epi®

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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Information

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Cover:
Mobile Phone
This picture painted by
Sven Berg
(European Patent Attorney, SE),
was part of the **epi** Artists
Exhibition 2015 at the EPO, Munich

Sven Berg

Der familiäre Hintergrund mag einen gewissen Einfluss auf Sven Berg gehabt haben, vor allem weil seine Eltern als auch seine Großeltern mütterlicher und väterlicherseits sehr aktive Künstler waren, die ihr Zuhause mit Ölgemälden, Illustrationen, Büchern und Skulpturen gefüllt haben. Während seines Studiums der angewandten Physik zeichnete Sven Cartoons für die örtliche Studentenzeitung, war aber ansonsten fern von jeder künstlerischen Betätigung außer bei den selbstgemachten Geburtstagskarten, die er an seine Freunde verschickt hat. Erst viel später, als er begann für das EPA zu arbeiten, hat er seine künstlerische Ader wieder entdeckt. Seit 1991 nahm er an den jährlichen Kunstausstellungen des EPA in München teil. Ihm fehlt zwar eine formale Ausbildung aber durch die tägliche Beobachtung und das Skizieren, begann die Kunst langsam wieder Gestalt anzunehmen. Seit 2013 ist Sven zurück in Schweden und hat nun endlich einen passenden Platz für ein Studio gefunden, wo er gleichzeitig malen und all seine patentrechtlichen Arbeiten erledigen kann.

The family background may have some influence on Sven Berg, mainly because the parents as well as the grandparents on both sides were active artists, who filled the home with oil paintings, illustrations, books and sculptures. While at the university, with applied physics as path, Sven made cartoons for the local student paper, but otherwise kept away from art, except for the handmade birthday greetings cards that he spread to friends. Only later, as he had begun working for the EPO, he rediscovered the artist side. From 1991 he participated in the annual EPO artist exhibitions in Munich. Formal training in the field is lacking, but with daily observations and sketching, the art has slowly begun to take some shape. Since 2013, Sven is back in Sweden and have now finally found a suitable space for his studio, where he can paint as well as work with the patent related files.

Le contexte familial a pu avoir une certaine influence sur Sven Berg, principalement parce que ses parents et grands-parents étaient des artistes actifs qui ont rempli la maison de peintures à l'huile, d'illustrations, de livres et de sculptures. A l'université, étudiant en physique appliquée, Sven a fait des dessins humoristiques pour le journal étudiant local mais s'est tenu à l'écart des beaux-arts à l'exception de la fabrication de cartes d'anniversaires qu'il envoyait à ses amis. Ce n'est que plus tard, après avoir commencé à travailler à l'OEB, qu'il a redécouvert son côté artistique. Il participe depuis 1991 à l'exhibition artistique annuelle de l'OEB à Munich. Sans formation particulière dans le domaine, mais avec une observation et des croquis journaliers, son art a lentement commencé à prendre forme. De retour en Suède depuis 2013, Sven a trouvé un lieu spacieux pour son atelier, où il peut peindre et travailler également sur des dossiers de brevet.

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Editorial

M. Névant (FR), Editorial Committee

E pur si muove! (and yet it moves!)

Marc Névant

Almost five hundred years after the Italian mathematician, physicist and philosopher Galileo Galilei pronounced this famous phrase (or so we are told), we recently heard again from Galileo.

On 12 December 2017, the Ariane 5 rocket successfully launched four new Galileo navigation satellites on behalf of the European Space Agency and the EU joining 18 other Galileo satellites already in synchronous orbit. Following the launch of a further four satellites, the Galileo satellite constellation will be fully operational by 2020. It will have an accuracy close to 90 cm being more accurate than either the US GPS or the Russian GLONOSS.

It is noteworthy that the satellites were built by a German company, with navigation instruments provided by a British company, and placed on orbit by a pan-European launcher. This joint effort reminds us of the Airbus success story which is the result of collaboration between European states and companies which began at the end of the 1960s. This collaboration fueled innovation which enables Airbus to compete effectively with its archrival Boeing.

Cooperation and innovation across Europe are the key to the development of such projects, and there is no reason why successes of the past can not be replicated in sectors where Europe has an edge, such as in life sciences or cybersecurity. **epi** has long been experiencing pan-European cooperation through its various bodies and committees, and its members are on "stand-by" and eager to contribute to future European collaborations.

This year marks a milestone in the life of our Institute which will turn 40. Thus, we look forward to the celebrations of this anniversary which will take place in Malta on 13th and 14th April 2018.

Nächster Redaktionsschluss für **epi** Information	Next deadline for **epi** Information	Prochaine date limite pour **epi** Information
Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **18. Mai 2018**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.	Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **18 May 2018**. Documents for publication should have reached the Secretariat by this date.	Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de **epi** Information est le **18 mai 2018**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

If something went wrong: Professional Liability Insurance IPRISK for epi members

Information from C. Quintelier, Chair of the **epi** Working Group on Professional Liability Insurance (PLI) and P. R. Thomsen, Treasurer of **epi**

For European Patent Attorneys working in private practice it is important to have a Professional Liability Insurance (PLI) which covers for financial claims filed by (former) clients due to asserted mistakes or shortcomings of the professional activities of a patent attorney. Even for those European Patent Attorneys working in industry, a professional liability insurance can be useful for those activities carried out for external clients being not related to the employer. That may also be the reason why in some EPC countries, e.g. UK and Germany, it has become a requirement under national law to have a professional liability insurance for nationally qualified patent attorneys. However, there are other countries where no insurance product is offered to cover specifically the typical professional activities of patent attorneys.

As already announced in **epi** Information 3/2017, **epi** has signed a framework agreement with the insurer Lloyds and the broker RMS aiming at providing to **epi** members the insurance product IPRISK, which constitutes a professional liability insurance specifically designed for the typical activities of an **epi** member. Under the framework agreement an individual **epi** member, or the European patent attorney's firm, can conclude such an insurance with standard terms negotiated by **epi** with RMS and Lloyds. In some countries a professional liability insurance for nationally qualified patent attorneys must be recognized by a special institution. **epi** is for instance currently working with IPREG, the regulator for nationally qualified patent attorneys in the UK, to have IPRISK recognized so that it can be offered as single professional liability insurance solution for **epi** members who are also nationally qualified UK patent attorneys. If similar accreditation is necessary in your EPC country the **epi** Working Group on the PLI would be very grateful to receive more detailed information from our interested members.

IPRISK is covering all typical activities of a European Patent attorney including but not limited to drafting, prosecution and opposition work of European, but also national or PCT patent applications in EPC-countries. Even trademark and design work can be insured. The amount of the annual premium to be paid will depend on the selected maximum coverage, the deductible (amount you will have to pay from your pocket in case of a claim), the turnover and the number of **epi** members to be insured. Since launch of the IPRISK in October 2017 inquiries came from 22 different EPC countries and insurances were issued in 10 different countries. From first experience during the last months, it appears that IPRISK is particularly attractive for smaller patent attorney firms. The **epi** Working Group on PLI is very interested to constantly improve IPRISK together with the insurer and broker and would be happy to receive any hints and input from **epi** members.

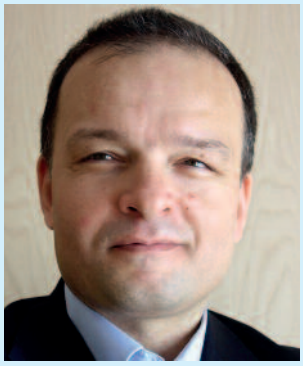
If you are interested in such a professional liability insurance or would like to receive a concrete offer please provide some initial information on a short questionnaire that can be found at http://www.iprisk.management or after log-in on the **epi** website http://patentepi.com/en/professional-liability-insurance/product-information.html.

For specific questions and suggestions you may also contact RMS directly (RMS Risk Management Service Ltd, Attn. Giuseppe Antonuzzo, Phone: +49 911 5407 688, Email: contact@iprisk.management) or the **epi** Secretariat under the email address insurance@patentepi.com.

Obituary

Sertaç Köksaldı

Turkish Council Member of the **epi**



As IP team of the BSH (a Bosch Group company), it makes us sad and we deeply regret to learn that Mr. Sertaç Köksaldı passed away. Among colleagues, we respect very much a good attorney and good character. We all do our job as good as we can for our company and for our clients. And still we are all colleagues of an IP community, and we are all human beings, with families and friends. Therefore we feel deeply sorry and express our condolence over the death of Sertaç Köksaldı to his family.

The BSH IP-TEAM

Report of the Editorial Committee

M. Nollen (BE), Chair

"Highly qualified persons" with writing skills

The Institute of Professional Representatives appears for the first time in the Travaux Préparatoires in the minutes of the meeting of 15-19 May 1972.[1] In the preceding decade, the idea had been that national patent attorneys having sufficient experience would be allowed to practice before the European Patent Office. This, however, led to rather undecided debates in view of the differences in qualification between the member states.

The qualifying examination and the Institute

In the Conference of April 1972 it was stated that provisions were needed "in order to ensure that representation before the Patent Office was undertaken by highly qualified persons"[2]. One month later, it was agreed that in the "final phase" only persons fulfilling the three following conditions would be entitled to act as representatives: they would have to be nationals of one of the Contracting States, have their place of business or employment within the territory of one of the Contracting States, and have passed the European qualifying examination.[3] In this context, the Institute constituted by the persons entitled to act as representatives was mentioned, and it might also be involved in disciplinary matters. [4]

In the meanwhile, the Institute celebrates its 40th anniversary. In addition to the qualifying examination and disciplinary matters, the **epi** is active as a spokesperson for the representatives at the EPO, stimulates permanent education and publishes **epi** Information.

Editorial Committee

The Editorial Committee is evidently the place for those "highly qualified persons" with writing skills – not only with writing skills, but also with reviewing skills and with ambition. And I am very pleased to introduce the new Editorial Committee, increased from four to eight members plus a delegate and a staff member:

Photo: A. Leganza (Italy), J. Schmid (Germany), M. Nevant (France), M.Nollen (Belgium), S. Amira (Monaco), L. Casey (Ireland), D. Herrmann (Germany), M. Thesen (Germany), T. Tangena (Netherlands, delegate from the Presidium), with the support of S. Liebig (epi Secretariat).

1 Travaux préparatoires EPC 1973, available on epo-website, art 134, therein pages 81-87 of the PDF
2 Id.Page 91
3 Id Page 86
4 Id.Page 82

Ambitions of the Editorial Committee

As we agreed in our first committee meeting , it is the ambition to make "**epi** Information" a "must read" for all European patent attorneys. More precisely, the goal is that a qualified European patent attorney is informed of relevant Case Law, of upcoming proposals and changes that may have an impact on the practice – such as the new Rules of Procedures of the Boards of Appeal in the current issue. In this context, book reviews, conference reports and opinions form valuable additions. Furthermore, the **epi**-website is to be informative for the general public as well as useful for all who are actively involved within **epi**.

A working group of authors

In view of the ambitions, the Editorial Committee would be pleased to set up a working group of authors. This is a group of patent attorneys with writing skills that would commit to draft an article in **epi** Information at least once a year. The subject of the article could be chosen by the author and/or suggested by the Editorial Committee. It is furthermore feasible that an author would be given the opportunity to provide an update on law changes, such as for instance in relation to PCT or on specific areas of interest. We do not offer any monetary remuneration, but we offer critical and constructive feedback, as well as the opportunity to occur in a "must read" journal for the profession.

We further would be pleased to find volunteers for the website. We have in mind a person that recently retired from busy practice but willing to do something interesting for the profession. Tools for working from home or an opportunity to work regularly in the **epi** Secretariat can be provided.

Anybody interested can contact the Editorial Committee via editorialcommittee@patentepi.com. I hope that many of the "highly qualified persons" consider this opportunity and contact us.

Report of the European Patent Practice Committee (EPPC)

C. Mercer (GB), Chair

The European Patent Practice Committee (EPPC) met on 24 and 25 January. It was the first meeting of the Committee after the **epi** Council elected its members in the Council meeting C83, held in Warsaw last 18th November, 2017.

Mr Chris Mercer was unanimously elected Chair of the EPPC. The Committee also elected two Secretaries and set up six Sub-Committees (EPC, Guidelines, MSBA, PCT, Trilateral and IP5, Quality). The members of the Thematic Groups (ICT, Pharma, Chemistry and Mechanics) attended the meeting and were given a slot to identify current needs and elect their corresponding Chairs.
The election of associate members for EPPC, its sub-committees and the different thematic groups was postponed until the next meeting of the Committee with the aim to, in the meantime, recruit as many volunteers as possible. Anyone interested in becoming an associate member to any of these bodies is invited to send an email to committees-support@patentepi.com

The Committee also exchanged views with Mr Alfred Spigarelli (Director Quality Management) on quality matters. The EPPC further discussed the EPO proposal to launch optional postponement of examination at the request of applicants ("User Driven Early Certainty"). Besides, it reached conclusions on certain matters concerning the revision of EPC and PCT Guidelines, which will be compiled by Ms Anette Hegner (Chair of the Guidelines Sub-Committee) and sent to the EPO.


Chris Mercer

Lastly, the EPPC heard brief reports on meeting held with the EPO and prepared future internal discussions as well as further meetings with the Office.

Should you be interested in knowing more about the topics discussed by the EPPC during its meeting, please send an email to eppc@patentepi.com

The Minutes of the EPPC are available on the **epi** website. Following the EPPC meeting, there has been continued deep discussion on the UDEC proposal and a delegation from EPPC attended a consultation meeting at the EPO on 9th February, where there was an interesting discussion on the project. EPPC has also prepared a letter to the Committee on Patent Law on the topic.
On 8th February, there was a meeting of the SACEPO Working Party on Quality and a report on this will be issued in due course. EPPC will be represented at the next meeting of the Committee on Patent Law.

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair, S. Wright (GB), Secretary

The Committee on Biotechnological Inventions met on 5 February. It was the first meeting of the Committee after the **epi** Council elected its members in the Council Meeting C83, held in Warsaw last 18th November, 2017.

1. Introduction

Everyone on the Committee, including new members, introduced themselves. Ann De Clercq mentioned the Terms of Reference. It was agreed to have associate members, Andreas Oser, Gabriele Leißler-Gerstl, Rafal Witek and Adrian Tombling present at the meeting. Ann De Clercq asked the Committee whether she could stay on as the Chair, and Simon Wright as Secretary. The Committee agreed to let both officers to continue in their respective positions.

2. Comments on previous minutes, reports to council, papers published by epi Biotech Committee


Ann De Clercq

The previous minutes, reports and published papers were approved. We published an overview concerning national laws on plants, but a lot has changed recently, and so this needs updating.

3. Nagoya protocol overview

There is a new section in the German Patents Act (further information can be supplied on request). This

requires that biological resources should be mentioned in a patent application: the law passed in 2016. The Committee is looking into the impact of the Nagoya protocol also for other countries.

4. Patentability of plants and animals – amendments to EPC and GLs

The Administrative Council (AC) introduced new amended Rules last June, taking effect from 1 July 2017. The suspension on relevant cases has now been lifted, and these are now being examined. There are amended Guidelines, and since they have been published the new disclaimers decision has issued, suggesting that a disclaimer to deal with the new exclusion regarding plants may be possible. It is still not clear whether plant parts (in particular propagation parts) are patentable or not. The EPO Guidelines suggest they are not patentable, even though that is not what the law says. We also need further clarification on disclaimers, in other words what disclaimer(s) are likely to be allowable, and the exact wording.

5. SPC survey

An **epi** ad-hoc group, led by the Treasurer, Peter Thomson, has now responded.

6. Guidelines

These are updated every year. There will be a small working group to deal with the biotechnology sections.

7. Topics for meeting with EPO biotech directors on 6 February 2018

The topics as already passed to the EPO in beforehand were briefly discussed.

1. Plants and animals – amendments Rules 27 and 28 – amendments guidelines for examination: any updates?

2. Marker panels: more and more examiners request comparative data with prior art markers in order to acknowledge inventive step, even though the prior art is completely silent regarding the potential of the markers used in said panel: new trend to ask for more experimental data?

3. New type of "plausibility" objections in biotech area: do the examiners have new guidelines in this respect?

For example, a prior art document which is cited for novelty is said to disclose more than is actually experimentally disclosed therein as it would be plausible that the person skilled in the art could have done more experiments. Also cases wherein the Examiner mentions that it is not plausible that all envisaged embodiments of a claim would work as an objection under inventive step. Should the prior art and the claims under examination not be examined with the same type of plausibility?

4. Antibodies: any new guidelines for examiners or important case law which they follow?

Under the heading of "Antibodies", we also would be interested to hear the EPO's reaction, if any, to the US CAFC decision in Amgen v Sanofi from October last year to the effect that claims to antibodies defined solely by their binding to a novel antigen are not valid in the US anymore due to lack of written description. For example, are there any new Board of Appeal cases that deal with this issue, or any discussions about practice changes? Does the established practice of the EPO still stands.

5. Deposit of Biological material:

a. Form 1200 (entry into the European phase), item 8, 2nd paragraph, does not make sense as the deadline expired 16 months from the priority date and the information has already been submitted to the PCT authorities. It is proposed to amend item 8 of Form 1200 in a similar manner as item 9.1.

b. PCT online request forms do not anymore allow to indicate the correct depositary institution in Belgium.

6. Although not a topic specifically related to biotech we would like to ask the EPO: could more informative summaries be given of informal interviews so that the reasoning behind the decision can be understood.

7. Topics to be selected still from the list of topics discussed at our previous meetings with EPO: any updates to be announced by the EPO in any of these areas?

a. Stem Cells
b. Sequence Listings and alignments
c. Pharmacogenomics
d. Medical use claims (insofar biotech related)
e. Non-unity (insofar biotech related)
f. Added Matter – Article 123(2) EPC (insofar biotech related)
g. Guidelines for Examination (other biotech matters than point 1)

8. If time: interested to hear about deferring examination, we will however not be able to express our views as these will be expressed by **epi** delegates at the 9 February consultation and the 20 February CPL meeting.

8. Associate members requests/appointments

The following members have been reappointed or newly appointed as associate member: Bo Hammer Jensen (DK), Caroline Pallard (NL), Hans-Rainer Jaenichen (DE),

Andreas Oser (DE), Camila Lidén (SE), Gabrielle Leissler-Gerstl (DE), Jan Desomer (BE), Adrian Tombling (UK), Rafal Witek (PL), Willemijn Gommans (NL).

9. Any other topics.

Gabriele Leissler-Gerstl introduced a discussion of the deferred examination. The UDEC paper (user driven early certainty) issued by the EPO was discussed. A draft response had already been prepared by Chris Mercer. The proposal is to delay examination up to three years, on request, once the examination fee has been paid. Third parties however can trigger examination by filing third party observations that are both substantive and non-anonymous. Applicants will still need to file an initial response to the search opinion. The majority of the Committee were in favour of a deferral. A letter was addressed to EPPC in this respect.

10. Next meeting

Most probably in autumn 2018, if possible to be scheduled and timed with a meeting at the EPO.

Continuing Professional Education (CPE)

In the first half of the 2018 the following seminars will take place:

Opposition and Appeal

24 April 2018	Budapest (HU)	**epi** roadshow supported by the EPO

Unitary Patent and Unified Patent Court

9 May 2018	Bologna (IT)	**epi** roadshow supported by the EPO

Terminology training manual for professional representatives

G. Arca, European Patent Academy

The EPO has developed a bespoke patent terminology training manual in English, French and German in collaboration with the British Council, the Institut Français and the Goethe-Institut. Focusing specifically on the European patent grant procedure, its purpose is to help professional representatives and EQE candidates further develop their language skills.

The manual is divided into four chapters, each reflecting a different EQE paper: filing a patent application, replying to communications, notices of opposition, and legal matters. The texts used in the training material are largely based on original EQE papers, examiner reports and other official EPO documents. The printed material is supplemented by a USB flash drive containing audio tracks.

Each chapter features practical exercises that focus on specific relevant terminology and grammar and highlight areas for language development. Listening activities developed on the basis of EQE documents concentrate on word recognition and repetition to improve comprehension skills, while writing activities, also developed using EQE documents, aim to help users produce texts that are both linguistically accurate and effective.

The material is designed for either group training or individual self-study. When used for group training, a teacher's handbook is available, which you can request by writing to academy@epo.org. To order your free copy of the manual go to www.epo.org/terminology-training.

In memoriam Erich Wäckerlin

Erich Wäckerlin passed away on January 8th, 2018 at his home in Flurlingen, Switzerland. He served the EPO both as a director and as a member of the Boards of Appeal. Among his colleagues in the Boards he was known for his intelligence, competence, and dedication to judicial work. We would also like to remember him here in his role as trainer, coach, moderator and mentor for many different training events, ranging from EQE preparatory courses to seminars for judges. Many of us at the European Patent Academy had the opportunity of working with Erich, even after his retirement; more, it was a pleasure working with him, as he was always sharing his passion for communicating and transmitting knowledge. With Erich's departure, we are losing an expert speaker capable of fascinating the audience at his lectures, thanks to both his knowledge for all facets of patent law and to his personal characteristics: we all knew him as a patient, gentle colleague, always ready to listen and to enter into constructive exchanges, with a verve and an irony which often delighted us.

The Boards of Appeal of the EPO

The European Patent Academy

The new year started with very sad news for many of us. Our fellow tutor Erich Wäckerlin passed away on January 8th 2018, after a severe illness. As was characteristic of him, this was a surprise to most of us.

During his long career in various functions in patent offices (Swiss and the EPO) Erich was very active as a tutor and a trainer at CEIPI and other instances. After his retirement from the EPO, he also continued as a technical judge in the Swiss Federal Patent Court and ran a company with his son Michael, again alongside his many training activities.

For several years I had the chance to cooperate with Erich on the **epi**/EPO seminar series "Life of a patent". I could not have hoped for a better partner in setting up this new seminar back in 2013. Erich was very knowledgeable in everything relating to patents, the EPC and training in general but he was also an extremely kind and nice person to work with. One could always count on him being there as a supportive presence, but never interrupting or undermining his fellow tutor. He was always a gentleman, in the best sense of the term.

Erich was also excellent company. Breakfast and dinner discussions with him were always fascinating, due to his many interests in various aspects of life such as literature, history, art and architecture. Our last discussion, in November at Prague airport after a seminar, was about buildings by Alvar Aalto in Finland and ways to visit them. Sadly, his visit could not become a reality.

Erich will be sorely missed by numerous tutors and coaches, including myself. I know it is customary to say "may he rest in peace", and in Erich's case we can be certain that he will, as nothing else is possible for such a kind soul.

*Kaisa Suominen, **epi**-Tutor*

EQE training courses in Maastricht

C. Mulder (NL), N. Blokhuis (NL), N. Duhayon (BE),
I. Surdej (BE) and P. Pollard (NL)

Since 2014, Maastricht University offers small-scale training for candidates preparing for the European Qualifying Examination (EQE). This training is for candidates who already have a basic understanding of European patent law.
The training for each of the papers starts with three days of workshops (A and B are combined), given in the historic centre of Maastricht. Various methods for tackling the relevant papers are discussed including coaching from the trainers. Access will be provided to Maastricht University's electronic learning environment for online support from fellow students and the trainers all the way up to the date of EQE. Assignments will be set out to improve the skills of the participants and boost their confidence.
In autumn 2018, we give preparation courses preparing for the Pre-Exam as well as for all four main exam papers.

Training for EQE Paper D

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

Workshop duration: 3 days: Monday 8 - Wednesday 10 October 2018. Online learning trajectory: from October 2018 to March 2019: 8 assignments (6 with a set of Part I questions and 2 Part II cases); one of the assignments will be marked by the tutor.

Training for EQE Paper C

In Paper C of the EQE, a notice of opposition has to be drafted following the grant of a European patent. In the course, a newly developed, simple and efficient methodology for tackling Paper C will be taught. The methodology will be put to practice with various example cases.

Workshop duration: 3-days: Monday 22 - Wednesday 24 October 2018. Online learning trajectory: from October 2018 to March 2019: 8 assignments (6 C cases and 2 full C Papers); one of the cases will be marked by the tutor.

For the participants in the trainings for EQE Paper C and D, there will be an opportunity to attend a final face-to-face question and answer session with the trainers in January 2019. In preparation, an answer to an EQE exam paper can be handed in, which will be corrected and commented upon by the trainer.

Training for EQE Papers A and B

In Paper A of the EQE, a set of claims and the introductory portion of a European patent application have to be drafted. In Paper B, a response to a communication from the examining division has to be drafted, while taking account of the cited prior art and the instructions from the client.

Workshop duration: 3-days: Monday 5 - Wednesday 7 November 2018. Online learning trajectory: from October 2018 to March 2019: several assignments; one of the assignments will be marked by the tutor.

For detailed information and registration, see
https://www.maastrichtuniversity.nl/education/course/eqe-exam-training

Training for the Pre-Exam

In November 2018, Maastricht University will offer candidates preparing for the Pre-Exam a training course focused on the legal questions as well as on the claim analysis part.

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

Workshop duration: 2 days: Monday 19 and Tuesday 20 November 2018. Online learning trajectory: from December 2018 to March 2019, a number of assignments will be set out.

Pre-Exam - Legal Questions
The legal questions of the Pre-exam require you to quickly and correctly apply your legal knowledge to a legal situation presented in each of the 10 questions.

Workshop duration: 1 day: Wednesday 21 November 2018. Online learning trajectory: from December 2018 to March 2019, a number of assignments will be set out.

For detailed information and registration, see
https://www.maastrichtuniversity.nl/education/course/eqe-pre-exam-training

All course material and teaching will be in English.
The courses are given by a team of renowned teachers.

VESPA
Verband der freiberuflichen
Europäischen und Schweizer Patentanwälte

VIPS
Verband der Industriepatentanwälte
in der Schweiz

organisieren auch in diesem Jahr ein

PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2019

- Der Kurs versteht sich als letzte Etappe vor der Eignungsprüfung und als Ergänzung zu den eigentlichen Ausbildungskursen.
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben der Teile A bis D und die Instruktion der Prüfungstechnik und -strategie durch erfahrene Europäische Patentanwälte.
- Die Aufgaben können nach Wunsch auf deutsch, englisch oder französisch bearbeitet werden, Modul 2 wird auf deutsch durchgeführt.
- Die Bewertung erfolgt vertraulich anhand der bei der Eignungsprüfung angewandten Kriterien. Eine schriftliche Korrektur wird abgegeben, Fragen an die Tutoren sind möglich.
- Der Kurs ist aus drei zeitlich getrennten Modulen aufgebaut (Module 1 und 3, jeweils einschliesslich Modul 2, können auch einzeln belegt werden) und umfasst je die Teile A bis D der Europäischen Eignungsprüfung.
- Teilprüfungskandidaten können auch einzelne Teile (A, B, C oder D) belegen, wobei die Kursgebühr entsprechend reduziert wird.
- An den Modulen 2 und 3 können auch Resitter teilnehmen (auch an einzelnen Teilen), deren nicht bestandene Prüfungsarbeiten (2018) wir im Rahmen von Modul 3 schriftlich kommentieren.

Aufteilung des Kurses:

Modul 1 (ab Juni 2018)
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Anmeldeschluss Modul 1 (und 2): 01.06.2018

Modul 2 (September 2018)
Vorstellen von Prüfungstechnik und -strategien für die einzelnen Teile. Besprechung der Fragen zu Prüfungsaufgaben 2017 und, wo erwünscht, Fehleranalyse der Kandidatenarbeiten.

Modul 3 (Anfang November 2018)
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CEIPI preparation courses for the EQE 2019

Schedule

1. PrePrep courses

Paper	Paris (FR)	Paris (EN)	Strasbourg (DE)
A+B	28.09.2018	28.09.2018	21.09.2018
C	29.09.2018	29.09.2018	22.09.2018
D	07.-08.09.2018	26.-27.09.2018	19.-20.09.2018

2. Seminars (Strasbourg) + Resitter

Pre-exam: 5 - 9 November 2018
ABC: 19 – 23 November 2018
Resitter C: 30.11 – 01.12.18 (Strasbourg)
D: 7 - 11 January 2019

Contact:
Christiane Melz
Secretariat of the International Section of CEIPI
phone: 0033 3 68 858313
email: *christiane.melz@ceipi.edu*

3. Intensive "last-minute" courses

Munich:
Intensive course Pre-exam: 24 – 25/01/19
Intensive course papers AB: 21 and 22/01/19 (afternoon)
Intensive course paper C: 22 and 23/01/19 (morning)
Intensive course paper D: 24/01 – 25/01/19 (morning)

Paris:

Intensive course Pre-exam: 24 – 25/01/19
Intensive course papers AB: 22 and 24/01/19 (afternoon)
Intensive course paper D: 23 - 24/01/19 (morning)
Intensive course paper C: 25/01 – 26/01/19

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European Patent Office
Dir. 5.2.3
Legal and Unitary Patent Division
80298 Munich
Germany

Tel.: +49 (0)89 2399-5231
Fax: +49 (0)89 2399-5148
legaldivision@epo.org
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Revision of the Rules of Procedure of the Boards of Appeal at the EPO

C. Mercer (GB), M. Nollen (BE)

The September 2017 letter was drafted by the EPPC with C Mercer as chair. The revision from letter to article was done by M Nollen with feedback from C Mercer and J Schmid.

In 2007, the Rules of Procedures of the Boards of Appeal (RoPBA) were approved by the Administrative Council. These Rules have since then been used frequently to refuse submissions of parties as late filed and not *prima facie* relevant. Last year, a project was launched to revise these Rules. A new draft has now been made available. A consultation has been launched to give feedback on these Rules[1].

The proposed changes to the Rules of Procedures relate particularly to the Articles on consolidation of proceedings (Art. 10), on the basis of the proceedings (Art. 12), on amendment to a party's case (Art. 13) and on oral proceedings (Art 15). An Article on transitional provisions (Art. 25) has been added. The proposed Article 12 facilitates the Boards in being strict about admitting evidence and amendments. Importantly, it now makes explicit that not merely the grounds of appeal, but also the decision under appeal and any minutes of oral proceedings constitute the basis for appeal proceedings. Article 13 now has more focus on amendments during appeal proceedings. Article 15 now specifies a (extendable) three-month term for the written decision after oral proceedings and allows for the provision of an abridged form of the reasons in certain situations.

The **epi** will submit a response to the draft Rules. The Working Group preparing the response invites all European Patent Attorneys to give input and send comments to eppc@patentepi.com. Although firms and individuals may also respond individually, it is deemed that a joint response on behalf of all European patent attorneys, and particularly those more than incidentally involved in appeal proceedings, will be more useful for the Boards of Appeal.

epi's letter of September 2017

The starting point of the **epi**'s response is a letter **epi** sent to the Boards of Appeal in September 2017. In this letter, the **epi** addressed the functioning of the appeal procedure in its entirety. The following is an edited version of the letter.

epi believes that any changes in the RoPBA should aim at maintaining high quality of appeal decisions as well as independence of the Boards, but also at enabling the Boards to increase efficiency of appeal proceedings and reduce total pendency time. However, rules and practices of appeal procedures directly correlate with the rules and practices of the first instances (Examining Divisions, Legal Division and Opposition Divisions) whose decisions give rise to appeals, and, as a consequence, meaningful improvements in appeal procedures should be accompanied by corresponding adjustments in the first instance practices. This would apply in particular to opposition procedures.

The principles which **epi** sees as essential for the RoPBA and any amendments thereof are that:

(i) The Boards act as instances of appeal, not tribunals to hear new cases;
- this implies that new facts, evidence and requests can be introduced only if convincing reasons are provided for the late filing. Thus, criteria should be defined when late filings can be accepted (relevance and solid reasons justifying late filings);
- this implies on the other hand that the appeal is not a purely legal review.

(ii) A case management system ensures timely and effective consideration of appeals;
- this includes a clear time schedule for the Board and the parties and an early and mandatory preliminary opinion by at least one member of the Board. A significant reduction of the pendency of the average appeals proceedings [by at least 50%] should be the ultimate goal.

(iii) There is consistent procedural practice across all Boards;
- this applies especially to the application of criteria for the admissibility of evidence and requests filed after the opposition proceedings or after the start of the appeal.

(iv) The way in which the Boards are constituted encourages cross-fertilization between the Boards.

(v) Transitional provisions that ensure that there are no detrimental effects to pending proceedings have to be provided.

1 See: http://www.epo.org/law-practice/consultation/ongoing.html

It is important that any major change of the RoPBA will not be effective for pending cases, where under the presently valid Rules there are still opportunities to react, which won't be available under the proposed new Rules.

Appeals under Current Practice

The current appeal practice at the EPO is generally experienced as being in average of good quality as to substance. However, many users feel that the average pendency, which is in the order of three years, is too long. Also differences in practice, especially in the application of criteria for allowing parties to adjust their case during the appeal proceedings, are considered by many to be too large. As a result, there is room for improvement of the efficiency and predictability of appeal proceedings.

At the same time, it is recognised that part of the reasons for these difficulties reside in the preceding procedures before the first instances of the EPO. Hence, overcoming these difficulties not only requires an adaptation of the appeal practice, but also of the first instance practice, either by direct changes in the first instance practice or by adjustment of first instance proceedings to changed rules for appeal, or both.

One issue with the current practice of the first instance divisions (Examining and Opposition Division) in the EPO is that it is often difficult for a decision to be taken on all the issues which should be dealt with by the first instance. If such a division takes the view that a set of claims does not meet one of the formal requirements of the EPC (Arts. 83, 84 and 123 and Rule 80 EPC), the application may be refused or the patent may be revoked. Then, the Division does not need to, and typically does not, address any of the substantive grounds (Arts. 52-57 EPC). If the Board overturns the decision of the first instance, it tends to remit the case to the first instance. This clearly is a waste of time as, even with an expedited opposition procedure and an expedited appeal procedure, this can add at least two years to the time needed to resolve the matter. The **epi** considers it important that a way of dealing with this issue is developed.

With the above in mind, **epi** provides below some commentary on the principles set out above.

(i) The Boards as instances of appeal

epi considers that, wherever possible, the Boards should aim to decide primarily whether the decision taken by the first instance was technically and legally correct. In principle, any new evidence or request filed during the appeal proceedings would only be admissible if it could not reasonably be filed before, and clearly serves to come to a swift decision.

epi recognises that, in many cases, especially under the present practice, a very strict regime will not be possible and not be desirable. Occasionally, the first instance will make a decision which is a surprise to one of the parties. The first instance may take an unexpected view of, for instance, the meaning of a claim, the common general knowledge of a skilled person, the inherent content of a prior art document or the closest prior art for the purposes of inventive step. In such instances, **epi** considers that the party(ies) to appeal proceedings should be able to file new evidence or, in the case of a patent proprietor, new auxiliary requests, to address the unexpected situation.

It is within the Boards' discretion to decide on the admissibility of new auxiliary requests and new evidence. In exercising its discretion, the Board will take into account the whole of the proceedings before the first instance so as to determine whether the decision was unexpected.

epi also considers that auxiliary requests and evidence should be dealt with using different criteria when considering admissibility, and these should be distinguished from new arguments. In this respect, the notion "amendment to a party's case" of Article 13 RoPBA needs specification.

As regards *auxiliary requests*, if a new auxiliary request could and should have been filed in the first instance proceedings, then the Board should refuse to admit it. If the auxiliary request could perhaps have been filed in the first instance proceedings but merely involves deletion of a claim, e.g. by combination of an existing independent claim and an existing dependent claim, then that auxiliary request should be admitted at any stage of the proceedings. Also, a new request which does not require any new discussions and clearly allows a swift settlement of the appeal, should in principle always be allowed.

As regards new *evidence*, such as new documents or declarations, if new evidence could and should have been filed in the first instance proceedings, then the Board should refuse to admit it. In any event, **epi** considers that the Boards should generally exercise their discretion and admit the new evidence if it deals with an unexpected decision of the first instance or new evidence or argument introduced by the other party (patentee or opponent).

If, in opposition proceedings, any new evidence leads to a new line of attack on the claims[2], then this new evidence should be excluded from the proceedings unless it is occasioned by the decision or submission by the proprietor, or the patent proprietor agrees to its admission. New evidence

2 It may be that an opponent had unsuccessfully attacked a claim under inventive step using, say, D1 as the closest prior art. This gives rise to a first line of attack. If the opponent then files a new document, say D10, and then uses this as the closest prior art, then the opponent is raising a new line of attack under Article 56. This means that, in appeal, the opponent is not appealing against the decision of the first instance but is instead starting a new opposition. This should not be allowed.

should not enable an opponent to start a new opposition at the appeal stage, which would frustrate the purpose of an appeal instance.

epi is aware that, occasionally, an opponent will identify a new, novelty-destroying or otherwise highly relevant document which clearly affects the validity of an independent claim. If this is clearly the case, then the Board may admit that document into the proceedings and may order the opponent to pay the proprietor's costs, if the new document necessitates postponement of the proceedings.

As to *new arguments*, i.e. new lines of reasoning based on the same, already invoked evidence, these should normally be allowed at all stages.

(ii) New Case Management System

epi considers that a new Case Management System should be instituted. Once a Board has been constituted[3] for the case, much of the preliminary work can be carried out by one member (the Rapporteur) without necessarily involving the other Board members until the case is ready for oral proceedings (or for a decision if oral proceedings have not been requested). The Rapporteur should in the view of **epi** send out a communication to the party or parties in order to deal with any points which arise during his preliminary review of the case, setting a short deadline (2 months) for responding to the communication. Afterwards, the Rapporteur would send to the party or parties summons to oral proceedings together with the Rapporteur's preliminary opinion on the case.

epi considers that it should be compulsory for the Rapporteur to send out a preliminary opinion, but it should be made clear that it is the opinion of the Rapporteur and that the Board as such may ultimately have a different view. The preliminary opinion should set out in some detail the Rapporteur's views and expected outcome. The party or parties may be given a short period (2 months) for filing any comments on the preliminary opinion. After the period for commenting, the Rapporteur will then brief the other members of the Board so that they are fully prepared for the oral proceedings or for a decision.

For oral proceedings, the present procedure for their conduct can be adopted, except that a person (member of the Board or not) other than the Rapporteur should be assigned to prepare the minutes. **epi** considers that the Rapporteur should be able to concentrate on the issues being discussed at the oral proceedings and not be burdened with taking the minutes. **epi** also considers that the minutes should be much more comprehensive than they are now in light of the fact that there may be a petition for review.

The proposed system is summarised in the following scheme.

Time in months from statement	**Action**	**Time limit**
0	statement of appeal	Art. 108, 2nd sentence
4,5	response of respondent(s)	4 m from notification of statement; no extensions, unless appropriate
7	(last) opportunity for appellant(s) to reply to response of respondent(s)	2 m, no extensions
8,5	(last) opportunity for respondent(s) to comment on reply of appellant(s)	2 m, no extensions
10,5	optional communication of Rapporteur indicating points of relevance	
13	(last) opportunity for all parties only to comment on points raised by Rapporteur	2 m, no extensions
14	report of Rapporteur with preliminary opinion on all aspects of appeal, indication of issues to be discussed in oral proceedings (and of those which need not according to the Rapporteur), summons to oral proceedings at date no less than 4 m and no more than 8 m after report (in a transitional period of reducing backlogs, the 8 m maximum may be flexible)	
16,5	opportunity for parties to comment, **only** to the issues raised by the Rapporteur	2 m from report
18-22	oral proceedings oral decision	decision only when Board is ready for it; otherwise shortly after oral after oral proceedings, at the latest with written decision
20-24	written decision	2 m from oral proceedings

3 **epi** considers that a new method for constituting a Board would be beneficial, as set out below.

epi considers that placing the responsibility for case management primarily with the Rapporteur and shifting most of his preparatory work to a relatively early stage of the appeal proceedings will strongly enhance procedural efficiency and reduce pendency times, allow the proceeding while maintaining high quality as to substance. Naturally, the Rapporteur should be free to consult other Board members if needed at any stage.

G 1/16 – Disclaimers – History, Decision and Practice

by C. Mercer (GB)
This article was written with valuable input form D. Goodmann (GB)

There has been a great deal of interest in G 1/16, the most recent decision of the Enlarged Board of Appeal (EB). **epi**'s European Patent Practice Committee (EPPC) formed a Working Group to contribute to the Enlarged Board's deliberations. The Working Group provided a first set of comments after the EB had indicated that it was seeking views from interested parties. During the EB proceedings, the EB issued a preliminary view of the points which still needed discussion and the Working Group provided a second set of comments addressing the points made by the EB. These can both be found on the **epi** website[1]. A member of the Working Group attended the oral proceedings.

So what is all the fuss about?

Disclaimers

Going back to basics, the case was all about disclaimers. As we all know, a disclaimer is a negative claim limitation, typically excluding specific embodiments or areas. A simple example of a claim with a disclaimer in it is "*A metal, wherein the metal is not steel*".

Disclaimers are then divided into undisclosed disclaimers and disclosed disclaimers. The example above would be an undisclosed disclaimer if there was no mention of steel in the application. However, if the application did mention steel, for instance by stating that: "*In some embodiments, the metal is not steel*" or, sometimes, "*In some embodiments, the metal is steel*", then the disclaimer is a disclosed disclaimer. Disclaimers have been dealt with by the EB before. I will refer to the two main cases here.

Undisclosed Disclaimers

The first case is G1/03 which deals with undisclosed disclaimers. G1/03 held that undisclosed disclaimers are allowable provided that they meet a four step test. Step 1: Is there a suitable reason for a disclaimer? Step 2: Does the disclaimer remove no more than is necessary? Step 3: Is the disclaimer unrelated to inventive step and sufficiency? Step 4: Is the disclaimer clear and concise? The answer must be "yes" to each question, otherwise the disclaimer adds matter.

Step 1 can be answered with "yes" if the disclaimer restores novelty over Article 54(3) prior art or over an "accidental" anticipation in Article 54(2) prior art or removes subject-matter excluded from patentability. As to what an accidental anticipation is, in G1/03, the EB said that "*… from a technical point of view, the disclosure […] must be so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention*". Excluded subject-matter includes such things as methods of treatment of the human body, uses of human embryos for industrial or commercial purposes etc.

Step 2 can be answered with "yes" if the disclaimer is carefully drafted so that only that which is disclosed in the prior art or that which is excluded subject-matter is covered by the disclaimer. If you disclaim too little, the claim is not allowable because it still lacks novelty or still encompasses excluded subject- matter. If you disclaim too much, it may not be allowable under Article 123(2) EPC.

Step 3 can be answered with "yes" only if the disclaiming of the subject-matter does not have any effect on inventive step or sufficiency. As was said in G1/03: "*A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC*" (reason 2.3).

Step 4 can be answered with "yes" only if it is possible to make a precise description of the subject-matter to be disclaimed. This can be difficult if the prior art containing the subject-matter is itself unclear. However, the EPO may, in such circumstances, allow an applicant to remove more than necessary for the sake of clarity or conciseness (T 2130/11; Guidelines H-V, 4.5).

Disclosed Disclaimers

The second case is G2/10, which dealt with the question of disclosed disclaimers. The question in that case was: "*Does a disclaimer infringe Article 123(2) EPC if its*

1 http://patentepi.com/en/epi-papers/g1-16-oral-proceedings.html

subject-matter was disclosed as an embodiment of the invention in the application as filed?". If, in the case of the claim set out above, the application stated that: "*In some embodiments, the metal is not steel*", then it is usually the case that the disclaimer is allowed. More interesting is the situation where the application states that: "*In some embodiments, the metal is steel*". In G 2/10, the EB decided that a disclosed disclaimer is allowable if the subject-matter remaining in the claim after the introduction of the disclaimer is explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed. Determining whether or not that is the case requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.

Which Case Applies?

It can be seen that the rules governing the allowability of disclosed disclaimers seem to be more strict than those applying to undisclosed disclaimers. Therefore, the question arose as to whether the rules of G 2/10 should also apply to undisclosed disclaimers as well?

Case Law of the Boards of Appeal before the Reference (July 2016)

There were two lines of cases in relation to whether G 2/10 applied to undisclosed disclaimers as well as disclosed disclaimers.

T 1870/08 held that G 2/10 applies to an undisclosed disclaimer that seeks to establish novelty over novelty-only prior art. T 2464/10 said that G 2/10 did not consider G 1/03 to be exhaustive as to the conditions that needed to be fulfilled for an undisclosed disclaimer to be regarded as allowable under Article 123(2) EPC. This means that the Gold Standard test (the test of G 2/10) should be performed in addition to the tests in G 1/03. T 1441/13 said that the G 2/10 test is the overriding principle for any amendment to be allowable under Article 123(2) EPC. This applies equally to undisclosed and disclosed disclaimers.

However, T 74/11 said that G 1/03 was the correct test for assessing the possible introduction of an undisclosed disclaimer, not G 2/10.

EPO's Guidelines for Examination (November 2017)

The EPO's Guidelines for Examination (H-V, 4.1; November 2017) suggest that G 2/10 applies to undisclosed disclaimers. In addition to applying the four-step test of G 1/03, the Guidelines point out that: "*However, the introduction of the undisclosed disclaimer should not lead, for example, to the singling out of compounds or sub-classes of compounds or other so-called intermediate generalisations not specifically mentioned or implicitly disclosed in the application as filed (see G 2/10). More generally, the test applicable under Art. 123(2), as defined by G 2/10 (see H- V, 4.2), also applies to so-called undisclosed disclaimers (see T 1176/09)*".

The G 1/16 Referral

The case from which the reference originated is T 437/14. The claim at issue contained two undisclosed disclaimers in view of accidental anticipations. The Appeal Board (AB) hearing that case felt that it should apply G 1/03 and G 2/10, but was not sure how it could do that. The AB accepted that the disclosures were indeed accidental and justified according to G 1/03. However, the AB also thought that G 2/10 was universal and, if applied, would mean that the disclaimers would contravene Article 123(2) EPC. The AB was therefore unable to decide whether the claim complied with Art 123(2) EPC.

The AB therefore referred the following questions to the EB: 1. Is the Gold Standard referred to in G 2/10 applicable to undisclosed disclaimers? 2. If the answer to 1 is yes, is G 1/03 set aside? 3. If the answer to 2 is no, may the G 2/10 standard be modified in view of G 1/03?

There were a large number of submissions made to the EB. In favour of applying the Gold Standard of G 2/10 to all disclaimers were arguments to the effect that: this would lead to a uniform concept of disclosure; G 1/03 did not define exceptions to the Gold Standard, but instead further limited the circumstances in which an undisclosed disclaimer could be used; G 2/10 did not provide any justification for not applying the Gold Standard to undisclosed disclaimers; and the Gold Standard should be applied for disclaiming excluded subject-matter only.

Against applying the Gold Standard to undisclosed disclaimers were arguments to the effect that: G 1/03 allowed a specific narrow exception to requirements of Article 123(2) EPC for legal, non-technical reasons; and by definition an undisclosed disclaimer does not have basis in the application as filed. The majority of submissions presented such arguments.

The G 1/16 Decision

The EB decided that undisclosed disclaimers need to satisfy only the G 1/03 test but that disclosed disclaimers need to satisfy the G 2/10 Gold Standard test. The main reason for this decision was that applying G 2/10 to undisclosed disclaimers "*… leaves virtually no chance of an undisclosed disclaimer being allowable … where an undisclosed*

disclaimer is introduced into the claim it (almost) automatically follows that the subject-matter remaining in the claim after the introduction … can hardly be considered to have been explicitly or implicitly, and directly and unambiguously, disclosed in the application as filed".

Practice Points

It is worth noting that disclaimers are still dangerous, especially because of the Article 123(2) / Article 123(3) trap. Article 123(3) EPC states that: "*The European patent may not be amended in such a way as to extend the protection it confers*". If a disclaimer is judged to add matter post-grant, it will often be impossible to remove the disclaimer without impermissibly broadening the scope of the granted claim.

This should have an influence on your drafting practice. It may be better to use positive limitations instead of a disclaimer, but these can only be used if they have been included in the application. You may even want to consider including disclaimers in your drafts if it is clear that they may be needed (e.g. to disclaim subject- matter that is typically excluded from patentability in Europe). In making amendments, if you are going to try using a disclaimer, then it might be advisable to provide an additional independent claim that is narrower than the claim containing the disclaimer, but which recites positive limitations only. Another option is to file a divisional with an alternative limitation that addresses the novelty or excluded subject-matter issue in a different way. Certainly, if you have to use an undisclosed disclaimer, it should be as narrow as possible to exclude only the subject-matter which needs to be disclaimed. Finally, you should ensure that all of the claims that are dependent on a claim containing an undisclosed disclaimer also require that disclaimer. If a dependent claim recites a limitation that already addresses the prior art or excluded subject-matter issue, then the incorporation of an undisclosed disclaimer through a claim dependency may add matter.

Conclusion

It almost seems that there was a fuss over nothing as the EB basically left a clear distinction between disclosed and undisclosed disclaimers. However, the EB decision does make it plain that the provisions in G 2/10 are not to be applied in the case of undisclosed disclaimers. Moreover, the fact that the EB keeps considering disclaimers means that they are trouble and should be avoided.

New EPO Guidelines for Examination on the Patenting of Graphical User Interfaces

Dr. D. Herrmann (DE), European Patent and Trademark Attorney, Patentanwalt

The EPO has completely revised its Guidelines for Examination regarding "presentations of information" and "user interfaces" (EPO GL 2017, G – II, sections 3.7 and 3.7.1). These substantial revisions are mainly based on recent decisions by the EPO Boards of Appeal 3.5.05, in particular decision T 336/14. The EPO has now concretised the circumstances in which features of a GUI are considered "technical features" and hence relevant for the assessment of the inventive step. Even though this topic is not completely settled in the case law of the EPO's Boards of Appeal, a general trend appears to emerge at the EPO, which the new EPO Guidelines for Examination aim to account for.

Graphical User Interfaces (GUIs) have become our constant companions in many different areas: mobile telephones, distributed network communications, medical equipment and machines in industrial processes are many areas of use.

The long-established standard practice of the EPO requires that, in order to be patented, claimed subject-matter must solve a technical problem with technical means in a way which is not obvious. According to Art. 52 (2) EPC and the established practice of the EPO, the presentation of information, aesthetic creations, programs for computers and business methods are, as such, not considered to be technical.

With regard to the patentability of GUIs, this meant and still means that features of a patent claim which relate to information which is displayed to a user via a GUI are analysed to determine if, in the context of the claimed subject-matter, they contribute to providing a technical effect. If they do not make such a technical contribution, they are not taken into account during the assessment of inventive step, in accordance with the examination approach of the widely known COMVIK decision **T 641/00** of the EPO, and hence cannot support the presence of an inventive step. In the

revised Guidelines for Examination, the EPO emphasizes that, during the assessment of inventive step, the examiner is supposed to assess the context of the claimed subject-matter, the task the user carries out and the actual purpose which is served by the particular presented information.

When looking at GUIs, the particularly relevant question is which criteria a GUI-related feature has to fulfil in order to be recognized as a "technical feature" that contributes to the technical effect of the claimed subject matter, so that it is to be taken into account when assessing inventive step.

"Functional data" vs. "Cognitive data"

First of all, the EPO emphasizes again in the revised Guidelines for Examination that presentations of information in the sense of Article 52 (2) d) EPC is to be understood as the conveying of information to a user, i.e. cognitive data, and is to be distinguished from the technical representations of information directed to a technical system to process, store or transmit that information. Features of data encoding schemes, data structures electronic communication represent "functional data" and are not regarded as such presentations of information.

Functional data is data which shows the inherent technical features of the underlying system in questions, such as information for the synchronisation of coded picture lines (line numbers and addresses) for a corresponding reading apparatus (**T 1194/97**) or a television signal which reproduces information which shows the technical features of the television system (**T 163/85**).

Taking the Human by the Hand via the GUI - "What" vs. "How"

In the case of such cognitive data, the revised Guidelines for Examination now clearly distinguish two sub-categories of presentations of information, namely (i) whether the relevant features concern "what" (which information) is presented, in other words the content of the information presented, and (ii) "how" (in which manner) the information is presented. However, the revised Guidelines for Examination emphasize also that a presentation of information does not extend to the technical means used for generating such presentation of information.

The decision **T 336/14** addressed the question which role the nature or the content of the displayed information plays in the assessment of inventive step of the information presented using a GUI. The decision concerned the appeal proceedings in an opposition regarding a patent, the patented subject-matter of which was a graphical user interface for an extracorporeal blood treatment machine.

T 336/14 – Main Request

In the main request, the graphical user interface differed from the prior art only in that saved data displayed in visually associated position to two touch keys on a display (i) comprised the operating instructions for readying the machine for use and (ii) two pictograms were shown on the display upon activating the two touch keys, wherein the pictograms represent configurations of the machine correlated to the operating instructions (T 336/14, reasons 1).

In decision T 336/14, the Board of Appeal 3.5.05 applied a special examination procedure or testing scheme, whose main criteria were now partly incorporated into the revised Guidelines for Examination and should therefore be taken into account when drafting patent applications for the EPO.

The patent in question of T 336/14 concerned "cognitive data" and its content (i.e. the question of "what" is presented) and not "how" (i.e. in which manner) the information is being presented.

When assessing whether such displayed cognitive content can be seen as a technical feature, the Board of Appeal concentrated on whether the user interface and the content of the displayed information credibly assist the user in carrying out a technical task by way of a continued or guided human-machine interaction process. In particular, it concerned the question of "why", in other words "for what purpose" the information was displayed (T 336/14, reasons 1.2.4).

In other words, according to the Board of Appeal, to answer the question of whether the displayed cognitive content is to be considered a technical feature, it must be reviewed whether the displayed information is "technical information" which credibly enables the user to properly operate the underlying technical system and thus has a technical effect. It is particularly relevant to assess whether the displayed cognitive information contains an internal machine condition and prompts the user to interact with the machine in a continued or guided way to enable the proper functioning of the machine (T 336/14, reasons 1.2.4). The same Board of Appeal 3.5.05 made similar statements in an earlier decision T 407/11.

The Board of Appeal concentrated on "why", or "for what purpose" the operating instructions for activating the extracorporeal blood treatment machine are shown on the user interface of the extracorporeal blood treatment machine together with two pictograms which are correlated to the operating instructions. The patent concerned a way of supporting a nurse in starting the extracorporeal blood treatment machine in a safe and efficient way by displaying the operating instructions and the pictograms.

The Board of Appeal found, however, that activating the key according to the patent claim did not necessarily bring on the change of an internal state of the extracorporeal blood treatment machine and the displayed pictograms did not contain any details of the current state of the machine. In addition, the patent claim did not even indicate an order in which the keys or the operating instructions needed to be used in order to guarantee a proper operation of the machine.

As a consequence, the Board of Appeal came to the conclusion that the claimed operating instructions and the pictograms did not credibly or causally support the user in terms of a continued or guided human-machine interaction. In particular, the Board of Appeal found that the displayed information, if at all, could only help the user to better understand or remember the steps to be carried out to start the extracorporeal blood treatment machine and would, therefore, only address the mind of the user.

Consequently, the distinguishing features of the main request would relate to the presentation of information as such, which, according to settled case law of the Board of Appeal, does not support the presence of an inventive step.

T 336/14 – Auxiliary Request

In one of the auxiliary requests, an additional distinguishing feature was inserted that a part of the display changes if one of the operating instructions is carried out. In essence, the purpose of this is to give the user a visual feedback in the event that the user of the machine follows at least one of the operating instructions presented (T 336/14, reasons 3). The Board of Appeal admitted that this visual feedback on the carrying out of one of the operating guidelines referred to an internal state of the machine and would represent "technical information". However, the Board of Appeal emphasised that this distinguishing feature would not necessarily require that carrying out the operating instructions has to be successful to trigger the visual feedback. In fact, what is being displayed visually is merely the activation of any operating instruction. If and how – in other words how successfully – the activated operating instruction is carried out by the extracorporeal blood treatment machine is left open by the patent claim, so that a proper functioning of the extracorporeal blood treatment machine is not necessarily ensured by the claimed graphical user interface. An inventive step was, therefore, also denied by the Board of Appeal for the auxiliary request.

In the headnote of decision T 336/14, this Board of Appeal emphasised that when assessing inventive step of a claim which comprises a mix of technical and non-technical features, in which the cognitive information displayed on the GUI relate to "what" is presented rather than "how" the information is presented, it has to be analysed whether the GUI, together with the content presented, *credibly* assists the user in performing a technical task (related to "why" that content is presented) by means of a continued and/or guided human-machine interaction process.

T 1802/13

Following their decision T 336/14, the same Board of Appeal 3.5.05 took a similar position in decision **T 1802/13** for an application related to "how", i.e. in which manner, the information is being presented and not "what", i.e. which information, is presented. Similar to the issue of "what" is presented as decided in T 336/14, the Board of Appeal decided in reasons 2.1.5 of T 1802/13 that, regarding the technicality of the manner in which information is presented, the main issue to be established is whether the underlying GUI, together with the manner in which cognitive content is presented, *credibly* assists the user in performing a technical task by means of a continued and guided human-machine interaction process (basically being related to the question "for what purpose" the information is presented).

In the recent past, both decisions have been referred to and confirmed by a few other Boards of Appeal and only in a limited number of decisions.

For example, the Board of Appeal 3.2.02 decided in **T 690/11** that the criteria of T 336/14 would follow the established line of case law of the Boards of Appeal. In that particular case, the Board of Appeal 3.2.02 found that features of a GUI, the aim of which is that a user makes an entry and triggers an internal process of the system in question, and the GUI graphically displays the course of this process, has a technical character (T 690/11, reasons 3).

In its decision **T 2461/11** the Board of Appeal 3.4.03 referred to T 1802/13 and considered features relating to enlarging an image of a data setting on a display, maintaining the enlarged image and reducing the enlarged image in dependence of a sensed manipulation of the control by the user as credibly assisting the pilot in performing entry of manually-adjustable data settings in an aircraft cockpit and hence as technical features (T 2461/11, reasons 2.3.4).

Thus, the EPO completely revised the above-noted sections on the presentation of information and user interfaces in the Guidelines for Examination mainly based on the two decisions T 336/14 and T 1802/13. The revised Guidelines for Examination now state that features defining a presentation of information (i.e. features related to "what" information or "how" information is presented) produces a technical effect if it credibly assists the user in performing a technical task by means of a continued and/or guided human-machine interaction process.

The revised Guidelines for Examination even go beyond the literal statements made in these two decisions by stating that such a technical effect is considered credibly achieved if the assistance to the user in performing the technical task is objectively, reliably and causally linked to the feature. This would not be the case if the alleged effect depends on subjective interests or preferences of the user, wherein this latter statement has indeed been stated in several decisions by the Board of Appeal (e.g., **T 336/14, T 1802/13, T 1143/06, T 1741/08, T 1670/07**).

Fortunately, the EPO seems to agree in the revised Guidelines for Examination that the determination of the extent to which particular presentation of information may be considered to credibly support the user in performing a technical task is difficult.

In view of this observation, the EPO provides an "advice" to the examiners according to which this determination may be simplified for the examiner during an assessment of inventive step by comparing the claimed subject-matter with the prior art first, thus allowing the determination to be limited to the distinguishing feature. Unfortunately, the EPO included a statement into this "advice" to the examiners according to which this comparison may reveal that the potential support for the performance of the technical task is already achieved in the prior art, with the alleged consequence that the distinguishing features would make no technical contribution.

This "advice" to the examiners in the revised Guidelines for Examination is at least vague and could be interpreted by the examiners as meaning that a distinguishing feature would "become" non-technical, if the technical effect provided by the distinguishing feature (considered in isolation) is already known from the prior art.

Such an interpretation would, however, violate general principles for the assessment of inventive step: Firstly, whether a claimed (distinguishing) feature is technical or not has to be assessed in context of the claimed subject-matter and without considering the prior art. Secondly, the objective technical problem does not have to be a new problem and can even be a mere alternative. That is, if the closest prior art already achieves the technical effect associated with the distinguishing feature, then the objective technical problem may have to be reformulated such that it is less ambitious, but this does not make the distinguishing feature less technical.

Consequently, this "advice" to the examiners in the revised Guidelines for Examination should be taken with care and should be clarified: To be clearly in line with the general principles for the assessment of inventive step, the Guidelines for Examination should be revised to state that the examiner may compare the claimed subject-matter with the prior art first, so as to limit the number of features the technical contribution of which must be analysed. However, once the distinguishing features are identified, the examiner needs to check for each distinguishing feature in consideration of its function in the context of the claimed subject-matter, and without considering the prior art, whether the distinguishing feature makes a technical contribution to solving a technical problem.

Representatives should closely monitor how the examiners use this "advice" in daily practice.

The revised Guidelines for Examination list several examples, largely based on decisions by the EPO Boards of Appeal, where a technical effect for GUI features was confirmed or denied.

Examples: "What should (not) be presented?"

The revised Guidelines for Examination state that an internal state prevailing in a technical system is an operating mode, a condition or an event which is related to the internal functioning of the system, may dynamically change and is automatically detected. Its presentation typically prompts a user to interact with the system, for example to avoid the technical malfunctions. If the cognitive content of the information presented to the user relates to an internal state prevailing in a system and enables the user in properly operating this technical system, it has a technical effect according to the revised Guidelines for Examination.

Even though it unfortunately only appears to be implicitly stated in the revised Guidelines for Examination, that the mere presentation of such an internal state prevailing in a technical system is a technical feature, it is important for the applicants and patent proprietors to know that a series of partly older but hitherto accepted decisions view a technical effect in the mere display of internal states of apparatuses (**T 115/85, T 362/90, T 599/93** reasons 4, **T 1073/06** reasons 5.4, **T 756/06** reasons 13, **T 1670/07** reasons 12, 13; **T 528/07**, reasons 5.2). The revised Guidelines for Examination now state that features defining user input are more likely to have a technical character than those solely concerning data output and display, because input requires compatibility with the predetermined protocol of the machine, whereas output may be largely dictated by the subjective preference of the user. This seems to imply that, in line with these partly older decisions, the mere presentation of such an internal state prevailing in a technical system could in principle still be considered technical, but with a lower probability. It is therefore advisable to not only include features in an application related to the mere presentation of an internal state prevailing in a technical system, but to also include features related to an interaction between a user and a GUI (e.g. initiating or responding to the presentation of the internal state), such that, in worst case, at least the combination of the presented information and the interaction with the user

can be credibly argued to assist the user in properly operating the underlying technical system.

However, the revised Guidelines for Examination also state that static or predetermined information about technical properties or potential states of the machine and specifications of the device's operating instructions do not qualify as an internal state prevailing in the device. If the presentation of static or predetermined information merely has the effect of helping the user with the non-technical task preceding the technical task, it does not make a technical contribution.

The revised Guidelines for Examination also mention that information representing a state of a non-technical application run on a computer system, such as a casino game, a business process or an abstract simulation model, would constitute non-technical information exclusively aimed at the user for his subjective evaluation or non-technical decision–making and would not be directly linked to a technical task, even if ultimately states of processors or memories are modified, which seems to be taken from **T 336/14, T 1073/06, T 1704/06 and T 528/07**.

The revised Guidelines for Examination further explicitly state that features which specify a mechanism enabling user input, such as entering text, making a selection or submitting a command, is normally considered to make a technical contribution. For example, providing in a GUI an alternative graphical shortcut allowing the user to directly set different processing conditions makes a technical contribution, which the revised Guidelines for Examination seem to have taken from the slightly older but apparently still accepted decision **T 1188/04** by the Board of Appeal 3.5.01.

In a further example not discussed in the revised Guidelines for Examination, the Board of Appeal 3.5.05, which issued the decisions T 336/14 and T 1802/13, found in the above mentioned earlier decision T 407/11, related to a user calling a function in a data-processing electronic system and providing an error message to the user in response, that a technical effect can be seen if it is prevented in the data-processing electronic system that the function called up by the user is, due to his error, either not carried out at all by the system or in a way which is not wanted (**T 407/11**, reasons 2.1.4, 2.1.5).

The revised Guidelines for Examination also state that performance-oriented improvements to the detection of user input, such as allowing faster or more accurate gesture recognition or reducing the processing load of the device when performing the recognition, do make a technical contribution. However, where the actual achievement of effects (e.g. simplifying the user's actions or providing more user–convenient input functions) depends exclusively on subjective user abilities, such effects may not form the basis of an objective technical problem to be solved.

Examples: "How should it (not) be presented?"

A feature in this sub–category of presentations of information specifies a form or arrangement in which, or a timing at which, information is conveyed to the user. The revised Guidelines for Examination state that features defining a visualization of information in a particular diagram or layout would normally not be considered to make a contribution, even if the diagram or layout arguably conveys information in a way which a viewer may intuitively regarded as particular appealing, lucid or logical.

Dealing with limited available screen space would be a part of designing presentations of information for human viewing and would therefore not be an indication of a technical effect per se, according to the revised Guidelines for Examination. For example, the general idea of giving an overview of the plurality of images and the limited display area or eliminating whitespace between the window-panes would only be a matter of layout design and would not involve the technical considerations. The EPO seems to base such statements on decisions like **T 1562/11**.

However, features related to resolving conflicting technical requirements in a videogame may be technical, which is based on **T 928/03**. Also, a visual aid for a surgeon allowing the surgeon to position an implant more precisely would be considered to provide a technical effect, according to the revised Guidelines for Examination.

Furthermore, when the manner of presenting information produces in the mind of the user an effect which does not depend on psychological or other subjective factors but on biophysical parameters, which are based on human physiology and can be precisely defined, that effect would qualify as a technical effect.

The above examples show that a confirmation and a denial of a technical effect in the technological area of GUIs are quite close to each other and also appear to increasingly depend on the credibility of effects attributed to claimed features based on what is described in the application as originally filed.

Conclusions

The EPO takes a revised view on "presentations of information" and "user interfaces" in the current version of the Guidelines for Examination. When assessing inventive step of a claim which comprises a feature in which cognitive information is conveyed to a user via a GUI, in the EPO's view it has to be analysed whether the GUI, together with the content presented or the manner of presentation, *credibly* assists the user in performing a technical task by means of a continued and/or guided human-machine interaction process, which is related to "why" or "for what purpose" that information is presented.

If the cognitive content of the information presented to the user relates to an internal state prevailing in a technical system and credibly assists the user in properly operating this technical system, it should be considered providing a technical effect. In applications relating to GUIs, it is advisable to include features related to the presentation of an internal state prevailing in a technical system, features related to an interaction between a user and the GUI, and a description of credible technical effects.
The more recent decisions of the Board of Appeal 3.5.05 indicate a further concretising, or even tightening, of the criteria applied by the EPO that cognitive information conveyed to a user must fulfil in order to be treated as a technical feature and hence relevant for the assessment of the inventive step.

Decision G 1/15 by the Enlarged Board of Appeal on partial priority – Consequences, Implications and Possible Problems

Dr. G. Krobath (DE), European and German Patent Attorney

Abstract: This article discusses the decision G 1/15 on partial priority by the Enlarged Board of Appeal of the European Patent Office and points out several potentially problematic consequences of the decision, in particular concerning a possible unequal treatment of applicants, concerning the determining of a priority date of a subject-matter and concerning the novelty of a subrange of a larger range.

Overview

In the first section, the decision G 1/15 of the Enlarged Board of Appeal on partial priority and the background of the decision will be presented. In the second section, consequences, implications and possible problems resulting from this decision will be discussed.

I. The Decision G1/15

I.1 Background

The basic question which laid the ground for the decision G 1/15 of the Enlarged Board of Appeal is:

Can a claim encompassing a generic term (so-called generic "OR"-claim) which can validly claim priority only for a subset of the generic term be divided into two parts, a first part claiming the priority validly and a remaining second part not claiming the priority validly?

In the earlier decision G 2/98 of the Enlarged Board of Appeal, it was stated (Reasons point 6.7, last sentence) that:

"The use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2), second sentence, EPC is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters." (emphasis not included in the original decision)

Thus, after the decision G 2/98, the question for determining if a partial priority of a generic "OR"-claim is valid was: what is a *"limited number of clearly defined alternative subject-matters"*?

E.g., if the specific term is *"Helium"* and the generic term is *"noble gases"*, it seems clear that partial priority for the generic "OR"-claim is valid according to the decision G 2/98, since noble gases comprise *"a limited number of clearly defined alternative subject-matters"*, since there are only six noble gases in nature, i.e., a limited number, and each of them is a clearly defined alternative.

However, if a first priority application discloses a subject-matter comprising bronze and a later application claims a subject-matter comprising metal alloys, the priority is probably not valid according to the wording of the decision G 2/98 since the number of metal alloys is neither limited nor are the metal alloys clearly defined alternatives.

I.2 Toxic Divisional Application

One problem before the decision G 1/15 was the so-called „toxic divisional application". An applicant files a first non-European priority application concerning subject-matter X and then later files a second European patent application claiming subject-matter Y, wherein X is subset of Y, and subject-matter X, and claims the priority of the first application. Then, the applicant files a European divisional application based on the second application and shifts all content concerning X in the divisional application while leaving only disclosure concerning Y (without explicitly naming X, e.g., as an example) in the second application.

Now, the priority date of the divisional application is the date of filing of the first application (since it claims the pri-

ority of the first application validly) and the priority date of the second application is the date of filing of the second application (since Y cannot validly claim the priority of the first application disclosing only X unless Y encompasses *"a limited number of clearly defined alternative subject-matters"*; according to the general view before the decision G 1/15), wherein the date of filing of the second application lies after the date of filing of the first application.

Since the divisional application has an earlier priority date than the second application, the divisional application is state of the art according to Art. 54 (3) EPC for the second application (assuming that the divisional application will be published). Since the general is not novel over the specific, the claimed subject-matter Y in the second application is not novel over the divisional application, which discloses X. Thus, by filing a divisional application, one application by the applicant (divisional application disclosing X) prevents the applicant from getting a patent for a second application with a more generic claim (second application claiming Y).

I.3 Overview of the decision G 1/15

The Enlarged Board of Appeal decided in the decision G 1/15:

"Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR"-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect."

Furthermore, the Enlarged Board of Appeal stated in Reasons point 5.3 of the decision G 1/15:

"As a consequence, the proviso laid down in G 2/98, (supra, Reasons point 6.7, last sentence), cannot be construed as implying a further limitation of the right of priority."

Hence, the statement *"provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters"* in the decision G 2/98 is no condition for a partial priority to be valid, but rather a nullum.

II. Consequences, Implications and Possible Problems

The decision G 1/15 by the Enlarged Board of Appeal has many consequences. Firstly, no toxic divisional applications are existing anymore, since the subject-matter of the later application, which claims priority of a priority application, is de facto divided in two parts, a first part which is disclosed in the priority application and which claims the priority validly and a remaining second part which is not disclosed in the priority document and which does not claim the priority validly, wherein the second part is in principle novel over the first part.

Hence, in the situation discussed in section I.2, the first part of Y, which comprises X, claims the priority validly and the remaining second part of Y (i.e., Y without X) does not claim the priority validly but is novel over X, in principle.

For further discussions of the decision G 1/15, let us take a look at the following Example 1:

A first application discloses a temperature range of 10 °C – 20 °C and a later second application claims a temperature range of 10 °C – 30 °C, wherein the second application claims the priority of the first application[1].

According to the decision G 1/15, the range claimed in the second application is de facto divided in a range 10 °C – 20 °C, which claims the priority validly, and in a range of >20 °C – 30 °C, which does not claim the priority validly, but which is (mathematically) novel over the range 10 °C – 20 °C.

However, there are several problems arising out of the decision G 1/15.

II.1 Unequal Treatment of Applicants

One problem caused by the decision G 1/15 is that a first applicant submitting an application claiming subject-matter Y and a second applicant submitting an application claiming subject-matter Y are treated differently concerning Y if the first applicant can claim a priority for subject-matter X (wherein X is a subset of Y), which was disclosed in an earlier priority application.

This aspect is discussed in detail in the following on the basis of Example 2:

Applicant A1 files a first application disclosing subject-matter X and later files a second application claiming Y, wherein X is a subset of Y, and claims the priority of the first application. Applicant A2 files an application claiming Y, on the same day on which applicant A1 files the second application.

Applicant A1 has no problem claiming Y, since Y according to the decision G 1/15 is de facto conceptually divided in X (which claims the priority validly) and Y without X (which does not claim the priority validly but which is novel over X, in principle).

1 In this article, the subject-matters of the priority application and the latter application are always the same except for the differences explicitly mentioned herein

Applicant A2 does not get a patent which claims Y, since the part of the second application of applicant A1 concerning X is state of the art according to Art. 54 (3) EPC for the application of applicant A2. Hence, the claimed subject-matter Y in the application of applicant A2 is not novel over X, which is disclosed in the application of applicant A1. Applicant A2 has to draft an undisclosed disclaimer to exclude X from the subject-matter Y, so that the claimed subject-matter in the application is novel.

However, there are very stringent rules for an undisclosed disclaimer which does not violate Art. 123 (2) EPC (cf. the recent decision G 1/16 by the Enlarged Board of Appeal of December 2017). The undisclosed disclaimer may only exclude as much as is necessary for the remaining subject-matter claimed to be novel over the disclosure of the earlier document according to Art. 54 (3) EPC. If more than this is excluded by the undisclosed disclaimer, the disclaimer is a violation of Art. 123 (2) EPC and not allowable. If the undisclosed disclaimer is part of the issued patent, the applicant is caught in the Art. 123 (2) EPC / Art. 123 (3) EPC trap.

The rules for an undisclosed disclaimer are even more stringent if an explicitly disclosed embodiment is excluded by the disclaimer (e.g., applicant A2 has included an explicit embodiment in the form of X in the application).

Thus, applicant A2 has to formulate an undisclosed disclaimer with due care. If the disclaimer is too broad, the disclaimer is an inadmissible extension according to Art. 123 (2) EPC, and if the disclaimer is too narrow, the claimed subject-matter is not novel. Further, applicant A2 is always in danger of the disclaimer subsequently (after the issue of the patent) being deemed to be too broad and the patent being lost due to Art. 123 (2) and (3) EPC.

One could argue that this unequal treatment of applicant A1 and applicant A2 is appropriate since applicant A1 filed a first application with subject-matter X before and applicant A2 did not. However, this priority application for the subject-matter X should have no implications for the subject-matter Y without X, since these two subject-matters are two distinct inventions, wherein one subject-matter is novel over the other subject-matter by definition. An application with a claim encompassing the second subject-matter Y without X was submitted to the European Patent Office by each of the two applicants on the same day. Hence, for this subject-matter Y without X, there should be an equal treatment of applicant A1 and applicant A2.

If the Enlarged Board of Appeal had made a different decision in G 1/15, e.g., if it had decided that there is no partial priority in such a case or only in very limited cases, applicant A1 would have had to file the second application with an explicit OR-claim, i.e., claiming "Y without X or X", or draft an undisclosed disclaimer later, too. In this case, the disclaimer drafted by applicant A1 has to exclude (at least) X from Y, i.e., applicant A1 is in a very similar situation as applicant A2 who has to draft an undisclosed disclaimer excluding only X from Y.

However, with the decision G 1/15 as it is, there seems to be an unequal treatment of applicant A1 and applicant A2 concerning the subject-matter Y (without X), since applicant A2 has to draft an undisclosed disclaimer and is in danger of losing his patent while applicant A1 is not in this danger.

II.2 Determining the Priority Date of a Specific Subject-Matter Can Be Difficult

The determining of the priority date for a specific subject-matter can be difficult after the decision G 1/15. Before the decision G 1/15, the situation was clearer since the priority was only valid in connection with ranges if the same exact range was claimed in the later application which was disclosed in the earlier application. Now, according to the decision G 1/15, ranges can de facto conceptually be divided into many different subranges without any of the subranges having to be explicitly claimed in the later application. Thus, the number of subranges can in principle be unlimited, since the number of priority applications of which priority is claimed by an application is unlimited.

The determining of the priority date can become even more difficult, e.g., if the subject-matter is an alloy comprising ten or fifty different compounds.

The Enlarged Board of Appeal has considered this problem in the decision, but stated in Reasons point 6.6 of the decision G 1/15 concisely:

"The task of determining what is the relevant disclosure of the priority document taken as a whole, and whether that subject-matter is encompassed by the claim in the subsequent application, is common practice in the EPO and among practitioners of the European patent system and as such should not pose any additional difficulty. Nor does it create uncertainty for third parties, as argued by the respondent and in some amicus curiae briefs. Although it can be a demanding intellectual exercise, the decisions reached in cases T 665/00, T 135/01, T 571/10 and T 1222/11 all show that it can be carried out without any need for additional tests or steps."

However, e.g., in the case of ten priority documents and an alloy comprising ten different compounds, wherein the priority documents encompass many different ranges, respectively, the task of determining the priority date of a specific alloy can be more than a demanding intellectual exercise; it can create legal uncertainty.

This applies even more to the following Example 3, also briefly mentioned in the decision G 1/15:

The first application discloses a subject-matter with a value of "ca. ½" while the later second application claims a subject-matter with the range of "¼ to ¾" claiming the priority of the first application.

According to the decision G 1/15, the range "¼ to ¾" is de facto conceptually divided into the subrange "¼ up to ca. ½" claiming the priority not validly, the value "ca. ½" claiming the priority validly and the subrange "larger than ca. ½ to ¾" claiming the priority not validly.

Several problems arise from this de facto dividing of the range into several subranges: is the priority date of the subject-matter with the value "0.55" the date of filing of the first application or of the second application; i.e., is the value "0.55" still covered by "ca. ½" or does the value "0.55" lie in the range "larger than ca. ½ to ¾", wherein the range "larger than ca. ½ to ¾" cannot claim the priority validly?

How far the value "ca. ½" extends is unclear and creates legal uncertainty. Before the decision G 1/15, the priority would not have been valid (according to general view) since the value "ca. ½" is not explicitly claimed in the subject-matter of the later application and, thus, the priority date of the subject-matter with the value "0.55" would have been the date of filing of the later second application.

II.3 Margin of Uncertainty/Error Margin

One further consequence of the decision G 1/15 is – as discussed above – that a range which is claimed in a later application, wherein the later application claims the priority of an earlier application, is de facto divided into subranges which do not have to be explicitly claimed in the later application. The subranges of the larger range, wherein one subrange claims the priority validly and the other subrange does not claim the priority validly, are immediately adjacent to each other, i.e., for moving from one subrange to the immediate adjacent subrange only an infinitesimal change of the respective value is necessary.

Let us take another look at Example 1, wherein the range disclosed in the first priority application is 10 °C – 20 °C and the later second application, which claims priority of the first application, claims the range 10 °C – 30 °C. According to the decision G 1/15, the subrange 10 °C – 20 °C claims the priority validly, while the subrange >20 °C – 30 °C does not claim the priority validly but is (mathematically) novel over the range 10 °C – 20 °C.

However, every physical value has a margin of uncertainty or error margin. Does the range up to 20 °C (i.e., including exactly 20 °C) not also include a value above 20 °C due to the margin of uncertainty/error margin and is the subrange starting exactly above 20 °C novel over the range ending at 20 °C?

There is at least one decision of the Boards of Appeal discussing this aspect, viz T 0594/01. The relevant discussion can be found in Reasons points 4.1.5 to 4.1.7 (emphases not in the original):

"4.1.5. Furthermore, although the Board concurs with the Appellant that only an unambiguous disclosure may be considered in assessing novelty, it remains the case that any technical information is addressed to a skilled reader. In that context, it must be pointed out that it is common general knowledge, as shown by document (10) on page 46, ***that every experimental measurement in quantitative analytical chemistry as well as any result of any physical measurement cannot be dissociated from the margin of uncertainty attached to the measurement****. Normally, the uncertainty of a measured experimental value is irrelevant for the assessment of novelty. However, when a specific experimental value is disclosed in an example of the prior art, seeking to distinguish the claimed subject-matter therefrom only in terms of an upper limit required to be "lower than" the experimental value must fail as the claimed subject-matter is still not distinguishable from the prior art within the margin of experimental error.*

4.1.6. Therefore, the carbon dioxide concentration range defined in Claim 1 of each request, ***i.e. lower than 0.1 wt%, does not distinguish it from the experimental carbon dioxide concentration value, i.e. 0.1 wt%****, disclosed in Example No. 4 of document (1).*

4.1.7. For these reasons, the subject-matter of Claim 1 of the main and first auxiliary requests ***lacks novelty*** *in view of document (1)."*

Thus, according to this decision, the range lower than 0.1 wt% does not distinguish itself from the physical value 0.1 wt% and is not novel over the value 0.1 wt%.

Hence, when the later second application claims the range of 10 °C – 30 °C, how does the range >20 °C – 30 °C distinguish itself from the value 20 °C, which is disclosed in the first priority application as an end value of the subrange? The value 20 °C as an end value of the range 10 °C – 20 °C is not *"a specific experimental value"* as in the case of the decision T 0594/01, but every experimental measurement and, hence, every physical value has a margin of uncertainty.

Furthermore, when a value is given as 20 °C, it comprises the values from 19.5 °C to 20.4 °C (due to the normal rules of error margins/rounding according to the Guidelines for Examination in the European Patent Office section G-VI 8.1). Hence, the question arises if the range 10 °C – 20 °C also comprises values up to 20.4 °C and one wonders how a range >20 °C to 30 °C can be novel over a range/value which includes 20.4 °C?

The "test" for determining what is disclosed in an application concerning priority is the same "test" as for determining novelty (cf. the decisions G 1/03 and G 2/10). Hence, usually, when a subject-matter is not novel over a document, the subject-matter can claim the priority validly.

If the range starting at >20 °C does not distinguish itself from the value 20 °C (cf. the decision T 0594/01 cited above) and, thus, is not novel over 20 °C, can a part of the range >20 °C validly claim the priority and if so up to what value? What is the situation if the temperature of 20 °C is given as a "specific experimental value" in the priority document?

So, in Example 1, when the value 20 °C is disclosed as *"a specific experimental value"* the question is: is the border which divides the claimed range 10 °C – 30 °C into two subranges, wherein one subrange on one side of the border claims the priority validly and the other subrange on the other side of the border does not claim the priority validly according to the decision G 1/15, at 20.4 °C, since the value 20 °C comprises values from 19.5 °C to 20.4 °C (according to normal rounding rules and the Guidelines for Examination in the European Patent Office section G-VI 8.1)? Or is the value dividing the two subranges even higher than 20.4 °C?

Does not the same problem pose itself at this border of 20.4 °C? I.e., if 20.4 °C as an end value is disclosed in the first priority application, does the range starting at larger than 20.4 °C distinguish itself from the value 20.4 °C of the first priority application due to margin of uncertainty in view of the decision T 0594/01 cited above?

In particular, what is the situation if the first priority application discloses 20.4 °C as a "specific experimental value"?

Wherever one puts the border between the subrange of a larger range which claims the priority validly and the subrange of the larger range which does not claim the priority validly, the difference between the two subranges is infinitesimal, and, thus, it raises the question if the one subrange distinguishes itself from the end value of the other subrange, i.e., if the one subrange is novel over the other subrange, considering the ever existing margin of uncertainty of every physical value.

This problem is enhanced since –typically– a specific way to measure temperature does not have to be disclosed in the application to enable the subject-matter to be carried out by the person skilled in the art. However, a temperature of 20.4000 °C measured with one method (e.g., an alcohol thermometer), i.e., a value within the range 10 °C – 20 °C of the first priority application (considering the rules of rounding according to the Guidelines for Examination in the European Patent Office section G-VI 8.1), may be measured to be 20.4001 °C with another method (e.g., an infrared measuring device), i.e., a value larger than 20 °C and in the range ">20 °C to 30 °C" (even when considering the rules of rounding according to the Guidelines for Examination in the European Patent Office section G-VI 8.1) and, thus, not within the range claiming the priority validly. Hence, a value given as 20 °C can be within the range claiming the priority validly with one measuring method and outside of the range claiming the priority validly with another measuring method.

So, the question remains: where is the border which divides a range into two subranges, wherein one subrange claims the priority validly while the other subrange does not claim the priority validly? And, does the one subrange distinguish itself from the other subrange when considering the error margin?

In the decision G 1/15, the Enlarged Board of Appeal has not considered the rules of rounding nor the ever existing margin of uncertainty of physical values, at least the decision does not address any of the subjects.

These problems can cause legal uncertainty, since determining the priority date of a subject-matter with a specific value can be relevant in determining if a specific publication is state of the art for a specific value of a range claimed in the later application.

III. Summary

The decision G 1/15 has "solved" the problem of toxic divisional applications by allowing partial priority without requiring explicit claiming but has created some new problems. These new problems can lead to an unequal treatment of applicants and can cause legal uncertainty in determining the priority date of a specific subject-matter. It remains to be seen if causing the problems outlined in this article and the corresponding legal uncertainties outweigh the benefits of the "extinction" of toxic divisional applications.

Zusammenfassung
Dieser Artikel diskutiert die Entscheidung G 1/15 bezüglich Teilpriorität der Großen Beschwerdekammer des Europäischen Patentamts und macht auf einige möglicherweise problematische Konsequenzen der Entscheidung aufmerksam, insbesondere bezüglich einer möglichen Ungleichbehandlung von Anmeldern, bezüglich des Bestimmens eines Zeitrangs eines Gegenstands und bezüglich der Neuheit eines Unterbereichs eines größeren Bereichs.

Résumé
Cet article traite de la décision G 1/15 concernant la priorité partielle de la Grande Chambre de recours de l´office européen des brevets et indique quelques conséquences problématiques possibles de la décision, en particulier concernant un traitement inégal possible des demandeurs, concernant la détermination de la date de la demande antérieure et concernant la nouveauté d´un domaine partiel d´un domaine plus grand.

Everything You Always Wanted To Know About The Problem-Solution Approach But Were Afraid To Ask

by M. M. Fischer (DE), European and German Patent Attorney

Even though European Patent Attorneys are expected to be well-versed in the correct application of the problem-solution approach, there are still questions which put even experienced practitioners on the spot, are not so easy to answer or have not yet been addressed by the Boards of Appeal. Following the maxim "If you do not ask you will never know", this article presents a compilation of ten questions on the problem-solution approach and proposes answers mostly based on recently published articles, case law decisions and the author`s own experience in European patent law.

1. Who selects the closest prior art? And why?

One answer is given in the recent decision **T 855/15**: "It is irrelevant for the question of inventive step whether or not the "skilled person would [...] select" a piece of prior art "as a starting point to arrive at the invention". Article 56 EPC requires the assessment of whether an invention would be obvious to the skilled person "having regard to the state of the art". For this assessment, the deciding body will select one or more documents for consideration. However, no argument is required as to whether the skilled person would select a document. In fact, the board considers that a consideration of what the skilled person would do, in particular whether the skilled person "would select" a document, in order "to arrive at the invention as claimed" would amount to hindsight reasoning, because the skilled person would have to be assumed to know the invention before an argument could be made as to what he would do in order "to arrive at" it."

Another answer is given by Dai Rees: "The skilled person picks a piece of prior art, recognizes a problem with it and, with the help of his common general knowledge (CGK) and/or a specific other piece of prior art but without any additional spark of invention, solves it, arriving at the claimed subject-matter. A major problem with this story is the question: why did the skilled person choose this piece of prior art to begin with? One thing we clearly cannot do is argue that he chose it because it was the closest prior art. If he knew it was the closest prior art he would also already know what the invention was, and that is one thing which is certainly not allowed. (Note that this is explicitly excluded in the English "Pozzoli" guidance.) It does not really help to say that he is given the piece of prior art to read; all that means is that someone else has to choose it, so then we have to specify both who and why! So all we can say is that he chooses this particular starting point because he can; it is simply one of the many prior art documents he might choose to start from. But this is not satisfactory; surely the skilled person, given a free choice, would choose as his starting point something which was most promising as a basis for development, any development. [...] The problem and solution approach... does not actually introduce a skilled person until the last step. This introduces the possibility of a different interpretation of the approach which, I believe, fits the story-telling view better. It can be called the "multiverse" scenario. In this story instead of starting with the skilled person we start with a piece of prior art, any "feasible" piece of prior art. Which means there is not one possible story, but very many, in principle at least one for each piece of prior art. Of course, some stories will turn out to be plausible and some not. What about the skilled person? In this scenario the skilled person is determined not by the claimed invention but by the prior art. It can be posited that every piece of prior art has its own corresponding skilled person, a person who knows about that particular piece of prior art. "[1]

2. Are all features of the claim equally important in the selection of the closest prior art?

No. It follows from the case law that the number of features in common may be a secondary criterion but is not the decisive criterion (see e.g. point 3.9 of the reasons of **T 698/10**). There are typically features in a claim which define the subject-matter globally and others which define the subject-matter locally. A global feature would e.g. relate to the type (in German also "Gattung") of the claimed subject-matter. For example, the feature "wherein the screen is a flat screen" (in contrast to a cathode ray tube screen) could be considered as a global feature since it defines the screen as a whole (here in terms of the technology used), while a feature such as "wherein the screen has a main switch" could be considered as a local feature since it does not define the screen as a whole but only a (small, local) item of the screen which does not have influence on the screen as a whole. The global features should be anticipated by the closest prior art. The first words of an apparatus claim are often global features since they define the sort of

1 Rees, D. "Inventive Step: The Stories We Tell", p.9-10, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2952332

subject-matter that is claimed. For example, a record cannot be used as the closest prior art for a claim starting with "A digital data carrier…". Although the distinction between global and local features has no basis in the case law, it often correlates with the idea of "same purpose" or "same type" and is applicable and helpful in many cases.

In **T 334/10** it was held that in medical use claims relating to a medical use of a compound the closest prior art can only be a document D38 which deals with the same or similar therapeutic use even if there is another prior art document D2 that shows a compound that is structurally closer to the claimed compound than the one of document D38 but does not show any therapeutic use of the compound in general or the claimed therapeutic use in particular.

T 1248/13 deals with "a casing for warhead components, characterized in that the casing is made up of a laser sintered material, wherein the laser sintered material comprises polymer particles and aluminium or magnesium powder".

The Board argued that the fact that D4 does not disclose a casing for a warhead disqualifies said document as starting point for the problem-solution approach.[2]

By the way, the application of the problem-solution approach in stages with the first stage to be the selection of the closest prior art was confirmed by the Enlarged Board of Appeal in **R 3/15** in which the Opponents argued that their right to be heard was violated because they were not allowed to present a complete line of argumentation against inventive step using the problem-solution approach starting from D1, while the Board of Appeal considered D1 to be an unrealistic starting point and considered D2 to be the closest prior art.

The Enlarged Board confirmed the appropriateness of the Board of Appeal`s conduct of the proceedings by stating: "In the present case, the Board considered that the case could be decided in respect of the issue of inventive step by systematically applying the problem-solution approach stage by stage. Thus, it systematically limited its decision-making and accordingly the discussion with the parties to determining the closest prior art first, before discussing the other aspects of the inventive step of the subject-matter claimed according to the patent proprietor's first auxiliary request."

3. In which way is the purpose mentioned in the description of the application important for the selection of the closest prior art?

In **T 2255/10** it was held that in establishing the closest prior art, the determination of the purpose of the invention is not to be made on the basis of a subjective selection from among statements of purpose which may be set out in the description of the application, without any reference to the invention as defined in the claims. On the contrary, the question to be asked is, what, in the light of the application as a whole, would be achieved by the invention as claimed.

For this reason, statements of purpose must be read in conjunction with the claims. Merely inserting such a statement into the description does not entitle an applicant effectively to "veto" any inventive step objection based on a document which is unrelated to this purpose, if it is not plausible that the invention as claimed would actually achieve the stated purpose.

4. What is the common general knowledge (CGK), how does it differ from the rest of prior art and what else should I know about it?

The term "common general knowledge" is not used in the EPC. However it is inextricably linked to the notion of a skilled person that is used both in Art. 56 EPC and Art 83 EPC.[3] Common general knowledge is knowledge which the skilled person has at its immediate disposal (**T 206/83**), either because he knows it or is aware of the place where to find it. (One should not forget that, similar to CGK, the skilled person also has at his disposal the means and capacity for routine work and experimentation (Guidelines G-VII, 3).)

"According to **T 1464/05** reason 5.2.2, the skilled person *knows all* the prior art (at least in the relevant field). I do not find this an appealing explanation for two reasons: (i) it again turns the skilled person into something which is clearly not a realistic person whose motivation one can reasonably judge; and (ii) it fails to distinguish between the CGK and all the rest of the prior art, although these are clearly treated differently when assessing how the skilled person would use them. While it seems reasonable to require that the skilled person *has access* to all the prior art, a fiction necessitated by the requirement of Art. 54 (2) EPC that all pieces of prior art have equal status, this does not mean that the skilled person must *know the content of* all the prior art."[4]

2 In the assessment of novelty, the Board made the following noteworthy remark: "The question for assessing the criteria of novelty is not as much if the product achieved in D4 is "not unsuitable" [for a warhead component] but if the skilled person working in the field of casings for warheads would consider said sintered product to be obviously and directly suitable for such an application."

3 It should be noted that (the skilled person and his) CGK is also used in the assessment of novelty (Art. 54 EPC) for curing insufficiency of a prior art disclosure, in the assessment of added matter (Art. 123(2) EPC) and CGK also determines whether or not an error in an application can be corrected under R. 139 EPC, although neither Art. 123 (2) EPC, Art. 54 EPC nor R. 139 EPC explicitly mention the skilled person.

4 Rees D., "Inventive Step: The Stories We Tell", p. 10-11, weblink see above

That means the CGK is the mental furniture of the skilled person, the knowledge that the skilled person has at hand. The main difference between the CGK and the rest of the prior art is that it is normally obvious to combine a document with the CGK (see Guidelines G-VII, 6 (iii).). Hence, using common general knowledge as a secondary prior art in the problem-solution approach usually requires a bit less argumentation compared to using a normal publication, e.g. it needs hardly to be argued why such content would be consulted. As an analogy, if two prior art documents are considered to be two tiles, then the CGK may be considered to be the grout that sticks to them (=no incentive needed) and helps to fill the small gap that is needed to arrive at the claimed invention.

As another analogy from the world of computers, if the skilled person were a computer, then the CGK would be everything that is stored in his main memory (or that can be quickly load onto his main memory) that is quickly accessible, while all the rest of the prior art is stored on a harddisk that he carries with him but to which he has only slower access. He also needs an incentive to search for something on the harddisk and transfer it into the main memory.

Another difference between the CGK and the rest of the prior art is that if it is argued that prejudice exists that diverted the skilled man away from the alleged invention (which may be an indication for the presence of an inventive step in relation to an invention that rejects the prejudice), then this prejudice must be derivable from the CGK to reflect the common thinking in the relevant technical field. "A prior patent stating that a claimed invention is not realizable does not create a prejudice (**T 206/83**). Such a statement expressed in a patent is regarded as not being the expression of general opinion and is no proof of an existing prejudice because the specification of the prior art patent may be based on special premises or on the view of the drafter (**T 19/81**)."

Incidentally, technical standards may be treated in a similar manner as common general knowledge. In **T 519/12** it was held that it is expected from the skilled person that he would exercise his skills in the framework of technical standards in force in his field of activity. No inventive activity can thus be derived from a feature that simply reflects the content of such a technical prescription (see point 3.5).

Finally, attention is drawn to decision **T 1090/12** in which the Board of Appeal used the CGK to invalidate a claim but seems to abstain from providing proof of this CGK. This appears to be in contradiction with Case Law Book (8th edition, July 2016), section I.C.2.5 "Proof of common general knowledge: where an assertion that something is common general knowledge is challenged, the person making the assertion must provide proof that the subject-matter in question is in fact CGK (**T 438/97, T 329/04, T 941/04, T 690/06**)." In the current case, the board however seemed to be of the opinion that the situation is different if the board itself uses CGK to invalidate a claim.

5. Does CGK have a territorial dimension?

This question was answered in the negative in **T 426/88**. The appellant had argued that a book, written in German, was not a general reference book consulted by experts in that field in Great Britain. The board, however, adhered to the definition of the state of the art given in Art. 54 EPC 1973, according to which no account was taken of the location at which the skilled person exercised his profession. This is in contrast to jurisdiction from the UK: "The reason for this is that, whether one is concerned with the validity of a European Patent (UK), or a UK patent, one is concerned with a right in respect of the UK. It is true that the prior art may have been published anywhere in the world, but I do not think that alters the need for the skilled team to consider that art as if they were located in the UK. I do not think it matters that a fact was common general knowledge in (say) China, if it was not common general knowledge here. The position may be different if all the persons skilled in a particular art in the UK are acquainted with the position in China, but no point of that kind arises here."[5] Australia removed the territorial limitation of CGK in 2013.[6]

6. Can a prior use be a secondary prior art disclosing the solution to the objective technical problem?

The author is not aware of any decision of the Boards of Appeal in which a prior use has been accepted as a secondary prior art containing the solution to the objective technical problem. A prior use can normally only be used as closest prior art (e.g. T 1464/05). The reason is that following the could-would approach there should be an incentive in the prior art as a whole that would have prompted the skilled person to apply the solution to the closest prior art. This incentive is typically found in a secondary prior art document that supplies the solution to the objective technical problem. However, a prior use is not a written teaching but only exists as such (e.g. as a publicly available apparatus) without any written incentive or hint that would for example show the skilled person that it solves the objective technical problem.[7]

(By contrast, common general knowledge is often used as a secondary prior art disclosing a solution to the objective technical problem. However, in **T 1756/14** common general knowledge was taken as the closest prior art.)

5 Arnold J in Generics (UK) Ltd (t/a Mylan) v Warner-Lambert Company LLC [2015] EWHC 2548.
6 https://www.dennemeyer.com/insights/overview/news/164-update-on-the-ip-reform-in-australia-raising-the-bar/
7 Chandler/Meinders, "C-Book", 3rd edition, Carl Heymanns Verlag, 2010, p.77

7. When is the objective technical problem formulated as "providing an alternative solution"?

If the objective technical problem determined in the problem-solution approach is already solved in the closest prior art, then the problem itself does not have to be reformulated but can be considered to find an alternative solution to this problem (**T 92/92, T 495/91**). While it is often readily apparent in mechanical cases whether or not a technical effect is achieved (= objective technical problem is solved) by the claimed invention, this may not be the case in chemistry cases unless the patent application (or other evidence submitted by the applicant) makes it plausible that the technical effect is indeed achieved. In this case, the technical effect and hence the objective technical problem has to be reformulated, for example as a less ambitious problem (**T 20/81**). However, in many cases if no particular technical effect can be derived, one will end up again with having to reformulate the problem as to provide an alternative. However, experience shows that the problem "providing an alternative solution" often (not always) leads to the conclusion that the claimed invention is considered to be obvious. (If one solution is already known, then it may be obvious for the skilled person to substitute it with an (equivalent) alternative solution, for example based on his common general knowledge.) To mention a counterexample, a case in which an argumentation based on an "alternative solution" was successful is **T 478/10**.

8. Does the skilled person, in the assessment of obviousness, perform a search in order to find a secondary prior art or is he given the secondary prior art?

This question goes back to Derk Visser in the 24th edition of "The Annotated European Patent Convention": "In the third stage of the problem and solution approach an assessment is made whether or not the solution of the problem is obvious for the skilled person. The assessment depends on the precise question that is being asked. There are two possible questions.

The first question that could be asked is: would a development by the skilled person starting from the closest prior art and guided by the problem to be solved result in the claimed invention? If yes, the invention is obvious. The skilled person must develop the closest prior art, which involves a prior art search for a solution of the problem. There are three issues with the first question. The first one is that there are usually many ways in which a problem can be solved. It is therefore a matter of chance that the search of the skilled person will result in the invention. The second issue is that the Guidelines and case law do not mention a search in the third stage. The third issue would give rise to arguments for and against finding the relevant prior art. However, such arguments are not addressed in the Guidelines. Rather, the Guidelines merely discuss whether or not a combination of certain prior art is obvious.

The second question is: is the solution, i.e. the combination of prior art that together disclose the features of the invention and found during the search under Art. 92, obvious for a skilled person in view of the problem of the closest prior art to be solved? The solution found during the search is presented to the skilled person and the question is whether the combination of prior art in the solution is obvious for him in view of the problem. If yes, the invention is obvious. An issue with this question is that it involves more hindsight than the first question. In the second question the complete solution is presented to the skilled person. In the first question only the closest prior art and the problem are given to the skilled person. Another important difference with the first question is that no search is carried out in the third stage of the problem and solution approach.

The Guidelines and case law do not explicitly state which question should be asked. However, section I.D.5 of the Case Law of the Boards of Appeal appears to imply that the second question is the correct one. The second question is also consistent with the procedure followed by EPO examiners during the assessment of inventive step."[8]

The author of this article has to admit that he assumed the first question to be the correct one.[9] The author interprets the sentence: "Once the problem has been recognised, a search through the prior art for solutions seems fairly plausible;"[10] to be in line with the first question.

Moreover, it appears that each question defines "the solution" differently. With regard to the first question, the solution seems to be the teaching which solves that objective technical problem and is disclosed in a further prior art item. With regard to the second question, the solution seems to be the combination of the closest prior art with a further prior art item that together disclose the features of the invention. Neither the case law nor the Guidelines seem to give a clear definition of what is meant by "the solution".

Regarding the third issue of the first question, it is methodologically not clear from the Guidelines whether the test for obviousness and the could-would approach is the same and which arguments can be put forward under the could-would approach? It appears that the could-would approach only addresses the question whether there is an incentive in the prior art as a whole that would prompt the skilled person to apply a further

8 Visser, D., "The Annotated European Patent Convention", 24th edition, H. Tel Publisher B.V., 2016, p.118
9 "Problem and solution approach: Basic case law and recent development (Part II)" – EPI Information 4/2016
10 Rees, D. "Inventive Step: The Stories We Tell", p.11, weblink see above

teaching to the closest prior art.[11] (A lack of "insurmountable difficulties" to apply a second teaching to the closest prior art is not enough to acknowledge an inventive step (**T 142/84**)). But is the fact that a secondary prior art is from a remote technical field that the skilled person would not find/read it also examined under the could-would approach? The Guidelines discuss the latter under the abilities of the skilled person at G-VII, 3, while the could-would approach is explained at G-VII, 5.3. However, contrary to the Pozzoli approach applied in the UK, the determination of the abilities of the skilled person is not an explicit extra stage of the problem-solution approach. It is also not clear whether technical incompatibilities or teaching-aways should also be examined under the could-would approach.

The question remains whether the two questions will effectively lead to a different outcome of the assessment of inventive step. Or is the difference merely a stylistic one which teaches us that arguments for or against obviousness should be presented in line with the second question (if it is indeed the correct one), i.e. try to avoid terms as "search" or "find" in the argumentation of the could-would approach?

9. Are problem inventions often acknowledged by the Boards of Appeal?

No. The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious. Problem inventions are rarely acknowledged by the Boards of Appeal (**T 2/83, T 225/84, T 540/93, T 135/94, T 1263/03**). The latest decision in which a problem invention was acknowledged is **T 764/12** in which the technical contribution of the patent in suit resided in identifying a problem which was hitherto not recognised in the prior art, namely the need for protection during storage at ambient environmental conditions of a chewing gum base comprising environmentally degradable polymers. The arguments of the opponent that the claimed invention lacked inventive step because coating was well known to reduce degradation over time were not relevant.

10. Is it possible to change the closest prior art in an appeal?

Yes, but you have to provide arguments why you think that the closest prior art in the appealed decision is incorrect and why another document should be selected instead. Otherwise the appeal will be inadmissible. In **T 1649/10**, the Opposition Division denied patentability of the Main Request based on a document D10 as the closest prior art and then the teaching of D4 that suggested the use of the missing feature (a scatterer). The patent was maintained in amended form based on an auxiliary request. The opponent (appellant I) and the proprietor (appellant II) appealed. The Board of Appeal decided that the appeal of appellant II was inadmissible because in the statements of grounds it was argued that there was inventive step when taking D4 as the closest prior art in view of D10. The Board decided that such simple 'turning around' of the closest prior art is not allowed. Importantly, appellant II did not provide arguments why D4 should be considered as the closest prior art in the statements of grounds, which would have made the appeal admissible.

In **T 55/11**, appellant I swapped the closest prior art for the first time at the appeal oral proceedings (from D1 in combination with D13 to D13 in combination with D1). Appellant II requested that this new argument should not be admitted into the appeal proceedings. The board, in the exercise of its discretion, decided to admit the new arguments put forward by appellant I since D1 and D13 were both before the opposition division and had been extensively discussed throughout the proceedings. In addition, the combination of D13 with D1 compared to D1 with D13 does not change the inventive step argument in terms of technical features and problem to be solved. In addition this new argument is not incompatible with, or contradictory to, appellant I or II's previous case, nor does it raise any complex issues.

Any feedback is welcome. Please send it to:
michaelfischer1978@web.de

11 On the other hand, the could-would approach explicitly mentions the skilled person so that it should be the right place to discuss the skilled person`s abilities.

Next Board and Council Meetings

Board Meetings

100th Board Meeting in Malta (MT) on 13 April 2018

Council Meetings

84th Council Meeting in Malta (MT) on 14 April 2018
85th Council Meeting in Helsinki (FI) on 10 November 2018

Fristsetzung bei vom Europäischen Patentamt zu bestimmenden Fristen

by L. Walder-Hartmann (DE)

Abstract
Rule 70(2) of the Implementing Regulations of the European Patent Convention and other rules of the Implementing Regulations provide for a period to be specified by the European Patent Office. The European Patent Office uses different relevant events triggering the running of the specified period. In the author's view, the EPO cannot determine the relevant event. In all cases of a period to be specified, it follows from the European Patent Convention that the relevant event is notification. Heeding this, the manner of setting time limits becomes uniform, bringing about advantages for both the applicant and the European Patent Office. The practical relevance is high due to the multitude of cases affected.

Zusammenfassung
Regel 70(2) der Ausführungsordnung des Europäischen Patentübereinkommens sowie weitere Regeln der Ausführungsordnung sehen eine vom Europäischen Patentamt zu bestimmende Frist vor. Vom Europäischen Patentamt werden hierbei verschiedene fristauslösende Ereignisse herangezogen. Nach hier vertretener Auffassung kann das Europäische Patentamt das fristauslösende Ereignis nicht selbst bestimmen. Vielmehr ergibt sich aus dem Europäischen Patentübereinkommen, dass bei allen zu bestimmenden Fristen die Zustellung das fristauslösende Ereignis ist. Hierdurch wird die Fristsetzung einheitlich, was sowohl Vorteile für die Anmelder als auch für das Europäische Patentamt hat. Bei der großen Vielzahl betroffener Fälle ist die praktische Relevanz hoch.

I. Einleitung

Regel 70(2) des Europäischen Patentübereinkommens (EPÜ) bestimmt für den Fall, dass Prüfungsantrag vor der Übermittlung des europäischen Recherchenberichts (ESR) gestellt wurde, dass das Europäische Patentamt (EPA) den Anmelder auffordert, innerhalb einer zu bestimmenden Frist zu erklären, ob er die Anmeldung aufrechterhält.

Für europäische Patentanmeldungen, die direkt beim EPA eingereicht wurden (EP- Direktanmeldungen), schickt das EPA eine Mitteilung nach Regel 70(2) EPÜ auf dem Formular 1082. Auf diesem Formular ist das Datum angegeben, an dem im europäischen Patentblatt auf die Veröffentlichung des Recherchenberichts hingewiesen wird, und der Anmelder wird aufgefordert, innerhalb von sechs Monaten nach diesem Veröffentlichungsdatum zu erklären, ob er die Anmeldung aufrechterhält.

Diese Verwaltungspraxis des EPA wird seit langer Zeit angewandt, ist jedoch nach Auffassung des Autors nicht EPÜ-konform. Stattdessen müsste, wie auch in allen anderen Fällen, in denen das EPÜ eine vom EPA zu bestimmende Frist vorsieht[1], eine Fristdauer in Monaten[2] ab der Zustellung der betreffenden Mitteilung gesetzt werden.

Die nachfolgende Erörterung wird am Beispiel der Regel 70(2) EPÜ ausgeführt, gilt jedoch gleichermaßen für alle Vorschriften des EPÜ, die auf eine vom EPA zu bestimmende Frist abstellen.

II. Auslegung der Regel 70(2) EPÜ

Für die Methodik der Auslegung des EPÜ sind die Artikel 31 bis 33 des Wiener Übereinkommens über das Recht der Verträge (WÜRV) einschlägig[3]. Artikel 31(1) WÜRV hebt die grammatikalische, systematische und teleologische Auslegung hervor. Nach Artikel 32 WÜRV kommt die historische Auslegung nachrangig zur Anwendung.

Die grammatikalische Auslegung von Regel 70(2) EPÜ allein ist unergiebig, da der Begriff der zu bestimmenden Frist nur im Kontext, d.h. der Systematik des Fristenregimes des EPÜ zu verstehen ist.

1. Systematische Auslegung

a. Vorbemerkung zum Begriff der Frist nach dem EPÜ

Artikel 120 EPÜ bildet den Ausgangspunkt für die Fristenregelungen des EPÜ (vgl. Art. 164(2) EPÜ). Aus Artikel 120 EPÜ geht hervor, dass eine Frist eine Dauer hat (Art. 120 c) EPÜ) und auf bestimmte Art zu berechnen ist (Art. 120 b) EPÜ). Der Ausführungsordnung ist hierzu zu entnehmen,

1 Regeln R. 3(3), R. 5, R. 50(3), R. 53(3), R. 59, R. 60(2), R. 70(2), R. 70a(2) (durch Verweis), R. 71(1), R. 77(2), R. 79(1), R. 79(3), R. 81(2), R. 94, R. 95(2), R. 100(2), R. 101(2), R. 108(2), R. 118(2), R. 151(2), R. 152(2) EPÜ.
2 Zwischen zwei und sechs Monaten; vgl. Regel 132(2) EPÜ.
3 Zwar unterliegt das EPÜ formal nicht dem WÜRV, da es früher geschlossen wurde, aber das WÜRV wird dennoch angewendet; siehe G 1/83, G 5/83, G 6/83, jeweils Nr. 3 und 4 der Entscheidungsgründe.

dass eine Frist einen Fristbeginn hat. Der Fristbeginn ist ein Tag, der durch den Eintritt eines Ereignisses (fristauslösendes Ereignis) festgelegt ist. Ein solches Ereignis kann eine Handlung sein, z.B. die Zustellung eines Schriftstücks, d.h. der Zugang des Schriftstücks beim Empfänger (Regel 131 (2) EPÜ).

Die Bestimmung des Fristendes aus dem Fristbeginn und der Fristdauer wird als Fristberechnung bezeichnet. Bei der Fristberechnung ist mit dem Tag nach dem Fristbeginn zu beginnen, d.h. mit dem Tag, der auf den Tag folgt, an dem das Ereignis eingetreten ist, aufgrund dessen der Fristbeginn festgelegt wurde (Regel 131(2) EPÜ). Die Fristdauer ist kalendarisch hinzuzuzählen und ggf. automatisch zu verlängern (Regel 134 EPÜ). Weitere Einzelheiten zum Fristende enthält Regel 131 (3)-(5) EPÜ.[4]

Zu bemerken ist, dass eine Frist zwar im Voraus festgelegt wird, d.h. zumindest bestimmbar ist, aber erst durch tatsächliche Umstände ausgelöst wird, nämlich den Eintritt des fristauslösenden Ereignisses. Während das EPÜ das fristauslösende Ereignis festlegen kann, d.h. die Bedingung für einen Fristbeginn, ist der Fristbeginn selbst ein konkretes Datum, das sich für den Einzelfall aus der tatsächlichen Lage der Dinge ergibt.

Nach dem EPÜ gibt es ein und nur ein fristauslösendes Ereignis für jede Frist (Regel 131(2) EPÜ: „Tag…, an dem das Ereignis eingetreten ist, aufgrund dessen der Fristbeginn festgelegt wird"). Liegen die entsprechenden Umstände im konkreten Fall tatsächlich vor, d.h. ist das eine, fristauslösende Ereignis eingetreten, dann beginnt die Frist unbedingt und unausweichlich zu laufen.

Das EPÜ unterscheidet zwei Kategorien von Fristen, bzw. von Fristsetzungen. Zum einen gibt es Fristen, die durch das EPÜ festgelegt sind (Art. 120 a) EPÜ), und zum anderen 'vom Europäischen Patentamt zu bestimmende Fristen' (Artikel 120 c) EPÜ). Ein Beispiel für die erste Kategorie ist die Fristenregelung nach Regel 70(1) EPÜ, während Regel 70(2) EPÜ in die zweite Kategorie fällt.

b. Der Begriff der 'zu bestimmenden Frist'

Der Begriff der vom EPA 'zu bestimmenden Frist' kommt nicht nur in Regel 70(2) EPÜ, sondern in vielen weiteren Regeln der Ausführungsordnung des EPÜ vor.[5] Er ist durch das ganze EPÜ hindurch einheitlich zu verstehen, denn es ist mangels gegenteiligen Anzeichens anzunehmen, dass der Gesetzgeber bei der Verwendung desselben Begriffs in verschiedenen Normen stets dasselbe meint. Es stellt sich die Frage, was das EPA konkret bestimmen darf und zu bestimmen hat, nämlich die Fristdauer, das fristauslösende Ereignis oder beides.

Artikel 120 c) EPÜ besagt, dass in der Ausführungsordnung die Mindest- und die Höchstdauer der vom EPA zu bestimmenden Fristen bestimmt werden. Regel 132(1) EPÜ stellt klar, dass der Bezug auf eine 'zu bestimmende Frist' im EPÜ stets meint, dass das EPA diese Frist bestimmt. Regel 132(2) EPÜ füllt dann die Ermächtigung des Artikel 120 c) EPÜ zur Regelung der Mindest- und Höchstdauer aus, indem die Mindestdauer mit zwei Monaten und die Höchstdauer mit vier, bzw. bei besonderen Umständen sechs Monaten festgelegt ist. Aus diesem Zusammenhang mit der Mindest- und Höchstdauer ergibt sich bereits, dass Regel 132(2) EPÜ dem EPA lediglich ermöglicht, die Fristdauer innerhalb des gesteckten Rahmens zwischen der Mindest- und der Höchstdauer festzulegen.[6] Die englische Sprachfassung besagt an der entsprechenden Stelle auch klar, dass das EPA eine 'period' (Zeitspanne) festlegen soll (Art. 177(1) EPÜ). Es wird also auf den Aspekt der Fristdauer abgestellt, ähnlich wie z.B. in Regel 131(3)-(5) EPÜ, auch wenn die deutsche und französische Fassung hier undifferenziert von 'Frist' ('délai') spricht.

Regel 132(2) EPÜ besagt also nichts anderes, als dass das EPA eine Fristdauer zwischen zwei und sechs Monaten festlegen darf und dies nach Regel 132(1) EPÜ auch zu tun hat, wenn im EPÜ von 'einer zu bestimmenden Frist' die Rede ist. Weder die Artikel noch die Regeln des EPÜ enthalten die Einräumung irgendwelcher weitergehender Befugnisse für das EPA und insbesondere nicht die Befugnis, das fristauslösende Ereignis festzulegen. Daraus, dass Regel 132(2) EPÜ nicht explizit die Festlegung des fristauslösenden Ereignisses durch das EPA ausschließt, darf nicht geschlossen werden, dass das EPA hierzu die Kompetenz besäße oder sich verschaffen könnte. Ohne Ermächtigung durch das Gesetz kann das EPA keine Bestimmungen erlassen, insbesondere keine Bestimmungen zu Fristen, die für Anmelder negative Rechtsfolgen haben können.

Letztlich kann dies aber dahingestellt bleiben, weil sich das fristauslösende Ereignis immer, wenn von einer 'zu bestimmenden Frist' die Rede ist, aus dem EPÜ ergibt. Da es ein und nur ein fristauslösendes Ereignis geben kann, ist dadurch kein Raum für das EPA, ein abweichendes fristauslösendes Ereignis festzulegen.

c. Der Begriff der 'Aufforderung' und das fristauslösende Ereignis

Wurde Prüfungsantrag gestellt, bevor dem Anmelder der ESR übermittelt wurde, so hat das EPA nach Regel 70(2) EPÜ den Anmelder aufzufordern, innerhalb einer zu bestimmenden Frist zu erklären, ob er die Anmeldung aufrechterhält. Ähnliche Formulierungen, die in der deutschen Sprachfassung des EPÜ teils 'Aufforderung'/

4 Siehe zum Fristenregime des EPÜ im Allgemeinen z.B. Singer/Stauder/Kroher, Europäisches Patentübereinkommen EPÜ, 7. Auflage 2016, Artikel 120, Rn. 7-17.

5 Siehe oben Fn. 1.

6 Vgl. auch Singer/Stauder/*Kroher*, Europäisches Patentübereinkommen EPÜ, 7. Auflage 2016, Artikel 120, Rn. 5, 34-38.

'auffordern' teils 'verlangen'/'Gelegenheit geben' beinhalten, finden sich auch in anderen Regeln des EPÜ, die sich auf eine zu bestimmende Frist beziehen.[7]

Eine Aufforderung ist empfangsbedürftig. Ohne den (formgerechten) Zugang der Mitteilung, die die Aufforderung enthält, ist eine Aufforderung schlicht nicht erfolgt. Der Anmelder muss auf dem gesetzlich bestimmten Wege der Zustellung Kenntnis erlangen, dass überhaupt eine Frist gesetzt ist und welche Dauer sie hat. Die reine Möglichkeit der Kenntnisnahme auf anderem Weg, z.B. durch Einsicht in das europäische Patentregister, reicht nicht aus. Es kommt also auf die formgerechte Zustellung durch eingeschriebenen Brief an (Artikel 119, Regeln 125(1) und 126(1) EPÜ).

In dem Bezug auf die Aufforderung[8] liegt auch der Schlüssel dafür, warum das fristauslösende Ereignis in all den Fällen durch das EPÜ bestimmt ist, in denen das EPÜ von einer vom EPA 'zu bestimmenden Frist' spricht. Denn wenn es auf die Zustellung ankommt, dann kann nur der Zugang des zugestellten Schriftstücks das fristauslösende Ereignis sein, weil es ein und nur ein fristauslösendes Ereignis gibt (vgl. Regel 131(2) EPÜ). Da es auf den Eintritt des Ereignisses 'Zustellung' ankommt, ist hierdurch auch der Fristbeginn gegeben und es ist ausgeschlossen, dass der Eintritt eines anderen Ereignisses den Fristbeginn markieren kann.

Daraus folgt, dass eine 'zu bestimmende Frist' nach systematischer Auslegung stets nur eine vom EPA zu bestimmende Fristdauer meint, welche zwischen zwei und sechs Monaten, also zwischen der Mindest- und der Höchstdauer festgesetzt werden kann (Artikel 120, Regel 132(2) EPÜ), während das fristauslösende Ereignis in diesen Fällen immer der Zugang der zuzustellenden Mitteilung ist (Regel 131(2) EPÜ).

2. Teleologische Auslegung

Aus dem ersten Halbsatz von Regel 70(2) EPÜ geht zunächst hervor, dass es möglich ist, den Prüfungsantrag vor Übermittlung des ESR zu stellen. Wird der Prüfungsantrag entsprechend früh gestellt, so kann der Anmelder unter Umständen die Erfolgsaussichten für eine Patenterteilung nicht gut einschätzen, weil ihm der relevante Stand der Technik verborgen sein mag, oder er kann zu diesem Zeitpunkt den kommerziellen Erfolg der Erfindung noch nicht gut abschätzen. Ist später aus dem ESR ersichtlich, dass die Anmeldung wegen eines starken Standes der Technik allenfalls geringe Aussichten auf Erteilung hat, oder stellt der Anmelder fest, dass er z.B. aus wirtschaftlichen Gründen das Interesse an der Anmeldung verloren hat, so ermöglicht Regel 70(2) EPÜ einen Untergang der Anmeldung, ohne dass die Prüfungsabteilung zuständig geworden wäre (Regel 10 EPÜ) und die Prüfung begonnen hätte. Dadurch werden dem EPA Arbeitskraft und dem Anmelder weitere Kosten gespart, auch weil in diesem Fall die Prüfungsgebühr zurückerstattet wird (Artikel 11 Gebührenordnung). Sinn und Zweck der Regel 70(2) EPÜ ist es also, Ressourcen des EPA und des Anmelders zu schonen.

Umgekehrt droht durch Fristsetzung nach Regel 70(2) EPÜ auch ein ungewollter Untergang einer Anmeldung, da Regel 70(3) EPÜ bei Fristversäumnis die Zurücknahme der Anmeldung fingiert. Die Mitteilung nach Regel 70(2) EPÜ hat also auch eine Warnfunktion.

Während der erste Aspekt im Hinblick auf die Frage der Auslegung der Fristsetzung in Regel 70(2) EPÜ unergiebig ist, weist der zweite Aspekt wiederum darauf hin, dass es auf den Zugang der formgerecht zuzustellenden Mitteilung ankommt.

3. Historische Auslegung

In den Vorbereitungsarbeiten zum EPÜ'73, konkret im ersten Arbeitsentwurf von 1961[9], war ein Artikel 156 vorgesehen, der im zweiten Absatz Folgendes besagte: „Ist in diesem Abkommen oder in der Ausführungsordnung zu diesem Abkommen eine Frist für die Vornahme einer Handlung vorgesehen, deren Dauer vom Europäischen Patentamt zu bestimmen ist, so darf diese Frist nicht auf weniger als zwei Monate und nicht auf mehr als vier Monate festgesetzt werden. Die Frist kann auf Antrag in besonders gelagerten Fällen auf insgesamt sechs Monate verlängert werden."

Dieser Artikel ist offensichtlich ein Vorläufer der Regel 132(2) EPÜ, der genau wie besagte Regel von der Festlegung einer Frist durch das EPA auf nicht weniger als zwei und bis zu maximal sechs Monaten spricht, dabei allerdings explizit deutlich macht, dass es die Dauer der Frist ist, die hier vom EPA zu bestimmen ist. Entsprechend wurde hierzu bemerkt[10], dass es verschiedene Gruppen von Fristen gebe, darunter „Fristen, deren Länge vom Europäischen Patentamt 'zu bestimmen' sind, wobei das Europäische Patentamt sein Ermessen nur innerhalb des Rahmens ausüben darf, der im Abkommen selbst genau festgelegt ist". Dem EPA soll somit ein Ermessen hinsichtlich der Fristdauer eingeräumt werden und sonst nichts.

Die aktuelle Regel 132(2) EPÜ ist demgegenüber sprachlich verkürzt, ohne dass jedoch eine Änderung des Inhalts damit einhergehen sollte. Die historische Auslegung bestätigt damit ebenfalls das Verständnis, wonach 'eine

7 'verlangen': R. 3(3), R. 5; 'auffordern': R. 50(3), R. 53(3), R. 59, R. 60(2), R. 70(2), R. 70a(2), R. 71(1), R. 77(2), R. 79(3), R. 94, R. 100(2), R. 101(2), R. 108(2), R. 118(2)c), R. 151(2), R. 152(2) EPÜ; 'Gelegenheit geben': R. 79(1), R. 81(2), R. 95(2).

8 Für andere Formulierungen ('verlangen', 'Gelegenheit geben') gilt dasselbe.

9 Siehe https://www.epo.org/law-practice/legal-texts/epc/archive/epc-1973/traveaux_de.html unter 'Artikel 120'.

10 Am angegebenen Ort.

zu bestimmende Frist' als 'eine zu bestimmende Fristdauer' zu verstehen ist, während das fristauslösende Ereignis nicht vom EPA bestimmt werden kann.

4. Schlussfolgerung

Alle Auslegungsmethoden ergeben, dass Regel 70(2) EPÜ ebenso wie alle anderen Regeln des EPÜ, die auf 'eine zu bestimmende Frist' Bezug nehmen, so zu verstehen sind, dass der Anmelder aufgefordert wird, bzw. ihm Gelegenheit gegeben oder von ihm verlangt wird, eine Handlung innerhalb einer Frist vorzunehmen, die mit dem Zugang der entsprechenden, zuzustellenden Mitteilung beginnt und deren Fristdauer (zwischen zwei und sechs Monaten) das EPA zu bestimmen hat. Dabei greift die Zustellungsfiktion nach Regel 126(2) EPÜ meistens ein, so dass es selten auf den tatsächlichen Tag des Zugangs ankommt.

III. Die Position des EPA

Auf Rechtsanfrage[11] mit der Anregung, die Verwaltungspraxis bezüglich EP- Direktanmeldungen zu ändern, oder eine aus dem EPÜ begründete Gegenposition zu entwerfen, wurde von der Rechtsabteilung des EPA die Position vertreten, das EPA könne das fristauslösende Ereignis bestimmen. Dieses sei in Form der Veröffentlichung des Recherchenberichts festgelegt und über diese Veröffentlichung werde der Anmelder mittels Form 1082 informiert. Zur Begründung wurde zum einen auf die Richtlinien für die Prüfung am Europäischen Patentamt (Richtlinien) verwiesen, was unbeachtlich ist, da die Richtlinien nicht zur Auslegung des EPÜ heranzuziehen sind, und zum anderen geltend gemacht, es solle ein Gleichlauf mit Regel 70(1) EPÜ herbeigeführt werden, um eine Ungleichbehandlung von Anmeldern zu verhindern. Auf weitere Anfrage[12], was das EPA mache, wenn die Frist gemäß Form 1082 abgelaufen sei und der Anmelder die Mitteilung nachweislich nie erhalten habe, wurde erklärt, das EPA schicke ein formloses Schreiben, in dem eine weitere, außerordentliche Frist zur Erklärung über die Aufrechterhaltung nach Regel 70(2) EPÜ gesetzt werde.

Diese Gegenposition beinhaltet keine Auslegung des EPÜ und ermangelt somit einer stichhaltigen Begründung. Die Praxis des EPA ist zudem in sich widersprüchlich.

1. Mitteilung nach Regel 70(2) EPÜ hat nicht nur Informationscharakter

Wie oben dargelegt, ist die Fristsetzung nach Regel 70(2) EPÜ von der Kategorie der vom EPA zu bestimmenden Fristen, im Gegensatz zu den im EPÜ festgelegten Fristen (Artikel 120 a) und c) EPÜ). Das fristauslösende Ereignis von im EPÜ festgelegten Fristen muss nicht die Zustellung sein, sondern kann z.B. die Veröffentlichung des Recherchenberichts sein (wie z.B. in Regel 70(1) EPÜ). Eine solche Frist, dessen fristauslösendes Ereignis nicht die Zustellung ist, beginnt bei Eintritt des fristauslösenden Ereignisses unabhängig davon zu laufen, ob der Anmelder darüber informiert wird oder davon weiß. Eine Mitteilung des EPA zu solch einer Frist (wie z.B. eine Mitteilung nach Regel 69 EPÜ) weist den Anmelder nur auf die bereits laufende Frist hin. Ein Unterbleiben einer solchen Mitteilung hat aber auf den Fristlauf und insbesondere den Fristablauf keinen Einfluss.

Hingegen ist bei der Kategorie der vom EPA zu bestimmenden Fristen die Mitteilung selbst konstitutiv für die Frist, die ohne die Mitteilung nicht gesetzt und ohne den Zugang beim Empfänger niemals ausgelöst würde. Es ist also nicht möglich, dass Form 1082 den Anmelder lediglich – wie bei gesetzlich festgelegten Fristen – über eine bereits seit der Veröffentlichung des Recherchenberichts laufende Frist informiert.

Nähme man aber an, das EPA könnte das fristauslösende Ereignis bestimmen und wie nach gegenwärtiger Praxis auf die Veröffentlichung des Recherchenberichts legen, dann würde genau das geschehen. Dann aber müsste man konsequenterweise annehmen, dass es auf die Zustellung für den Fristlauf nicht ankommen kann, denn eine bedingte Frist der Art 'Fristbeginn ist die Veröffentlichung des Recherchenberichts, aber nur, wenn die Zustellung erfolgt ist' kennt das EPÜ nicht. Das würde bedeuten, dass die Frist nach Regel 70(2) EPÜ, die für EP-Direktanmeldungen mit sechs Monaten ab Veröffentlichung des Recherchenberichts gesetzt ist, auch dann abliefe, wenn der Anmelder die Mitteilung nach Regel 70(2) EPÜ niemals erhielte.

Hier widerspricht das EPA sich selbst. Indem das EPA eine weitere Frist zur Antwort auf die Aufforderung nach Regel 70(2) EPÜ setzt, wenn sich nachträglich ergibt, dass die Mitteilung nach Regel 70(2) EPÜ nicht zugegangen ist, gibt das EPA zu, dass es eben doch auf die Zustellung angekommen wäre. Denn wenn die Fristsetzung korrekt gewesen wäre, wäre die Frist unabhängig von der Zustellung der entsprechenden Mitteilung abgelaufen, eine Fristversäumnis eingetreten und die Frist könnte nicht einfach erneut gesetzt werden. Da aber die Zustellung nach der Position des EPA nicht das fristauslösende Ereignis war, könnte die Zustellung nur als weitere Bedingung für den Fristlauf verstanden sein, was aber im EPÜ nicht vorgesehen ist. Weitere Widersprüchlichkeiten ergeben sich dann dadurch, dass das angebliche fristauslösende Ereignis ('Veröffentlichung des Recherchenberichts') einfach durch ein anderes ersetzt wird ('Zustellung'), wenn die Zustellung bis zum Ablauf der gesetzten Frist nicht eingetreten ist.[13] Auch solch einen Vorgang kennt das EPÜ nicht.

11 Rechtsanfrage des Autors vom 17.1.2017 und Antwort vom 1.6.2017.
12 Rechtsanfrage des Autors vom 5.9.2017 und telefonische Auskunft vom 6.9.2017.
13 Noch augenscheinlicher ist diese Merkwürdigkeit bei der ähnlichen Behandlung von R. 53(3) EPÜ nach der Amtspraxis des EPA. Dort kann allein das Zuwarten des EPA ohne Fristablauf dazu führen, dass ein anderes fristauslösendes Ereignis herangezogen wird als es zu einem früheren Zeitpunkt der Fall gewesen wäre; siehe Richtlinien A-III, 6.8.

Wäre die Frist hingegen nach der oben beschriebenen Auslegung von Regel 70(2) EPÜ gesetzt worden, d.h. mit der Zustellung als fristauslösendem Ereignis, lösten sich die Widersprüche auf, denn bei nicht erfolgter Zustellung hätte die Frist niemals zu laufen begonnen und könnte neu gesetzt werden.

2. Regel 70(1) EPÜ ist für die Auslegung von Regel 70(2) EPÜ irrelevant

Regel 70(1) EPÜ enthält eine im EPÜ festgelegte Frist, nämlich die Frist zur Stellung des Prüfungsantrags. Regel 70(1) EPÜ gestaltet dabei Artikel 94(1) EPÜ aus. Der primäre Regelungsgehalt ist die Entscheidung des Gesetzgebers, wer Prüfungsantrag stellen kann und bis wann.

Hingegen geht Regel 70(2) EPÜ von ganz anderen Voraussetzungen aus, nämlich davon, dass Prüfungsantrag bereits gestellt ist (und zwar frühzeitig vor Übermittlung des Recherchenberichts). Regel 70(1) EPÜ und die darin enthaltene Frist spielen in dieser Konstellation bereits keine Rolle mehr. Regel 70(2) EPÜ dient der Schonung von Ressourcen des EPA und des Anmelders (siehe oben II.2). Auch wenn ein Anmelder, der Prüfungsantrag bei Übermittelung des Recherchenberichts noch nicht gestellt hat, ähnliche Überlegungen anstellen kann wie nach Erhalt der Mitteilung nach Regel 70(2) EPÜ, nämlich ob sich die Fortführung der Anmeldung überhaupt lohnt und ob dementsprechend Prüfungsantrag gestellt werden soll oder nicht, bleibt doch der primäre Regelungszweck von Regel 70(1) EPÜ ein anderer. Regel 70(1) EPÜ und Regel 70(2) EPÜ, die historisch aus unterschiedlichen Artikeln entstammen[14], haben systematisch und von der primären Zielsetzung nichts miteinander zu tun. Regel 70(1) EPÜ ist für die Auslegung von Regel 70(2) EPÜ daher nicht heranziehbar und kann keinen Einfluss darauf haben, wie die Frist nach Regel 70(2) EPÜ zu setzen ist.

Eine „Ungleichbehandlung" von Anmeldern, die den Prüfungsantrag früh stellen und solchen, die es erst nach Übermittlung des Recherchenberichts tun, ist durch die unterschiedlichen Normen bereits angelegt und somit rechtlich nicht zu beanstanden[15]. Dass das EPA in der Praxis den Anmeldern einen möglichst ähnlichen Zeitraum geben möchte, ist zu begrüßen. Dies darf jedoch nicht dazu führen, dass das EPA versucht, die – bereits von der Kategorie her – unterschiedlichen Fristen nach Regel 70(1) EPÜ und Regel 70(2) EPÜ rechtlich gleich zu machen, sondern kann nur dazu führen, sie durch entsprechende Fristsetzung *praktisch ähnlich* zu machen.

IV. Konsequenzen für die Praxis

Nach der hier vertretenen Auffassung müsste das EPA seine Verwaltungspraxis ändern und alle vom EPA zu bestimmenden Fristen einheitlich auf die Zustellung der entsprechenden Mitteilung beziehen. Die zugehörigen Formblätter wären ebenso anzupassen wie die Richtlinien. Insbesondere gilt dies für das Formblatt 1082, welches für EP-Direktanmeldungen die Mitteilung gemäß Regel 70(2) EPÜ beinhaltet.

Derzeit ist eine Einheitlichkeit der Fristsetzung nicht einmal innerhalb einzelner Normen gegeben, weil unterschiedliche fristauslösende Ereignisse herangezogen werden. Beispielsweise wird für Euro-PCT-Anmeldungen auf Form 1224 die Frist nach Regel 70(2) EPÜ richtigerweise auf die Zustellung bezogen, während für EP- Direktanmeldungen auf Form 1082 die Frist nach Regel 70(2) EPÜ auf die Veröffentlichung des ESR bezogen wird.

Durch die Änderungen würde die Fristsetzung einheitlich und die Rechtssicherheit erhöht. Der Aufwand für die Ausbildung von Formalprüfern und Patentanwaltsfachangestellten würde verringert, weil nicht länger unterschiedliche Fristsetzungen zu berücksichtigen wären (und zwar nach Situationen, die im Gesetz gar keinen Ausdruck finden). Damit würden auch Fehlerquellen für die Fristennotierung eliminiert, Fristversäumnisse vermieden und mit Gebühren verbundene Rechtsbehelfe seltener. Es ergäben sich also auch in der Praxis Vorteile sowohl für das EPA als auch für die Anmelder.

Unbequemer mag es zwar erscheinen, dass z.B. der Hinweis auf die Frist zur Zahlung der Benennungsgebühren (Regel 39(1) EPÜ), der derzeit auf demselben Formblatt 1082 zusammen mit der Mitteilung nach Regel 70(2) EPÜ geschickt wird, nicht länger dieselbe Fristsetzung hätte. Letztlich ist dies aber nur Ausdruck der unterschiedlichen Kategorien von Fristen, denn Regel 39(1) EPÜ beinhaltet eine vom EPÜ festgelegte Frist und Regel 70(2) EPÜ eben nicht. Unabhängig von Vor- und Nachteilen sind Fristen letztlich so zu setzen, wie es das Gesetz vorsieht, wovon nicht aus praktischen Gründen abgewichen werden kann.

Die hier aufgeworfene rechtliche Problematik könnte in einem Beschwerdeverfahren vor dem EPA geklärt werden.

14 Art. 94(2) EPÜ'73, bzw. Art. 96(1) EPÜ'73.
15 Beispielsweise wäre es vollkommen legitim, wenn das EPA die Fristdauer der Frist nach Regel 70(2) EPÜ auf vier Monate setzte.

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Postanschrift / Mailing address / Adresse postale
epi
Bayerstrasse 83
80335 Munich
Germany
Tel: +49 89 24 20 52-0
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