*, ECLI:EU:C:2010:416 (CJEU case C-558/08 July 8, 2010); *L'Oréal v. eBay*, ECLI:EU:C:2011:474 (CJEU case C-324/09 July 12, 2011); and *Interflora v. M&S*, ECLI:EU:C:2011:604 (CJEU case C-323/09 Sep 22, 2011). The case *Wintersteiger v. Products* 4U, ECLI:EU:C:2012:220 (CJEU case C 523/10 Apr 19, 2012) did not concern the infringement criteria but the jurisdiction of a national court for a trade mark infringement on a foreign website, according to Art 5(3) (now: Art 7(2)) Brussels I Regulation.

3 [2018] GRUR 924 (BGH Feb 15, 2018).
4 [2019] GRUR 1053 (BGH July 25, 2019).

the infringement provisions towards a flexible weighing of interests of the trade mark owner, third parties and the public at large.

The CJEU's interpretation of the infringement criteria in keyword advertising disputes is endorsed in the dissertation. The CJEU does not regard the use of another's trade mark as a keyword as an infringement *per se*. The focus on the need for transparency in online advertising reflects a balance between adequate trade mark protection and other important policy aims such as competition and consumer information. The leeway left to the national courts enables a thorough examination of the circumstances of each case.

Despite the advantages of this approach, the CJEU's focus on the trade mark functions is criticised. It is argued that this lacks a foundation in European trade mark legislation, results in an inconsistent system of infringement criteria, and that it is detrimental to legal certainty. A number of solutions are proposed to address these problems. The most feasible solution is to expand the scope of the limitations. In fact, owing to the reform of the European trade mark system, this expansion has already begun. A broader catalogue of limitations, possibly including a general fair use clause, would render the CJEU's functional approach redundant.

Besides legislative proposals, suggestions are provided for a more precise interpretation of the CJEU's guidance under the current law in order to avoid diverging national court decisions and to enhance legal certainty. In general, the absence of the disputed trade mark in the advertisement itself and the mentioning of the advertiser's own identity should be sufficient to deny an infringement. In any case, the interests of competition and consumer information must be taken into consideration.

Conclusion

Keyword advertising remains an important topic. Search engine advertising is still of considerable and increasing commercial relevance. In addition, as seen above, the principles developed in this regard are nowadays being applied beyond the context of search engines with respect to other online business models in which trade marks are used as navigation tools. Furthermore, the case law on keyword advertising has had an immense effect on trade mark infringement law in general.

If you are interested in this topic, please consult my dissertation, which can be freely accessed on the Research Portal of the Vrije Universiteit Amsterdam (https://research.vu.nl/en/publications/the-use-of-trade-marks-in-keyword-advertising).

Educational Events

Webinars in 2021

In the beginning of 2021, **epi** continues with offering webinars free of charge to all members and students. The registration for each webinar will be made available as soon as the dates are confirmed. All members receive the concrete schedule by email.

The webinars are dealing with the following topics:

Collaboration with oversea patent attorneys (4 sessions)

In the practice of a patent attorney, it is important to cooperate with colleagues in other countries. Whereas European patent attorneys are generally most knowledgeable about the European and perhaps the national patent systems, it is necessary for them to have some knowledge of the practice in countries in which their clients also want to obtain patent protection. Further, overseas colleagues may have clients that want to obtain European patents, for which these overseas colleagues use European patent attorneys to act as a local patent agent.

In these four webinars the speakers will highlight the major differences between the foreign and the European practice, the major communication problems and they will provide you with advice how to best contact and work with foreign patent professionals from countries like China, India, Brazil and the USA.

IP Commercialization (three sessions)

In March **epi** members can expect three webinars on IP Commercialization conducted by Tony Tangena.

Intellectual Property (IP) needs to create value
In this webinar we will discuss how global changes in the last 30 years affected the way companies deal with IP. Some topics: Fourth industrial revolution; Is Europe still innovative? Why should companies bother with IP; How to create value from IP; the Intellectual economy with its open innovation and public-private cooperation. What is the role of the patent attorney? Also, some examples of how industries deal with IP will be discussed.

IP strategy
In this webinar we will discuss a short summary of session 1 focused on the intellectual economy and then explain what this means for an IP Strategy: Different ways of using IP; Value creation models; How to choose and implement an IP strategy; Value based IP management; What strategic choices to make and what about IP for SMEs?

Patent valuation
The last webinar deals with valuation of IP: Why is it important to know the value of IP? Patent valuation models: Costs, Market, Income. We will discuss an example how to value a patent.

Committee Reports

Report of the By-Laws Committee

P. Moutard (FR), Chair

Since the C 88 Council meeting, one BLC meeting took place on 21 October 2020. The Chairman of the BLC participated (via the video-conferencing system) to the Board meetings of 21 July 2020 (B111), 16 September (B112) and 27 October 2020 (B113).

The following topics were discussed by the BLC during the meeting of 21 October 2020:

- the Re-design of the **epi** Collection of Decisions;
- the BLC presentation about "rights and duties of Council members" for C89 ;
- the proposal of the Internal Auditors to amend Art. 16.3 of the By-Laws (BL);
- the proposal to amend Art.10C BL and Art.4 BL (at C87 Lisbon the adoption of these proposals was postponed);
- the **epi** Strategic Plan.

Due to lack of time several topics were postponed to a next BLC meeting: possible amendments of the Terms of Reference of the PEC, of Article 5.2 BL (to include the case of voluntary resignations), and of Article 18B.4 d).

The next BLC meeting should take place at the beginning of December 2020.

Pascal Moutard

I. The Re-design of the epi Collection of Decisions

This work has made substantial progress, due to the involvement of Vernessa Pröll and Amparo Coll.

2 BLC members, Günther Schmalz and Paolo Gerli are now also working on this project, which should be ready for a presentation at C 90.

II. Presentation about "rights and duties of Council members" during C89

This topic had been postponed several times because of other pending issues and because of the time spent at the beginning of this year on other topics in connection with the Covid crisis and the organization of the spring e-Council meeting (C88).

A presentation was made during interruptions of the election session of C89. Key aspects related to the Council were thus presented to the Council members, concerning the right and duties of Council members, but also the conduct of Council meetings and the voting and the election rules during **epi** Council meetings.

III. The proposal of the internal auditors to amend Art. 16.3 BL

This proposal was discussed during the BLC meeting of 21 October 2020 and the BLC first came to the conclusion that it was preferable to keep in art.16.3 BL a reference to the "amended budget".

A further discussion took place on 29 October 2020 with the Internal Auditors and the Treasurer.

Finally, the BLC agreed with the auditors' proposal.

IV. The proposal to amend Art.10C BL and Art.4 BL

The BLC had presented a proposal at C87 (Lisbon) to amend these articles.

This topic was reconsidered by the BLC on October 21 and it seems that further discussions are needed with the reporting group to find an acceptable solution.

V. The epi strategic plan

The BLC has agreed to discuss possible strategic issues for the future of the **epi**, not only limited to the By-Laws or the Collection of Decision.

Report of the Professional Conduct Committee

G. Checcacci (IT), Chair

The main activities of PCC in the latest months can be summarized as follows.

1) The usual activity of issuing advices to **epi** members under art. 7(d) of the Code of Conduct has not been very intense: few requests have been received, and none of them required special study by a Chamber of PCC. In practice, the Chair and the Secretariat had simply to direct the requesters to other more appropriate entities (EPO, national offices).

Giorgio Checcacci

2) The WG working on a proposal to amend the Code of Conduct has continued and almost completed its work. After the Council meeting C88, inspired by the elections of the Board members, the WG included in the proposal an article dealing with the conduct of candidates at **epi** elections.

3) The WG assisting the President has continued to operate.

4) The whole committee had its annual meeting on 21 September 2020, by videoconference. Due to (or rather: thanks to) this special form, also all substitutes were invited and many indeed attended and actively contributed to the discussions. This practice will be maintained for future meetings, particularly if held by videoconference.

At the meeting, the proposal of the WG (item 2 above) was examined and partially approved: for an article (art. 5(d): transfer of files), the WG was requested to amend the proposal. This was done in a meeting of the WG on 9 November 2020. Since the proposal of the WG was still

to be completed, it could not be presented for decision to the Council meeting C89. Nevertheless, the proposal was enclosed **for information** of all Council members; it will be presented for approval at a next Council meeting, including art. 5(d) as well.

PCC also discussed plans for activities of the next PCC, deciding that PCC should focus more on improving awareness of the Code of Conduct among **epi** members; this is reflected in the plan for PCC for the next term, that is also reproduced below.

Plan for the term 2020-2023

PCC, concluding its term 2017-2020, leaves new PCC some suggestions for the future activities; these suggestions are summarized in this plan. Of course, it will be responsibility of the new PCC to follow this plan, or to amend it.

The suggestions derive from the basic consideration that the main target of PCC should always be that of improving the professional conduct of all **epi** members.

Thus, PCC should pursue the following activities, with the involvement and collaboration of other committees as appropriate:

1 Current activities, to be continued:
   a. issuing advices under Art. 7(d) CoC – responsible: Chambers
   b. assisting the President, Presidium and Board in disciplinary matters – responsible: *ad hoc* Working Group
   c. revising the Code of Conduct – responsible: *ad hoc* Working Group
   d. finalizing the adoption of the amended Regulation on Discipline in preparation for UPC (as decided at C85, decisions 8 and 9) - responsible: Chair

2 New activities:
   a. publish the content of advices given under art. 7(d) CoC, in anonymised form – responsible: *ad hoc* Working Group
   b. define training and information initiatives to spread a better awareness of the provisions of the Code of Conduct – responsible: *ad hoc* Working Group

Report of the Nominations Committee

C. Quintelier (BE), Outgoing Chair

The Nominations Committee has sent an e-mail to all **epi** members in order to invite those who are interested to work in a committee to nominate themselves, thereby using the tools made available on the **epi** website. Early September 2020 a reminder has been sent to all **epi** members in order to draw their attention on the time limit to enrol.

As for some committees there were fewer candidates than the number of electable members, the nominations procedure was reopened. In order to make clear when the time period would expire for this re-opening phase, the **epi** Secretariat had put the time limit on the website in order to clearly inform the members of the time limit.

Since the 2017 committee election, the Rules for elections of committee members in Council have changed, in particular Rules 3.3.4 and 3.3.5 came into force. We have noted some problems with the application of those new Rules, as well for what concerns their application by the **epi** members, as for the surcharge of work it caused at the **epi** Secretariat. The mere fact that the spring Council meeting was delayed due to the Corona pandemic, already caused a delay in making the nomination form available on the **epi** website. We also noted that some nominations did not comprise a CV of the candidate, which on its turn imposed additional work on the **epi** Secretariat to request the candidate to supply a CV. We would like to use this opportunity to draw the attention of all **epi** members on the importance of providing a CV and of completing the questionnaire made available on the website. The CV and the answers to the questions in the questionnaire are there for providing information to the Council members, who have to vote. In view of the fact that today there are 38 EPC Contracting States it is impossible for the Council members to know all the candidates. Therefore the CV and the questionnaire are there for helping the Council members with their choice for whom to vote.

Also the time limit mentioned in 3.3.4 on the one hand and the time limit mentioned in 3.3.5 on the other was confusing form some members.

The **epi** Secretariat and the Nominations Committee have taken note of the different problems and we will investigate this further and consult with the By Laws Committee on how the situation can be improved for the next election.

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

Newly elected Committee members

The Biotech Committee members for term 2020-2023 were elected ad the last Council meeting: https://patentepi.org/r/info-2004-02. We also have many associate members who actively help us with biotech **epi** advice.

Patentability of plants and animals – G 3/19

Opinion **G3/19** dated 14 May 2020[1] has a high impact and is being commented on by many **epi** members and legal practitioners in the life sciences area.

Ann De Clercq

epi Biotech Committee discussed the impact of this opinion in its last digital committee meeting of 26 August 2020 as well as that of 12 October 2020 and will continue to do so.

The CPL52 (Committee on Patent Law) meeting on 10-11 November 2020 was attended by Ann De Clercq as well as the **epi** President Francis Leyder and Vice-President Heike Vogelsang-Wenke.

The EPO explained that **G3/19** was held to:

- Confirm the law and practice followed by the EPO
- Safeguard the uniform application of harmonised European patent law
- Reaffirm the power of the AC of the EPO to clarify questions of patentability

The EPO has implemented Opinion G 3/19 in its examination and opposition practice. Stays have been lifted. A revised draft of the relevant parts of the GLs for Examination has been prepared.

Exclusions according to R. 28(2)

The EPO confirmed that no EP patents can be granted for conventional plants/animals for applications filed on or after July 2017 and claiming no valid earlier priority date. The exclusion covers plants, plants reproductive material (incl. cells) and animals.

Technically-induced mutated plants

The EPO confirmed that technically-induced mutant plants (both via targeted and random mutagenesis causing modifications in the genome of a plant) are patentable. Patents related to such plants need a disclaimer to exclude the scope of the same plant obtained by a non-technical process

Mandatory disclaimers

The EPO clarified their position on disclaimers: they are required in all cases in which a feature of a claimed plant can be the result of both a technical intervention and an essentially biological process (EBP). The disclaimer requirement is set out in the Guidelines for Examination and is strictly enforced in the EPO's practice since implementation of Rule 28(2) EPC in 2017 (about 20 grants and 30 refusals).

Non-retroactivity of R. 28(2) – status of affected cases

According to Opinion G 3/19, Rule 28(2) EPC cannot be applied to applications filed or claiming priority before 1 July 2017 as well as European patents granted before that date.

About 310 examination and 10 opposition cases are affected. Proceedings are gradually being resumed. Application or patent at issue to be examined for compliance with all EPC requirements.

About 18 cases are pending before the Boards of Appeal. 2 cases already remitted to the examining division; in a number of further cases Board has expressed intention to remit the case.

Impact of G3/19 for granted EP patents

The EPO confirmed that a European patent confers on its proprietor the same rights as a national patent, subject only to formal validation (payment of national renewal fees and translation of the full or of the claims of the European patent if required). A European patent may be

1 https://patentepi.org/r/info-2004-03

revoked with effect for a Contracting State only on the grounds stipulated in the EPC.

The EPO also conveyed that the effect of a decision or opinion of the Enlarged Board of Appeal on the interpretation of the EPC by the authority or court of a Contracting State is subject to the law and practice of that State.

What is next?

The EPO submits that G 3/19 brings legal certainty and provides a sound basis for the EPO's practice concerning plant-and animal-related inventions. The Contracting States will be regularly informed by the EPO about the implementation of Opinion G 3/19 and the EPO's practice in this field.

The EPO is mindful of the ethical and economical implications of the issue and is continuing discussions with stakeholders, incl. NGOs.

In the following discussion at the CPL52 meeting national delegations and observers (such as **epi** and Business Europe) took the floor, all announced that they thanked the EPO for all their work. Discussion items were mainly related to random mutagenesis, mandatory disclaimers, ethical debates on plant patentability and potentially upcoming national courts or other decisions.

The **epi** Biotech Committee agrees in general with the overview given by the EPO but does have concerns and comments and a further discussion within the **epi** Biotech Committee on these points will take place.

Future discussions in other circles with respect to disclaimers, random mutagenesis, propagation material and animal patentability will also be followed by the **epi** Biotech Committee and commented on where needed. It is clear that the discussion on these topics will continue for a while.

These disclaimers might be the subject of future EBA or CJEU referrals and the Biotech Committee will follow up and discuss these developments closely.

Updated Guidelines for Examination Biotech 2021

Extensive amendments to parts F and G of the GLs relating to biotech inventions were proposed by the EPO to **epi** for discussion in several rounds. The topics mainly relate to:

- Plant biotech: G3/19 and disclaimers (amendments in existing parts and new paragraphs)
- Antibodies (NEW)
- Exclusions (stem cells) (amendments in existing parts)
- Homology, similarity, identity of genes and protein sequences (NEW)

We will keep on providing comments and information as the biotech parts are largely in review and new parts are being introduced in the new Guidelines that will come out in 2021.

These amendments to the Guidelines will imply also educating practitioners all over the world to learn what the norms of the EPO will include so that applications can be drafted to take account of these new Guidelines. We welcome that biotech examination practices of the EPO are clarified in the Guidelines for Examination.

Updating national biotech law overviews

epi Biotech Committee is updating its overviews on plant patentability, patentability of gene sequences and other matters and will provide them in one of the next **epi** Information editions.

Other points discussed

The Biotech Committee discussed the EC roadmap document and provided suggestions to Presidium.

A contribution to the **epi** strategic plan was forwarded to the **epi** Council and Presidium.

epi Biotech Committee will also look into patent disclosure requirements for Genetic Resources and Traditional Knowledge and will look into WIPO Standard ST.26 for Sequence Listings.

Meetings attended and to be scheduled

Topics were passed to EPPC for a new meeting with DG1 concerning biotech and other life sciences topics. Dates are being planned for beginning 2021 with EPO and with the EPPC thematic groups and Biotech Committee. These meeting are very informative and constructive for both sides.

The **epi** inaugural Biotech Committee meeting will take place on 7 December 2020 and other (ad hoc) digital meetings will be planned to meet with our new members and all our associate members in function of other upcoming meetings and additional topic discussions within the Biotech Committee.

Report of the Harmonisation Committee

J. Brown (GB), Chair

The inaugural meeting of the newly elected **epi** Harmonisation Committee was held by Zoom on Thursday, 19 November 2020.

All the newly elected members of the committee were present, namely Veronica Zemanova (CZ), Gabriele Leissler-Gerstl (DE), Ulrich Weingarten (DE), Luis-Alfonso Durán Moya (ES), Veli-Matti Kärkkäinen (FI), John Brown (GB), Catherine Hanratty (IE), Dermot Roche (IE), Filippo Santi (IT) and Magdalena Krekora (PL). Also in attendance were Heike Vogelsang-Wenke (DE) (**epi** Vice President), Nicole van der Laan (**epi** Legal Adviser) and Sadia Liebig (**epi** Secretariat).

John Brown (GB) was re-elected as Chairman of the committee and Filippo Santi (IT) was re-elected as the Secretary. After all the attendees had introduced themselves,

Representation of **epi** at the meeting of the Standing Committee on the law of patents ("SCP") at WIPO on 7th, 8th, 9th and 10th December 2020 was discussed. John Brown explained that, as far as we are concerned as an NGO, the SCP meeting would be a virtual one. The meetings of SCP are available on line via the WIPO website to anyone interested – registration is not necessary for this. **epi** can have two registered delegates to "attend" for each day. After discussion, it was agreed to ask Francis Leyder, **epi** President to nominate himself, John Brown, Guiseppe Colucci (member of the **epi** Litigation Committee), Luis Alfonso Duran Moya, Filippo Santi and Catherine as the **epi** delegates, with the intention that two delegates would "attend" each session (which days subject to the draft timetable of order of business which is not yet available).

There was a discussion of Substantive Patent Law Harmonisation ("SPLH"), many directed to the slides presented by Sylvie Strobel to the meeting held on 11th November 2020 of the EPO Committee on Patent Law and to the IT3 "Elements Paper" Proposal. It was difficult to have a meaningful discussion because the IT3 proposal is embargoed. As soon as the embargo is lifted, circulation to the committee will be arranged, followed fairly swiftly by the calling of a meeting of the committee.

Report of the Online Communications Committee

Y. Biron (FR), Secretary

1. Introduction

The EPO had to react with short term measures to the Covid 19 crisis starting in April 2020 and has set-up a plan for more mid- to long-term measures, involving internal and external evolutions, including changes to the legal framework. During the past months, OCC and EPO focus has been mainly on evolving towards **video conferencing in oral procedures**. Other major activities relate to the ongoing **Online Filing 2.0** pilot projects (incl. DOCX filing format) and the **Front Office working group**, focusing on national filings via EPO centralized systems.

2. Video conference for oral proceedings

During our latest EPO-OCC meeting, held on 3rd November 2020, the EPO reported **1500 examination video conferences had already been held since the beginning of the health crisis** (only two conferences could not be completed). 7000 are already planned in the next 12 months. 28 opposition video conferences have been held so far through Zoom, with better results than what was initially experienced – during test cases – with Skype for Business.

According to the EPO, Zoom was attractive for many reasons, but it took time to resolve well-known legal and security concerns, with updates of Zoom. Also, EPO building rooms are currently equipped with Skype for Business equipment, and nothing else, but the EPO recognizes the superiority of the Zoom platform in terms of experience. Examiners are still to be trained on the new platform (and they are far greater in number than Opposition Divisions). **No timing was communicated by the EPO on officially switching to Zoom** vs. Skype for Business but notes the user community's favourable opinion of Zoom. Zoom continues to evolve. End-to-end encryption (in beta) makes it very secure, but blocks some features needed for oral proceedings.

The OCC is also aware of limitations imposed by the employers of some epi Members restricting access to third-party videoconferencing software. We have drawn this to the attention of the EPO. In some cases this can be addressed using the web browser extension provided for the software rather than a full installation, but this is a potential issue that the affected epi Members should be aware of, irrespective of which solution the EPO ultimately settles on.

EPO notice dated 10th November 2020 specifies that the agreement of the parties to hold oral proceedings in opposition proceedings by videoconference will no longer be required. **Video conferences will therefore become the norm**, for all oral proceedings that are scheduled to take place on or after 4 January 2021, until 15 September 2021.

3. "Online Filing 2.0" Pilot (CMS replacement)

"Online Filing 2.0" Pilot Phase I started in May 2020 focused on the filing stage. **Pilot Phase II is about to start**, and the EPO really wants greater volume of feedback.

OCC members had direct experience of the pilot, which had been disappointing e.g. the first release maturity level was extremely low, smart card issues made testing the system very painful, the address book system showed serious flaws. The EPO recently encouraged all pilot users to test the system again, confirming new versions have been released, addressing many issues raised in the initial user feedback.

Pilot Phase II targets new steps in the prosecution process (post-filing) but still allows testing of the initially targeted filing stages. Phase II scope still includes Phase I stages.

The OCC asked the EPO that **the future system and CMS should co-exist for some time**, at least in the early stage, to allow previous settings to be adapted to the new system.

The EPO did not commit to this. The OCC considers 2 years a good guideline for any "sunset" period. CMS has its problems, but it had become more important for many users, during the lockdown.

The EPO confirmed that CMS is the only system officially considered as being decommissioned.

4. DOCX filing

Although a majority of the epi community expects benefits from the evolution towards DOCX filing (moving away from PDF conversion especially), some members, supported by the OCC, believe **important technical and legal issues must be addressed** on the topic. Specific meetings with the EPO will be organized in the coming months to address those issue.

No progress has been reported by the EPO on the possibility to file colour or 3D drawings, which was previously shared through this journal.

5. Existing online filing e-OLF (Front Office WG)

The EPO reports being ahead of schedule with its IT Cooperation Front Office project, thanks to very active group members, including national office experts and Ben Grau from epi. The purpose of the project is handling national filings via a common platform, **replacing eOLF in the long term**, at least for national filings. There are no plans to decommission eOLF for the time being.

Yannick Biron

The EPO has recently released a Proof Of Concept (POC), accessible to working group members only, demonstrating future technical features, which the OCC had the opportunity to review.

Noticeably, EPO systems will generate endpoints allowing connecting B2B APIs, i.e. automated exchanges between the EPO and IP Management Systems from the user community. The OCC offered to encourage contacts with software companies producing case management software.

6. Fax filing and alternatives

No change has been implemented by the EPO in recent months regarding fax filing.

One complementary solution, would be to allow **email filing** as an additional option. Email is under trial in

relation to cases having oral proceedings. The EPO did not clarify whether the solution would be extended.

Email flexibility is appreciated. However, origin of the email, confirmation of receipt, etc. are key issues to be resolved, even in exceptional situations. The pilot is expected to last about 12 months.

For the time being, OCC believes fax remains a simple and efficient solution, but additional methods such as email would be good to have.

7. Authentication (Smart Card)

An "Identity and Access Management" project has recently been launched at the EPO to investigate an alternative to the Smart Card solution. The EPO hopes that the project will provide results within the next 12 months.

Smart Card will still be supported by the EPO in the short term. The OCC informed the EPO that rather than a replacement, the solution should instead offer users an alternative to the Smart Card solution, which is appreciated by some users. The OCC also reported that the WIPO authentication system could be considered as a possible alternative.

8. Mailbox

According to the EPO, **938 organizations (5106 active users) currently use the Mailbox**. Already 950777 mail items were exchanged in 2020.

Approximately 1000 different types of communications (forms) are sent out to users by the EPO. 750 will be available through the Mailbox by December 2020, incl. 70 communications relating to opposition proceedings. Other forms are planned to be integrated in the future (150 planned; Appeal forms also). 100 more complex ones are going to be looked at on a case-by-case basis in the near future. These are roughly 50:50 EPC and PCT procedures. The EPO will publish a list of forms not available through the Mailbox (blacklist vs. whitelist for available forms).

Integrating the Mailbox with regular user mailboxes (Outlook, etc.) is under investigation. "Push" notifications are already foreseen in the next 12 months, i.e. if an email is received in the Mailbox, users would be able to configure being notified by standard email.

9. Digital Signatures

The EPO legal team is reviewing current practice in the field of digital signatures, to analyse whether accepting such electronic signatures on assignments (Art. 72 EPC) would be acceptable for the EPO. No clear agenda could be shared with the OCC.

Regarding all other documents requiring or bearing signatures, the EPO believes that the principle of free evaluation of evidence should apply (such approach not being applicable to assignments since Art. 72 EPC details the applicable rule with assignments). National law could serve as a basis for analysis, if required.

While the OCC mentioned that more and more applicants have stopped physically signing documents, the EPO informed the OCC that the current framework does not provide any easy answer, mostly because it seems difficult to identify what is an acceptable electronic signature (international and European guidelines not being practically useful according to the Office).

The OCC reminded the EPO that facsimile copies might also raise authentication issues, but the EPO does not have any objection to those.

10. Third-Party Observations filing platform

The OCC recently shared with the the EPO some epi members' feedback on the third-party observations filing platform, which has been in "pilot" since 2011. Big changes may not be implemented immediately, but some easier changes like increasing the current 6MB upload limit may be doable soon.

11. eDREX

No specific progress has been reported by the EPO to the OCC on further developments of eDREX, since our previous report.

12. Patent Information Systems (Register Alerts)

According to the EPO, register alerts and similar topics could progressively migrate towards the New User Area project, currently being set up by the Office.

Current download restrictions on the Register are linked to hoax attacks suffered by the EPO over the last number of months. Loss of service occurred due to specific robot activities. A mitigation policy is currently under discussion within the EPO and will be shared with the user community once approved.

13. New Online User Engagement Programme

The EPO's objective with its New Online User Engagement Programme is to improve online services provided by the EPO, helping professionals to get their job done.

The Programme key projects are listed below:

- **New EPO.org** website, including new access to legal texts, expected to lead to a new website by 2022 (mobile access being a key area of improvement)
- **New User Area**, focusing on a dedicated access for registered users, including future versions of MyFiles and Mailbox (user permission is a key aspect of the project) – epi members and their paralegal staff are encouraged to volunteer for the dedicated Focus Group[1].
- **New Electronic Filing**, focusing on technical interfaces with the user community IP Management Systems (first B2B interfaces expected by Q4 2022, according to EPO slides presented to the OCC)

14. Outages & legal certainty under Rule 134 EPC

Information on outages has been and will continue to be improved by the EPO, including possible legal remedies, when applicable. Time stamps and outage references will soon allow reference to a specific outage in case of any legal consequence.

1 https://patentepi.org/r/info-2004-04

Live updates on EPO IT systems are now available directly from the EPO website home page. The EPO recently informed the OCC that the section will keep being improved in the near future.

Grant publication dates plus 3-months (relevant for national validations) will now be avoided by the EPO whenever possible for any planned outage.

Importantly, the EPO plans a **4-day outage to perform critical maintenance on its servers, provisionally planned to last from 27th December 7am until 31st December 7am**. The finally decided timing will be communicated by the EPO before the outage.

The EPO register will not be available (EPO.org will be available on these days but static). CMS and eOLF have already been migrated to a new data centre, and so would remain available.

15. Interacting with the OCC

While Council has now elected OCC members for the next term, all epi members are encouraged to report any issues they face with EPO IT systems, submit any improvement suggestion, or provide any comment they would have on OCC-related topics, directly to the OCC Chair at OCC@patentepi.org.

epi Information is seeking occasional and regular contributors

M. Névant (FR), Chair of the Editorial Committee

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- an overview of changes in the EPO practice and related issues;
- an overview of most relevant Case Law of the Boards of Appeal; and
- an overview of relevant courses and other training opportunities.

In addition, perhaps you have been directly or indirectly involved in an interesting Opposition Proceedings or Appeal before the EPO and have a view that might be of particular interest to our readers? Clearly, it would be necessary to indicate in the article that you had a direct or indirect involvement in the case and from which perspective. Information on interesting decisions or activities in your own jurisdictions and which might appeal to a wider audience are also welcome. While there is no fixed rule on the length of an article, 1,000 – 1,500 words are to be preferred.

In some countries, an article published in **epi** Information can contribute towards your Continuing Professional Development requirements. It is suggested that you check locally for details.

Why not eMail us (editorialcommittee@patentepi.org) with your ideas/ contributions?

You never know, a whole new but hidden world of authorship and journalism might be revealed!

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91th Council meeting in November 2021

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In accordance with the decision of **epi** Council C89 on 13 November 2020, the amount for the **epi** annual subscription has been set at 190 EUR for 2021.

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- By bank transfer in Euro (bank charges to be covered by subscriber)
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Einzugsermächtigung

Eingangsfrist im **epi**-Sekretariat:

15. Februar 2021

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (**epi**) wird hiermit ermächtigt, den jeweils gültigen **epi**-Jahresmitgliedsbeitrag für das genannte Mitglied einzuziehen. Der Einzug erfolgt einmalig am 25. Februar des laufenden Jahres von dem nachfolgend anzugebenden Konto beim Europäischen Patentamt (EPA). Die Einzugsermächtigung wird wirksam beginnend mit dem Jahresmitgliedsbetrag 2021 und gilt für künftig fällige Mitgliedsbeiträge bis auf schriftlichen Widerruf.
Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem **epi** getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen werden dem Einzug des **epi**-Beitrags vorgezogen.
Bitte stellen Sie sicher, dass im Abbuchungszeitraum Ihr EPA Konto über eine ausreichende Deckung verfügt.
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☐ **Ich stimme den oben genannten Bestimmungen zu.**

Direct debiting mandate

Deadline for receipt by the

epi Secretariat:

15 February 2021

The Institute of Professional Representatives before the European Patent Office (**epi**) is hereby authorised to debit the **epi** annual subscription for the member named below at the appropriate rate. This direct debit occurs once on 25 February of the current year from the deposit account held with the European Patent Office (EPO) as specified below. This direct debiting mandate applies to the membership fee 2021 and the forthcoming subscriptions until it is revoked in writing.
Debiting will be done on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the **epi** (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

All fees and costs payable to the EPO on the debiting date have priority over the **epi** subscription.
Please be sure that during the period of time surrounding the time of the debit order there are sufficient funds in your EPO account to cover the entire debit order.
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☐ **I agree with the stipulations cited above.**

Autorisation de prélèvement

Date limite de réception au

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15 février 2021

L'Institut des mandataires agréés près l'Office européen des brevets (**epi**) est autorisé par la présente à prélever le montant en vigueur de la cotisation annuelle de l'**epi** pour le membre dont le nom figure ci-dessous. La présente autorisation de prélèvement sur le compte ouvert à l'Office européen des brevets (OEB) prend effet une seule fois le 25 février de l'année en cours. Cette autorisation de prélèvement vaut pour la cotisation 2021 ainsi que pour les cotisations suivantes jusqu'à révocation par écrit.
Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'**epi** (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Le règlement de toutes les taxes et de tous les frais dûs à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle de **l'epi.**
Veuillez vous assurer que votre compte à l'OEB est suffisamment approvisionné pendant la période de débit.
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☐ **J'accepte les conditions mentionnées ci-dessus.**

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