



- |   |  |   |
|---|--|---|
| 5 Report from the 80 <sup>th</sup> Council Meeting in Athens                                      | 52 Limits of a Limited Opposition                          | 59 Thoughts About the EQE – Part 1                                |
| 46 A Review of the “Problem and Solution” Approach to Inventive Step under Article 56 EPC, Part 2 | 57 Decision G1/14 Appeal Inadmissible or Deemed Not Filed? | 63 The History of Partial Priority System of the Paris Convention |



Cover:

### Jiankou Great Wall

This picture was photographed by Mr. Philip Walker (European Patent Attorney, DE) and was part of the **epi** Artists Exhibition 2015 at the EPO, Munich



## Philip Walker

**P**hilip Walker, britischer Patentanwalt und zugelassener Vertreter vor dem Europäischen Patentamt, wohnt in London und arbeitet in den Fachgebieten Elektromechanik und Physik. Seine patentanwaltliche Berufslaufbahn begann Philip Walker 2005 als Freiberufler und seit 2012 arbeitet er bei Canon Europe Ltd im In-House Team.

Seit 2010 beschäftigt sich Philip Walker intensiv mit Fotografie und hat sich auf Reisebilder spezialisiert. Mit seinen Fotos möchte er bewegende Impressionen einfangen, die Menschen zum Reisen inspirieren. Seine Werke waren in London sowie bei der **epi** Artists Exhibition in München 2015 ausgestellt. Das Titelbild wurde an einem seiner Lieblingsreiseziele China aufgenommen, und zeigt den nicht restaurierten Abschnitt der Chinesischen Mauer bei Jiankou.  
[www.philwalkerphoto.zenfolio.com](http://www.philwalkerphoto.zenfolio.com)

**P**hilip Walker is a qualified UK and European patent attorney based in London who specialises in electronics and physics. Philip Walker joined the patent profession in 2005 working firstly in private practice before taking a position with the in-house team at Canon Europe Ltd in 2012.

Philip Walker has been taking photography seriously since 2010 and specialises in travel images. Through his photography he aims to capture evocative imagery that inspires people to travel. He has exhibited his work previously in London and also at the **epi** Artists Exhibition 2015. The cover photo was taken in one of his favourite destinations, China, and shows the un-restored Jiankou section of the Great Wall of China.

[www.philwalkerphoto.zenfolio.com](http://www.philwalkerphoto.zenfolio.com)

**P**hilip Walker est un mandataire en brevets britannique et européen, basé à Londres et spécialisé en électronique et en physique. Philip Walker a commencé sa carrière dans la profession en 2005, tout d'abord dans le secteur privé avant de rejoindre en 2012 le département brevet de Canon Europe Ltd.

Philip Walker se consacre assidûment à la photographie depuis 2010 et s'est spécialisé dans les photos de voyage. Il cherche à travers ses photos à capturer l'imagerie évocatrice qui incite les gens à voyager. Il a déjà exposé ses oeuvres à Londres ainsi qu'à l'exposition artistique organisée par l'**epi** en 2015. La photo de la couverture de ce numéro a été prise en Chine, l'une de ses destinations préférées, et montre la partie non restaurée de la Grande muraille de Chine à Jiankou.  
[www.philwalkerphoto.zenfolio.com](http://www.philwalkerphoto.zenfolio.com)

## Table of Contents

### Editorial . . . . . 4

#### I – Information concerning epi

Report from the 80 <sup>th</sup> Council Meeting in Athens, by C. Mercer . . . . .	5
<b>epi</b> Biotech Committee Position Paper Concerning Purpose/Function Limited Protection of Nucleic Acid Sequences, by A. De Clercq . . . . .	7
Overview National Laws on Nucleic Acid Sequences, by A. De Clercq . . . . .	8

#### Committee Reports

Report of the European Patent Practice Committee (EPPC), by F. Leyder. . . . .	30
Executive Summary of the Meeting of the ICT Thematic Group of the EPPC . . . . .	32
Report of the Committee on Biotechnological Inventions, by A. De Clercq. . . . .	33
Report of the Reporting Group on Reform of the <b>epi</b> , by L.A. Duran . . . . .	34
Report of the Litigation Committee, by A. Casalonga. . . . .	36
Report of the epi-Finances Committee, by M. Maikowski . . . . .	39

#### Information from the Secretariat

Deadline 2/2016 . . . . .	4
Availability of the Meeting rooms within the Secretariat for <b>epi</b> Members . . . . .	29
Next Board and Council Meetings . . . . .	32
<b>epi</b> Disciplinary bodies and Committees . . . . .	74
<b>epi</b> Board . . . . .	78

### Education and Training

Forthcoming Educational Events . . . . .	40
Flexible <b>epi</b> Tutorials . . . . .	41
Tutors wanted . . . . .	41
CEIPI Preparation Courses for the EQE Pre-Examination and Main Examination 2017 . . . . .	41

### Information from the EPO

Article on Rule 140 Policy - Correcting the Text of a Published Patent, by L. Petrucci . . . . .	43
Contact Data of Legal and Unitary Patent Division . . . . .	45

### II – Contributions from epi Members and other contributions

#### Articles

A Review of the “Problem and Solution” Approach to Inventive Step under Article 56EPC Part 2 - The Comvik Formulation of the Problem, by A. Kennington . . . . .	46
Limits of a Limited Opposition, by Dr. L. Walder-Hartmann . . . . .	52
Decision G1/14 Appeal Inadmissible or Deemed Not Filed? A Review, by D. Visser . . . . .	57
Thoughts about the EQE – Part I, by B. Cronin. . . . .	59
The Problem and Solution Approach – Basic The History of Partial Priority System of the Paris Convention, by K. Shibata . . . . .	63

## Editorial

T. Johnson (GB), Editorial Committee

**e**pi Information is now up and running electronically. The Editorial Committee hopes that our readers are finding the new format helpful, interesting, and user friendly. Needless to say, we welcome any feedback.

Mention of feedback brings to mind that by the time many readers see this issue, the UK Government will have received feedback from the British people after their vote in the Referendum on 23<sup>rd</sup> June as to whether to remain in the EU or not. Could a vote to leave the EU have an impact on IP in Europe? For example, how would the Unitary Patent or UPC fare? Or the European Medicines Agency, presently located in the UK? We do not know the answer to such questions, nor do we of course make any political comment on the Referendum, but the result could impact on IP one way or the other.

The Institute is having its own internal debate – Referendum? -on the size of Council. A reduction in size has been proposed by The Reporting Group and this was debated at the recent Council meeting in Athens. No vote was taken then, but the debate will no doubt continue.

As many readers will no doubt also know, a delegation led by our President recently met President Battistelli and

some of his colleagues at the EPO to discuss the topic 'Partnership for Quality' (PfQ). President Battistelli mentions the meeting, which resulted in an MoU between the **epi** and EPO, in his Blog of 22<sup>nd</sup> April, 2016. We hope that Mr. Battistelli will not mind our quoting this extract from his Blog:

*"... the EPO and **epi** have signed an MoU on professional training. Under this formal agreement, we now have a clear framework under which our organisations can more effectively plan their cooperation on continuing professional development in the medium and long term. A significant part of this agreement is a joint programme to train EQE candidates, their supervisors and tutors as well as the vocational training of others whose work falls in this field. Furthermore, the MoU places an emphasis on the necessity to offer distance learning so that those wishing to continue their professional development can do so irrespective of their location."*

As we have often commented, there is never a dull moment in IP! And that we live in interesting times! On those happy notes, we wish all our readers a very pleasant Summer.

Post Script:

*We are extremely pleased to report another 'first' for **epi** Information. This is a special contribution from a Japanese Examiner, Mr. Kazuo Shibata, in the form of an Article on*

*the very interesting and much debated topic of partial priority. We are very pleased indeed to be able to publish this Article. See page 63 of this issue.*

Nächster Redaktionsschluss für <b>epi</b> Information	Next deadline for <b>epi</b> Information	Prochaine date limite pour <b>epi</b> Information
Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der <b>epi</b> Information ist der <b>12. August 2016</b> . 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 <b>epi</b> Information is <b>12<sup>th</sup> August 2016</b> . 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 <b>epi</b> Information est le <b>12 août 2016</b> . Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.



## Report on **epi** Council Meeting in Athens on 23<sup>rd</sup> April, 2016

C. Mercer (UK)

The 80th Meeting of **epi**'s Council took place on 23<sup>rd</sup> April, 2016 in a pleasant conference room in a hotel in the middle of Athens. As the meeting was well attended, the room was rather crowded and it was difficult for the President to see everyone who wanted to speak.

The President opened the meeting by welcoming the Council members to Athens and by asking Council to appoint two scrutineers. These two people deserve a vote of thanks as they were required to work very hard during the day. The President then suggested some changes to the agenda, in particular to move the discussion of the report of the Reporting Group up the agenda to give more time for discussion before voting. The agenda as amended was approved.

There was then a discussion of the Minutes of the last meeting and various minor amendments were proposed and agreed. The action points arising from the Minutes were reviewed. Although all points were being actively pursued, they have not all been resolved and so they will be dealt with at the next Council meeting. The Treasurer pointed out that there is the possibility to use a central travel agency to book flights to all **epi** meetings and encouraged Council members to use this as it reduces administration costs for **epi**. The Treasurer asked Council

members to provide feedback on this facility. It was pointed out that there was a discussion of disciplinary matters at the previous Council meeting and that this will require an amendment of a previous Council decision.

The President presented his report and in particular referred to the meeting of the Partnership for Quality (PfQ) which had recently taken place. At this, the President of the EPO, Mr. Batistelli, indicated that he would like to address **epi**'s Council and so it will be arranged for him to do so at the next Council meeting. It was noted that Mr. Batistelli had referred to the PfQ meeting on his blog and it was suggested that **epi** should also make available its account of the PfQ meeting.

Council then turned to the report of the Reporting Group, which had put forward a proposal for reducing the size of Council. The Secretary General also put forward a proposal. There was a lively debate, as is reported in this edition elsewhere, but no vote was taken at that time.

Council then received a report from the Electoral Committee which related in particular to electronic voting. This is a very important topic as a new Council has to be elected next year and it is necessary to have all the arrangements



in place so that this can happen smoothly. As part of making the arrangements, Council also elected a new Electoral Committee by unanimity.

The Secretary General gave his report and noted that the new website is up and running but still needs some fine tuning, in particular to facilitate access to documents. He also indicated the dates and locations for the next Board and Council meetings. Some problems with the Annual Report were raised and will be considered by the Secretary General.

The Treasurer presented his report and explained that the deficit will not be as large as had been projected. Some of the costs for the new server had been moved to the current year, the Treasurer had been able to reclaim VAT not only from Germany but also from other EU countries and there had been less committee meetings than had been allowed for. The external auditors were reported to be satisfied with the state of **epi**'s finances. The Treasurer indicated that it was envisaged that there would need to be further expenditure to modernise the IT systems in the Secretariat, in particular to add a CMS and to complete the server upgrade.

The Treasurer reported that there is a problem with the process for removing members who do not pay their subscription and that this could be solved by amending Rule 154 and **epi**'s Disciplinary Rules. This was discussed and a number of suggestions to assist in dealing with the problem were made. (It would help the situation greatly if any **epi** member who changes employment informs the EPO promptly of his or her new address details.) Council agreed in principle that Rule 154 and the Disciplinary Rules should be changed and left it to the relevant Committees to work out the details.

The Treasurer reported that, following a discussion in the last Board meeting, he had investigated the possibility of finding a provider of PII for any **epi** member who needs it. He has identified one provider but further work is needed. He proposed that a Working Group, under the leadership of the Deputy Treasurer, be formed. This was agreed by Council.

The Chairman of the **epi** Finances Committee then made his report which generally approved of **epi**'s financial position while, at the same time, making his usual helpful remarks about certain aspects, for which the Treasurer was grateful.

The Internal Auditors then gave an illustrated presentation and had a proposal for amendment of Article 22 of the Bye-Laws. This was deferred until the next Council meeting. The Internal Auditors proposed that the Treasurer be discharged (not from a gun but from his liability for the financial affairs of **epi**). After a few points had been raised and a few questions answered, this was unanimously agreed by Council.

Council then returned to the lively and informative debate on the proposals for reduction in the size of Council but, again, with no vote.

The Chairman of the By-Laws Committee then presented proposals for changes to the By-Laws following decisions made at previous Council meetings. All the changes were approved by Council.

There was a discussion of the professional titles which **epi** members could use in various EPC member states. Most of these were accepted but there remained a minor problem with the Dutch designation and a more major problem with the designation to be used by German-speaking Swiss **epi** members. More discussion on this point will be carried out before the next Council meeting.

It was then the turn of the Chairman of the Litigation Committee to report. He referred to the changes in the Committee's terms of reference and the UPC. In particular, he referred to ceilings on costs, which did not seem to account for the use of experts, and the mechanism for opting out of the jurisdiction of the UPC, which seemed to be too user-friendly, and the Code of Conduct which is in the process of being finalised. Council agreed that the Litigation Committee should continue to pursue its points with the Preparatory Committee. There was also reference to the EU Consultation on the Enforcement Directive to which **epi** should reply.

The Chairman of the Professional Conduct Committee reported on the work being carried out to change **epi**'s Code of Conduct to take account of the UPC and on the work being done on the UPC Code of Conduct.

Council then voted on the proposals for reducing the size of Council, both of which were rejected.

The President then reported on matters relating to the EQE and proposals which are in the very early stages of consideration. There are no formal proposals for any changes to the EQE. One point which was raised was whether there was a need for candidates whose native language is not one of the official languages of the EPO to be given more time when writing their answers. The general feeling was that this should be done but that it should be ensured that the examinations do not become more bulky and remain at the same level of difficulty as at present. There was also a discussion of the new system of pre-registration. This will be considered by the relevant people in **epi** before the next Council meeting. Also, PEC will issue a note on the subject. It was agreed that the **epi** members of the Supervisory Board would continue to report on developments of the EQE at Council meetings.

Council agreed that **epi** members in Belgium could carry out a ballot to determine whether Belgium should become a unitary constituency.

The Chairman of the Online Communications Committee reported again on the problems with the e-Drex. It appears that the EPO has accepted that there are problems with this and that they will be presenting proposals for dealing with it. There was also a discussion of whether the EPO could dispense with the use of telefax. However, it appears that what the EPO wants to do is

to dispense with the use of printed copies from telefax machines and store sent documents only in electronic form.

The Secretary General then summarised the decisions and actions points arising from the meeting and the President closed a long and interesting meeting.

## epi Biotech Committee Position Paper Concerning Purpose/Function Limited Protection of Nucleic Acid Sequences

A. De Clercq (BE), Chair

1. An overview was made of the national laws in the EPC contracting states on nucleic acids (see Annex).
2. In three countries namely France, Germany and Italy there is purpose/function limited protection for nucleic acid sequences set forward for national patent applications filed in these countries. At least in France and Germany, national patents applications for these inventions are rarely filed.
3. In Switzerland/Liechtenstein there is no literal purpose or function limitation of the protection of nucleic acid sequences in the patent law. However, the examination guidelines suggest to grant a patent only for those parts of a nucleic acid sequence derived by technical means from a naturally occurring sequence, that perform the purpose or function mandatorily disclosed in the specification as filed.
4. In Luxemburg DNA sequences are considered as chemical compounds. However, national patent applications for these inventions are rarely filed. The LU law specifies that only an invention constituting a technical application of a function of an element of the human body may be protected by a patent. This protection shall cover the element of the human body only to the extent necessary to the realization and the exploitation of this particular use. Such use must be disclosed in the patent application in a concrete and precise manner.  
The French law seems more restrictive than the LU law, as the French law excludes from patentability "d) the total or partial sequences of a gene taken as such". There is no equivalent to this in the LU law.
5. In Poland since December 1, 2015 new regulations came into force which define the requirement of specifying the function of a claimed gene in independent patent claim according to our PL member.

The effects of the new regulations have not been tested before administrative and civil courts.

6. In general, the **epi** Biotech Committee is of the opinion that purpose-bound protection for patentable nucleic acid molecules should not be introduced for EP patents. The EPC has no rules which point in this direction. There is no need to treat nucleic acid molecules any different than other types of compounds in terms of available patent protection and such a different treatment would be unfair to innovators in biotechnology and contrary to art 27 of TRIPS provisions which establishes the principle of non-discrimination as to the type of invention and field of technology.
7. The contribution to the art of an inventor who invents a new compound with a useful practical/technical application is not only that useful practical/technical application but also the new compound itself. The inventor's disclosure of the new compound enables others to make new and further inventions with that same compound, e.g. other useful applications of the compound, which would not have been possible had the first inventor not disclosed the compound. New applications that may be discovered by others following the disclosure of a new compound by a first inventor may also be eligible for protection even in cases where absolute protection of the compound has been granted. This allows the further progress of science and technology and is an important justification for absolute product protection.



**Ann De Clercq**

8. In this respect DNA molecules or genes are chemical compounds, they do not differ from "conventional" chemical compound because there are numerous examples of "conventional" chemical compounds having more than one or many different practical applications. Moreover, also not all genes are multifunctional. The multi-functionality argument is thus not specific for DNA molecules or genes and should thus also not be a reason to treat them differently.
9. A further thought is that at least for human genes the whole issue of purpose-bound protection has become obsolete since the publication of the human genome sequence in 2000. Since then absolute product protection for human genes has become practically impossible because such claims would no longer be novel. Thereby de facto only purpose-bound protection is available for human genes. The same holds for genes from all the other organisms whose genome sequences have been and are being published at an ever increasing rate. Arguably, if absolute product protection for DNA would no longer be available there would be less incentive to sequence new genomes and those sequences would become available at a lower rate, thereby slowing down progress of science and technology.
10. For example in Germany, Spain, Austria, Denmark and Greece there has not been compound protection for chemicals before basically the advent of the EPC and its harmonized counterparts in the early contracting states. Now the system of compound, first and second medical use contributions has been successfully established and the industry does not have any problems with the situation in principle. The system works so well in practice that they would not want to revert to the old situation anymore. Thus, the benefit seems to dominate any possible shortcomings.
11. Research would not be hampered due to absolute product protection for nucleic acid sequences, because there is experimental use exemption. This allows research for, e.g., identifying new properties of "old" and tentatively patented compounds.

## Overview National Laws on Nucleic Acid Sequences

A. De Clercq (BE), Chair

The table below contains answers to the following questions:

1) Is there purpose/function limited protection of nucleic acid sequences in the patent legislation of your jurisdiction? (YES/NO)

2) Could you please explain this and cite the relevant legal provision(s)?<sup>1</sup>

3) Has the patent office in your jurisdiction published guidelines for examination of purpose/function limited protection of nucleic acid sequences? If yes, could you please cite the relevant part(s) of those guidelines?

	2	3
<b>AL</b>	<p>The industrial applicability of gene sequences must be mentioned in the application in order to meet the requirement of industrial applicability.</p> <p>Excerpts from ALBANIAN LAW Nr. 9947 dated 07.07.2008 ON INDUSTRIAL PROPERTY:</p> <p>Article 5 Patentable Inventions [...] 5. Biotechnological inventions shall also be patentable if they concern: [...]</p>	NO

<sup>1</sup> Please note that the English translations provided are not necessarily official.



2	3
<p>c) an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</p> <p>Article 6 Exceptions to patentability Patents shall not be granted in respect of: [...] 3. The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene. [...]</p> <p>Article 10 Applicability in Industry and Agriculture [...] 2. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</p>	
<p><b>AT</b></p> <p>A purpose/function has only to be indicated in the specification and not in the claims. It is needed to meet the requirement of industrial applicability and does not limit the scope of the claims (see Sec 1 and 89a of the Austrian Patents Act).</p> <p>Excerpts from the Austrian Patents Act:</p> <p>§ 1. Patentable inventions (1) On request, patents shall be granted for inventions in all fields of technology, provided that they are new (section 3), not obvious to the person skilled in the art from the state of the art, and susceptible of industrial application. (2) Inventions that fulfill the conditions of subsection 1 shall be patented, even if they concern a product consisting of or containing biological material or a method by means of which biological material is produced, processed or used, wherein biological material means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system. These patentable inventions shall also include 1. biological material which is isolated from its natural environment or produced by means of a technical method even if it previously occurred in nature; 2. an element isolated from the human body or otherwise produced by means of a technical process,</p>	<p>No, but there exist examination guidelines in which the industrial applicability of sequences is discussed (the most relevant parts thereof are cited below).</p> <p>Excerpt from the Examination Guidelines of Biotechnological Inventions of the Austrian Patent Office:</p> <p>6 Industrial Applicability The Patent Act (§ 1 para. 1 of the Patent Law) stipulates that an invention must be industrially applicable. This is not the case if the product is unusable or useless. It is therefore necessary to consider whether the claimed invention fulfills a useful purpose. Directive 98/44 / EC (recital 22) and § 89a Patent Law stipulate that the industrial application of a sequence or partial sequence must be disclosed in the patent application as filed. Therefore, the intended use of a sequence, i.e. its function, has to be derivable from the application as filed at the filing date. [...] The possible use of short DNA sequences or ESTs (= partially sequenced cDNA clones) as probes, is not considered to be sufficient. [...]</p>

	2	3
	<p>including the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element. [...]</p> <p>(3) The following in particular shall not be regarded as inventions:</p> <p>[...]</p> <p>2. the human body at the various stages of its formation and development;</p> <p>3. the simple discovery of one of the elements of the human body, including the sequence or partial sequence of a gene;</p> <p>[...]</p> <p>§ 89a.</p> <p>The industrial application of a sequence or partial sequence of a gene must be disclosed in the application.</p>	
<b>BE</b>	<p>The industrial applicability of gene sequences must be mentioned in the application in order to meet the requirement of industrial applicability.</p> <p>Excerpts from the Belgian Code of Economic Law:</p> <p>Art. XI.5.</p> <p>[...]</p> <p>§ 6. The human body, at the various stages of its formation and development, and the simple discovery of one of parts thereof, including the sequence or partial sequence of a gene, are not patentable.</p> <p>A portion of the human body which has been isolated, or otherwise produced by a technical method, including a sequence or a partial sequence of a gene, is susceptible to patenting, even if the structure of that part is identical to that of a natural element.</p> <p>The industrial application of a sequence or a partial sequence of a gene which serves as a basis for the invention is to be concretely disclosed in the patent application.</p> <p>[...]</p>	<b>NO</b>
<b>BG</b>	<p>According to Art. 37 (5) of the Bulgarian Patent Law (last amendment 18.05.2012), a purpose/function has only to be indicated in the specification and not in the claims. It is needed to meet the requirement of industrial applicability and does not limit the scope of the claims.</p>	<p>Art. 36(6) of the Guideline for examination (19.03.2008) indicates only the case when a deficiency of nucleic acid sequences have been noticed and the time given to the Applicant to correct them.</p>
<b>CH</b>	<p>Excerpts from the Federal Act on Patents for Inventions (Patent Act)(text available under <a href="https://www.admin.ch/opc/en/classified-compilation/19540108/index.html">https://www.admin.ch/opc/en/classified-compilation/19540108/index.html</a>):</p>	<p>Extract from CH - Examination Guidelines:</p> <p>11.2.2 Naturally occurring DNA sequences; sequences derived therefrom</p>

2	3
<p>Art. 1b</p> <p>1 A naturally occurring sequence or partial sequence of a gene is not patentable as such.</p> <p>2 Sequences that are derived from a naturally occurring sequence or partial sequence of a gene may, however, be patented as an invention if they are produced by means of a technical process, their function is specifically indicated, and the further requirements of Article 1 are fulfilled; Article 2 remains reserved.</p>	<p>Claims on sequences or partial sequences of naturally occurring genes both in their natural environment as well as in isolated form (as genomic DNA) are not permissible. It should be noted that Art. 1b para. 1 of the Patent Law refers not only to sequences of human origin, but also to those of animal or plant origin.</p> <p>In contrast, sequences which are derived from a naturally occurring sequence can be patentable (Art. 1b para. 2 of the Patent Law). By "derived sequence" is meant any sequence which is obtained from a sequence or partial sequence of a gene and which is functionally equivalent to that. Therefore it includes, in particular cDNA, RNA, polypeptides and proteins.</p> <p>In case of derived sequences a patentable invention is recognized only if the sequences have been isolated or obtained in some other way by a technical process. However, this alone does not justify the existence of an invention, there must also be a function disclosed in a credible way in the description. Since this function is part of the invention, it must be contained in the documents as filed (see. Art. 49 para. 2 lett. b PatG (Patent Law)). If there is no indication of a function at the filing date, the patent application must be dismissed (after appropriate threats)</p> <p>The term "function" describes any property of the sequence that causally contributes to a result usable in the art. If a derived sequence of a gene is used to produce a protein (or a portion of a protein), it is not only required to disclose this protein, but also its function. When a nucleotide sequence is not used for the production of a protein, the function to be indicated could for example be that the sequence has a specific transcriptional promoter activity. Providing mere general and speculative information on said function is not sufficient. They must be sufficiently specified, be substantial and credible. As part of the examination additional information or documents can be requested based on Art. 13 VwVG (Administrative Procedural Law) to enable the required assessment of the function.</p> <p>The protection by a claim of a nucleotide sequence derived from a gene sequence is limited to the sequence sections which perform the function described in the patent. The wording of Art. 8c PatG (Patent Law) shows that this does not affect the amino acid sequences. In order to render the scope of protection clear in case of derived nucleotide sequences, the patent applicant must provide (if necessary as part of the examination), which sequence sections are functionally relevant. Not relevant sequence segments shall be deleted from the claims, either by the applicant or by the examiner.</p>

2	3
CY	NO
<p><b>CZ</b></p> <p>In the patent legislation, there are not any specific legal provisions related to this issue. However, in respect to the general patentability principle, the industrial applicability of DNA sequences must be fully disclosed in the patent application.</p> <p>Excerpts from ACT No. 206/2000 Coll. of 21 June 2000 on the Protection of Biotechnological Inventions and on the Amendment to Act No. 132/1989 Coll., on the Protection of Rights to New Plant and Animal Varieties, as amended by Act No. 93/1996 Coll.:</p> <p>Section 3 Exclusions of patentability Patents shall be not granted to [...]</p> <p>b) human body at various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene; it does not apply to an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element, and [...]</p> <p>Section 5 Special provisions on the application of biotechnological invention [...]</p> <p>(8) If the application concerns an invention of the sequence or partial sequence of a gene, their industrial applicability must be made obvious in the patent application.</p>	<p>NO. The Examination Guidelines do not mention purpose/function limited protection for sequences at all.</p>
<p><b>DE</b></p> <p>The German patent law foresees the following (implementation of Article 5(3) of the Biotech Directive):</p> <p>Section 1a [...]</p> <p>(3) The industrial application of a sequence or partial sequence of a gene shall be disclosed in the application specifying the function performed by the sequence or partial sequence.</p> <p>(4) If the invention concerns a sequence or partial sequence of a gene whose structure corresponds to that of a natural sequence or partial sequence of a human gene, the patent claim shall include its use for which industrial application is disclosed pursuant to subsection (3).</p>	<p>The official guidelines for examination do not contain anything concerning the cited provisions since the last update is still from 2004 and the biotech directive was implemented into the German patent law only in 2005.</p> <p>There is an English leaflet "Information for Patent Applicants" (2014 edition) available from the internet set of the German Patent and Trademark Office containing the following statements:</p> <p>"1.5 (What is capable of being protected? / Industrial Application)</p>



2	3
	<p>[...]</p> <p>The industrial application of a sequence or a partial sequence of a gene must be disclosed in the application specifying what function the sequence or partial sequence performs. If the structure of a sequence or a partial sequence of a gene is identical to the structure of a natural sequence or partial sequence of a human gene, its use shall be included in the patent claim (Sec. 1a (3) and (4) Patent Act)."</p> <p>"VI.2.1 (Documents to submit / Application documents / Claims)</p> <p>[...]</p> <p>If the sequence or partial sequence of a gene, having a structure identical to the structure of a natural sequence or partial sequence of a human gene, is the subject matter of the invention, the patent claim shall include its use, for which the industrial application has been disclosed under Section 1a (3) of the Patent Act."</p> <p>"VI.2.2 (Documents to submit / Application documents / Description)</p> <p>[...]</p> <p>The industrial application of a sequence or partial sequence of a gene shall be disclosed in the application specifying what function the sequence or partial sequence performs (Sec. 1a (3) Patent Act)."</p>
<p><b>DK</b></p> <p>There is no purpose/function limited protection in Denmark. Consequently, full product protection can be enjoyed.</p> <p>Excerpts from the Danish patent law:</p> <p>1a.-(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</p> <p>(2) Notwithstanding subsection 1 an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p>	<p>The patent office has also NOT issued any guidelines in respect of that.</p>
<p><b>EE</b></p> <p>Excerpts from the Estonian Patent Act (Act No. RT I 1994, 25, 406, as last amended by Act No. RT I, 28.12.2011,1):</p> <p>§ 6. Subject of invention</p> <p>[...]</p>	<p>NO</p>

2	3
<p>(2) The following, inter alia, are not regarded as the subject of inventions:</p> <p>1) discoveries, including descriptions of the formation or development of the human body or sequence or partial sequence of human gene, scientific theories and mathematical methods;</p> <p>[...]</p>	
<p><b>ES</b></p> <p>According to art 5 of the Spanish patent law (ley de Patentes) genes are patentable, and claims directed to DNA sequences do not need to be limited to their function. The only requirement is that the function should be explicitly disclosed in the application (description is enough). There is also a new law coming into force on 1 April 2017, but the provisions concerning this point are the same.</p>	<p>The guidelines of the Spanish Patent Office (part E) state that the function has to be described in the application. In that case the DNA sequence as such is patentable. The relevant part of these guidelines reads:</p> <p>The industrial application of a total or partial sequence must be explicitly disclosed in the patent application at the time of filing.</p> <p>Hence, a DNA fragment without any indication of a particular function is not considered patentable. However, a DNA fragment for which a particular function is indicated, for example to be used as a probe for disease diagnostic, is considered patentable, unless there are other reasons for its rejection.</p>
<p><b>FI</b></p> <p>There is no purpose/function limited protection for nucleic acid sequences in patent legislation in Finland. The patenting of DNA sequences, RNA sequences and amino acid sequences requires that their industrial use is disclosed in the application.</p> <p>Excerpts from the Patents Act:</p> <p>CHAPTER 1 , General Provisions</p> <p>Section 1a (30.6.2000/650) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</p> <p>An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may, without prejudice to the provisions of subsection (1), where the requirements for patentability are fulfilled, constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p>	<p>NO. In the guidelines (Handbook, "Patenttikäsikirja", I.2.2. p. 137) it reads:</p> <p>The patenting of DNA sequences, RNA sequences and amino acid sequences requires that the sequence and the industrial use is disclosed in the application.</p>
<p><b>FR</b></p> <p>The protection of an isolated DNA sequence is limited to its identified function. The purpose/function limited protection provided in the French law relates to human genes and sequences, i.e., is not said to apply to all types of organisms.</p>	<p>The French patent office has not issued specific guidelines regarding the patentability of DNA sequences. However, the French Examination guidelines contain a small paragraph regarding this point (Paragraph 2.3 (4); Page 116):</p>

## 2

Article L613-2-1 of the Intellectual Property Code provides that the scope of a claim concerning a gene sequence shall be confined to the part of such sequence that is directly related to the specific function disclosed concretely in the description. Although this article does not specify that the sequence is human it has to be noticed that this provision has been introduced in the law on 6 August 2004 in the same amendment than the article L.611-18 which targets specifically human sequences.

In practice, a claim directed to a gene sequence is considered as being limited to the technical application of a specific function associated with said sequence. In other words, the scope of a claim directed to a gene sequence will not be that of a product claim per se but rather the product for its specific disclosed function(s).

To the best of our knowledge, there is no case law in France to illustrate this point.

Excerpts from the Intellectual Property Code:

Article L611-18 (inserted by Act No. 2004-800 of 6 August 2004, Article 17a II, Official Journal of 7 August 2004):

The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

Only an invention constituting a technical application of a function of an element of the human body may be protected by a patent. This protection shall cover the element of the human body only to the extent necessary to the realization and the exploitation of this particular use. Such use must be disclosed in the patent application in a concrete and precise manner. The following, in particular, shall be considered unpatentable: [...]

d) total or partial sequences of a gene as such.

Article L613-2-1(inserted by Act No. 2004-800of 6 August 2004, Article 17 a III, Official Journal of 7 August 2004):

The scope of a claim concerning a gene sequence shall be confined to the part of such sequence that is directly related to the specific function disclosed concretely in the description.

The rights created by the grant of a patent including a gene sequence may not be called upon against a later claim on the same sequence if this claim satisfies the requirements of Article L. 611-18 and if it discloses any other particular application of this sequence.

## 3

(4) les séquences totales ou partielles d'un gène prises en tant que telles. Les inventions portant sur des éléments (éléments intrinsèques, tels que les cellules, protéines, ADN, divers métabolites) ou des produits (excrétas, tels que la sueur et l'urine) d'origine humaine, sont également considérées comme non brevetables, lorsque ces éléments et produits sont considérés en tant que tels, c'est à dire :

lorsque ces éléments ou produits sont présentés tels qu'ils se retrouvent dans la nature, en interaction avec leur environnement naturel. Par exemple un fragment d'ADN non isolé, tel qu'il se trouve intégré dans la totalité du génome humain. Breveter un tel ADN non isolé, reviendrait à breveter le génome humain lui-même.

lorsque ces éléments ou produits ont été simplement isolés et chimiquement caractérisés, alors qu'aucune fonction ou application industrielle n'a encore été identifiée. C'est le cas notamment d'un fragment d'ADN isolé dont on a déterminé la séquence, alors que l'on ne connaît pas le produit pour lequel cet ADN code ni, a fortiori, la fonction de ce dernier qui pourrait permettre d'en envisager une application pratique dans l'industrie (thérapeutique, agrochimique, etc.).

En revanche une invention portant sur un élément isolé du corps humain ou autrement produit par un procédé technique, et qui est susceptible d'application industrielle, n'est pas exclue de la brevetabilité, même si la structure de cet élément isolé est identique à celle d'un élément naturel. En effet, cet élément isolé est par exemple le résultat de procédés techniques l'ayant identifié, purifié, caractérisé et multiplié en dehors du corps humain, techniques que seul l'homme est capable de mettre en oeuvre et que la nature est incapable

d'accomplir par elle-même (considérants 20 et 21 de la Directive 98/44/CE).

These guidelines confirm the fact that the function and the technical application of a DNA sequence have to be clearly disclosed so as to render this sequence patentable.

The first example concerns a non-isolated DNA fragment (i.e. such as integrated in the human genome). According to the guidelines such a DNA fragment is not patentable.

The second example concerns the situation where a DNA fragment has been isolated and sequenced but the product of this sequence is not known and a fortiori its function is also not known. According to the guidelines such a DNA fragment is also not patentable.

	2	3
<b>GB</b>	<p>Isolated nucleic acid sequences may be patented, so long as the industrial application of the sequence is disclosed in the application as filed. However, for this protection to extend to propagated material, the genetic information must perform its function.</p> <p>Excerpt from Schedule A2, introduced by s76A UKPA:</p> <p>BIOTECHNOLOGICAL INVENTIONS [...]</p> <p>3. The following are not patentable inventions – (a) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene; [...]</p> <p>5. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p> <p>6. The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application as filed. [...]</p>	<p>No, the Examination Guidelines for Patent Applications relating to Biotechnological Inventions in the Intellectual Property Office issued in 2013 do not consider purpose or function limited protection for nucleic acid sequences. The Guidelines only confirm that the industrial application of nucleic acid sequences is required for patentability:</p> <p>55. Where the invention resides in a sequence or partial sequence of a gene, paragraph 6 of Schedule A2 to the Act additionally requires disclosure in the application as filed of the industrial application of that gene. The absence of this disclosure in an application when filed would seem to be fatal to that application.</p> <p>103. Paragraph 2 of Schedule A2 to the Patents Act 1977 permits biological material which is isolated from its natural environment or produced by means of a technical process to be the subject of an invention even if it previously occurred in nature. Paragraph 5 of Schedule A2 similarly states that an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may also constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p> <p>104. However, in line with section 1(2)(a) of the Patents Act and Paragraph 3(a) of Schedule A2, the simple discovery of biological material, eg a human gene, is not patentable. This is the situation that applies when a gene sequence is known simply as a sequence, possibly as part of the genome or in an isolated state. In that sense it is a discovery; nothing more is known about it other than that it exists as a piece of information.</p>
<b>GR</b>	<p>In Greece there is no other legislation regarding biotechnology and genetic engineering except the adaptation to Directive 98/44 of the European Parliament and of the Council on the legal protection of biotechnological inventions (Presidential Decree 321/2001).</p> <p>Excerpts from PRESIDENTIAL DECREE No. 321/24.09.2001:</p> <p>Article 4</p> <p>1. The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</p>	<p>The Greek patent office has not published any kind of guidelines for examination of purpose/function limited protection for nucleic acid sequences.</p>



2	3
<p>2. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p> <p>3. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</p>	
<p><b>HR</b></p> <p>Excerpts from the Croatian Patent Law:</p> <p>EXCLUSION FROM PATENTABILITY</p> <p>Article 6</p> <p>Excluded from patent protection shall be:</p> <p>[...]</p> <p>2. the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene. An invention relating to an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application as originally filed.</p>	<p>According to the Section B-II 2.2. of the Guidelines for examination of the patent application:</p> <p>2.2 Sequences and partial sequences of genes</p> <p>In general it is required that the description of a Croatian patent application should, where this is not self-evident, indicate the way in which the invention is capable of exploitation in industry. In relation to sequences and partial sequences of genes, this general requirement is given specific form in that the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</p> <p>A mere nucleic acid sequence without indication of a function is not a patentable invention (EU Dir. 98/44/EC, rec. 23). In cases where a sequence or partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which protein or part of a protein is produced and what function this protein or part of a protein performs. Alternatively, when a nucleotide sequence is not used to produce a protein or part of a protein, the function to be indicated could e.g. be that the sequence exhibits a certain transcription promoter activity.</p>
<p><b>HU</b></p> <p>The industrial applicability of a sequence or a partial sequence of a gene must only be disclosed in the patent application.</p> <p>Excerpts from ACT XXXIII OF 1995 on the protection of inventions by patents:</p> <p>Patentable biotechnological inventions</p> <p>Article 5/A</p> <p>[...]</p> <p>(3) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</p> <p>(4) An element isolated from the human body or otherwise produced by means of a technical process,</p>	<p>NO. There is nothing in the Guidelines concerning the purpose/function of patentable sequences.</p>

	2	3
	<p>including the sequence of partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.</p> <p>Disclosure of the invention, the claims and the abstract</p> <p>Article 60 (1) A patent application shall disclose the invention in a manner sufficiently clear and detailed for it to be carried out by a person skilled in the art on the basis of the description and the drawings. The industrial applicability of a sequence or a partial sequence of a gene shall be disclosed in the patent application. [...]</p>	
IE	<p>No, there is no limitation on protection. However, as per The European Communities (Legal Protection of Biotechnological Inventions) Regulations 2000 (which implements EU Directive 98/44/EC) Section 5(3) "If an invention concerns the sequence or partial sequence of a gene the industrial application thereof shall be disclosed in the patent application as filed".</p> <p>Excerpt from S.I. No. 247/2000 - European Communities (Legal Protection of Biotechnological Inventions) Regulations, 2000:</p> <p>5. (1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, shall not be patentable. (2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. (3) If an invention concerns the sequence or partial sequence of a gene the industrial application thereof shall be disclosed in the patent application as filed.</p>	<p>No, there are no Irish Patent Office examination guidelines.</p>
IS	<p>There is no limitation on claims scope stipulated by the Icelandic Patent Act, but the Regulation on Patents No. 477/2012, with amendments (valid from 11 October 2013) stipulates that "If an invention concerns a gene, how the nucleotide sequence or part of the sequence can be utilised commercially must be specified."</p> <p>Excerpt from the Icelandic Patent Act No. 17/1991, including all amendments:</p>	<p>No, there are no such guidelines in Iceland.</p>

	2	3
	<p>Article 1 a (Act No. 22/2004, Art. 2 (a) (Valid from May 11 2004)):</p> <p>The human body in its various stages of formation or development and the mere discovery of any of its elements, such as nucleotide sequences or partial nucleotide sequences of genes, cannot be considered patentable inventions.</p> <p>Notwithstanding Paragraph 1, an element of the human body, including a nucleotide sequence or partial nucleotide sequence of a gene, which is isolated from the body or produced in another way by a technical process may be considered a patentable invention even if the structure of such an element is identical to the structure of a natural element.</p> <p>Excerpt from the Regulation on Patents No. 477/2012, with amendments (valid from 11 October 2013):</p> <p>Art. 13 Description [...] If an invention concerns a gene, how the nucleotide sequence or part of the sequence can be utilised commercially must be specified. [...]</p>	
IT	<p>Italian Industrial Property Code foresees the following (implementation of Articles 5 of EU Biotech Directive):</p> <p>Art. 81 quarter(1)(d) IPC states that function and industrial applicability must be concretely indicated and described for an element isolated from the human body or otherwise produced by means of a technical process.</p> <p>Art. 81 quinquies(1)(c) IPC states that the specific function, which has to be industrially applicable, of a gene or fragments thereof must be indicated, described and specifically claimed.</p> <p>Excerpts from the ITALIAN CODE OF INDUSTRIAL PROPERTY (Legislative Decree N°30 of 10 February 2005, Text effective as from 2 September 2010, as amended by Legislative Decree N°131 August 2010):</p> <p>Section IV-bis Biotechnological Inventions</p> <p>81-quater. Patentability. 1. The following may be patented provided that they meet the requirements of novelty and inventive step</p>	No Guidelines made by Italian Patent Office.

2	3
<p>and are susceptible to industrial application: [...]</p> <p>d) an invention relating to an element isolated from the human body or produced otherwise, through a technical process, even if its structure is identical to that of a natural element, provided that its function and industrial application are concretely indicated and described. A technical process is understood as a process which only human beings are capable of carrying out and that nature by itself is not able to perform; [...]</p> <p>81-quinquies. Exclusions.</p> <p>1. Subject to the exclusions set forth in Article 45(4), the following may not be patented:</p> <p>a) the human body, from the moment of conception and in the various stages of its development, nor the mere discovery of one of the elements of the body itself, including the sequence or partial sequence of a gene, in order to guarantee that patenting rights are exercised with respect for the fundamental rights and integrity of man and the environment; [...]</p> <p>c) a simple DNA sequence, a partial sequence of a gene, used to produce a protein or a partial protein, unless an indication and description is provided of a function useful for evaluation of the requirement of industrial application and the corresponding function has been specifically claimed; each sequence is considered independent for patent purposes in the event of sequences that overlap only in the parts not essential to the invention. [...]</p>	
<p><b>LI</b> See under "CH"</p>	
<p><b>LT</b> No purpose/function limited protection for DNA sequences is specially mentioned in Lithuanian Patent law.</p> <p>Excerpt from THE REPUBLIC OF LITHUANIA PATENT LAW 18 January 1994 No. I-372, Vilnius (as last amended on 23 December 2010 by Law No. XI-1261):</p> <p>Article 4. Patentable Inventions Patents shall be available for any inventions in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. The following shall not be regarded as inventions: [...]</p>	<p><b>NO</b> Correspondingly examination of purpose/function limited protection for DNA sequences is not specified in national Guidelines for examination. (Regulations on Submission, Examination of Patent Applications and Issuance of Patent)</p>



	2	3
	<p>5) existing in a natural environment the human body or its element, including the sequence or partial sequence of a gene, at the various stages of its formation and development. This provision shall not apply to an element isolated from the human body or otherwise produced by means of a technical process, as well as to the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element [...]</p>	
<p><b>LU</b></p>	<p>The industrial applicability of gene sequences must be mentioned in the application in order to meet the requirement of industrial applicability.</p> <p>Excerpt from the Law of July 20, 1992 Amending the System for Patents for Invention, as amended by the Law of April 7, 2006:</p> <p>Art. 5ter</p> <p>1) The human body, at the various stages of its formation and development, including germ cells, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.</p> <p>2) An isolated element of the human body or otherwise produced by a technical process, including the sequence or the partial sequence of a gene, can constitute a patentable invention, even if the structure of this element is identical to that of a natural element.</p> <p>3) Only an invention constituting a technical application of a function of an element of the human body may be protected by a patent. This protection shall cover the element of the human body only to the extent necessary to the realization and the exploitation of this particular use. Such use must be disclosed in the patent application in a concrete and precise manner.</p>	<p>NO</p>
<p><b>MC</b></p>		<p>NO</p>
<p><b>MK</b></p>	<p>There is NO purpose/function limited protection of nucleic acid sequences in the patent legislation of Macedonia.</p> <p>Excerpt from the LAW ON INDUSTRIAL PROPERTY:</p> <p>Patentable inventions</p> <p>Article 25</p> <p>[...]</p> <p>(3) An invention shall not be considered as invention within the meaning of paragraphs (1) and (2) of this</p>	<p>The Macedonian patent office does not perform substantive examination. Consequently, there are NO guidelines for examination of purpose/function limited protection for nucleic acid sequences.</p>

	2	3
	<p>Article if it is: [...]</p> <p>4) human body in different stages of its formation and development or simple discovery of one of its elements, including a sequence or a partial sequence of a gene. [...]</p> <p>5) Element which is isolated from the human body or produced by means of a technical process containing a sequence or a partial sequence of a gene may also be protected by a patent when the structure of that element is identical with the one of the natural element, whereby the industrial applicability must be contained in the description of invention included in the application form. [...]</p>	
<b>MT</b>	<p>Isolated nucleic acid sequences may be patented, so long as the industrial application of the sequence is disclosed in the application as filed.</p> <p>Excerpts from the Patents and Designs Act, Cap 417 Laws of Malta:</p> <p>Art. 4 [...]</p> <p>(5) A patent shall not be granted in respect of: [...]</p> <p>the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene: Provided that an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element; [...]</p> <p>Art. 15 [...]</p> <p>(2)</p> <p>(a) Where an application refers to an element isolated from the human body or otherwise produced by means of a technical process including the sequence or partial sequence of a gene, the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.</p> <p>(b) When the application concerns a sequence or a partial sequence of a gene used to produce a protein or part of a protein, it is necessary to specify which protein or part of protein is produced or function or sequence it performs. [...]</p>	<p>NO</p>

	2	3
<b>NL</b>	<p>A function/use of nucleic acid and/or protein sequences must be mentioned in the application in order to meet the requirement of industrial applicability. No need to include this in the claim.</p> <p>Excerpts from the Dutch Patent Act:</p> <p>Article 2a [...] 2. Invention referred to in paragraph 1 at least include inventions concerning: [...] b. a part of the human body that is isolated or obtained otherwise via a technical process, including the sequence or a partial sequence of a gene, even if the structure of that element is identical to that of a natural element; [...]</p> <p>Article 3 1. No patent shall be issued for: [...] b. the human body in its various stages of its formation and its development, as well as the sole discovery of one of its parts, including a sequence or partial sequence of a gene; [...]</p> <p>Article 25 [...] 3. If an invention relates to a sequence or partial sequence of a gene, the description shall contain a concrete description of the function and the industrial application of that sequence or partial sequence. In the event that a sequence or a partial sequence of a gene is used for the production of a protein or partial protein, the description of the industrial applicability shall contain a specification of the protein or partial protein that has been produced and its function. [...]</p>	<p>NO, the patent office guidelines do not say anything about purpose/function limitation of claims.</p>
<b>NO</b>	<p>No, there is no explicit purpose/function limitation in the Norwegian Patent Act.</p> <p>Excerpt from the Norwegian Patents Act:</p> <p>Section 1 a. The human body, at all of the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions. An element which is isolated from the human body or otherwise produced by means of a technical</p>	<p>The Guidelines contain a general requirement that the industrial applicability of the invention should be disclosed in the application:</p> <p>3.3.7 Industrial applicability The description shall explicitly state how the invention shall be utilised industrially, if this is not obvious from the description of the invention or it immediately is evident from the nature of the invention (see T870/04). In view of the broad meaning of the term "which is industrial applicable" in the patent Act section 1, 1st paragraph, see chapter IV, point 3.1.[Guidelines], it must in most cases be expected</p>

2	3
<p>process, including the sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a naturally existing element.</p>	<p>that how the invention is industrial applicable will be self-explanatory such that an explicit description of this is not necessary. But it may be cases, e.g. concerning methods for testing, where the industrial applicability is not obvious and where this if that is the case must be clarified.</p>
<p><b>PL</b></p> <p>According to Article 932 of recently amended Polish Industrial Property Law which came into force on December 1, 2015:</p> <p>[...]</p> <p>2. In a patent application concerning a sequence or a partial sequence of a gene, the industrial application of the sequence must be disclosed in the patent description, and additionally its function is to be indicated in the independent patent claim.</p> <p>3. In order to fulfil the industrial applicability criterion in a case of use of a sequence or a partial sequence of a gene for production of a protein or a protein part, it is to be defined in the description of the invention which protein or which part thereof is produced and what is their function.</p>	<p>No. There are no Guidelines for Examination in Poland of purpose/function limited protection for nucleic acid sequences.</p>
<p><b>PT</b></p> <p>The Portuguese Industrial Property Code does not specifically mention limitations to the protection of nucleic acid sequences.</p> <p>Only Article 54(c) refers to the specific case of sequences or partial sequences of genes:</p> <p>Article 54 Special cases of patentability</p> <p>1. The following shall be patentable: [...]</p> <p>c) A new invention, involving an inventive step and being susceptible of industrial application, concerning any element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element, provided that the industrial application of a sequence or partial sequence of a gene is expressly stated and specifically explained in the patent application; [...]</p>	<p>However, the guidelines for examination of the Portuguese Patent Office include some provisions related to this matter:</p> <p>1.5.1.3 Protection of DNA sequences</p> <p>For the DNA sequence of an organism or for a protein found in nature, it will be necessary to find an industrial application. The clarification of the function of the respective DNA/protein sequence may be sufficient, but it must be based on viable methods, such as functional studies (Article 57 EPC) and only in this way will it be possible to patent one or more genes or portions thereof. In these cases, a sequence of nitrogenous bases (A, G, C and T) must be provided, which is to be inserted in programmes for this purpose (e.g. <a href="http://www.ncbi.nlm.nih.gov/blast/Blast.cgi">http://www.ncbi.nlm.nih.gov/blast/Blast.cgi</a>) so that it will be aligned with the genome sought and make it possible to assess the criteria of novelty and/or inventive step. For this purpose, it is important that this sequence be submitted in digital format.</p>
<p><b>RO</b></p> <p>No purpose/function limited protection for nucleic acids sequences, but Romanian Patent Law 64/1991 requires that its industrial application be disclosed in the patent application.</p>	<p>There are no Guidelines for Examination in Romania, but The Implementing Regulation of the Patent Law 64/1991, also mentions in art 72(3) that:</p>

2	3
<p>Excerpts from Law No. 64/1991 on Patents (as amended up to Law No. 83/2014):</p> <p>Chapter II - Patentable Inventions</p> <p>Art. 6 [...] (2) Inventions in the field of biotechnology shall be patentable if they relate to: [...] d) an element isolated from the human body or otherwise produced by a technical process, including the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element.</p> <p>Art. 8 (1) Patents shall not be granted under this Law in respect of: [...] c) the inventions having as a subject-matter the human body in its various stages of formation and development, as well as the mere discovery of one of its elements, including the sequence or partial sequence of a gene; [...]</p> <p>Art. 12 [...] (2) The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application.</p>	<p>The industrial applicability of a sequence or of a partial sequence of a gene shall be concretely disclosed in the patent application, by indicating the specific function of the sequence or partial sequence.</p>
<p><b>RS</b></p> <p>Excerpts from The Patent Law:</p> <p>Human Body and its Elements</p> <p>Article 8 The human body, at any stage of its formation and development, and the simple discovery of one of its elements, including sequences or partial sequences of genes, shall not be regarded as invention that can be protected by a patent. An element isolated from the human body or produced by means of a technical process, including the sequences or partial sequences of genes, may be patentable, even where the structure of that element is identical to that of a natural element. The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application on the day of its filing.</p>	<p>NO, the examination Guidelines do not concern purpose/function limited protection for patentable sequences.</p>

	2	3
<b>RS</b>	<p>Excerpts from The Patent Law:</p> <p>Human Body and its Elements</p> <p>Article 8</p> <p>The human body, at any stage of its formation and development, and the simple discovery of one of its elements, including sequences or partial sequences of genes, shall not be regarded as invention that can be protected by a patent.</p> <p>An element isolated from the human body or produced by means of a technical process, including the sequences or partial sequences of genes, may be patentable, even where the structure of that element is identical to that of a natural element. The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application on the day of its filing.</p>	<p>NO, the examination Guidelines do not concern purpose/function limited protection for patentable sequences.</p>
<b>SE</b>	<p>A function/use must be given in order to meet the requirement of industrial applicability, but this use does not have to be included in the claim and does not, arguably, limit the protective scope of a claim.</p> <p>Excerpts from The Patents Act:</p> <p>Article 1 b.</p> <p>The human body at the various stages of its formation and development, as well as the mere discovery of one of its elements, including the sequence of a gene or a partial sequence of a gene, cannot constitute a patentable invention.</p> <p>An isolated element of the human body or an element otherwise produced by means of a technical process, including a gene sequence or a partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical with that of a natural element. (Act 2004:159).</p> <p>Article 8, second paragraph:</p> <p>[...] If the invention relates a gene sequence or a partial sequence of a gene, the application must, however, always indicate how the invention can be applied industrially. The description shall be sufficiently clear for it to be carried out by a person skilled in the art with the guidance thereof. [...] (Act 2014:289)</p>	<p>NO, the patent office guidelines do not say anything about purpose/function limitation of claims.</p> <p>Excerpt from the Guidelines:</p> <p>B5, 3.2 [...] In order for a DNA sequence or partial sequence of a gene to be patentable, the application must specify how it is susceptible of industrial application (see § 8 PL of the second paragraph fourth sentence). For example, if a sequence or portion of a gene sequence is to be used to produce a protein, the description should specify which protein that is to be produced, and which function the protein shall exercise.</p>
<b>SI</b>	<p>The industrial applicability of gene sequences must be mentioned in the application in order to meet the requirement of industrial applicability.</p>	<p>NO</p>



2

3

Excerpt from the Decree on the Legal Protection of Biotechnological Inventions:

#### Article 5

(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

(2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

(3) The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

**SK**

However, the industrial applicability of DNA sequences has to be described in the patent application.

Excerpts from Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended (The Patent Act, consolidated version 2009):

#### Article 5

Patentability of inventions

[...]

(2) Patents pursuant to paragraph 1 shall be also granted for biotechnological inventions concerning to a product consisting of or containing biological material, or to a process by means of which biological material is produced, processed or utilised, including cases when invention relates to

[...]

d) an element isolated from a human body or produced by other means of a technical process, including a sequence or partial sequence of a gene also in the case when the structure of such element is identical with a structure of a naturally existing element.

[...]

#### Article 6

Exceptions to patentability

(1) Patents shall not be granted to

[...]

d) inventions relating to human body in different stages of its formation or development or relating only to discovery of some elements of human body, including sequences or partial sequence of a gene, with an exception pursuant to Article 5(2)(d),

[...]

NO, the examination Guidelines do not concern purpose/function limited protection for patentable sequences.

	2	3
	<p>Article 38 Special provision on application of biotechnological invention [...] (7) If a sequence or partial sequence of a gene is a subject-matter of an application, industrial applicability of an invention must be explained in the application. [...]</p>	
<b>SM</b>	<p>There is no purpose/function limited protection in San Marino.</p> <p>Excerpt from LAW n. 79 of 25 May 2005 - Industrial Property Consolidation Act:</p> <p>Article 2 (Subject-matter of the patent and exclusions from patentability) [...] 4. The following inventions are not patentable: [...] d) inventions concerning the human body, at all of the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene. [...]</p>	<p>The patent office has also NOT issued any guidelines in respect of that.</p>
<b>TR</b>	<p>There is not any limitation or any case law related to this subject.</p>	<p>No. The Turkish Patent Institute does not have any guidelines for examination of purpose/function limited protection for DNA sequences.</p>

## Meeting Rooms of the epi Secretariat

The meeting rooms are available for our **epi** members. For further information, please contact the **epi** Secretariat as follows:

Tel +49 89 242052 0  
Fax +49 89 242052 20  
e-mail: [info@patentepi.com](mailto:info@patentepi.com)



# Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair



Francis Leyder

This report completed on 16 May 2016 covers the period since my previous report dated 4 March 2016 published in **epi** Information 1/2016.

The EPPC is the largest committee of the **epi**, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT,

and (3) "the future EU Patent Regulation", including any revision thereof, except all questions reserved for the Biotech committee.

The EPPC is presently organised with six permanent sub-committees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, and Unitary Patent). Additionally, *ad hoc* working groups are set up when the need arises. Thematic groups are also being set up.

## 1. European patent with unitary effect in the participating Member States

The 19<sup>th</sup> Select Committee meeting was held on 15 March 2016. The Committee unanimously re-elected Mr Debrulle (BE) chairman of the Committee for a term of three years. There was large support, among the delegations that spoke, for the possible implementation at national level of a safety net provision in case of late rejection of a UPP request.

Some details of the implementation were discussed. A workshop dedicated to the basic specifications of the technical systems for the data transfer in relation to Unitary Patent Protection will be organised by the Office in the morning of 20 May 2016.

The next SC meeting has been scheduled on 21 September 2016.

In the meantime, the series of UP/UPC seminars initiated by **epi** has started, in Munich (on 15 April, with the support of the EPO), then in Helsinki (27 April) and in Dublin (11 May).

## 2. Meeting of ACPI with EPO and epi

On 16 March 2016, on the occasion of the visit of the President of ACPI (Asociación Colombiana de la Propiedad Intelectual) to the EPO and **epi**, I made a short presentation on the unitary patent system (available on our website for our members).

## 3. SACEPO/WPR 14

During the meeting of 7 April 2016, documents SACEPO WPR 2/16 to 5/16 were discussed.

The EPO reported on the results of ECfS "Early Certainty from Search", and presented the measures that will be taken to improve the overall EPO timeliness with the aim of meeting the "Paris Criteria" objectives (patents to be granted, on average, within three years; see OJ 8-9/1999, p. 547-548) by the end of 2020. In particular, this includes concluding grants on average within 12 months after the start of substantive examination. Quoting from document SACEPO/WPR 2/16:

"Telephone conversations will be promoted, while ensuring that the content is reflected in the public part of the file in the form of minutes. Minutes of a telephone conversation can be issued as a first examination action under Article 94(3) EPC."

"In the longer term, where the EPO internal examination handling times are shortened significantly, a discussion will be triggered on aligning certain time limits such as under Rule 132(2) EPC with internal examination time limits. In particular the extension up to six months and its conditions is scrutinised. Discussion will also be triggered on the conditions for use of further processing (Rule 135(1) EPC). These measures are expected to reduce pendency by speeding up the exchange between the EPO and applicants."

"Finally, the Office considers rationalising time limits related to the entry into the European phase, thereby strengthening the PCT procedure."

The EPO presented incentives to encourage withdrawals of the applications (SACEPO/WPR 3/16):

- (1) Applicants will receive advance notice of the intended start of the examination.
- (2) The EPO proposed to amend Art. 11 RRF so as to increase the fee refund in case of withdrawal, deemed withdrawal or refusal before substantive examination has begun from 75 % to 100 %
- (3) The EPO proposed to amend Art. 11 RRF and introduce an additional opportunity for a 50 % refund of the examination fee in case of withdrawal either before expiry of the time limit for replying to the first communication under Article 94(3) or before the date<sup>1</sup> of the communication under Rule 71(3) if the latter is the first from the Examining Division.

<sup>1</sup> The users noted that this would appear to penalise those applicants who provide the EPO with "ready to grant" applications.

The revised workflow of the opposition proceedings, already presented to **epi** during the meeting with VP1 last February, was explained. It is clearly a reaction to the announcement that the UPC would deal with revocation actions in 12 months. It would apply as from July 2016, after publication of a Notice in the OJ. The reduction to 15 months (from expiry of the opposition period) of the time needed to announce the decision in oral proceedings would be achieved by:

- Allowing extensions of time limits only exceptionally
- Allocating the opposition file to the primary examiner as soon as the proprietor has replied
- Issuing summons to oral proceedings (including summoning to oral proceedings at the instance of the EPO in the 10% of cases where parties had not requested them) – within 3 months of receipt of the proprietor's response
- Setting the date of the oral proceedings at least 6 months after the date of issue of the summons, and the final date under Rule 116(1) EPC normally two months before the oral proceedings

Finally, the participants were informed of forthcoming/envisaged changes in the area of the fee payment processing. (SACEPO/WPR 5/16).

- Introduction of clear prioritisation rules in the ADAs as of 1 April 2016: the EPO gives priority to booking automated debit orders.
- Introduction of a validation tool for erroneous batch payments of renewal fees (second half of 2016)
- Earlier visibility of deposit account replenishments (second half of 2016: next day, now 2-3 working days)
- Limitation of the filing of a debit order to "online means": debit orders filed on paper, fax or via web form filing using Forms 1001, 1200, 1010, PCT/RO/101 and PCT/IPEA/401 will no longer be carried out. Since 8% of all fee payment transactions are made using paper forms, we did not welcome this envisaged change, and did not support claims that it aims at "facilitating the payment processing" (obviously not in the opinion of the users behind these 8%), "reducing the administrative burden in the administration of the deposit accounts [...] for the applicants [...], meeting the users' expectations and avoiding unnecessary losses of rights".
- Applicability of Automatic Debiting to the current exceptions provided by the ADAs: under investigation.
- Excluding renewal fees from automatic debiting: possibility being explored.

#### 4. CPL46

The 46<sup>th</sup> meeting of the Committee on Patent Law (CPL46) took place on 12 May 2016. It discussed two topics relevant to the remit of the EPPC.

The Committee gave a favourable opinion to the amendments of Article 11 RRF proposed by the EPO. The EPO confirmed that, where a representative has been appointed, he would receive the advance notice of the intended start of the examination.

The Committee discussed the question of the last day of validity of a European patent in the Contracting States (20th anniversary, or the day before), but no conclusion could be drawn.

#### 5. PfQ

The Partnership for Quality meeting with **epi** took place on 19 April 2016. The EPO shortly presented how they are ensuring quality, and then informed participants on improvement of the overall EPO timeliness (see also my report of the SACEPO/WPR 14 meeting, item 3 above). The EPO slides are available to **epi** members on the **epi** website, Forum "News", Thread: Partnership for Quality meeting, Munich: <http://patentepi.com/en/epi/forum/threads/99>

#### 6. PCT WG9

The PCT Working Group will next meet in Geneva from 17 to 20 May 2016. The working documents are available on the WIPO website: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=39464](http://www.wipo.int/meetings/en/details.jsp?meeting_id=39464)  
A PCT User Meeting will take place on 18 May.

#### 7. PAOC thematic group

The PAOC thematic group of the EPPC (pure and applied chemistry, including pharmaceuticals) will again meet with the EPO Directors in that field on 22 June 2016.

#### 8. Independence of the Boards of Appeal

At the date of finalising this report, we were not informed of any further development.

#### Guidelines

The EPPC urges the readers of this journal to address to its Guidelines Sub-Committee at [eppc@patentepi.com](mailto:eppc@patentepi.com) any comments regarding the Guidelines for Examination in the European Patent Office <https://www.epo.org/law-practice/legal-texts/guidelines.html> or suggestions to improve them.

The same applies to the Guidelines for Search and Examination at the EPO as PCT authority <https://www.epo.org/law-practice/legal-texts/guidelines-pct.html>.



## Executive Summary of the Meeting of the ICT Thematic Group of the EPPC

The ICT Subcommittee of the **epi**'s EPPC Committee met with the EPO's Directors (henceforth: EPOD) of the ICT cluster (PD18) on 2 December 2015 in a third meeting.

- 1) An executive summary of the second meeting that shall be published in the **epi** Journal was accepted with minor edits.
- 2) The meeting had a strong focus on the completeness and pertinence of European searches in relation to later prosecution, as well as the number and applicability of clarity objections, for CII (computer implemented invention) applications. In addition to this, the EPOD advised about specific challenges and approaches taken in handling large filers' portfolios within normal, established programs such as PACE, Early Certainty, and the complaints procedure.
  - i) In discussing different BoA case law and its consequences, **epi** commended the approach of examiners prepared to take the effort to cite relevant documents in searches and office actions for all features of a claim – and sub-claims – rather than dismissing them on the basis of “non-technical”, “common knowledge”, or “design choice” objections without documentary evidence. **epi** expressed concern that non-technical motivation for inventions might easily be confused with non-technical problems and thus promote the frequency of such objections. **epi** held it should be possible to produce documents to support such objections to also facilitate better examination results. EPOD held that the number of “common knowledge” or “design choice” objections should decrease significantly given recent Examination Guidelines changes. Also, continuous amendments and supplements to the Examination Guidelines should give better guidance to Examiners to distinguish features contributing to technical effect from those that don't and thus ultimately improve searches and examination results. To support the understanding and correct assessment of the objective technical problem, as well as the aspects of the invention contributing to its solution,

EPOD considers that applications should be drafted with greater implementation detail. This would also help to avoid inappropriate “non-technical” or “common knowledge” objections.

- ii) **epi** expressed the opinion that the number of terminology-based clarity objections in CII applications seems very high and their merit sometimes questionable. Objections may be based on documents or other uses of the objected term with a different meaning but *entirely unrelated to the specification*. Still, Examiners often correctly understand the terminology and issue pertinent search reports or office actions. EPOD notes that feedback from EPO-internal quality control often points out clarity as being an issue, and much is done to address that. However, EPOD encourages representatives' feedback on allegedly inapplicable clarity objections to help improve Examiners' training in this respect and thus moderate the extent of non-pertinent clarity objections.
- iii) EPOD are generally amenable to receiving feedback from representatives. In appreciation of the point raised by **epi** that representatives do not wish to be seen to be “complaining” (due to a perception that this jeopardises the attorney-examiner relationship) EPOD will suggest a “re-branding” of the “complaints procedure” to a “user feedback procedure”.
- iv) EPOD outlined recent developments in PACE and ECfS programs. In relation thereto, EPOD summarised its strategy to support applicants in managing large portfolios following official complaint about high levels of delay, by suggesting filing of a limited number of PACE requests at a time (eg. bi-monthly) that can be reasonably dealt with. This way, the system is not overloaded with massive numbers of PACE requests in one batch from large filers, and smaller filers continue to receive at least equal or even improved benefit from PACE. EPOD indicated that since this regime was put in place, and together with the effects of ECfS, the EPO has a much more effective processing of PACE requests in critical areas of high delay.

### Next Board and Council Meetings

#### Board Meetings

95<sup>th</sup> Board meeting on 10 September 2016 in Haarlem (NL)

#### Council Meetings

81<sup>st</sup> Council meeting on 12 November 2016 in Berlin (DE)

82<sup>nd</sup> Council meeting on 24/25 April 2017 in Munich (DE)



# Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

This reflects the report to Council at the Athens meeting. Our committee had its last yearly meeting on October 9, 2015 and had a meeting with an ad hoc group of our committee with the EPO Biotech Directors on October 12, 2015.

Reports of both meetings have been published in the **epi** Information (1/2016 and 4/2015).

The EPO Biotech Directors have proposed to meet again with a delegation of our committee in spring 2017.

Simon Wright, Ann De Clercq and Tony Tangena attended on May 18<sup>th</sup> the Symposium "Restoring the balance between patents and plant breeders' rights" (Brussels). Simon Wright attended as observer the CPL meeting on May 12<sup>th</sup>.

The **epi** Biotech Committee has prepared an amicus curiae brief in the Arioso vs. Sequenom case (US). This was filed on 19 April 2016. A copy of this amicus curiae brief can be found on the **epi** website under the following link: <http://patentepi.com/en/epi-reports/position-papers.html>. The next Biotech Committee meeting will be held on 22 November 2016.

Below is a summary of some of the most important points discussed by email in our committee in since our last meeting in 2015.

## 1. Patentability of plants - EBA Decisions G2/12 ("Tomatoes II") and G2/13 ("Broccoli II")

We reported on this matter in our published reports in **epi** Information. We also published on this matter an article "Patentability of Plants" in **epi** Information 4/2015. Decisions G2/12 and G2/13 have clarified that product claims or product-by-process claims directed to plants or plant material other than a plant variety are not excluded from patentability under Art. 53 (b) EPC and are allowable if they fulfill the formal and substantive requirements of the EPC. These decisions confirm that exclusions to patentability have to be construed narrowly. The EPO Guidelines for examination were amended in this way. The EC Expert Group dealing with the EU Biotech Directive 98/44/EC was also discussing this topic and related topics concerning plants. The EU expert group delivered a report including plants recently. We regularly discuss these matters within our committee by email and at our meetings. We favor that all **epi** members in the group to regularly consult with the Biotech Committee. Due to the fact that this is a very specialized area our committee has associate members that also help a lot to the discussion in this area.

## 2. Stem Cells

This relates to R. 28 (c) EPC and G2/06. The EPO guidelines currently mention a certain practice of dealing with patentability of stem cells, in particular on the Brüstle case. We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016).



Ann De Clercq

## 3. Sequence Listings and alignments

As reported for the last council meeting we will reply in writing to the BASF letter (July 2015) that the **epi** Biotech Committee could not agree to all of the points of BASF. It was considered not useful to submit this kind of letter to the EPO at this moment. BASF can always present letters to the EPO by themselves.

## 4. Medical use claims

We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016) on this matter. This relates to T1021/11 (June 2015) which confirm that Swiss type and Art. 54(5) type claims can co-exist.

## 5. Added Matter – Article 123(2) EPC

We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016) on the Guidelines in respect of this matter. The emphasis should be on what the skilled person would understand from the specification.

## 6. Pharmacogenomics

We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016) on in respect of this matter.

## 7. Antibodies

We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016) on in respect of this matter.

The EPO cannot give access to the internal harmonization notes on this matter.

8. Purpose bound protection for genes

Our committee has finalized and published on the **epi** website an overview of the national laws on protection of nucleic acid sequences with a focus on the question whether countries have a purpose/function limited protection of such nucleic acid sequences. A copy of this report is attached. This overview has also been shared with the EC Expert Group on biotechnological inventions on which a few **epi** members sit. Our committee has also prepared a position paper on this matter as discussed at the last Council Meeting (see attached).

Discussion is ongoing at certain levels about purpose bound protection of genes.

9. Non-unity

We reported in our minutes of the meeting with the EPO of October 12th (**epi** Information 1/2016) on in respect of this matter.

10. Associate members

New associate member requests will be discussed by email and at our next committee meeting.

Report of the Reporting Group on the Reform of **epi**  
“Council decides not to change its size and composition”

L.A. Durán (ES), Chair



Luis Alfonso Duran

1. Report to Council in Athens April 23, 2016

The **epi** Council decided on November 14, 2015 in Cologne to reduce its size and entrusted the Reporting Group to prepare and present new proposals to be considered at its next Council meeting (see report on **epi** Information 4/2015, pages 130-132).

Accordingly, the Reporting Group met in London (Heathrow) on January 13th, 2016 and prepared a proposal that was sent to all Council members and substitutes on February 8th, 2016 inviting them to send their comments.

The proposal included a protection clause that in practice meant that no country would lose or gain more than one delegate from one election to the next. Furthermore, a proposal to solve the problem of uneven number of delegates in non-unitary jurisdictions was also included. The main reasons why the Reporting Group was proposing a change in the composition of Council were the following:

a) To try to get a better balance between the principle of proportionality (more representatives in those countries who have more **epi** members, following the advice given

by prof. Ulrich Battis in his expert opinion – see **epi** Information 4/2015) and representation (all Member States should be present in Council).

b) To achieve a better efficiency in the work of Council. A body with 140 members is difficult to manage. At the end, Council is elected by the **epi** members of their respective Member States, so, what Council members have to do is to collect the views of the members they represent and express these views at Council meetings. To do that, it is not required to have so many delegates.

c) Given the fact that travelling and hotel costs of Council meetings are reimbursed, a reduction in the size of the Council would reduce the amount of the **epi** budget applied to Council meetings. This freed-up of financial resources could be more efficiently dedicated towards other **epi** activities, like for example education.

So, in summary, the Reporting Group considered that a change in the composition of Council, as agreed by Council in its meeting in Cologne, would be desirable.

The proposal consisted in changing the current composition of the Council that is formed by 140 members calculated as follows:

up to 25 members:	2 delegates
from 26 to 500:	4 delegates
over 500:	6 delegates

to the following new composition (Proposal I):

from 1 to 20 members:	1 delegate
from 21 to 60 members:	2 delegates
from 61 to 180 members:	3 delegates
from 181 to 540 members:	4 delegates
from 541 to 1620 members:	5 delegates
from 1621 to 4860 members:	6 delegates
from 4861 to 14580 members:	7 delegates

This proposal would have reduced the composition of Council from 140 to 104 seats.

52 replies were received from Council members. The Reporting Group met again in Amsterdam (Schiphol) on February 24th, 2016 to analyze and discuss the replies received and prepared a new report to Council members including a new proposal (Proposal II, as follows):

from 1 to 100 members:	2 delegates
from 101 to 300 members:	3 delegates
from 301 to 900 members:	4 delegates
from 901 to 2700 members:	5 delegates
from 2701 to 8100 members:	6 delegates

This proposal would reduce the composition of Council from 140 to 100 seats.

Board members were asked to collect the views of the Council members of their respective jurisdictions, in order to be able to report about their views at the Board meeting held in Tallinn on March 13th, 2016 and to explore whether any of the two proposals would receive a sufficient support from Council in its Athens meeting. According to Article 14 of the Founding Regulation a 2/3 majority of Council membership is required to change the composition of Council.

In the light of the comments and observations of Board members a new compromise proposal was prepared by the Reporting Group (Proposal III) that would include the principle that no country would have less than two seats. This new proposal was the following:

up to 60 members:	2 delegates
from 61 to 180 members:	3 delegates
from 181 to 540 members:	4 delegates
from 541 to 1620 members:	5 delegates
from 1621 to 4860 members:	6 delegates
from 4861 to 14580 members:	7 delegates

This proposal would have reduced the composition of Council from 140 to 112, and it was presented to Council in Athens.

At the Athens Council meeting the Secretary General pre-

sented a motion so that, in case the proposal of the Reporting Group (Proposal III), would not get a sufficient support, an alternative proposal should be voted.

The proposal of the Secretary General was the following:

from 1 to 10 members:	1 delegate
from 11 to 30 members:	2 delegates
from 31 to 150 members:	3 delegates
from 151 to 500 members:	4 delegates
from 501 to 1500 members:	5 delegates
from 1501 to 4500 members:	6 delegates
over 4500 members:	7 delegates

This proposal would have reduced the composition of Council from 140 to 116 seats.

The two proposals were put to vote. Proposal III was rejected. The result of the voting was the following:

In favour:	62
Against:	63
Abstentions:	5
Council members absent:	9
Not elected Council member from MT:	1
Total:	140

Then the Proposal of the Secretary General was voted and, it was rejected as well, because it did not get the 2/3 majority (94 votes in favour). The result of the voting was the following:

In favour:	69
Against:	53
Abstentions:	1
Void votes:	1
People not voting:	6
Council members absent:	9
Not elected Council member from MT:	1
Total:	140

## 2. Future work of the Reporting Group

In the light of the decisions adopted by Council in Athens, it has become clear that Council is not in favour, with the sufficient majority, to change its current composition. Accordingly, it makes no sense that the Reporting Group continues its work in this direction.

The proposal presented and accepted by Council was that the Reporting Group would continue to work on other ideas, like for example in proposals to adopt email Council decisions, improving the methodology of Committee work and better communication of **epi** work to **epi** members.

New proposals on those subjects will be presented to the Council at its next meeting in Berlin on November 12<sup>th</sup>, 2016.

## Report of the Litigation Committee

A. Casalunga (FR), Chair



Axel Casalunga

### I) UPC courts fees and recoverable costs

The final draft has been published on February 25<sup>th</sup>, 2016.

It contains:

- an amended Rule 370 of the Rules of Procedure
- a table of fees
- a scale of ceilings for recoverable costs

In addition a draft Guidelines

has been issued, for establishing the value of actions for the determination of Court fees and recoverable costs.

When comparing the previous with the current version of the document, the following differences can be noted concerning the court fees:

- There is no more a fee for opt-out (or withdrawal of opt-out).
- It has been clarified that only one fee applies in the case of more than one claimant or defendant or a plurality of patents.
- Reimbursement in case of single judge, withdrawal or settlement is provided in addition of a possible reduction of 60% of all court fees for small and micro enterprises
- Only small enterprises and micro-enterprises are entitled to the reduction. Medium-sized enterprises, non-profit organisations, public research organisations and universities are not anymore eligible.
- A sanction has been introduced for the case where an applicant has wrongfully stated to be entitled to the reduction (additional 50% of the regular fee).
- Changes regarding the value-based fees:
  - In the range above 750.000 € to including 2.000.000 € value, the fees have been reduced.
  - In the range above 3.000.000 € to including 25.000.000 € value, the fees have been increased.
  - Above 30.000.000 € value, the fees have been increased. Additional ranges for up to and including 50.000.000 € value and for more than 50.000.000 € value have been introduced.
- The fee for an application for an order to freeze assets has been reduced.
- The fee for a request for discretionary review has been reduced.

The payment of the value based fee will now have to be made together with the lodging of the relevant action, at the same time as the payment of the fixed fee, on the

assumption of correctness and based on the estimated value of the litigation. The amount will be rectified during the interim procedure.

With regard to the recoverable costs, it has been clarified in the preamble (para. 1, last sentence) that the Court has a large margin of appreciation and that the ceilings are only a safety net, i.e. an absolute cap.

Changes regarding the ceilings for recoverable costs:

- Up to and including 1.000.000 € value, the ceilings have been reduced.
- In the range above 16.000.000 € to including 30.000.000 € value, the ceilings have been increased.
- Above 50.000.000 € value, the ceiling has been reduced.

The major part of the changes correspond to the suggestions made by **epi** in the position paper sent to the Preparatory Committee or can be accepted.

Nevertheless, the Litigation Committee considers that some points should be further amended.

According to the proposal of the Litigation Committee the **epi** sent to the Preparatory Committee a position paper containing the following comments:

- The 60% fees reduction applies only to small and micro enterprises, while Article 36-3 of the UPCA mentions also medium-sized enterprises, non profit organizations, universities, research organizations and natural persons. Concerning natural persons, the possibility to request legal aid as provided in Rules 375 and following is rather complex so that a reduction of fees would seem a better solution.
- §7 of the new draft for Rule 370 states that « only one fixed fee will apply if an action has more than one claimant and/or more than one defendant or if the action concerns a plurality of patents ». This is somewhat unclear since the following table of part IV mentions « fee ». It should be made clear that §7 applies to all fees (fixed fees and value based fees)
- The ceilings indicated for the recoverable costs seem to apply only to representation costs, meaning that they do not include experts costs, experiments costs, witnesses costs and any other costs: this should be clarified
- In case of bifurcation, it should be made clear that this would in fact constitute almost a second action, with a separate procedure and a separate oral hearing: the ceilings should take this into account

## II) Draft Rules of Procedure

The 18<sup>th</sup> draft of the Rules of procedure dated 19 October 2015 is almost definitive.

Nevertheless it seems still possible to make further remarks. According to the proposal of the Litigation Committee the following comments were sent by the **epi** to the Preparatory Committee:

### *Rule 5 - Opt-out and withdrawal of the opt-out*

According to Rule 5-4, no representation is compulsory for lodging an application for opt-out or an application to withdraw an opt-out. This provision is also in the UPCA and cannot therefore be amended.

However, when a representative is appointed it should be a professional representative or a legal practitioner as defined in Article 134 EPC or in Article 48 of the Agreement.

In other words the sentence contained in Rule 5-4 "such a representative may include" should be replaced by "such a representative shall include".

Alternatively, if this proposal is refused, it should be proposed to require a power of attorney from any representative appointed.

According to the present wording of Rule 5 as well as the online form of the CMS, there is almost no checking of the person lodging an application for opt-out or an application to withdraw an opt-out. It is namely sufficient to give a mobile phone number. Consequently, it is extremely dangerous and very easy for any fraudulent person to opt-out any patent from any company.

No examination will be made and only before a National court will be possible to explain that an opt-out is invalid because it was fraudulently applied for. It will be necessary to afford evidence of such a fraud.

For all those reasons, requiring a power of attorney to be filed when an application for opt-out or an application to withdraw an opt-out is lodged should be provided in Rule 5.4. Such a power of attorney should be executed by at least one of the proprietors of the patent and would permit in the future to challenge more easily a fraudulent action if the opt-out or the withdrawal of the opt-out was made against the will of the owner of the patent.

### *Rule 88 – Application to annul or alter a decision of the Office*

In the same way as for opt-out, no representation is compulsory for such an Application.

In view of the technicality of such an Application, the same remarks as for Rule 5 can be made. In the same way if a representative is appointed it should be either a professional representative or a legal practitioner defined in Article 134 EPC or a representative referred to in Article 48 of the Agreement.

A corresponding statement should be added in Rule 88-4.

### *Rule 220- Appealable decisions*

This rule is somewhat unclear:

In Rule 220-2 it is stated:

*"Orders other than those referred in Rule 220.1 and Rule 97.5, may be either the subject of an appeal together with the appeal against the decision or may be appealed with the leave of the Court of First Instance within 15 days of service of the Court's decision to that effect."*

The underlined decision seems not to be an order to be attacked. It seems to be a decision about the request for leave of the Court of First Instance. Accordingly, the 15-day term relates to the filing of the appeal following a positive decision about the allowance of the leave by the Court of First Instance. Accordingly, there is no clear term for filing the request for leave of the Court of First Instance (which should probably be 15 days of service of the Court's order to be attacked).

Consequently Rule 220-2 should be clarified.

Rule 220-3 states:

*"In the event of a refusal of the Court of First Instance to grant leave within 15 days of the order of one of its panels a request for a discretionary review to the Court of Appeal may be made within 15 calendar days from the end of that period."*

This wording is also not completely clear: What happens, if the refusal is issued after 15 days? Is a discretionary review allowable?

Consequently, Rule 220-3 should be clarified.

### *Rule 221 – Application for leave to appeal against cost decision*

Rule 221-1 states:

*"A party adversely affected by a decision referred to in Rule 157 may lodge an Application for leave to appeal to the Court of Appeal within 15 days of service of the decision of the Court refusing leave to appeal."*

This statement is not clear. The cost decision referred to in Rule 157 is a decision of the Judge-rapporteur of the first instance. The leave to appeal should first be requested from the Court of the First Instance and not from the Court of Appeal.

If this first request for leave to appeal is refused by the Court of First Instance, a further request for leave to appeal could be filed before the Court of Appeal according to Rule 221-1. The time period for filing this second request is of 15 days of service of the decision of the Court of First Instance rejecting the first request for leave.

The wording of Rule 221-1 should be amended along those lines.



### III) Draft Code of conduct for Representation before the UPC

The draft Rules of Procedure ("RoP") of the Unified Patent Court include certain restrictions on the actions of representatives of parties to actions in the UPC; and additionally create certain rights and obligations.

In the 18th Draft RoP the most important in this regard are:

- Rule 284 prohibiting a representative from misrepresenting cases or facts either knowingly or with good reasons to know;
- Rule 287 creating legal advice privilege in confidential communications between clients and advisers – whether lawyers or patent attorneys;
- Rule 288 creating litigation privilege in communications with third parties;
- Rule 290(1) granting to the UPC the powers normally accorded to courts of law in respect of representatives;
- Rule 290(2) requiring representatives strictly to comply with any Code of conduct ("CoC") adopted for representatives by the Administrative Committee;
- Rule 291(1) granting the UPC the power to exclude a representative from proceedings before the court for a range of transgressions including failure to comply with the CoC; and
- Rule 291(2) requiring the presiding judge in the event of exclusion of a representative to stay the proceedings in order to allow time for the appointment of a replacement representative.

Also worthy of mention is Rule 292 detailing the right of audience under Article 48(4) of an assisting patent attorney who is not otherwise qualified to provide representation. Rule 292 states that Rules 287 to 291 shall apply mutatis mutandis to such patent attorneys.

With regards to Rule 290(2), three organizations have taken it upon themselves to participate in drafting of a Code of Conduct. These are EPLAW (<http://www.eplaw.org/>), a voluntary-membership organization of commercial lawyers in Europe involved in patent work; EPLit, (<http://www.eplit.eu/>) another voluntary-membership organization chiefly representing European Patent Attorneys who are qualified to litigate before the UPC; and **epi**.

**epi** differs from the other two organizations in several important respects of course, being (a) constituted by statute (b) characterized by a compulsory membership regime and (c) focused on dealings with the EPO. Moreover **epi** is considerably larger than either of the other two organizations and is the only one of the three that acts in the interest of all European Patent Attorneys, including those falling under Article 48(4) UPC. This initiative has been welcomed by the Preparatory Committee for the UPC.

The current draft of the CoC is to be submitted to the Preparatory Committee for the UPC, for adoption by the Administrative Committee of the UPC once the agreement comes into force and the Administrative Committee has been created.

A preliminary draft will soon be made available for information on the **epi** website.

The Litigation Committee is actively working together with the Professional Conduct Committee of the **epi** to finalize this draft, before it is submitted to the Preparatory Committee.

### IV) Questionnaire on the IP rights enforcement Directive

The EU Commission has issued a questionnaire on the IP rights enforcement Directive (2004/48EC of 29 April 2004) with the aim of obtaining the opinion of the users on the present application of this directive in the EU Member States.

The following comments proposed by the Litigation Committee were sent to the EU commission:

The **epi** studied the questionnaire and felt generally that the future UPC, including the Rules of procedure were in line with the directive which is therefore satisfactory. In particular, the UPCA solves the current difficulties of cross border injunctions and damages for patent infringement within the territory of the Contracting Member States.

Of course, it will be necessary to carefully watch the development of the practice of this new court and the **epi** would propose to the EU Commission to report on the functioning of this new court in the future.

For the time being one point could be considered concerning access and preservation of evidence in the digital environment:

The increasing number of infringements occurring in the digital environment via websites, social media (such as Facebook pages for commercial purposes), app stores, etc. require namely quick and efficient means for preserving digital evidence that may easily be deleted from the publicly accessible webpage or other source. In that regard the IP rights enforcement directive, seem to be more designed with view to the seizure of physical proof (samples of products, materials, production machines, etc.) rather than to the preservation of digital evidence (such as data stored on servers, old or deleted versions of web pages, etc.).

Improvement in this regard could be considered.



## Report of the epi-Finances Committee

M. Maikowski (DE) , Chair

The 76<sup>th</sup> meeting of the Finance Committee took place in Munich on 6 – 7 April 2016.

The Treasurer (Mr P. Thomsen), Deputy Treasurer (Mr M. Sarap), and one of the Internal Auditors (Mr A. Tanner) attended in Munich as invited guests. The Secretary General attended by telephone for part of the meeting.

The Committee received reports from the Treasurer on (a) performance relative to budget in 2015, as recorded in the audited 2015 accounts of **epi**; (b) the budget for the remainder of 2016; and (c) projects and initiatives of the Treasurer, including investment strategies.

The Committee approves the current budget and the investment strategies proposed by the Treasurer. The Committee notes with disappointment the poor performance of investment advisers appointed in 2015, and approves the Treasurer's moves to replace them with more reliable advisers.

The Committee approves the Treasurer's plans for the introduction of new book-keeping software. The Committee in particular notes with approval the requirement for such software to integrate with "client relationship manage-

ment" (CRM) database software and educational event booking software also being introduced.

The Committee conducted a critical review of certain ongoing expenses of the Institute, including office equipment/furniture and the costs of organising meetings of the Board, Council and various other committees. The Committee reminds all chairs of committees in the Institute to exercise as much care as possible over the costs of organising meetings.

The Committee reviewed with the Treasurer the question of charging for advertising revenue in the electronic version of **epi** Information that is now distributed. The Committee recommends that the Treasurer takes advice from **epi**'s auditors on whether **epi** can earn revenues in this way while retaining its non-profit tax status in Germany.

The Committee congratulates the Treasurer on recent successes in obtaining VAT refunds in respect of expenses incurred not only in Germany but also in other EU Member States.

More generally, the Committee is grateful to the Treasurer and the Secretariat staff for the informative materials presented to the Committee's meeting.

## Forthcoming epi Educational Events

### epi CPE seminars

29	June 2016	Paris (FR)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
13	July 2016	London (GB)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
13	September 2016	Stockholm (SE)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
27	September 2016	Copenhagen (DK)	<b>epi</b> seminar »Opposition and Appeal« supported by the EPO
11	October 2016	Istanbul (TR)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
19	October 2016	Warsaw (PL)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
25	October 2016	Milan (IT)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
8	November 2016	Prague (CZ)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
17	November 2016	Eindhoven (NL)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
23	November 2016	Zurich (CH)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
7	December 2016	Hamburg (DE)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
14	December 2016	Barcelona (ES)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
25	January 2017	Manchester (GB)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
2	February 2017	Lisbon (PT)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO
8	February 2017	Brussels (BE)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow
	February 2017	Copenhagen (DK)	»Unitary patent and Unified Patent Court« <b>epi</b> roadshow supported by the EPO

### Preparation Courses for the EQE

#### Flexible epi Tutorial

(see announcement within this **epi** Information)

#### epi Mock EQEs 2016

The mock EQEs allow participants to attempt an EQE exam under exam conditions. The participants sit the papers in the same order, and in the same time, as the real exam. The exam papers are from previous EQE exams and are chosen for their didactic value. Experienced **epi** tutors mark the papers. About one month after the mock EQE, the tutors discuss the answers with small groups of candidates. Each participant receives personal feedback on his/her work.

Participants may sit any combination of papers.

#### Scheduled epi Mock EQEs:

The registration will be available shortly on the **epi** website. The final selection of the location(s) will be announced after the evaluation of the online registration.

The Mock sessions can be expected to take place in October/November 2016 and the feedback session in January 2017.

#### Online pre-examination training course by the European Patent Academy

Now entering its 7th year, the online pre-examination training course has matured into a comprehensive 6 month course. The course brings a blended e-learning offering introductory videos and many in-depth articles divided into 14 topic areas. Each of these topics have support questions and review questions, which are presented in a form similar to the real examination. In-depth case studies form the final part of this course. The course is supported by a selection of experienced **epi** tutors from around Europe. These tutors will help you through a discussion forum reserved for course participants and clarify any queries you may have. The course is delivered on a 6 month schedule, with new content every few weeks, to bring you to completion at a managed pace. With this course from the European Patent Academy you will be better prepared for the EQE pre-examination. This material is the basis for a good understanding of the main EQE relevant topics. Participation in this online course costs € 350, further information & signup can be found at <http://www.epo.org/learning-events/eqe/eqe-training.html>

#### Announcement of the CEIPI course

(see announcement within this **epi** Information)

## Flexible epi Tutorial

### Get your individual feedback on papers A/B/C/D

whenever you need it during your preparation for the EQE

- Sign for a tutorial whenever you want
- Decide which paper you want to prepare
- Arrange individually with your tutor:
  - the due date when transfer your prepared paper to your tutor
  - the date when to discuss the result of your individual paper with your tutor

- Discuss the result of your paper with your tutor
  - in small groups (on request) or
  - in a one to one session

**epi** connects you to a tutor speaking your preferred EPO language and will assist you, in case anything went wrong.

Further information on our website: <http://patentepi.com/en/education-and-training/qualifying-as-a-european-patent-attorney/epi-tutorial.html>

## Tutors wanted

Are you interested to transfer your knowledge and experience to the next generation of colleagues in our profession?

**epi** is looking to add new tutors to its current group of tutors.

What is an **epi** tutor? An **epi** tutor reviews EQE papers written by **epi** tutees by providing individual and personalised feedback on a candidate's answer.

As you passed the EQE you are experienced in preparing and writing the EQE papers, therefore no preliminary

teaching for new tutors is intended to be provided. However, a mentor, in the form of an experienced **epi** tutor, can be provided for a new tutor if required.

In case you are interested, please visit our website (<http://patentepi.com/en/education-and-training/epi-tutors.html>) for further information / enrolment form or contact the **epi** Secretariat (email: [education@patentepi.com](mailto:education@patentepi.com)). On request we will send you further information in order to be able to make a well-informed decision towards this important activity.

## CEIPI preparation courses for the EQE pre-examination and main examination 2017

The Centre for International Intellectual Property Studies (CEIPI), in particular its International Section, offers, as part of the Euro-CEIPI collaboration with the European Patent Academy, a complete range of high-quality exam preparation courses using proprietary high-quality training material. The tutors for these courses are a mix of professional representatives (from private practice and industry), and staff of the EPO. All have extensive knowledge and practical experience in the procedures before the EPO and the Boards of Appeal.

A **pre-examination** will be held in 2017 for those candidates who fulfil the requirements to present themselves to the pre-examination of the EQE in 2017 (see supplementary publication 2, OJ EPO 2014).

The CEIPI is organizing courses in Strasbourg to help candidates prepare for that pre-examination.

The seminar preparing for the pre-examination 2017 will take place from 31 October to 4 November 2016. It will cover relevant topics which can be expected for the pre-examination. The seminar will give participants the opportunity to apply their knowledge in a mock examination.

*The course fee is EUR 1 600. Closing date for enrolment is 23 September 2016. More information can be obtained from [christiane.melz@ceipi.edu](mailto:christiane.melz@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

As a complement to this seminar, the CEIPI offers an intensive "last-minute course" for the pre-examination to candidates wishing to improve their skills in respect of this

examination. Participants will sit two papers under exam conditions, followed by a discussion of the drafted papers with the tutor. This two-day intensive course will take place on 26 and 27 January 2017. For English- and German-speaking candidates, the course will be organized in Munich. For French-speaking candidates, it will be held in Paris.

*The course fee is EUR 750. Closing date for enrolment is 4 January 2017. More information can be obtained from [christiane.melz@ceipi.edu](mailto:christiane.melz@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

For all papers of the EQE **main examination** 2017 (A+B, C and D), the preparation programme starts with "Introductory Courses" in the early autumn of 2016, either in Strasbourg or in Paris, so as to set candidates "on the track", as early as possible, for preparing for the EQE.

The introductory courses are followed by the "Preparatory Seminars" for papers A+B and C in November 2016 and for paper D in January 2017 in Strasbourg, France. These seminars build up on the introductory courses and expand on the issues treated, as well as provide for working on a mock exam under exam conditions, which is then compared with a CEIPI "model solution".

### The introductory courses and the seminar for papers A and B will deal with the new format of these papers as from 2017

CEIPI, by its tutors, has developed this programme over the recent years and believes it has been successful in providing a large number of candidates (about 500 every year) with a set of courses adapted to the EQE, increasing their chances of success.

In addition, intensive "last-minute courses" for papers A+B and paper C are organized in January 2017, approximately one month before the examination. In these courses candidates can sit recent papers under exam conditions, followed by subsequent feedback from a tutor on the papers and the work delivered by the candidates, in small groups. The intensive courses also provide for answering any last-minute questions regarding papers A+B or paper C, respectively.

For paper C, which every year appears to be one of the major stumbling blocks of the EQE, this programme is supplemented with a "Special C-Resitter" course in November 2016, specifically designed for those who have failed the C-paper (more than) once.

The "Special Resitter" course is offered in Munich. The intensive courses for papers A+B and for paper C will be held in Munich for English- and German-speaking candidates and in Paris for French-speaking candidates.

All courses are provided in the three EPO official languages: English, French and German.

The program is as follows (more extensive information is given in OJ EPO 4/2016):

### "Introductory Courses" 2016

Paper	Paris (FR)	Paris (EN)	Strasbourg (EN, DE)
<b>A+B</b>	30.09.	30.09.	23.09.
<b>C</b>	01.10.	01.10.	24.09.
<b>D</b>	02. - 03.09.	28. - 29.09.	21. - 22.09.

Each course can be booked separately. The fee for each one-day course in Paris or Strasbourg is EUR 500. The fee for the one-and-a-half day courses in Strasbourg and Paris is EUR 750 each.

Closing date for enrolment is 15 July 2016.

*More information can be obtained from [sylvie.kra@ceipi.edu](mailto:sylvie.kra@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

### "Preparatory Seminars" 2016/2017

The A+B seminar will be held in Strasbourg, from 14 to 16 (am) November 2016, the C seminar from 16 (pm) to 18 (pm) November 2016. The A+B and the C part respectively can be booked separately.

The D seminar will be held in Strasbourg, from 9 to 13 January 2017. All these seminars are intended for those who wish to sit the EQE main examination in 2017.

The fee is EUR 1 600 for the five-day courses (ABC or D); for the A+B or the C part on its own the fee is EUR 825.

Closing date for enrolment is 23 September 2016.

*More information can be obtained from [christiane.melz@ceipi.edu](mailto:christiane.melz@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

The "Special C-Resitter" course 2016 will be held in Munich on 25 and 26 November 2016.

The course fee is EUR 850. The price includes the "C-Book", last edition.

Closing date for enrolment is 30 September 2016.

*More information can be obtained from [sylvie.kra@ceipi.edu](mailto:sylvie.kra@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

The intensive course for papers A+B will be held on 24 and 25 January 2017 in Munich (EN, DE) and in Paris (FR). The intensive course for paper C will be held in Munich (EN, DE) on 26 and 27 January 2017 and in Paris (FR) on 27 and 28 January 2017.

The fee for each of the Munich and the Paris courses for papers A+B or for paper C is EUR 750 respectively. Closing date for enrolment is 4 January 2017.

*More information can be obtained from [sylvie.kra@ceipi.edu](mailto:sylvie.kra@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

Contact: Christiane Melz, Secretariat of the International Section of CEIPI, phone 0033 368 858313, [christiane.melz@ceipi.edu](mailto:christiane.melz@ceipi.edu)

## Correcting the Text of a Published Patent

Luigi Petrucci (Administrator in Directorate Patent Procedures Management at the EPO), Munich

**D**ecision G1/10 of the Enlarged Board of Appeal (OJ 2013, 194) has clarified that a request under Rule 140 EPC is not admissible for correcting the text of a patent in a decision to grant, irrespective of whether the error was made (or introduced) by the applicant or by the Examining Division (G1/10, Reasons, point 11).

Indeed, if a correction to the text of a patent is obvious as required by Rule 140 EPC then there can be no surprise and no adverse effect on the proprietor or anyone else, because all concerned read the patent as if corrected, and therefore an actual correction is not necessary. If, on the other hand a correction is less than immediately obvious, then it cannot be allowed under Rule 140 EPC (see G1/10, Reasons, point 8).

Under Rule 140 EPC a decision to grant can be amended only from the day it is handed over to the EPO's internal postal service for transmittal to the applicant (see G 12/91 and T 798/95): this date is shown at the bottom right-hand corner of Form 2006 - "Decision to grant a European patent pursuant to Art. 97(1) EPC" (Guidelines H-II, 2.6, last paragraph).

Before that day any request for correction of the *Druckexemplar*, i.e. of the text transmitted to the applicant with the communication under Rule 71(3) (Form 2004), will be treated either as a request for correction under Rule 139 or as a submission of new amendments, even after the approval of the applicant has been received by the EPO. However, the text of a published patent can still be corrected in the following cases:

### Errors in publication

Mistakes in the specification of a European patent arising in the course of its production have no effect on the content of the patent granted. For this, only the text on which the decision to grant the patent is based is decisive (Guidelines C-V, 10, last paragraph).

Hence, if the text of the published specification (B-publication) differs from the *Druckexemplar* approved by the applicant, the text of the specification can always be brought into line with the latter (Guidelines H-VI, 4, first paragraph; see also T 215/11).

### Formatting/editing errors

As indicated in Guidelines C-V, 1.1, amendments and corrections made by the Examining Division are indicated in the *Druckexemplar* using standard marks (the standard marks used by the electronic tools are listed in guidelines C-V, Annex).

Furthermore, all the amendments and corrections will be listed on Form 2004W or 2004C accompanying the *Druckexemplar*.

Therefore, if the text of the B-publication differs from the text of the application as filed/published, and this change was:

- (i) not introduced by the applicant;
- (ii) not indicated by standard marks in the *Druckexemplar*; and
- (iii) not listed on Form 2004;

then this difference is a so-called formatting/editing error and it can be corrected by the EPO of its own motion or at the request of the patent proprietor at any time (Guidelines H-VI, 4, paragraph before last).

It does not matter if this discrepancy was introduced by the *e-drex* ("electronic *Druckexemplar*"), or by the OCR process, or any other electronic tool.

The Office arranges for the correction to be made public as soon as any publication and/or formatting/editing error is discovered in a specification. This is done by means of a note in the European Patent Bulletin and publication of a corrigendum (see Rule 143(2) and the Decision of the President of the EPO dated 14 October 2009, OJ EPO 2009, 598, Art. 1, point 2).

### Appeal

A decision to grant can be appealed if the granted text is not that approved by the proprietor: in this case the proprietor is adversely affected by that decision and is entitled to appeal (G 1/10, point 12 of the reasons).

This can happen in four cases:

- (a) the EPO did not dispatch to the applicant any communication under Rule 71(3) EPC before dispatching the decision to grant;
- (b) the Examining Division amended the *Druckexemplar* of its own motion after the approval by the applicant, and no further communication under Rule 71(3) EPC was dispatched before dispatching the decision to grant;
- (c) the EPO ignored the amendments filed by the applicant in reply to the communication under Rule 71(3) EPC and proceeded to dispatch the decision to grant;
- (d) the decision to grant does not (fully) reflect the amendments filed by the applicant in reply to the communication under Rule 71(3) EPC together with a Rule 71(3) waiver.

A decision to grant can also be appealed when there is a discrepancy in the list of documents on Form 2004 and the documents contained in the *Druckexemplar* (Guidelines H-VI, 4, last paragraph); for example:

- Form 2004 indicates page 1-10 of the description filed with letter dated xx-xx-xxxx, while the *Druckexemplar* contains pages 1-10 as filed; or
- Form 2004 indicates page 5 of the description as filed and in the *Druckexemplar* an amendment indicated by standard marks (and hence introduced by the Examining Division) is present.

The appeal can be filed within two months of notification of the decision to grant, i.e. two months from the date of dispatch plus ten days for delivery as specified by either Rule 126(2) EPC or Rule 127(2) EPC.

In all the above cases, the first instance will allow interlocutory revision under Art. 109 EPC and reimburse the appeal fee: the examination proceedings are re-opened and a new communication under Rule 71(3) EPC is dispatched to the applicant.

In any other case the first instance will forward the appeal to the Boards of Appeal.

### Approval by the applicant

When compared with the EPO practice before G1/10, the above exceptions allow only for limited corrections of a published patent.

This makes the approval by the applicant an essential step in the process of publishing a patent in the correct text.

While, in view of the present EPO practice as described above, it is not necessary for the applicant to check the *Druckexemplar* word-by-word, it is advised to check at least the following when receiving a communication under Rule 71(3) EPC:

- that the list of documents on Form 2004 corresponds to the documents the applicant expects to form the text of the patent;
- that the documents contained in the *Druckexemplar* correspond to the documents listed on Form 2004; and that
- the text of the amendments by the Examining Division listed in Form 2004 and indicated with standard marks in the *Druckexemplar*.

*Effect of a request for correction of the text of the patent under Rule 140 EPC on post-grant proceedings in front of the EPO*

The competence to correct errors lies with the body which took the decision: hence, for the decision to grant it lies with the Examining Division (see H-VI, 3.1, last paragraph).

However, since Rule 140 EPC is not available to correct the text of a granted patent, a request for such a correction under Rule 140 EPC is inadmissible independently of when it is filed (G1/10, Reasons, points 14 and 15).

Therefore, if a request for correction under Rule 140 of the text of a granted patent is filed by the proprietor during opposition or limitation proceedings, these proceedings will not be adjourned to wait for the decision of the Examining Division.

In case the request of correction under Rule 140 concerns bibliographic data, then the opposition or limitation proceedings will be adjourned until the Examining Division takes a decision on the matter.

### *Correction of the text of a granted patent during post-grant proceedings in front of the EPO*

An obvious error introduced by either the applicant or the Examining Division in the text of a granted patent can, under certain conditions, be corrected during post-grant proceedings in front of the EPO (Guidelines H-VI, 3.1, paragraph 5).

A submission by the proprietor of an amended specification containing only the correction of an obvious error will not be admitted either in opposition or limitation proceedings:

- in opposition proceedings because the amendment does not fulfil the requirements of Rule 80 EPC;
- in limitation proceedings because the amendment does not fulfil the requirements of Rule 95(2) EPC.

On the other hand, in opposition, if the proprietor files an amended specification fulfilling the requirements of Rule 80 EPC, then he can request the correction of the obvious error under Rule 139 EPC (see T 657/11). This request for correction will be dealt with by the Opposition Division (Guidelines H-VI, 2.1, last paragraph) according to the instructions contained in Guidelines H-VI, 2.2 – 2.2.2.

In an analogous manner, if an amended set of claims fulfilling the requirements of Rule 95(2) is filed, obvious errors contained in these claims can be corrected under Rule 139 EPC (see Guidelines D-X, 4.3, last paragraph). In this context, it is to be kept in mind that the limitation of a dependent claim only, without any independent claim being limited, is acceptable (see Guidelines D-X, 4.3, third paragraph).



## Contact Data of Legal and Unitary Patent Division

### Update of the European Patent Attorneys Database

Please send any change of contact details using EPO Form 52301 (Request for changes in the list of professional representatives: <http://www.epo.org/applying/online-services/representatives.html>) to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 523 of any change in your contact details.

Kindly note the following contact data of the Legal and Unitary Patent Division of the EPO (Dir. 5.2.3):

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](mailto:legaldivision@epo.org)  
[www.epo.org](http://www.epo.org)

Thank you for your cooperation.

# A Review of the “Problem and Solution” Approach to Inventive Step under Article 56 EPC

## Part 2 – The Comvik Formulation of the Problem

A. Kennington (GB)

### Part 2

This is the second part of a long article, which will be published in three parts in successive issues of epi Information.

The first part of this article considered the correct formulation of the problem in the problem and solution approach to analysing inventive step. It proposed that the formulation is only correct if the problem is known or obvious in view of

everything made available to the public before the priority date. This rule was derived from the requirement in Article 56 EPC that there is inventive step if the claim is not obvious in view of the state of the art, and the definition of the state of the art in Article 54(2) EPC that the state of the art comprises everything made available to the public. Consequently, if the problem is not obvious in view of everything

made available to the public, the problem and solution analysis cannot establish a lack of inventive step under Article 56 EPC.

However, this rule appears to conflict with the treatment of non-technical features in the formulation of the problem under the so-called Comvik approach. This part of the article reviews the origins of the Comvik approach and the circumstances under which it was developed. The third part of this article, to be published in the next issue of epi Information, considers the apparent conflict between the Comvik approach and the requirements of Articles 56 and 54(2) EPC, and proposes a modification to the approach that makes it consistent with these Articles and with the proposed rule that the problem should be obvious.

### Origins of the Comvik Approach

The idea that the problem should include non-technical features from the claim does not originate with decision T 0641/00 Comvik. It appears to have been proposed initially in decision T 1053/98 Canon (22 October 1999), which was decided only 15 months after the initial break with the “technical contribution” approach in decision T 1173/97.

In **T 1053/98** (Canon), the application related to a fax machine. It was already known for a fax machine, intended to be shared between several different users, to pre-store a number of names and allow a pre-stored name to be selected as the sender of the fax. The alleged invention involved recording the name selected for each fax sent together with the cost of sending the fax, so that a report could be output that allowed fax costs to be allocated between the different users. The appellant and the Board disagreed over the correct formulation of the problem. The Board considered that the overall aim of the invention was the economic aim of controlling charges, and stated that non-technical aims are usually not taken into account when formulating the technical problem.

The appellant’s formulation of the problem was regarded as being almost entirely non-technical, such that a solution to the problem would have to include the idea of monitoring the costs incurred by each user of the fax

machine. The Board stated (part 3.4 of the Reasons) “*It is this non-technical part of the solution which provides an incentive for the technical part ... Consequently, in order to assess inventive step it would be necessary to consider in particular – and above all – the non-technical part of the solution.*”

The Board then continued (part 3.5 of the reasons) “*It is exactly to avoid this situation that a technical problem has to be formulated in such a way that there is no possibility of an inventive step being involved by purely non-technical features. Such a formulation of the problem could refer to the non-technical aspect of the invention as a given framework within which the technical problem is posed.*” The Board then proposed a problem that included monitoring costs. Thus a non-technical aspect, that the Board considered would have to be part of the solution according to the appellant’s formulation of the problem, was moved into the problem itself.

The appellant objected that the Board’s formulation of the problem included parts of the solution. In part 3.7 of the reasons, the Board defended itself, saying “*The Board agrees that its formulation of the technical problem to be solved by the present invention indeed contains elements of a solution, namely a non-technical solution (monitoring costs) to a non-technical problem (charge control). However, for the reasons already stated, it appears that a more general wording of the technical*

*problem to be solved is not possible in cases such as the present one. The formal starting point should be the closest prior art, and this must be a technical document. Therefore the technical problem will relate to such technical prior art."*

Several aspects of the Board's reasoning are worth commenting on, and parts of it read strangely to modern eyes.

In the passage quoted from part 3.4 of the Reasons, the Board stated that because the non-technical part of the solution provided the incentive for the technical part, it would be necessary to consider the non-technical part in order to assess inventive step. It is not clear why the Board thought this. Under the subsequently-adopted Comvik approach the non-technical features could simply have been ignored in the consideration of inventive step.

In part 3.5 of the Reasons, the Board does not say why or how the inclusion of a non-technical aspect of the invention in the problem would avoid the possibility of an inventive step being involved by purely non-technical features. Again, under the Comvik approach this concern would not exist, since such non-technical features would be ignored in the assessment of inventive step. Thus the Board's motivation for adding the non-technical aspects to the problem no longer applies under modern case law.

The Board seems to have made no attempt to establish the legality of its decision to include non-technical elements of the solution into the problem. The only justification given by the Board is the practical one given at the beginning of part 3.5 of the Reasons. This is unfortunate, since a tribunal must always follow the law. However desirable a particular outcome may seem in practice, this cannot justify a departure from the requirements of the EPC.

I believe that if the facts of this case are reconsidered in the light of the current treatment of non-technical features, it can be seen that there is no need to include non-technical features from the solution in the statement of the problem. This reconsideration can be based on two legal principles.

First, an invention must be technical, and the invention must have an inventive step. This follows from Article 52(1), which reads as follows.

*European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.*

Since inventive step must be a feature of the invention, and the invention must be technical, non-technical fea-

tures in a claim cannot contribute to inventive step unless they combine with technical features to contribute to a technical effect.

Second, Article 56 defines inventive step as not being obvious "having regard to the state of the art", and the state of the art can be regarded as everything that has been made available to the public anywhere in the world before the priority date of the claim. Therefore the problem can incorporate anything that is known having regard to the state of the art and anything that is obvious having regard to the state of the art. The word "everything" requires that nothing made available to the public can be excluded from the state of the art, and therefore non-technical features must be included in the state of the art. Since the state of the art necessarily includes all known non-technical features as well as all known technical features, the problem does not have to be seen as an exclusively "technical" problem (decision T 1784/06, of 21 September 2012, has recently stated explicitly that a technical problem is not an absolute requirement of the problem and solution approach).

Combining these two principles, we can say that the claimed solution must involve a non-obvious technical invention, but the problem may be technical, non-technical or a mixture of technical and non-technical. If the solution to an obvious problem is technical but obvious, there is no inventive step. If the solution is not obvious, but is also not technical, there is again no inventive step since inventive step has to be a property of the invention and the non-technical aspects of the solution cannot provide an invention in accordance with Article 52(1) EPC. However, if the solution to an obvious problem is technical and not obvious, there is an inventive step (even if the problem is entirely non-technical) since the claim includes non-obvious technical features. To put it another way, when the problem and solution approach is used, the (known or obvious) problem may be technical or non-technical, but there is only an invention if the solution is both non-obvious and technical.

Turning to the facts of decision T 1053/98, it was well known long before the priority date to split a telephone bill between different users on the basis of how much each person had used the telephone, and it was also well known that manual records of who used the telephone were unreliable. In the case of a facsimile machine to be used by multiple different departments, as in prior art D2 of T 1053/98, it would be obvious to want to split the telephone bill for use of the machine between the departments on the basis of the amount that each department had used the machine. Once the skilled person sees that the machine of D2 already has means for selecting the name of the user sending the fax on any particular occasion, it must be obvious to add the feature of storing usage data against each name so as to provide

a more reliable report of how much each department has used the machine.

Therefore the Board in decision T 1053/98 could have avoided adopting a new procedure, of adding features from the solution to the formulation of the problem, if it had adopted a more robust approach to combining the starting point prior art with non-technical common general knowledge. Additionally, its concern that it could be required to give weight to non-technical features of the solution no longer arises since it is now accepted, especially in the light of the revised wording of Article 51(1) EPC in EPC 2000, that non-technical features of the claim may simply be ignored as incapable of contributing to an inventive step.

On the other hand, it should be accepted that if the technical aspects of the claim are not obvious over what is already known, there is an inventive step even if the novel technical features are provided purely for a non-technical purpose. This was confirmed in Board of Appeal decision T 1689/07 Proctor & Gamble, Colour-changing absorbent article (6 November 2009).

Consequently, it appears that there has been development of the jurisprudence since decision T 1053/98, such that there is no need to follow its proposal to incorporate non-technical but new and non-obvious features of the claim into the formulation of the problem.

**T 0931/95** (Pension Benefits Systems, dated 8 September 2000) does not make any reference to earlier decision T 1053/98, but this decision appears to adopt a similar approach to non-technical features of the invention.

In this case, the applicant filed a main request and auxiliary requests. Claim 1 of the main request was directed to a method of controlling a pension benefits programme. The claimed steps all related to performing pension-related data-processing operations on personal or pension cost data, using a computer. Claim 1 of the 1st auxiliary request (which was claim 5 of the main request) related to apparatus for controlling a pension benefits system comprising data processing means arranged to receive and process various items of personal and pension-related data.

Claim 1 of the main request was considered to relate to a method of doing business. Each of its steps was a purely business step, and the fact that it was carried out on a computer did not stop the steps from relating to a business method “as such”. Therefore this claim was rejected as being non-technical.

Claim 1 of the 1st auxiliary request was an apparatus claim that required the presence of data processing means. The data processing means included a processor that comprised computing means for determining an

average age, determining a periodic cost, and estimating expenses. This claim was held to be technical because the processor comprising computing means was a technical feature. Specifically, the Board held that it was implicit in the EPC that an invention had to have a technical character, but that there was no basis for distinguishing between new features and known features in a claim when considering the requirement for technical character (contrary to the previous “technical contribution” test).

The Board then ruled that the claim lacked inventive step. In part 8 of the reasons for the decision, the Board pointed out that the improvement envisaged by the invention was essentially economic, which cannot contribute to inventive step. It continued as follows.

*The regime of patentable subject-matter is only entered with programming of a computer system for carrying out the invention. The assessment of inventive step has thus to be carried out from the point of view of a software developer or application programmer, as the appropriate person skilled in the art, having the knowledge of the concept and structure of the improved pension benefits system and of the underlying schemes of information processing as set out for example in the present method claims.*

The Board then stated that the technical claimed apparatus are defined functionally by precisely the details of the improved system that it considered the skilled person should be regarded as knowing. Consequently those features were all obvious.

In the passage quoted above, the Board stated that the assessment of inventive step has to be carried out from the point of view of a skilled person having knowledge of the improved pension benefits system. In other words, the Board stated that it was necessary to assess inventive step starting from knowledge that was not in the prior art. On the face of it, this appears to be contrary to Article 56 EPC. Unfortunately, the Board in this case provided no discussion of the legality of this approach, nor of why it felt compelled to treat the skilled person as having knowledge not in the prior art.

Judging from the way in which the inventive step of the computing means was considered, it appears that the Board felt that the only way to prevent the non-technical features from being considered in the assessment of inventive step was to treat them as already known by the skilled person. However, if we follow modern jurisprudence in stating that non-technical features cannot contribute to inventive step unless they combine with technical features to produce a technical effect, it appears to be possible to arrive at the same conclusion as the Board in T 0931/95 without needing treat the skilled person as knowing the new non-technical features.

The claim in this case recited a processor comprising computing means. The computing means were for carrying out non-technical steps. There was no suggestion that the non-technical steps combined with the technical computing means to have a technical effect. On the contrary, the result of the steps appeared to be entirely non-technical information. Therefore the purposes or uses of the computing means, as recited in the claim, were non-technical and it would be correct to ignore them when carrying out the assessment of inventive step. This would have the effect of reducing the claim to data processing means including a processor comprising computing means. This is not new over any known general purpose computer. Thus it is possible to reach a finding of lack of inventive step (or even a finding of lack of novelty) simply by ignoring the non-technical features, and there was no need to treat the non-technical features as if they were known to the skilled person.

Therefore if this case was decided today, using the modern approach to non-technical features, it would not be necessary to add the new non-technical features to the knowledge of the skilled person. The result, that claim 1 of the 1st auxiliary request lacked inventive step, could be achieved starting from a definition of the problem that only included matter that was already known from the state of the art and did not include any novel features.

**T 0641/00** (Comvik, dated 26 September 2002) concerned identities in a cellular mobile telephone phone. In a mobile phone, the SIM card stores a subscriber identity known as an IMSI. This is transmitted when the telephone is used, to identify the user. Comvik's application claimed a method in a GSM mobile telephone system in which a SIM was allocated at least two IMSIs, with corresponding information being stored in a system database, and the user selectively activating a desired one of the identities to allow for selective distribution of call costs between the identities. Claim 1 included the feature that the method was used to distribute costs between different users.

The Board considered that the claim contained a mix of technical and non-technical features. The Reasons for the Decision starts with a lengthy discussion of the relevant law and practice. In discussing the problem and solution approach in part 5 of the Reasons for the Decision, the Board stated that the problem must be a technical problem, and if no technical problem can be derived from the application then there is no invention within the meaning of Article 52 EPC, citing decision T 0026/81. It then stated that if a feature does not contribute to the solution of a technical problem by providing a technical effect, it is not relevant for inventive step (Reasons for the Decision, part 6).

When discussing the formulation of the problem, the Board stated:

*"...the problem must be one that the skilled person in the particular technical field might be asked to solve at the priority date." (Reasons for the Decision, part 5)*

and

*"The technical problem should not be formulated to refer to matters of which the skilled person would only have become aware by knowledge of the solution now claimed. ... Thus a problem should not contain pointers to the solution or partially anticipate it." (Reasons for the Decision, part 7)*

but continued

*"However, in the Board's view this principle applies to those aspects of the subject matter claimed which contribute to the technical character of the invention and hence are part of the technical solution. Merely because some feature appears in the claim does not automatically exclude it from appearing in the formulation of the problem. In particular where the claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met." (Reasons for the Decision, part 7)*

The Board then justified this view by referring to earlier decisions T 1053/98 and T 0931/95 (discussed above). It did not discuss the compatibility of this approach with Article 56 EPC. The Board appears to have considered that, by putting non-technical features from the claim into the statement of the problem, it ensured that only technical aspects of the invention were regarded as contributing to the solution. The Board went on to state that this approach *"is actually a method of construing the claim to determine the technical features of the claimed invention"*.

The Board determined that the novel features of claim 1 were (i) allocating at least two identities to the SIM, (ii) the two identities being selectively usable, and (iii) the selective activation being used for distributing costs. However, it considered that selectively distributing costs according to specific schemes (features (ii) and (iii)) was not technical. In accordance with its stated view about incorporating non-technical features in the problem, the Board reformulated the problem to include the feature of allowing user-selectable discrimination, between calls for different purposes or different users, for the purpose of cost distribution. In the light of this formulation of the problem, the Board considered that it would be



obvious to allocate multiple IMSIs to a SIM (feature (i)), on the grounds that this was the only way to allocate costs for one mobile telephone between multiple identities. Therefore the claim lacked inventive step.

### Specifically, the Board stated

*“Discriminating between calls originating from one and the same mobile station, therefore, requires the allocation of different IMSI numbers, or in other terms, the implementation of a corresponding number of GSM applications (feature (i)). Faced with this technical requirement, the skilled person finds a solution in document D8 ....” (Reasons for the Decision, part 15)*

Thus the novel technical features of the claim became obvious because the novel non-technical feature was included in the formulation of the problem and was therefore regarded as known to the skilled person even though it was not available to the public at the priority date of the claim.

It is worth noting that, in its discussion of earlier decision T 1053/98, the Board referred to an approach that *“accepts it as correct to formulate the technical problem to include non-technical aspects whether novel or not”*. Therefore the Board was clearly aware that it might be including in the problem of a feature that was not available to the public.

It is difficult to understand some of the thinking that underlies the decision.

In the discussion of earlier decision T 0931/95, the Board stated that this *“approach, which is actually a method of construing the claim to determine the technical features of the claimed invention, allows separating the technical from the non-technical aspects of the invention even if they are intermingled in a mixed type claim feature”*. It is hard to make sense of this statement.

The act of formulating the problem, or attributing certain knowledge to the person skilled in the art, does not contribute to the act of construing a claim. The act of construing a claim is one in which the meaning and scope of the claim are determined. When doing this, there is no need to identify which features of the claim are known, and no need to consider how to formulate the problem. In general, the act of construing the claim will need to be undertaken, at least partially, before attempting to define the problem or identify what features are known to the skilled person. There is no point in trying to formulate the problem, or identify what relevant knowledge the skilled person has, until features of the claim have been identified.

Equally, it does not seem to be correct to say that the

approach, of treating the skilled person as knowing non-technical features of the claim, allows the separation of the technical from the non-technical aspects of the invention. In order to treat the skilled person as knowing the non-technical aspects, it is necessary first to identify what those non-technical aspects are. Therefore the non-technical aspects must have been identified before this approach can be put into practice. However, once the non-technical aspects have been identified, they can be separated from the technical features and ignored when considering whether the technical aspects of the invention solve the problem. It does not seem to be necessary to add the (already identified) non-technical aspects to the stated problem in order to separate them from the technical features.

Perhaps the Board in T 0641/00 Comvik felt that where a new technical feature is adopted in order to achieve a non-technical aim, the non-technical nature of the aim or motivation behind the invention somehow pollutes any new technical feature that is obvious over the non-technical aim and renders such features not eligible for a patent. In order to achieve this effect within the problem and solution approach, the non-technical aim is incorporated in the statement of the problem used for the analysis of inventive step. However, if this was the motivation behind the practice of adding novel non-technical features to the problem, it was not clearly stated in the decision and appears to be incorrect. If an invention includes technical features that are not obvious over everything that has been made available to the public, it is inventive according to the EPC. This test relies only on the presence of those features in the claim. The additional presence of other features in the claim, which may be known or may be non-technical, is irrelevant. The aim or motivation for adopting the new and non-obvious technical features is also irrelevant. A technical invention is patentable regardless of whether it is aimed at solving a technical problem or a non-technical problem, and it does not matter if it is the obvious solution to the problem that the inventor set himself or herself provided that the problem set by the inventor is itself unknown and the invention is not obvious over what is known.

The point, that a non-technical motivation does not prevent patentability, is made in decision T 1689/07 Proctor & Gamble, Colour-changing absorbent article (6 November 2009). In that case the examining division refused the application on the grounds that the claimed article was an aesthetic creation since the technical feature distinguishing the claimed article from the closest prior art had solely an aesthetic effect. The Board in that case disagreed. It stated that *“Whether the final aim of the technical effect achieved by the claimed absorbent article ... is only aesthetic ... has no impact on the technical nature of the claimed absorbent article itself. It is in fact common practice that inventions such*



*as dyes or hair colouring compositions, although having only an aesthetic goal, are nevertheless patentable inventions in the sense of Article 52 EPC since ... dyes and hair colouring compositions[,] are not per se aesthetic creations."*

Accordingly, if a technical feature in a claim is obvious over the inventor's motivation, but that motivation is itself unknown and the technical feature is not obvious over what is known, that technical feature should confer patentability on a claim and it should make no difference whether the inventor's motivation was technical or non-technical.

### Compatibility of the Comvik Approach with the Proposed Rule on the Formulation of the Problem

It is apparent from the preceding discussion that the rule for formulating the problem in the Comvik approach is unlikely to be compatible with the proposed rule that the problem should be formulated so as to be known or obvious over the state of the art. This can also be seen by considering whether the outcome in T 0641/00 Comvik would have been different if the proposed rule had been followed. I have argued above that in earlier cases T 1053/98 and T 0931/95 there was no need to include any novel non-technical features in the statement of the problem, and the same outcome could have been reached by entirely conventional reasoning. This does not appear to be the case with T 0641/00 Comvik. When considering T 0641/00 Comvik, the following possible situations may be considered.

First, the (non-technical) idea of user-selectable discrimination between calls originating from one and the same mobile station, e.g. for selectively distributing costs, might have been known or obvious at the priority date of the claim. In this case, the problem as formulated by the Board would have been known or obvious from the state of the art. Alternatively, the technical requirement of allocating different IMSI numbers to the same mobile station might have been known or obvious for some other reason. In either case, the technical requirement would have been known or obvious from the state of the art, and therefore the claimed invention would have been obvious over a problem that was itself known or obvious having regard to the state of the art. Under these circumstances the outcome of decision T 0641/00 Comvik would have been consistent with the proposal that the problem should be known or obvious from the state of the art. However, this does not appear to be the case. On the contrary, in decision T 0641/00 the Board clearly considered that both the non-technical idea and the technical requirement were new, and there is no suggestion that either of them was obvious from the state of the art.

Second, it might be possible that the claim was an obvious solution to the problem, even if the problem did not contain the non-technical idea of user-selectable discrimination between calls originating from one and the same mobile station. In this case, there would have been no need to include the non-technical idea in the statement of the problem. However, there is nothing in the decision to suggest that the Board took this view. On the contrary, the fact that the Board relied on the skilled person's knowledge of the cost distribution concept in order to find the claim obvious, suggests that the Board did not consider the claim to provide an obvious solution to the problem in the case that the problem omitted the non-technical idea.

Finally, it may be the case that the claim was not obvious over the problem unless the problem included the novel non-technical idea of user-selectable discrimination between calls originating from one and the same mobile station, and it may also be the case that this non-technical idea was itself not obvious over the state of the art. This appears to have been the view of the Board. However, this must imply that the claim was not obvious over the state of the art alone, and only became obvious by including in the formulation of the problem a (non-technical) idea that did not exist in the state of the art (defined as everything made available to the public in any way before the priority date). Consequently it does not seem possible to reconcile the Board's approach with the proposal that the problem, as formulated for the problem and solution approach to inventive step, should be known or obvious based on the prior art.

Many subsequent decisions have followed the Comvik manner of formulating the problem, and there is not space to review all of these in detail. Nor is it necessary to do so. The circumstances of the Comvik decision itself, as discussed above, demonstrate clearly that this manner of formulating the problem cannot always be reconciled with the rule that the problem must be known or obvious having regard to the state of the art.

Therefore it appears that either it is necessary to abandon the proposed rule that the problem should always be formulated so as to be known or obvious over the state of the art, or it is necessary to modify the "Comvik approach" so as to abandon the practice of including non-technical features in the problem where those features are not known or obvious. In general, I am reluctant to propose a change to well-established practice of the Boards of Appeal. However I think that in this particular case there are good reasons for considering that jurisprudence has moved on and it is now appropriate to modify the Comvik approach in this way.

#### To be continued

The third part of this article, to be published in the next issue of **epi** Information, will review the reasons for modifying the Comvik approach and will propose a suitable modified approach.

# Limits of a Limited Opposition

L. Walder-Hartmann (DE)

## Part 1

This is the first part of a long article, which will be continued in issue 03/2016 of the epi Information

The EPC requires a statement about the extent to which a patent is opposed (R. 76 (2) (c) EPC). If it is not the entire patent that is indicated in this statement, the opposition is understood to be a limited opposition. The way in which a limited opposition influences the examination of the opposition has been determined in more detail in the decision G 9/91 of the Enlarged Board of Appeal. However, not all case con-

stellations have been considered. The question remains where exactly the limits of a limited opposition lie and if, and under which conditions, such a limited opposition may later be extended. To answer this question, an investigation into the nature of an opposition is necessary as well as a critical review of the reasons of the decision G 9/91 in this context. This investigation is the subject of the present part A of the article. In a second part B, the results of the investigation are used to identify the limits of a limited opposition and the conditions under which they can be pushed.

## I. Introduction

It is common understanding that the European Patent Convention (EPC) does not only allow for an opposition to be filed against the patent as a whole, but also allows – in a sense to be discussed – for an opposition of limited extent. The possibility to limit the extent of the opposition is derived from Rule 76 (2) (c) EPC which states that the notice of opposition shall contain, inter alia, a statement of the extent to which the European patent is opposed. The European Patent Office (EPO) form for filing an opposition contains fields to indicate whether the opposition is filed against the patent as a whole or only against certain claims to be specified by their numbers.

The function and implications of Rule 76 (2) (c) EPC have been debated. Some held Rule 76 (2) (c) EPC to be relevant only for the assessment of the admissibility of the opposition as set forth in Rule 77 (1) EPC,<sup>1</sup> but not relevant for the examination of the opposition in accordance with Art. 101 (1) EPC.<sup>2</sup> According to this position, the power of an Opposition Division<sup>3</sup> to examine the opposition would always have extended to the patent as a whole. It is a different question if, in view of Art. 114 (1) EPC, the Opposition Division would then have had the obligation to always examine the patent as a whole or if the extent indicated in the notice of opposition would have limited the obligation albeit not the power to examine. Others saw Rule 76 (2) (c) EPC to fulfill a double function, namely not only for the admissibility of the opposition, but also for substantive examination. This is the view endorsed by the Enlarged Board of Appeal in the decision G 9/91, stating that the extent to which the patent is opposed according to Rule

76 (2) (c) EPC sets the legal and factual framework within which the substantive examination shall be conducted in principle.<sup>4</sup>

The Enlarged Board of Appeal ruled in the decision G 9/91 that the power of an Opposition Division to examine and decide on the maintenance of a European patent under Article 101 (1) and (2) EPC (previously Articles 101(1) and 102 EPC'73) depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 76 (2) (c) EPC (previously Rule 55 (c) EPC'73). Further, the Enlarged Board of Appeal ordered that subject-matters of claims depending on an independent claim which falls in opposition or appeal proceedings may be examined as to their patentability even if they have not been explicitly opposed provided their validity is *prima facie* in doubt on the basis of already available information.<sup>5</sup>

The second part of this order of the Enlarged Board of Appeal already makes it clear that the extent to which the patent is opposed does not in itself constitute a formal and therefore absolute barrier for substantive examination. A first question is therefore how far the duty and power to examine goes if an opposition of limited extent according to Rule 76 (2) (c) EPC has been filed, and particularly if the decision G 9/91 holds a final answer to this question. A second question is if there are circumstances under which the opposition can be extended by a party to the proceedings, possibly up to the point where it becomes an unlimited opposition.

These two questions will be examined in part B of the present article. In this part A of the article, the order of the decision G 9/91 and the reasons carrying the decision will be scrutinized and the legal meaning of a limited opposition will be discussed in section II.

1 G 9/91, Reason 6 of the decision, presenting the position of the opponent.

2 Note that Art. 101 (1) in connection with Rule 81 (1) EPC only speaks of the examination of grounds of opposition invoked in the notice of opposition, but does not explicitly limit the examination to the extent to which the European patent was opposed.

3 For brevity, reference will only be made to the "Opposition Division" herein, but the same holds for a Board of Appeal.

4 G 9/91, Reason 6 of the decision.

5 G 9/91, Order.

## II. Limited Opposition

### 1. Nature of Opposition

The reasons of the decision G 9/91 stress that the opposition proceedings before the EPO have an effect coming close to national nullity proceedings, and that the opposition proceedings can “in principle” be considered as contentious proceedings between parties.<sup>6</sup> While the effects may be similar (e.g., revocation has an effect *ex tunc*, just as revocation/nullification in national proceedings), there are fundamental differences in the nature of these proceedings. The foremost such difference is the matter in dispute.

#### a) The matter in dispute

In nullity proceedings, the matter in dispute is the plaintiff's claim or the relief sought. In contrast, the matter in dispute in opposition proceedings is the European patent, not the opposition.<sup>7</sup> The difference becomes apparent in the different orders of the decisions issued by the Opposition Division on the one side and the competent national courts on the other side. The order corresponds to what has been requested by one of the parties (at least in opposition proceedings where no minus may be awarded, but only that which is requested).

The set of possible orders is laid down in Art. 101 (2), (3) EPC, and corresponds to the set of possible requests.<sup>8</sup> Notably, the second sentence of Art. 101 (2) EPC, speaking of rejecting the opposition, deviates in terminology from the first sentence which speaks about an order to revoke the European patent, and also deviates in terminology from Art. 101 (3) EPC which speaks about an order to maintain the European patent (in amended form) or of a revocation of the European patent. Clearly, the matter in dispute can only either be the opposition or the European patent. The title of article 101, albeit not being legally binding, has the right of it by speaking only about revocation or maintenance of the European patent, i.e. about orders concerning the actual matter in dispute, the European patent. Art. 101 (2), second sentence EPC should read “Otherwise, it shall maintain the European patent”.<sup>9</sup>

A request of the opponent for revocation of the European patent in parts is not possible. To understand this better a model European patent shall be considered herein that has 4 claims, of which claims 1 and 3 are independent, and claim 2 depends on claim 1 and claim 4 depends on claim 3. Now, a request to revoke claim 1 is not possible because, unlike in nullity proceedings, such an order cannot

be issued. It is likewise not possible for an opponent to reformulate this request positively by seeking maintenance of the patent in amended form, namely in the form of claims 2-4 (which would be renumbered as amended claims 1-3 according to EPO practice). The opponent cannot request maintenance of the European patent in a certain amended form either. It is established and undisputed that it is only the patentee who can amend the European patent to defend it (Art. 113 (2) EPC). The patentee and only the patentee can therefore request maintenance of the European patent in amended form. That means, the only valid request of an opponent is for revocation of the European patent.<sup>10</sup>

But if an opponent can only request revocation of the European patent, what then is the meaning of a limited opposition, i.e., an opposition in which the statement according to Rule 76 (2) (c) EPC indicates that the extent to which the European patent is opposed is not the patent as a whole, but, e.g., only claim 1?

#### b) Entire patent is always subject to opposition

Contrary to what is said in Reasons 10 of the decision G 9/91, a limited opposition does not mean that the subject-matters of claims 2-4 are not subject to opposition in the sense of Art. 101 EPC and that there are no proceedings in the sense of Art. 114 EPC in existence concerning such subject-matters,<sup>11</sup> and that the EPO has no competence to deal with them at all. If this were true, then claims 2-4 in the above example could not fall under any circumstances. However, if the patentee defends his patent only in the form as granted, and claim 1 is found not to comply with the EPC, then the entire patent must be revoked because the Opposition Division is bound to the patentee's request and has no other choice.<sup>12</sup>

This finding by itself shows that the opposition always seizes the whole European patent, which is the matter in dispute as explained above. Further, even if the patentee requested maintenance of the opposed patent in amended form on the basis of some of the claims 2-4, e.g., on the basis of independent claim 3 and its dependent claim 4, then the Opposition Division would maintain the European patent as amended according to Art. 101 (3) EPC. Yet, in doing this, the Opposition Division explicitly does decide on claims to which the extent of the opposition according to Rule 76 (2) (c) EPC did not reach. Again, this result is the consequence of the Opposition Division deciding positively on the matter in dispute, the European patent, and not negatively in the sense of a ruling such as “Claim 1 is revoked”. The part of the order of the decision G 9/91

<sup>6</sup> G 9/91, Reason 2 of the decision.

<sup>7</sup> If the matter in dispute were the opposition, then, for instance, continuation of the opposition proceedings by the EPO of its own motion (Art. 84 (2), second sentence EPC) would be impossible.

<sup>8</sup> Besides procedural requests, such as a request to hold oral proceedings, which are of a different quality and cannot be put forth alone.

<sup>9</sup> Notwithstanding, Rule 77 correctly speaks of rejecting the opposition because the inadmissibility concerns the opposition, not the European patent.

<sup>10</sup> G 9/91, Reason 2 of the decision, says the opponent may seek a relief in the form of revocation of the patent as granted in parts. While the opponent may wish for an outcome of the opposition proceedings maintaining the patent in a certain amended form, this is not something that opponent can directly influence.

<sup>11</sup> Following the reasoning of G 9/91 is the subsequent case law T 1066/92; T 443/93; T 31/08.

<sup>12</sup> T 1019/92, reason 2.1 of the decision.

that says that the power of an Opposition Division to decide on the maintenance of the European patent depends upon the extent to which the patent is opposed is therefore misleading.

## 2. Legal Implications of the Statement of Extent

Although the wish of the opponent to limit the opposition expressed by the statement according to Rule 76 (2) (c) EPC does not constitute a (valid) request, it does have legal implications. In this respect, the decision G 9/91 frees the Opposition Division of the duty to examine a European patent amended in this way. But, what is more, G 9/91 does not only free the Opposition Division of its examination duty, but forbids any examination for compliance with the EPC in the case at hand. The question if the legal framework of the EPC allows a limitation of the duty and of the power of the Opposition Division to examine an amended European patent needs some attention.

### a) The parties in interest

While the opponent and the patentee are parties to the proceedings, and the opponent typically has his own motives to oppose a European patent, there is also the public involved as a party of interest.<sup>13</sup> The interest of the public is to keep the register free of invalid patents.<sup>14</sup> The view that interests of the public play a role in opposition proceedings is further supported, e.g., by the possibility of the EPO to continue opposition proceedings even if the opposition was withdrawn (Rule 84 (2), second sentence EPC). This means that the opponent can initiate the opposition proceedings, but cannot terminate them, not even jointly with the consent of the patentee. That is why opposition proceedings are not fully governed by the principle of party disposition.<sup>15</sup> Opposition proceedings shall fairly balance not only the interests of the parties to the proceedings, but of the parties in interest, which includes the public.

### b) Limitation of the duty to examine

While Art. 101 (3) (a) EPC requires an examination that the European patent in amended form meets the requirements of the EPC before a decision on the basis of Art. 101 (3) (a) EPC can be issued, the duty to examine is not unlimited. That is why Rule 76 (2) (c) EPC is not a rule which does not comply with the higher ranking articles (Art. 164 (2) EPC), but is a bound on the duty to examine cast into a legal norm. The reason that the Enlarged Board of Appeal was right to limit the duty of examination of the Opposition Division is – in last consequence – one of a balance of interests and procedural economy. The opponent lacks need of legal relief if the opponent amended

the European patent as discussed. Now, it is only the interest of the public that has to be balanced against the interests of the patentee when the opponent is satisfied. In this case, the interests of the patentee will usually predominate given that the principle of procedural economy shall be respected. Hence, the opposition proceedings can and should be concluded without spending further resources of the EPO, unless there are exceptional situations where the interest of the public prevails. Situations where the interest of the public can prevail are indicated in the second part of the order of the decision G 9/91 (see 3. below).

### c) Limitation of the power to examine

While the limitation of the duty of the Opposition Division is fully justifiable, the limitation of the power of the Opposition Division to examine needs further attention. Consider the case of withdrawal of the opposition. Withdrawal of the opposition shows that the opponent has no interest in the revocation of the patent (anymore). Still, the Opposition Division may continue opposition proceedings of its own motion (Rule 84 (2), second sentence EPC), balancing the interests of the public against that of the patentee. If the law allows an Opposition Division to continue opposition proceedings of its own motion even if there is no interest in revocation on the side of the opponent, the Opposition Division should also be able to continue opposition proceedings of its own motion if there is limited interest in the revocation on the side of the opponent.

The reason why the power to examine was limited in the decision G 9/91 was the wrong assumption that the EPO lacked the competence to examine because the parts of the European patent outside the extent to which the patent is opposed in the opponent's statement are forever not part of the opposition proceedings and that the EPO lacks the power to decide thereon. As shown above, this assumption is not justified. The entire European patent is subject to opposition proceedings.

## 3. Examination of Subject Matter Outside the Statement of Extent as Laid Down by G 9/91

The order of the decision G 9/91 further says that subject-matters of claims depending on an independent claim which falls in opposition proceedings may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is *prima facie* in doubt on the basis of already available information. Since – absent any need – dependent claims are never examined if the claim on which they depend falls in opposition proceedings, this order means the following. If the patentee requests maintenance of the European patent in amended form based on a granted claim that depended from an independent granted claim found invalid in opposition proceedings, then the Opposition Division can enter into substantive examination as to the patentability of such a claim provided its validity is *prima facie* in doubt on the basis of already available information, even if this claim has not

<sup>13</sup> T 197/88

<sup>14</sup> Schulte/Voit, Patentgesetz mit EPÜ, 9. Auflage, § 81 PatG, mn. 39.

<sup>15</sup> The principle of party disposition (in German: "Dispositionsmaxime") concerns the question if the parties can fully dispose of the matter in dispute.

been indicated to fall within the extent to which the European patent is opposed in the statement according to Rule 76 (2) (c) EPC.

#### **a) No implicit coverage by the statement of extent**

The reason for this order given in the decision G 9/91 is that such dependent subject-matters have to be considered as implicitly covered by the statement under Rule 76 (2) (c) EPC.<sup>16</sup> From the point of view taken by the Enlarged Board of Appeal that the EPO would lack the competence to deal with anything outside the extent indicated under Rule 76 (2) (c) EPC, this assumption of implicit coverage is the only way out if the desired order is the order reproduced above. However, this reasoning is not necessary because the opposition always seizes the whole patent, and the EPO has no issues with a lack of competence as discussed above. Moreover, this reasoning is also not convincing as it goes against all established ways how legal statements shall be interpreted. The indications made in the statement under Rule 76 (2) (c) EPC are precise, in particular since the EPO form forces the opponent to exactly indicate a list of claims if a limited opposition is desired. Such a precise statement does not allow a legal interpretation according to which something else was actually meant.

#### **b) Principles of procedural fairness and procedural economy dictate the extent of examination**

If a deviation from the extent indicated in Rule 76 (2) (c) EPC shall be made then, as mentioned above, this is justified if it fairly balances the interests of the parties, including the public. Given that the opponent is satisfied and only the interests of the public and of the patentee need to be balanced, then it is reasonable and fair to decree that the EPO shall have the opportunity to examine a European patent in amended form based on a formerly dependent claim if the validity of such a claim is *prima facie* doubtful based on information already available in the proceedings. Available information encompasses the information of the documents that were validly introduced into the proceedings and common general knowledge.

It is in the discretion of the Opposition Division whether substantive examination based on available information is carried out in this case. This follows from the wording of the order of the decision G 9/91 ("may be examined"). The case is comparable to the continuation of opposition proceedings by the EPO of its own motion (see Rule 84 (2) EPC speaking of "may be continued"). The exercise of this discretion, and the question if discretion was exercised properly, are analogous to the case of continuation of the opposition proceedings by the EPO of its own motion because the same balance between the public interest and the interest of the patentee has to be evaluated in both cases, while the opponent evidently has no more own interest. That means, the EPO shall examine a request to maintain the patent in amended form on

the basis of claims not indicated in the statement according to Rule 76 (2) (c) EPC if the EPO would have continued the opposition proceedings of its own motion according to Rule 84 (2) EPC when faced with the same request.

### **4. Finality of the Statement of Extent**

Further, the decision G 9/91 establishes that, once the opposition period is over, the limitation of the opposition – to be understood in the sense explained above – becomes generally final.<sup>17</sup> The opponent may generally not later make the opposition unlimited, e.g. due to a change of mind.

In this regard, a consideration discussed in the decision G 9/91 is that the function of the time limit set forth in Art. 99 (1) EPC, namely the double function of the opposition period within the legal framework of the EPC with respect to admissibility (Rule 77 (1) EPC) and establishment of the factual and legal framework for substantive examination,<sup>18</sup> would be pointless if a limited opposition could be extended after the opposition period.<sup>19</sup> These considerations are again carried by the false assumption that there are no opposition proceedings pending as far as claims outside the statement of extent are concerned.

#### **a) Opposition period is not a limiting factor**

The time limit of the opposition period is not the limiting factor and would not become pointless if the opposition could be extended. For instance, German law knows the extension of complaints, and the question if such extensions shall be allowed is answered with regard to fairly balancing the interests of the parties. In opposition proceedings, the question would also be under which circumstances one may consider such an extension to be justified. The answer is not derivable from the time limit of the opposition period and not from an alleged lack of competence of the EPO, but derives again from the principle of procedural fairness and from the principle of procedural economy.

#### **b) Principles of procedural fairness and procedural economy are limiting factors**

Regarding fairness, the Enlarged Board of Appeal notes that the patentee shall be given a fair chance to consider his position at an early stage of the proceedings.<sup>20</sup> This position is in line with the case law and the practice of the EPO that the parties' cases shall be set out fully as early as possible, and anything late-filed, be it evidence or, as in this case, newly introduced means of prosecution or defence, are either not admitted or only admitted if certain conditions are met.

<sup>17</sup> The exceptions are discussed in section III. below.

<sup>18</sup> G 9/91, Reason 6 of the decision.

<sup>19</sup> G 9/91, Reason 10 of the decision.

<sup>20</sup> G 9/91, Reason 6 of the decision.

<sup>16</sup> Likewise T 443/93.



This goes hand in hand with considerations of procedural economy, which is the reason for the existence of a limited opposition. Continuing the example case from above, the European patent with the four claims, where the opponent filed a limited opposition indicating only claim 1 in the statement according to Rule 76 (2) (c) EPC, let us assume the opponent requested oral proceedings only for the case that claim 1 is defended by the patentee<sup>21</sup> and let us assume that the patentee requests maintenance of the European patent based on independent claim 3 and its dependent claim 4. Then the Opposition Division could issue a written decision at once, maintaining the patent in amended form according to Art. 101 (3) (a) EPC. This decision would not even have detailed reasons because the EPO is free of a substantive examination under these conditions. Evidently, such opposition proceedings could be over after a rather short amount of time.

### c) Implications on the possibility to appeal

In this context, one may wonder if the opponent, whose only possibility is to request revocation of the patent, can appeal such a decision because he will formally not have obtained what he requested. Evidently, the answer should be no because the opponent declared in his notice of opposition that he does not have a legal interest in opposition beyond the indication made in his statement according to Rule 76 (2) (c) EPC. An appeal would be inadmissible due to lack of need of a relief. The statement about the extent to which the patent is opposed is therefore again not without legal consequences. It could be viewed as an implicit waiver of the right to appeal under the condition that the patentee will request, and the opposition division grant, maintenance of the European patent based on granted claims outside the indicated extent.<sup>22</sup> In fact, this case is special in that none of the parties can appeal because none of the parties is then adversely affected by the decision (Art. 107, first sentence EPC). This justifies why the decision, which does not have detailed reasons because no substantive examination was carried out, does not need to have detailed reasons.

<sup>21</sup> This is a valid procedural request because the condition on which it depends is an inner-proc

<sup>22</sup> The waiver is additionally subject to a reservation. The opponent reserves the right to extend the opposition if he is sued out of the opposed European patent (see section III.).

## 5. Summary

To determine where the limits of the order of the decision G 9/91 lie, careful scrutiny of the reasons of the decision G 9/91 is necessary. The reasons appear to be partly based on incorrect assumptions about the nature of an opposition. Instead of a lack of competence of the EPO to examine and decide on subject matter outside the extent of opposition indicated in the statement under Rule 76 (2) (c) EPC, the principle of procedural fairness and the principle of procedural economy dictate how far the duty of an Opposition Division to examine reaches, and how far the power of an Opposition Division to examine shall go. Therein, the limit of the power is given by a dutiful exercise of discretion analogous to what is laid down in Rule 84 (2) EPC.

In consequence, a limited opposition can be extended in some cases after expiry of the opposition period if the extension respects the principles of procedural fairness and procedural economy. These questions will be dealt with in an additional part B of this article.

### Zusammenfassung

Das EPÜ erfordert eine Erklärung darüber, in welchem Umfang gegen das europäische Patent Einspruch eingelegt wird (R. 76 (2) (c) EPÜ). Falls nicht das gesamte Patent in dieser Erklärung angegeben wird, wird der Einspruch als beschränkter Einspruch verstanden. Die Art und Weise, in der ein beschränkter Einspruch die Prüfung des Einspruchs beeinflusst, wurde im Detail in der Entscheidung G 9/91 der Großen Beschwerdekammer festgelegt. Es bleibt jedoch die Frage, wo genau die Grenzen eines beschränkten Einspruchs liegen und ob, und falls ja unter welchen Bedingungen, ein solcher beschränkter Einspruch später erweitert werden kann. Um diese Frage zu beantworten, ist eine Untersuchung der Rechtsnatur des Einspruchs und eine kritische Beleuchtung der Entscheidungsgründe der Entscheidung G 9/91 notwendig. Diese Untersuchung ist Gegenstand des vorliegenden Teils A des Aufsatzes. In einem zweiten Teil B werden die Ergebnisse dieser Untersuchung verwendet, um die Grenzen des beschränkten Einspruchs und die Bedingungen zu identifizieren, unter welchen sie verschoben werden können.



# Decision G1/14 Appeal Inadmissible or Deemed Not Filed? A Review

Derk Visser (NL)<sup>1</sup>

Recently the eagerly awaited decision G1/14 of the Enlarged Board of Appeal of the EPO was issued<sup>2</sup>. However, instead of answering the referred question, the Enlarged Board looked into the procedure of the case and decided that the referral was inadmissible.

## 1. Referred Question

The proprietor appealed the decision of the opposition division revoking his European patent EP2122134. According to the Board of Appeal both the notice of appeal was filed and the appeal fee was paid after expiry of the two-month appeal period. In its decision T1553/13 of 20.02.2014<sup>3</sup> the board reviews the two lines of case law on the sanction on late filing an appeal.

The established line of case law is: if the notice of appeal is filed late and the appeal fee is paid late, the notice of appeal is deemed not filed. The late paid appeal fee will be refunded. A new line of case law holds that the appeal does not comply with Art. 108<sup>4</sup> if the notice of appeal is filed late and the appeal fee is paid late. Therefore under Rule 101(1), the appeal is inadmissible and the late paid appeal fee will not be refunded.

One of the reasons for the second line of case law is that an appellant should not be provided with a more favourable treatment in case of late payment of the appeal fee (i.e. the appeal is deemed not filed and the appeal fee is reimbursed) as in case of, for example, a late filed statement of grounds (inadmissibility of the appeal and no reimbursement of the appeal fee)<sup>5</sup>.

The board referred the following question to the Enlarged Board of Appeal:

"If, after expiry of the time limit under Article 108, first sentence, EPC, a notice of appeal is filed and the fee for appeal is paid, is the appeal inadmissible or is it deemed not to have been filed?"

The referral received the reference G1/14<sup>6</sup>. The answer to the question is not only important for the sanction on late

filing of an appeal and payment of the appeal fee, but also for late payment of several fees<sup>7</sup>.

The referring board inclines to the new line of thought. Hence, a late filed notice of appeal and a late paid appeal fee will result in a validly filed appeal, although inadmissible. However, Art. 108 states "Notice of appeal shall be filed ... within two months of notification of the decision". It is a procedural principle that an act completed after expiry of a period will be regarded as not received and will not be considered. The new line of thought deviates from this principle in that it does consider acts completed late.

## 2. Procedure

The Enlarged Board analysed in its decision G1/14 of 19.11.2015<sup>8</sup> the procedure that led up to the referral G1/14.

25-04-2013 EPO sends the decision to revoke the European patent by the courier service UPS to the representative of the proprietor.

26-04-2013 An employee of the representative's firm accepts the letter according to the "Tracking Information" of UPS, which was returned to the EPO.

07-05-2013 The representative signs the Acknowledgement of Receipt.

08-05-2013 The Acknowledgement of Receipt was returned to the EPO by fax.

08-07-2013 (Monday) The notice of appeal was filed and the appeal fee paid. The representative thought that the two-month appeal period is triggered by the signing of the acknowledgement of receipt.

The Board of Appeal applied Rule 126(1) and (2) and decided that the employee was authorised to accept post and that the appeal was filed late<sup>9</sup>.

## 3. Decision

The Enlarged Board decided that Rule 126(1) and (2) are written for despatch only by post with advice of delivery, not for despatch in any other way, such as by UPS<sup>10</sup>. Hence,

<sup>1</sup> European Patent Attorney at EIP llp in London, email dvisser@eip.com

<sup>2</sup> Decision G1/14 was issued on 19.11.2015. At the time of writing this review the decision was not yet published in the OJ EPO but was only available in German in the database of the Boards of Appeal decisions on the EPO website.

<sup>3</sup> T1553/13, Board of Appeal 3.2.06, published in OJ EPO 2014 A84

<sup>4</sup> All law references are to the EPC unless otherwise stated

<sup>5</sup> T1553/13 Reasons point 8.1.2

<sup>6</sup> T2017/12 referred a similar question, receiving reference G2/14. That case was terminated, because the application was deemed to be withdrawn. See OJ EPO 2015 A13.

<sup>7</sup> Examination fee, Art. 94(1); opposition fee, Art. 99(1); limitation fee, Art. 105a(1); fee for petition for review, Art. 112a(4); fee for transfer, R. 22(2); fee for intervener, R. 89(2); fee for conservation of evidence, R. 123(2); fee for re-establishment, R. 136(1).

<sup>8</sup> G1/14 Summary of Facts and Submissions point VI and Reasons point 4 and 5.

<sup>9</sup> T1553/13 Reasons point 2 - 4

<sup>10</sup> G1/14 Reasons point 5 - 8. The Enlarged Board did not give further reasons why 'post' does not cover UPS.

the assumption that the rule was applicable in the present case is not correct and the conclusion that the appeal was filed late, which is necessary for the referred question, lacks legal basis. As a consequence, no decision is required under Art. 112 from the EBoA and the referral is inadmissible<sup>11</sup>.

#### 4. How to Move Forward

There are several possibilities to move forward in the present case<sup>12</sup>.

The Board of Appeal could use Rule 125(4) on irregular notification and establish the date of receipt of the decision using the UPS 'Tracking Information'. The date of receipt would be 26-04-2013, making the appeal filed late.

Alternatively, the board could use the 'Acknowledgement of Receipt' signed by the representative. The board has stated that such Acknowledgements of Receipt were intended to be used in case of problems with the advice of delivery<sup>13</sup>. The date of receipt would be 07-05-2013 and the appeal would be filed in due time.

The applicant could invoke good faith, because a user of the EPC should be able to rely on the EPO for sending decisions in a way complying with Rule 126(1) and (2)<sup>14</sup>. Moreover, the EPO has not communicated to the users the relevance of the 'Acknowledgement of Receipt' Form 2936 for establishing the date of receipt, neither in its notice<sup>15</sup> nor on the form 2936 itself. The relevance was for the first time clarified in the present decision of the Board of Appeal. If the ground of good faith is accepted, the EPO should resend the decision of the opposition division.

#### 5. Discussion

Rule 126 before amendment referred to 'Notification by post'<sup>16</sup>. The interpretation of the term 'post' in 2013, narrowly restricting it to the national post or broadly including courier services, depended on the department within the EPO and on the moment of time. In Germany under national law 'post' is only the Deutsche Post. Note, that Rule 133<sup>17</sup> made a distinction between 'post' and 'delivery service'.

The different interpretations are also apparent in the present case. At the time the decision of the opposition division in the present case was despatched, the EPO office in Munich used UPS in a pilot for deliveries to addressees in Germany, for which service it regarded Rule 126(2) applicable. The BoA accepted the 'Tracking Information' as advice of delivery under Rule 126<sup>18</sup>. The EBoA decided that 'post' does not cover courier services such as UPS<sup>19</sup>.

In recent years the market for postal services in many EPC contracting states has been liberalised. The EPO wanted to take advantage of the liberalisation and be able to choose its postal delivery providers on the basis of cost and reliability. The reliability of the post in several contracting states was not good; often the advice of delivery was not returned or not completed by the recipient. In 2010 the EPO tried to improve the reliability by enclosing an Acknowledgement of Receipt with all communications sent to parties by registered mail with advice of delivery<sup>20</sup>. In 2014 a proposal was submitted to the Administrative Council to amend the rules and make the EPO free to choose its postal delivery provider<sup>21</sup>. The amendment was necessary to avoid any ambiguity in the term 'post' in the rules. The proposed terminology 'postal service provider', covering both national post and courier services, was taken from EU directives<sup>22</sup> that established the free postal market. The amended rules entered into force on 01-04-2015<sup>23</sup>.

The EPO will choose reliable providers for delivering the communications. However, the EPO has not provided a list of the postal service providers they will use. Such a list would increase the legal certainty of users in that they can invoke good faith in case a communication triggering a period is despatched by a delivery service for which Rule 126(2) does not apply, as in the present case. Note, that the EPO has published a limitative list of postal service providers for which Rule 133 applies<sup>24</sup>. The EPO has recognised these providers as rendering a reliable service, so users of these providers can obtain the procedural advantage of the rule.

Although decision G1/14 provides a clear teaching on notification, it is regrettable that it has not removed the legal uncertainty caused by the two different lines of case law.

11 G1/14 Reasons point 9 - 10

12 At the time of writing this review no documents had been put in the file after remittal of the case to the Board of Appeal.

13 T1553/13 Reasons point 7

14 G5/88 Reasons point 3.2 on the protection of legitimate expectations "In the application of this principle to procedure before the EPO, measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings."

15 Notice from the EPO of 10.06.2010 published in OJ 2010, page 377

16 In German 'Zustellung durch die Post' and in French 'Signification par la poste'

17 Rule 133 in the version before the amendment of 01.04.2015, when the phrase 'if it was posted, or delivered to a recognised delivery service' was replaced by 'if it was delivered to a recognised postal service provider'

18 T1553/13 Reasons point 3

19 G1/14 Reasons point 8

20 Notice from the EPO of 10.06.2010 published in OJ 2010, page 377

21 Administrative Council document CA/47/14 of 25.09.2014

22 Directive 97/67/EC as amended and Directive 2008/06/EC

23 Decision of the Administrative Council of 15.10.2014 published in OJ EPO 2015 A17

24 Decision of the President of 11.03.2015 published in OJ EPO 2015 A29, Article 2

# Thoughts on EQE Training

B. Cronin (CH)

**T**he EQE was set up to provide high quality input for the EPO. This article explores developments in EQE training, how training unfolds until about 80% of candidates qualify, why teaching and learning come naturally to our profession due to EQE training, how candidates naturally pick up professional techniques as part of their training, and why EQE training has made a major contribution to EPO quality. A follow-up article uses the notion of learning outcomes to assess the effectiveness of exam-driven training

## Introduction

The EQE has proven itself to be effective for promoting professional training throughout Europe and I strongly believe that this exam-driven training is of capital importance for our profession and the European patent system. I would like to illustrate this by covering the following topics :

- The early years of the EQE and training
- Training possibilities
- Training over the long term
- Teaching/learning
- Exam-applied professional techniques
- Contribution of the EQE to quality

## Early years of the EQE and training

Let's begin by looking at the early years of the EQE and how it served as driving force for training in Europe.

The creation of the EQE is a tribute to the foresight of the European Patent System's founding fathers. From the outset, instituting a qualifying exam was perceived as a way of promoting high quality input for the European Patent Office over the long term.

The EQE started in the early 1980's. The small number of candidates sitting the exam nevertheless created a need for training, which led initially to CEIPI and QMC setting up preparation courses. This had two implications:

- 1) The compulsory on-the-job training period is a necessary pre-requisite to taking the exam, but is not enough to do well in the exam. That is still true today.
- 2) The exam itself tests whether candidates are at the level required to pass but does nothing to educate them to reach this level. This is where specific training comes in because candidates need to complement their work experience.

So right from the beginning, the exam has been the driving force for training in Europe.

Gradually, more and more training possibilities were provided as the number of new recruits to the profession increased. Correspondingly the EQE underwent major revisions in the 1990's, making the exam fairer but more difficult to pass, so the annual pass rate declined.

## Training possibilities

Exam-specific training responded to demand and now includes : EQE preparation courses directed to one or more exam papers ; mock exams organised by various associations ; preparation schemes with a series of exercises and mock exams, like the ASPI training in France, as well as CEIPI's pre-prep courses, cramming courses and resitters courses in addition to the original seminars. Deltapatents became a major course provider and supplier of course materials. The EQE Forum provided on-line training possibilities. Inauguration of the pre-exam gave rise to dedicated training courses. Tutorials, where candidates hand in work for discussion with a tutor, are also offered.

These external courses represent the visible tip of EQE training, most of which involves individual candidates doing personal work on exam papers that they self-correct based on the examiners reports, possibly with support from a tutor. Personal work on the exams is complemented by work experience coordinated with the exam preparations.

In addition, the CEIPI-**epi** decentralised basic training is an hors d'oeuvre to specific exam preparations.

## Training over the long term

In my view, the effectiveness of training could be judged by the professional proficiency achieved by the trainees, assessed over the long-term.

Let's consider the training path of our recruits over 8 years in terms of what they do and what they achieve.

For the first couple of years trainees lay a foundation for their future competence by practical work on the job to provide a working knowledge of the patent system. This is combined with some study that typically includes the long-term basic course. During this period, the trainees are students learning from their supervisors who are treated like fountains of knowledge.

The amount of supervision is very variable. Some will be left to fend for themselves. Others are spoon fed.

After the foundation period, the thrust of exam training is how to apply knowledge in the practical context of serving a client.

The pre-exam provides an opportunity to begin exam preparations earlier than in the past, by starting work on the multiple-choice legal questions, which is a good exercise in time management, and on claim analysis which begins attention to claim scope and clarity.

The pre-exam encourages candidates to begin preparations for the main papers a full year before the exam. In the past, many candidates began serious preparations only 6 months preceding the exam, leading to massive overload. Exam preparations consist mainly of work on past papers, progressing towards an undefined level of fitness to practice.

External courses constitute an important aspect of EQE training. They enable trainees to step out of the office and focus on the exam. Courses accelerate progress and prompt trainees to pick up knowledge and techniques needed for the exam and which they can also use at work.

The exam papers simulate a European Patent Attorney's work in servicing the needs of a client. The papers set tasks the trainee has to accomplish in accordance with the client's requirements. These tasks correspond to our core activities – drafting claims and an introduction – replying to an EPO communication – drafting a statement of opposition – replying to a client's legal questions and providing a legal opinion. So the exam tests core skills expected of a European Patent Attorney.

Practicing with past exam papers implies proceeding by trial and error or, as I prefer to say, by the correction of errors. Trainees start by familiarisation with the papers and gradually accelerate until they finish in time, always correcting errors so the answers progressively become more reliable. Making errors and correcting them straightaway is a powerful learning mechanism. Failure to promptly and properly correct during preparation definitely leads to poor performance during the exam.

The exam papers constitute excellent learning materials. By tackling these papers the trainees learn a lot and develop professional skills they can deploy at work. The content of the exam papers takes trainees beyond their day-to-day work experience, which enhances their development.

What's more the exam papers provide trainers with ready-made course materials. All EQE training courses use past exam papers as examples to be worked through with a view to preparing for the next year's exam.

By striving to meet up to the exam client's expectations, the trainees evolve from being students who ask questions and need supervision to becoming qualified professionals who are competent to answer questions and supervise others, i.e. they go through a transition period culminating with an acknowledgement of their "fitness to practice" when they succeed in the exam.

Some trainees achieve full success in the exam after only 4 years experience. Others take longer, possibly repeating one or more papers. About 80% of the candidates pass eventually, some first time and others after several resits. Considering those who first sat the exam in 2000, the statistics show that about 26% passed at the first attempt, 48% by year 2, 64% by year 3, 71% by year 4, and 75% passed by year 5. The overall pass rate then levels off to 80% by year 8.

In other words, the transformation rate of greenhorns into qualified professionals was 64% by 6 years in the profession (exam year 3) or 75% by 8 years in the profession (year 5). The difference is not in the level of proficiency reached, but the duration of the training period to achieve this level.

The missing fraction (about 20 %) who never qualify is made up of those who leave the profession and those who remain in the profession but gave up hope of passing the exam, for instance working as national patent agents, patent liaison or patent engineers. Many of these are part qualified and will have made progress through their exam experience.

From exam year 2 onwards there is an ever-decreasing number of resitters many of whom have a partial success. Overall, resitters make up about two thirds of the successful candidates.

Repeating one or more papers of the exam has the positive effect of inducing the candidates to extend their training period until they demonstrate that they have reached the fit to practice threshold. Repeating a paper once or twice proves beneficial in most cases because the candidates gain insights through the efforts they put in. There is however a danger of getting into a cyclic failure mode as a result of disjunctive training : hard work in a few months preceding the exam, followed by doing nothing in the summer.

Multiple resitting can be soul-destroying for individuals and doubt-engendering for their entourage. Multiple resitters are nevertheless characterized by their perseverance coupled with a determination to prevail over the examiners. When an experienced candidate finally succeeds, he or she can relish in the hard-acquired status as European Patent Attorney. Some go on to become accomplished tutors.

8 years from entry into the profession, we have a majority (say 75%) of qualified European Patent Attorneys who trained for and passed the exam, and about 5% of resitters who passed 2 or 3 papers and are still battling on towards later qualification.

When qualified, the new generation maintain their enthusiasm for learning, and continue their professional devel-

opment in a harmonious way by taking on new professional challenges, by becoming tutors or by joining the examination corps, and frequently by supervising young trainees of their firm or department.

8 years seems a long time, but is shorter than the time it takes for an experienced professional to reach maturity in a non-examination context. This typically takes 10 years or more. Moreover, it is questionable if working experience alone can suffice to reach the level of proficiency of an exam-qualified European Patent Attorney.

8 years is also short compared to the expected remaining career duration, which is 25-30 years for someone who qualifies at age 35 or 40.

In addition to achieving fitness to practice on core activities, the new generation use their newly-acquired competence as a basis for expanding the scope of their activities beyond the exam. They do this by defending oppositions, taking part in oral proceedings, perhaps some experience of litigation as well as other aspects of IP like trademarks, designs, licensing and so on. All this follows on naturally from the learning capacity on core aspects developed through exam preparation.

Measuring the effectiveness of exam training over the long term in this way, provides a satisfactory picture. An overall 80% success rate in the exam is something to be proud of. Saying that over 10,000 candidates have passed is better than making an issue of the low pass rate each year.

### Teaching/learning and why it comes naturally to our profession

Patent Attorneys perform a wide span of activities. One of these activities is teaching that we perform naturally, often without realising its importance.

First, we have to educate our clients about the patent system and in particular to guide them through the system and answer their questions. This applies in private practice and in industry. And of course our clients also educate us about their technology and interests, so teaching is a two-way exercise.

Second, we have to educate administrative staff in addition to supervising them. For this we need the legal expertise on formalities developed by the exam.

Third, we have to educate and guide our trainees so they will be able to supervise and educate the next generation in due course.

Fourth, many European Patent Attorneys become tutors and lecturers, and through teaching continue to learn. So our profession is involved in a complete learning/teaching cycle.

Just as teaching is an important aspect of our activities, learning is too. At work we are constantly faced with new inventions and technologies and keeping up with developments in the patent system.

Learning begins as soon as a trainee enters the profession and increases exponentially as exam preparations take over. The exam provides trainees with the incentive to qualify and the motivation to learn. This ensures a very rich learning phase during exam preparations and fosters life-long learning.

Incentive and motivation are keys to the effectiveness of exam-driven learning.

Once the stress of the exam is past, the motivation to keep learning is intact and newly-qualified European Patent Attorneys embark on new professional challenges and keep learning all the time, in particular by teaching.

It follows that learning/teaching for the exam is part of our professional development. In teaching, our role evolves from being knowledge transmitters to becoming learning facilitators where we share our learning experiences with trainees.

In preparing for the EQE many trainees attend courses. They are attentive and motivated. They learn substantive issues and pick up professional skills on the way. They also notice the course organisation and format. For some this is an inspiration. A few years later they join as tutors in one of the tutorial schemes and later become course leaders in exam preparation courses.

The fact that new trainers are coming from the ranks of successful candidates, is a natural progression. The individual exam papers offer excellent training materials directed to our core activities and take the trainees into new areas, so gradually they conquer more and more new territory until it forms the baggage of a trained European Patent Attorney ready to teach the next generation.

The ease with which trainees develop into teachers stems from the suitability of the EQE papers as training materials. The trainees are impregnated with past papers during their exam preparations. When they become teachers, using future papers as examples comes naturally.

### Exam-applied professional techniques

The exam papers are complemented by our professional tools needed to solve them, such as the novelty matrix or features matrix, and time lines in various formats for showing dates in different contexts. All such tools can be applied in the exam context, so the exam training serves to reveal new tools to trainees who learn how to apply them.

Standard argument formats like the problem-solution format for inventive step or a word-by-word equation for



demonstrating lack of novelty also find their application in the exam and constitute effective learning/teaching tools. Exam training also disciplines candidates into inputting information from the written documents in an efficient way because they have to finish the exam papers in a limited time, which for many candidates seems rather short. To input the information efficiently, trainees need to refine their everyday reading techniques. They have to become proficient in scanning and reading a document for a specific purpose. For example, in drafting, candidates read the clients letter with a view to spotting any information for supporting patentability, like advantages. Another example is the opposition paper where candidates read the patent to be opposed with a view to finding ammunition for the opposition, like effects associated with the claim features that can be worked into a problem-solution attack for obviousness. All patent professionals practice purposeful reading and exam training helps trainees to master this technique.

Apart from the pre-exam, the answers for all exam questions have to be presented in writing.

Handwriting is a means of outputting information that many of our trainees do not exercise in their jobs. Most candidates nevertheless manage to produce answers in more-or-less legible scripts. No doubt improvement of handwriting is possible, but the purpose of the EQE is not to promote the art of calligraphy. It aims to make candidates present reasoned statements that are simply legible. Candidates rightfully do not concentrate on penmanship but on ways to condense the extensive papers into notes that they convert into a reasoned output. In so doing, they reduce an unstructured input into a structured output according to their plan that is built up in a specific way depending on the particular task : drafting, replying to a communication, opposition and legal opinion.

Part of the success of our exam-driven training comes from the fact that we do not set out to learn professional techniques. Candidates set out to accomplish the client's

tasks specified in the exam papers and they pick up professional tools and techniques on the way. It is these tools and techniques that have a lasting effect on professional performance.

### Contribution of the EQE to quality

The European Patent Office has become obsessed with quality. This has led to initiatives like "raising the bar". Yet the EPO already has a high quality input largely as a result of EQE training over the years.

From the early 1990's we started teaching candidates how to reply to an official communication. In the beginning, the candidates did not have a clue how to do this. They had received no training and were left to swim. As a result of the ongoing exam training, a reply format meeting up to "best practices" has become standard and is implemented on a large scale.

The standard of real opposition statements has evolved considerably, due mainly to the fact that former EQE candidates when faced with real oppositions have based their statements on what they learnt for the exam.

In other words, EQE survivors have been setting the standards for best practice that the EPO is campaigning to generalise.

### Conclusion

This means the EQE has been meeting up to its "raison d'être" which – as I said at the outset - was to provide high quality input to the EPO. That result stems not from the exam itself but from the exam-driven training that has set the standards for our daily practices.

It follows that exam-driven training has been of capital importance not only for our profession but also for the success of the European patent system. The effectiveness of exam-driven training is examined in a follow-up article.

## Gedanken über die Vorbereitung auf die EEP

### Zusammenfassung

Die EEP (europäische Eignungsprüfung) wurde eingeführt, um einen hohen Qualitätsstandard vor dem EPA zu gewährleisten. Dieser Artikel untersucht die Entwicklung der Vorbereitung zur EEP. Er zeigt auf, wie die Ausbildung optimiert wurde, so dass etwa 80% der Kandidaten die Qualifizierung erreichen und verdeutlicht wie Aus- und Weiterbildung auf selbstverständliche Art und Weise zu unserem Berufsbild gehören. Im Zuge der Vorbereitung auf die EEP erlernen die Kandidaten professionelle Techniken im Rahmen ihrer Ausbildung. Dies wiederum leistet einen wichtigen Beitrag, um den hohen Qualitätsstandard beim EPA zu gewährleisten. Ein Fortsetzungsartikel untersucht die Effektivität der prüfungsorientierten Ausbildung.

## Réflexions sur la formation EEQ

### Abrège

Le EEQ a été créé pour fournir un apport de haute qualité à l'OEB. Cet article explore l'évolution de la formation EEQ, comment la formation se déroule jusqu'à ce qu'environ 80% des candidats soient qualifiés, pourquoi l'enseignement et l'apprentissage viennent naturellement à notre profession en raison de la formation EEQ, comment les candidats acquièrent naturellement des techniques professionnelles dans le cadre de leur formation, et pourquoi la formation EEQ a apporté une contribution majeure à la qualité de l'OEB. Un prochain article utilise la notion de « résultats d'apprentissage » pour évaluer le rendement de la formation dérivée des examens.



# The History of Partial Priority System of the Paris Convention

K. Shibata (JP)

From a historical point of view, it can be said that the partial priority system of the Paris Convention had effects similar to the first-to-invent system (under Pre-AIA<sup>1</sup>) of the United States in that a subsequent application claiming partial priority makes it possible for the applicant to secure the possession of the basic invention described in the first application. An applicant could exclude any intervening references which occurred during the priority interval and disclosed the invention written in priority applications by showing that the references clearly fall inside the disclosure of his/her first application.

The partial priority system was helpful for inventors (including researchers in academia) who wish or are required to make public their achievements as early as possible. Without the effect of overcoming such references, the inventors would be forced to postpone the publication of the results of their research not only after the filing of the first application but also after the filing of the partial priority application, as well. This is because their subsequent appli-

cations, for which priorities were claimed based on the first applications, might be refused if they included some parts not disclosed in the first applications, such as improvement inventions or additional inventions. On the other hand, if the claiming of partial priority could exclude any publication of the basic invention by the inventor or a third party made during the priority interval, applicants could overcome rejection and secure patent protection on their subsequent

applications that include improvement inventions or additional inventions. The author, of course, recognises that the current practice is different from the above-mentioned partial priority system, and does not intend to deny the current practice. It seems so natural that the interpretations of the Paris Convention have been changed. This article aims only to show the historical background around the Paris Union.

Incidentally, all opinions expressed in this article are the personal opinions of the author, and do not represent the opinions of the organisation to which he belongs.



Repository: collections.vam.ac.uk

Great Exhibition of 1851 in London

## 1. Before the establishment of the Paris Convention

The first occasion on which the need for some international arrangement concerning patents became apparent was at the Great Exhibition of 1851 in London.<sup>2</sup> Uninhibited “looking”<sup>3</sup> can lead to problems for exhibitors who have not yet put their inventions on the market in the country where the exhibition takes place or, more importantly, have not secured protection for it through a patent. Thus, the threat of free riding by competitors and piracy arose to counterbalance the undoubted benefits of public exhibition. After some considerations, the Protection of Inventions Act 1851 was established,



Source: WIPO

which stipulated that a provisional registration could be obtained from the Registrar of Designs under the Designs Act 1850 upon the Attorney General's certification of the inventor's identity and the sufficiency of the description of the invention.<sup>4</sup> This registration gave protection akin to one of a patent for a period of one year from the time of the registration of the certificate without affecting the validity of any letters patents that might subsequently be granted within the term.<sup>5</sup> The provisional protection provided by the 1851 Act was adopted as a general feature of British patent law in 1852. Other nations adopted similar provi-

sional protection for inventions on their own international or universal exhibitions, notably Paris (1855 and 1857), London (again in 1862), and Vienna (1873).

1 The Leahy-Smith America Invents Act.

2 Sam Ricketson, *The Paris Convention for the Protection of Industrial Property A Commentary*, Oxford University Press, (2015), p.30.

3 Louise Purbrick, “Knowledge is Property: Looking at Exhibits and Patents in 1851”, *Oxford Art Journal*, No253 (1997) p.20.

4 The Protection of Inventions Act 1851, sIII, sIV.

5 The Protection of Inventions Act 1851, sVII.

After the settlement of the provisional protection at international exhibitions, debates on that a patent right should not be protected where the right is not worked in the country occurred in a number of countries, with patent abolitionists such as RA Macfie in the United Kingdom. The Netherlands actually repealed its patent law. However, the International Patent Congress, which was held during the course of Universal Exhibition in Vienna in 1873, ceased such movements. After considerable discussion, pro-patent resolutions were agreed to by the Congress.<sup>6</sup> These pro-patent movements were followed by the International Congress on Industrial Property, which was held at the same time as the Paris Universal Exposition of 1878, and the First Paris Diplomatic Conference 1880. At the First Paris Diplomatic Conference, Jagerschmidt, the French delegate, presented the draft of the Convention and proposed the idea of the right of the priority for the first time as follows:

*Article 3 Any deposit of a patent application... duly made in one of the contracting countries shall constitute for the applicant a right of priority of registration in all the countries of the Union for a period of – (my translation)<sup>7</sup>*

Jules BOZÉRIAN, the chairman of the Conference, gave some explanation of the scope of the article, to inform the discussion as follows:

*In France, when an invention received, anywhere and in any manner, any publicity, it cannot validly be patented. It is, in an honest interest, to remove that provision. Wealth is not generally the prerogative of the inventors, and it is hardly so often they can obtain a patent in their own country. If we multiply the charges upon him for filing patent applications in other countries, it will be unable to guarantee his rights. On the other hand, a foreigner often will see his rights lost in France, because he has obtained, prior to the filing that will be carried out, his patent in his own country and that, therefore, his invention will not be new under French law. At the Congress of 1878 a practical way was sought to remedy this situation. It was first thought to allow the applicant to make a declaration in all consuls. But they said rightly that no consuls everywhere and, on the other hand, this mode of procedure would lead to quite considerable expense. Then it was proposed to decide that the declaration in a contracting country would be valid in all other countries. The applicant does not have a patent for it, but he can obtain it within a certain period without incurring forfeiture for lack of novelty.<sup>8</sup>*



Charles Jagerschmidt

gallica.bnf.fr/Bibliothèque nationale de France

The delegation from Austria, in which the patent law stipulated novelty similar to French patent law, proposed to amend Article 3 as follows:

*If the law of a Contracting State would require the publication of the patent, the character of the novelty of the invention could not be altered by this publication, provided that the patent application will follow for a period of three months from the date of this publication.<sup>9</sup>*

According to the chairman's statement and Austrian amendment proposal, it is understood that priority system originally

aimed to prevent collision between a right holder's act in a first country and a patent in a second country.<sup>10</sup> In the nineteenth century, no countries had systems of substantive examination prior to grant, even for such basic matters as novelty, with the exception of the United States, where such a system had been instituted with the appointment of expert examiners in the Act of 1870, and Germany, where a similar situation applied after the passing of a new federal law in 1877.<sup>11</sup> The United Kingdom, while still not providing for substantive examination, instituted a system of third party oppositions that were heard prior to grant by the Law Officers.

At this stage, since the patent was issued without undue delay after the filing in many countries, that is, the invention described in the first application was published in the Patent Gazette before the date of the patent application in the second country, patent publication in the first country might constitute prior art in the second country.

## 2. Change of the priority periods and the intermediate acts

The successive Acts of Paris Convention for the Protection of Industrial Property 1883, the Article 4, which was the former Article 3 of Jagerschmidt's draft, was as follows:

*A person who has duly filed an application for a patent, or for the registration of an industrial design, or of a trade mark, in one of the contracting States, shall enjoy, for the purpose of filing in the other States, and subject to the rights of third parties, a right of priority during the periods hereinafter started.*

*Consequently, the subsequent filing in any of the other States of the Union before the expiration of*

6 Der Erfinderschutz und die Reform der Patentgesetze : Amtlicher Bericht über den Internationalen Patent-Congress zur Erörterung der Frage des Patentschutzes Pieper, CarlIn Comm. der Schulbuchhandl (1873) s.259.

7 Actes de la Conférence Internationale pour la Protection de la Propriété Industrielle réunie à Paris 1880 (1902) p.23.

8 Actes de la Conférence Internationale pour la Protection de la Propriété Industrielle réunie à Paris 1880 (1902) p.40.

9 Actes de la Conférence Internationale pour la Protection de la Propriété Industrielle réunie à Paris 1880 (1902) p.39.

10 In Stephen P. Ladas, *Patents, trademarks, and related rights: national and international protection*, Harvard Univ. Press Ed. (1975), p.475, there is the following instruction: "the real object of the right of priority was to prevent the loss of the novelty of the invention, especially by publication following the application for a patent. Such publication was made soon after the filing of the application in other countries, and therefore it was proper and convenient to have the period of the right of priority start from such filing."

11 Ibid, Ricketson, p.17.

*those periods shall not be invalidated through any acts accomplished in the interval, as for instance, by another filing, by the publication of the invention or its exploitation by others, by the putting on sale of copies of the design, or by use of the mark.*

*The above-mentioned periods of priority shall be six months for patents and three months for industrial designs and trademarks. They shall be increased by one month for overseas countries.*

The problem concerning self-collision that J. BOZÉRIAN explained was solved by the introduction of the right of priority, whose duration was six months. After the Paris Convention entered into force on 7 July 1884, as of the Madrid Conference in 1890, applicants became tending to decide to await the grant of the patent before applying in foreign countries. However, a period of six months starting from the first filing was too short for an effective securing of the interests of inventors, especially those who filed their first application in countries in which the system of the previous examination of the invention prevailed. Various suggestions were made with the purpose of making the priority period longer. Thus, the delegation from the United States at the Madrid Conference in 1890 proposed that the period of the right of priority should begin from the date of the official publication of the invention, instead of the date of filing the first application. Actually Mr. Forbes, delegate from the United States, stated as follows:

*The amendment that the United States proposes to bring in Article 4 of the Convention aims to make the latter actually beneficial to American inventors who want to protect their inventions in other Union states. It is well known that in its present form, the Convention is of no value to Americans, because of priority periods which start at the filing of the application in the country of origin, often expire (almost always in reality) prior to the issuance of the US patent. By the fact of the expiration of the priority periods, the inventor risks losing, while the patent application is still pending, the rights under the Convention; or, if he tries to take advantage of these rights by filing the application abroad during the said period, the risk is that the foreign patent is issued before the American patent. Then it is exposed to two dangers. The first is that the national patent term is limited by the foreign patent; the second, that his invention is published while it is still kept secret by the US Patent Office (my translation).<sup>12</sup>*

The other delegations dissented from this US proposal. The Belgian proposal to the effect that the period be increased from six to twelve months, which was assented to by the United States, was eventually withdrawn at the Madrid Conference. In the Brussels Conference of Revision, in 1900, giving effect to the vœux adopted by the succes-

sive Congresses of AIPPI (Vienna, 1897; London, 1898; Zurich, 1899; Paris, 1900), the priority period was extended from six to twelve months.<sup>13</sup>

At the Brussels Conference of Revision, disclosure of the invention by the applicant himself was also discussed. The reasons were described by the International Bureau in the following terms:

*Disclosure of the invention by the applicant himself. — It would also help to remove in the same paragraph the words "by a third party." In some trials, we tried to interpret these words in a sense that the publication or exploitation of an invention by the applicant for the patent application himself, would have the effect of invalidating the filing by this same applicant during the priority period. We find examples in United International Bureaux for the Protection of Industrial Property, years, 1801, p. 121, and 1802, p. 82. The courts have not accepted this view, but for now in order to prevent any trouble about it, it is better to clarify the text, by deleting the words above mentioned (my translation).<sup>14</sup>*

Eventually the phrase "by the publication of the invention or its exploitation by others" was amended to the phrase "by publication or exploitation of the invention".<sup>15</sup> In this regard, Dr. Ladas pointed out as follows:

*Publication of Invention by the Inventor or Third Parties Is No Bar. ... Moreover, the purpose of article 4 was in favor of giving to the applicant the opportunity to publish and work his invention, in order to facilitate his plans and find in other countries persons interested in it. At the Brussels Conference the words "par un tiers" were stricken.<sup>16</sup>*

This amendment established the system where applicants will not put themselves in peril if it is they who publish or exploit the invention after priority date.

### 3. The origin of multiple priorities (Brevets additionnels)

The extension of the period of the right of priority to twelve months made possible the accession of Germany to the Paris Union. Soon after Germany acceded to the Paris Convention, with effect from 1 May 1903, it was faced with the practical question of whether a subsequent application in Germany could claim priority on the basis of more than one prior application in countries of the Union when grouped in a single subsequent application. In other words, the question was whether multiple priorities could be recognised. The question was settled by discussion at a

<sup>13</sup> Ibid, Ladas, pp. 476-477.

<sup>14</sup> Actes de la Conférence de Bruxelles Première et Deuxième Sessions 1897 et 1900 (1901) p.36.

<sup>15</sup> Both phrases in English were translated by BIRPI in 1960.

<sup>16</sup> Ibid, Ladas, p.496.

<sup>12</sup> Procès Verbaux de la Conférence de Madrid de 1890 (1892) p.93.



plenary assembly of the Patent Office on 30 November 1904, the decision being in the affirmative.<sup>17</sup>

Seven years later, at the Washington Conference of Revision, in 1911, multiple priorities were first proposed in order to avoid improvements of the original invention having to be prosecuted in applications for patents of addition. The reasons were described by the International Bureau in the following terms:

*NEW PARAGRAPH5 –additional patents*

*It often happens that, after filing a first patent application, an inventor improves his invention while the period of priority is still valid and requests for these improvements either ordinary patents or additional patents or certificates. The problem has arisen of whether the inventor who patents his invention in one or more countries of the Union can combine all of their elements in the same application or whether he must on the contrary apply for as many foreign patents as he has successively obtained for his invention in the country of original deposit. The latter, and more stringent, solution is scarcely in harmony with the spirit of the Convention, which aims to favour and promote the inventive spirit. If the multiplicity of the successive patents in the country of original deposit is a consequence of the fact that they had been requested following the successive improvements, this is not true of the applications in other countries once the invention has been fully adapted. It is only natural for all the elements to be grouped within the same application at that point, provided that the character of the invention has remained unchanged and that it has only been improved and not basically transformed or modified in its principles (my translation).<sup>18</sup>*



Source: WIPO

ities aiming combination of the original patent and additional patents. In those days, there were no uniform criteria of inventive step all over the world. Even if the original invention was publicly known, the additional invention would not have been rejected normally due to the lack of novelty of the additional invention. An inventive step provision started to be introduced worldwide between the London Conference of Revision and the Lisbon Conference of Revision. As of the Lisbon Conference in 1958, only the United States, the United Kingdom and Japan stipulated criteria of inventive step. Furthermore, systems that were common, at that time after introduction of criteria of inventive step, were such that, even if the original patent was publicly known, a patent of addition was not questioned regarding the inventive step from the relevant publicly known fact (provided that novelty is required).<sup>20</sup>

At the Hague Conference of Revision, in 1925, the question of multiple priorities was again discussed. There was a French proposal to allow claims to multiple priorities at least up to a total of four, subject to preservation of the unity of invention. It was further suggested that in the case of complex applications division should be allowed provided that the respective partial priorities were respected.<sup>21</sup> Actually the delegation from France stated as follows:

*[L]a France propose deux alinéas nouveaux, sous les lettres e) et f), ainsi conçus:*

*e) Aucun pays de l'Union ne pourra refuser une demande de brevet par le motif qu'elle contient la revendication de priorités multi-*

*ples, à moins que le nombre n'en dépasse quatre et à la condition toutefois qu'il y ait unité d'invention au sens de la loi du pays. Si l'examen révélait que la demande est complexe, le demandeur pourrait diviser la demande, en conservant comme date de chaque demande divisionnaire la date du dépôt initial et le bénéfice de la priorité.*

*f) La priorité ne peut être refusée par le motif que certains éléments de l'invention pour lesquels on réclame la priorité ne figurent pas parmi les revendications formulées dans la demande au pays d'origine, pourvu que ces éléments soient nettement précisés dans la description.*

The proposal met with the approval all members of the competent Sub-committee except for Great Britain.<sup>19</sup> British representative objected that there would be practical difficulties owing to the different claims, and that it would be too complicated to establish whether the claims corresponded to the relevant prior applications. Although several delegates pointed out that certain countries such as Germany were already practicing the system without encountering any serious difficulties, the British opposition prevented the adoption of the proposed amendment to Article 4.

There are two surprising matters. One is that Germany had already adopted multiple priorities system before the Washington Conference. The other is that multiple prior-

20 For example, in the United Kingdom that had the patent of addition system until legal revision in 1977, the Patents Act put into force in 1950 provided that in the case where the original invention is publicly known, an additional invention is not required to involve an inventive step against the original invention (Section 26(7) of the Patents Act 1949). In addition, in France where the patent of addition system was established in 1844 for the first time in the world, it was provided, even after "activité inventive", which is equivalent to inventive step, came to be clearly stated in patent law through 1968 revision, that an additional invention is not required to involve activité inventive (inventive step) against the original invention. Furthermore this practice is still alive under the Indian Patent System. The practice ruled in the Patents Act Section 56 was affirmed by the Bombay High Court in 2008 (Ravi Kamal Bali v. Kala Tech). Moreover Australian Patents Act 1990 s25 stipulates validity for patents of addition in the same manner as Indian Patent Act.

21 Actes de la Conférence de La Haye de 1925(1926) p.337.

17 Dr. Gerhard Schricker "Fragen der Unionspriorität im Patentrecht" GRUR Int, Heft 3 (1967) p.87.

18 Actes de la Conférence de Washington de 1911(Berrie,1911) p.45.

19 Actes de la Conférence de Washington de 1911(Berrie,1911) p.277.

The majority of members countries on the competent sub-committee were in favour of allowing multiple priorities, but a smaller group, including Great Britain, rejected the idea.<sup>22</sup> It was finally agreed, however, that in the event of a claim for multiple priorities at least a division of the patent application must be allowed, without affecting the relevant right of priority.<sup>23</sup> Article 4F of the Hague Act reads as follows:

*If an application for a patent contains a claim for multiple priorities or if examination reveals that an application relates to more than one invention, the competent authority must, at least, allow the applicant to divide his application in accordance with conditions determined by the domestic legislation, and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any.*

Although this solution overcame the worst inconveniences of the previous situation, it did not constitute a thoroughly satisfactory settlement. The question was therefore placed on the agenda of the London Conference of Revision, in 1934. The program drafted by the host country and the BIRPI noted that strict application of Article 4, according to which a second application could be based on only one of the applications filed in the first country, was an obstacle to inventors and required them unnecessarily to comply with additional formalities.<sup>24</sup> It was therefore proposed that multiple priorities should be allowed, and the competent sub-committee concurred in this view.<sup>25</sup> An appropriate provision was approved in the plenary, and was incorporated as section F of Article 4, the previous section F concerning the filing of complex applications becoming Article 4G. Article 4F of London Act reads as follows:

*No country of the Union may refuse a patent application on the ground that it contains multiple priority claims, provided that there is unity of invention within the meaning of the law of the country.*

With regard to the interpretation of the effect of the right of priority for improvements of the original invention under Article 4F, there are two possibilities. One is that the right of priority is given rise to with respect to each invention, and the other is that the right of priority is given rise to with respect to each element of an invention. The reason two possibilities occur is that Article 4F makes no mention of the subject-matter of the right of priority. However, this question can be solved by checking legislative example in the Netherlands. In 1956, the new paragraph Article 7(3) was inserted into the Patent Act in order to correspond to Article 4F and 4H of the Paris Convention introduced at the London Conference of Revision. The text is as follows:

*Priority may not be refused on the grounds that in the invention more than one right of priority, as referred to in this article is invoked. The priority cannot be refused on the grounds that the invention or any part thereof for which the right of priority is invoked does not specifically require an exclusive right in the application in the country of origin, provided that the invention or that portion in the documents related to this application accurately disclosed such that the invention or part can be understood by an expert and can, on the basis thereof, be applied (my translation).*

The comment of the Government on this amendment is as follows:

*The purpose of the newly inserted provision is clarifying that the priority extends over every invention or any part of an invention (iedere uitvinding of ieder gedeelte), regardless of whether it is made in the claims of the previous application (my translation).<sup>26</sup>*

Returning to the London Conference, it provides the key to solve what the subject-matter of the right of priority is. Namely, Explanatory Memorandum and Proposals concerning new Article 4H reads as follows:

*4. IDENTITY OF APPLICATIONS. ... This is to give this notion of identity applications an essential flexibility that France had presented to the Hague Conference on the proposal to introduce in Article 4 of the Convention a letter f) new as follows: "The priority may not be refused on the ground that certain elements of the invention for which priority is claimed (La priorité ne peut être refusée par le motif que certains éléments de l'invention pour lesquels on réclame la priorité) do not appear among the claims made in the application to the country of origin, provided that these elements are clearly specified in the description" . (V. Acts Hague, p. 337.)<sup>27</sup>*

It is understood that Article 4H is also on the premise of multiple/partial priority, and the subject-matter of the right of priority stipulated in the authentic text (French text) of the Convention is not always limited to the invention itself but also can be a part of the invention. In addition, scholars in modern society, there are also those who are showing a similar view. Dr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO) et al. describe as follows:

*Since an invention builds on the prior art, it is possible that it combines features from several different applications that have been filed by the same applicant. Is it possible to claim multiple priorities based on previous applications, or to claim a partial priority for an element of an invention, based on a previous application, while*

22 Actes de la Conférence de La Haye de 1925(1926) p.430.

23 Actes de la Conférence de La Haye de 1925(1926) p.539.

24 Actes de la Conférence réunie à Londres(1934)p.170

25 Actes de la Conférence réunie à Londres(1934)p.367

26 Memorie van Toelichting, No. 3, Zitting 1953-1954-3451", p.2.

27 Actes de la Conférence réunie à Londres(1934)p.171.

claiming no priority for the rest of the application? ... Multiple priorities enable an applicant to claim different prior applications (within the preceding twelve months) in the same application, but the applicant has the advantage of priority for each "invention" or element of an invention only from the date of the corresponding earlier application.<sup>28</sup>

#### 4. The introduction of partial priority

At the Lisbon Conference of Revision, in 1958, Article 4F was again reworded. The initiative came from a suggestion made by the International Bureau that the recognition of partial priority should also be specifically covered. Proposal with Statement of Reason prepared by the International Bureau on the Request of the Government of Portugal states as follows:

*Partial priority presupposes that a subsequent application filed in one of the countries of the Union claiming priority within the period of 12 months includes elements that are not stated in the previous application; in this case, priority based on the date of previous filing is available only for "elements of invention" firstly stated in the scope of claims or in the application documents as a whole and other elements belong to the subsequent application; consequently, it causes partial priority; in this manner, belonging of several differently-dated privileges to a single invention causes a special case of multiple priorities (AIPPI Yearbook, Prague Congress, 1938, page 125).*

*An explicit regulation of the partial priority is lacking in the text of London. This text makes possible, it is true, evading a special provision for partial priorities in the text of the Convention, but in a way inconvenient and expensive. The applicant may file **the additional element of the invention** in another Union country, meet the demands and claim multiple priorities under Article 4 letter F.*

...

*We consider that it would be advisable to supplement the text of the Convention and propose to insert a paragraph 2 to Article 4, letter F, which would read as follows:*

*2. A patent application cannot be rejected by a convention country on the ground that it claims one or more priorities, or it also contains one or more new elements, provided that there is unity of invention within the meaning the law of the country (my translation, emphasis added).<sup>29</sup>*

During the discussions in the second committee of the Conference, the word "new elements" was controversial. The delegation from the Netherlands stated as follows:

*Moreover, it is not desirable to speak of new elements, because the word "new" in the field of patent law, the special meaning of "new compared to the state of the art".<sup>30</sup>*

The proposed text of Article 4F was amended in order to make it explicit that a subsequent application filed with respect to the elements that had not appeared in the earlier application. The Lisbon Conference unanimously agreed to the recognition of claims for partial priority. The new version of Article 4F lays down the clear obligation incumbent on member countries to recognise claims for both multiple and partial Union priority, provided that the general requirements of Article 4 are fulfilled<sup>31</sup> and that there is unity of invention.

It is understood that elements of the invention can be the subject-matter of the right of priority. Furthermore, there is another informative document in the Proposal with Statement of Reason. At the Conference, the International Bureau submitted a proposal for the introduction of a general grace period in Article 4J of the Paris Convention. The text of Article 4J is as follows:

- 1. The grant of a patent shall not be refused on the ground that the element of the invention which is the subject of the application has been disclosed by a person other than the inventor or his representative within 6 months preceding the application.*
- 2. This provision shall apply where the disclosure is made by the inventor himself or his representative, subject to any restrictions which may be imposed by the domestic legislation of the country in which the patent application is made (my translation).<sup>32</sup>*

The Proposal with Statement of Reason states that the reason behind the proposal was inventors often must disclose some elements with its invention before knowing the need to undertake other tasks.<sup>33</sup>

By checking both the provisions of Article 4F and J, it is understood that these proposals aimed that the respective elements, which are gradually being added to an invention, can be the subject-matter of the right of priority and non-prejudicial disclosure. This understanding corresponds to the Netherlands Patent Act which stipulates that portion can be the subject-matter of the right of priority. In this regard, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* instructs in same manner as follows:

30 Actes de la Conférence de Lisbonne(1958)p.343.

31 Actes de la Conférence de Lisbonne(1958)p.343: "dans le cas où une priorité aurait été invoquée par erreur, la réaction serait généralement de ne pas reconnaître le droit de priorité (ce qui, de ce fait même entraînerait comme conséquence que le contenu de la demande ne serait plus nouveau et que celle-ci serait refusée pour cette raison) ".

32 Actes de la Conférence de Lisbonne(1958)p.350.

33 Actes de la Conférence de Lisbonne(1958)p.349.

28 Fredrick Abbott, Thomas Cottier and Francis Gurry, *The International Intellectual Property System: Commentary and Materials*, Kluwer Law International (1999) p.678, 685.

29 Actes de la Conférence de Lisbonne(1958)pp.340-341.



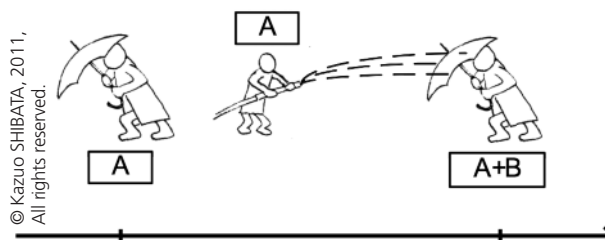
It frequently happens that an invention is not immediately complete, so that, even after a patent application has been filed for it, improvements or additions are found which are made the subject of other patent applications. The Convention makes it possible to claim, in one and the same later application in other countries of the Union, **separate (multiple) priorities for the different parts of the invention**, based on the various first applications made in respect of each of those parts, provided, of course, that these various applications are filed within the term of priority counted from the first application. ...

It frequently happens that, after a first application for a patent has been filed, subsequent applications in respect of the same invention for which the priority of the first application is claimed contain elements of the invention which were not present in the first application and which either no separate patent application has been filed in time to claim multiple priorities or no separate patent application will be filed at all (for example, **because the added elements do not, in themselves, have an inventive character**). Under the Convention, such additions in later applications will not prevent priority from being recognised for those other elements of the invention which were already present in the first application (emphasis added).

In addition, some scholars even in modern society have shown similar views. For an example, Dr. Sam Ricketson, a Professor in the Law School, the Universities of Melbourne, describes partial priority as follows:

This refers to the situation where elements are included in the subsequent application that were not in the earlier application or applications for which priority is claimed. In other words, these are situations where the progress of research and development has occurred and new aspects or components have been identified after the making of the first application, but have not been included in any of these application(s). For obvious reasons, these elements cannot be the basis for claims of priority in subsequent applications filed under the Convention; on the other hand, they should be capable of giving rise to a right of priority in themselves with respect to later applications based on them.<sup>34</sup>

Conceptual Diagram of "umbrella"-theory



**A priority (which has the effect of preventing an application from being invalidated) shall not be refused on the ground that a patent application claiming one or more priorities contains element B, which was not included in the basic application.**

subsequently, a reference that discloses element "A," which has arisen during the priority period, does not become prior art of the entirety of the claimed invention "A or B" or "A and B". The idea is the so-called "umbrella" theory. The actual case is *Hakennagel*.<sup>36</sup> BpatG stipulated as follows:

[A]ccording to Art. 4F Paris Convention concerning multiple priorities, additional features may be present provided that there is unity of invention. The smallest unit of invention is not necessarily the

claim; it can also be features or groups of features – for example, "A and B" within "A and B and C." Therefore, the utility model "A and B," which was a prior publication in this case, was not considered prejudicial.

In the Netherlands, as already mentioned, the Patent Act stipulated that the priority extended over every invention or any part of an invention. It seems to be similar to "umbrella" theory.

## 5. Practices concerning partial priority in some countries

In some countries, for example, France, the constitution or constitutional system permits administrative and judicial authorities to apply directly to private parties the provisions of an international treaty, if these provisions are worded in such a way as to make such direct application possible ("self-executing" provisions). In other countries, for example, the United Kingdom, the provisions of an international treaty can bind only the state and are never applicable to private parties without first having been embodied in domestic legislation. In these countries the provisions of the Convention cannot be "self-executing"; although they may, even without being binding, influence an administrative or judicial decision concerning domestic law, they can only become binding by application of Article 25 of the Convention, that is, when the country concerned introduces the rules of the Convention into its domestic law.<sup>35</sup> Then I look at practices concerning partial priority in some countries during the period from the ratification of the Lisbon Act until G2/98 Opinion.

In Germany, there used to be an idea that, regarding element "A" in a claim covering invention "A or B" or invention "A and B" in a subsequent application, partial benefits are enjoyed from the first priority date for "A," and consequently,

35 G.H.C Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (1969)p.14.  
36 *Hakennagel*, BPatG 22.3.1995; GRUR 1995, 667.

34 Ibid, Ricketson, p.374.

In Japan also, “umbrella” theory used to be applied in examination practice because the Japanese Patent Law had not applied multiple claims until 1988. There is a case in which the court dealt with the issues. In the case of *“a device for reading information with a read-out light beam”*,<sup>37</sup> the interpretation of the subject matter of the right of priority was disputed. The plaintiff argued that “A right of priority under the Paris Convention is given rise to with respect to each invention, and is not supposed to be given rise to with respect to each element of an invention.” The court ruled that where elements are not combined but are aggregated, a right of priority under the Paris Convention is given rise to with respect to each element provided that there is unity of invention.

With regard to the United States, first of all, it is necessary to explain the first-to-invent system. In the United States, an inventor/applicant can overcome a prior art reference (excluding those published more than one year before the filing date of the US patent application) by proving that the date of the invention is prior to the effective date of said prior art reference. Necessary procedures thereof are stipulated as follows in United States of America Patent Regulations Title 37 - Code of Federal Regulations 1.131(b) (Rule 131(b)).

*The showing of facts shall be such...as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application.*

Rule 131 is designed to make the first-to-invent system function effectively. In 1957, the court in *Stempel, Re*<sup>38</sup> held that, in the case of proving actual reduction to practice by submitting an affidavit, a reference disclosing part of a comprehensively claimed invention (hereinafter called “partial reference”) is antedated if it is proven that said part has been actually reduced to practice prior to the reference. This holding had not been overruled until recently, and is also reflected in the Manual of Patent Examining Procedure (MPEP) (MPEP 715.02 II and MPEP 715.03 I. B.). It is similar to the idea of the effect of the right of priority under the “umbrella” theory, which enables a subsequent application to enjoy a partial benefit that countervails an intervening reference with respect to a subsequent application, based on priority documents. The principle of *Stempel* is based on the first-to-invent system, and it is not directly related to the interpretation of the effect of the right of priority under the Paris Convention. However, *Ziegler, Re*<sup>39</sup> in 1965, antedating the partial reference which intervenes between a priority application and the subsequent US application not based on actual reduction to

practice but based on constructive reduction to practice was recognised. It was consistent with “umbrella” theory.

In the United Kingdom there was no “umbrella” theory that partial benefits are enjoyed from the first priority date for elements of claim. However, section 5(1) of the Patents Act, 1949 stipulated as follows:

*Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim (in this Act referred to as the priority date); and a patent shall not be invalidated by reason only of the publication or use of the invention so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.*

The provision was succeeded to section 6 of the Patents Act 1977. The section 6 reads as follows:

*(1) It is hereby declared for the avoidance of doubt that where an application (the application in suit) is made for a patent and a declaration is made in accordance with section 5(2) above in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it shall not be invalidated by reason only of relevant intervening acts.*

*(2) In this section— “relevant application” has the same meaning as in section 5 above; and “relevant intervening acts” means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 5(3) above.*

Under these circumstances, publication of an application, used as the basis for a priority claim was believed to be a non-prejudicial disclosure under Section 6(1) of the UK Patents Act 1977.<sup>40</sup> This means that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use together with A, and the subsequent application whose claim 1 is A, and claim 2 is A+B, even if A is proved to belong the state of the art between the two priority dates, the subsequent application was not invalidated. However, if A +B is proved to belong the state of the art between the two priority dates, the

37 Heisei 1 (Gyo Ke) 115, (Judgment: 22.06.1993).

38 *Stempel, Re* 241 F.2d 755, 113 USPQ 77 (CCPA 1957).

39 *Ziegler, Re* 347 F.2d 642, 146 USPQ 76 (CCPA 1965).

40 Ian Muir, Matthias Brandi-Dohrn, Stephan Gruber, *European Patent Law: Law and Procedure Under the EPC and PCT*, (Oxford University Press, 2002), pp27-28.

subsequent application was invalidated. Under the “umbrella” theory, without claim A, claim A+B enjoys the partial benefit, but in the UK it must be claimed A in the subsequent application in order to enjoy the partial benefit. The author thinks that it seems to be connecting with the prior claim approach in the UK old practice.

The “prior claim” approach, which was superseded by the “whole contents” approach, addressed the double patenting issue by rejecting applications including a claim identical with one of unpublished application or patent granted filed before the applications. The “prior claim” approach does not seem to be related directly with claiming priority, but the court in *Alfa-Laval Aktiebolag's Application Case*, in which the recognition of the right of priority was disputed in relation to the requirements for the “first application”, stipulated as follows:

*The question to be answered is whether that earlier Swedish application claimed protection for the invention of this sub-assembly when so incorporated; and for this purpose, having regard to its clarity and comprehensiveness, examination of the main claim of that earlier application affords a sufficient basis for deriving the answer... It is to the invention for which protection was applied for that one must look, and not to some different and other invention which can be spelled out of the document when the reader has been told where to look and how to emphasise (emphasis added).<sup>41</sup>*

The “prior claim” approach is inconsistent with “umbrella” theory. Actually, the UK court did not rely on “umbrella” theory. However, there is one case in that the UK court judged fairly generous and applicant-friendly with regard to priority recognition. The court in *Canon K.K.'s Application* case stipulated as follows:

*It would surely be "a development along the same line of thought which constitutes or underlies the invention described in the earlier document". It is not one that "brings something new into the combination which represents a departure from the idea of the invention described in the earlier document". In order to anticipate criticism, perhaps I should also add that I do not think that "a development or addition" within section 4(6) necessarily requires that the invention of the later claim should fall wholly within the scope of the earlier invention as described (emphasis added).<sup>42</sup>*

The statement by the court reminds me of the proposal concerning “NEW PARAGRAPH5 -additional patents” by the International Bureau at the Washington Conference of Revision. The proposal described that an improvement invention claimed in a subsequent application could enjoy the benefit of plural priorities from multiple applications where the character of the improvement invention had

remained unchanged from those of the multiple applications and its principle basically had not been transformed or modified from their principles. Furthermore it is said that the court interpreted the requirements for the “same invention” broadly. Such broad interpretation, however, could cause some tradeoffs for applicants. It is said that, for instance, broadening the interpretation would make the requirement of “the first application” with regard to claiming priority stricter. In this regard, the court in *Kopat's Patent* affirmed the Comptroller General's discretion. The Comptroller General, in his decision, stated as following:

*This transmission is not specifically described and illustrated in the patentees' specification and no specific protection is, therefore, sought for it in this country. Accordingly, if it could be argued that the invention as defined by claim 1 bears only a remote or chance relationship to this transmission, I should be prepared to decide this matter in favour of the patentees. But, this is not the case; the claim is in fact a very close description of the transmission, **every one of the many features of the claim being readily identifiable** in the transmission (emphasis added).<sup>43</sup>*

The UK old interpretation of the requirements for the “same invention” does not seem consistent with “gold standard” under the EPC. “Gold standard” would have saved *Kopat's Patent*.

Finally, Board of Appeal in EPO has rarely addressed an issue similar to “umbrella” theory. However, in T301/87, the Enlarged Board consisting of 5 members indicated that, when there is a claim which can enjoy the benefit of priority in the subsequent European application, protection from invalidation by any interim disclosure of the content of the priority document extends not only to claims which are fully or clearly entitled to that priority but to all claims of the European application. The actual statement by the board is as follows:

*When priority is claimed for a European patent application under Article 88 EPC, the publication (or any other disclosure within the meaning of Article 4B of the P.C.) of the content of the priority application, in the interval between the filing of that application and the filing of the (final) European patent application cannot be used as state of the art against any claim in the latter application. However, if such publication goes beyond the content of a previously filed application and includes subject-matters not covered by the disclosure of that application, such disclosure may in principle be cited against any claim in the (final) European patent application relying on a priority date subsequent to the publication date. It might be added that **a different view on this matter would render the system of multiple priorities rather illusory** (emphasis added).<sup>44</sup>*

41 *Alfa-Laval Aktiebolag's Application* R.P.C. (1968) 85 (8): 216.

42 *Canon K.K.'s Application* R.P.C. (1980) 97 (4): 133.

43 *Kopat's Patent* R.P.C. (1965) 82 (12): 404.

44  $\alpha$ -interferons/BIOGEN, T301/87 ;OJ EPO 1990,335.

## 6. Establishment of European Patent Convention

Article 88(2) EPC, second sentence, provides that, where appropriate, "multiple priorities may be claimed for any one claim". During the discussion in preparation for the 1973 Munich Diplomatic Conference, four proposals<sup>45</sup> were made to specifically provide for multiple/partial priorities for any one claim. The prior three proposals were subsequently analyzed in a memorandum drawn up by FICPI. It is said that the FICPI Memorandum is the legislative intent of the EPC. It is also said that the proviso "Where appropriate" was included to clarify that "OR"-claims as described in the FICPI Memorandum can enjoy multiple/partial priorities, but that this does not apply to "AND"-claims as outlined the Memorandum. With regard to "AND"-claims the FICPI Memorandum reads as follows:

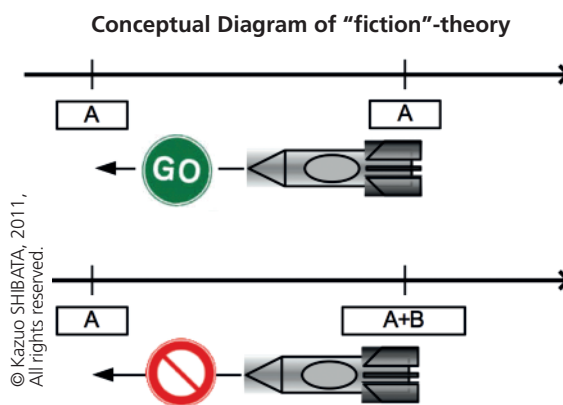
*It is probably recognized by everybody that where a first priority document discloses a feature A, and a second priority document discloses a feature B for use together with A, then a claim directed to A+B cannot enjoy a partial priority from the first priority date, because the invention A+B was disclosed only at the date of the second priority document. In other words, if A+B is proved to belong to the state of the art between the two priority dates, the claim to A+B must be declared invalid. If A in itself is a patentable invention, and the application contains both a claim to A, and a claim to A+B, the first priority can be claimed for the claim to A, and the second priority for the claim to A+B, thus multiple priorities can be claimed for the application as a whole, but not for any individual claim of the application.*

Actually "umbrella" theory seems to be disregarded. However the Memorandum never says that if A is proved to belong to the state of the art between the two priority dates, the claim to A+B must be declared invalid. Then it is possible the legislative intent was a similar idea of Section 6(1) of the UK Patents Act 1977. The interpretation of disregarding "umbrella" theory was made step by step, namely G3/93 Opinion and G2/98 Opinion. At the end of the G3/93 Opinion, the Enlarged Board of Appeal concluded that a decision of the same sort was also made in the United States, by referring to *Gosteli*.<sup>46</sup>

<sup>45</sup> UNICE (cf. M/19, point 8), CIFE (cf. M/22, point 4), FEMPI (cf. M/23, point 23) and FICPI (cf. M 48/I, Section C).

<sup>46</sup> *Gosteli*, Re 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). Concerning detailed analysis about the judgment, refer to Kazuo Shibata "Some Problems with the Current Practices Concerning the Priority System" (2010) E.I.P.R. Issue 10, pp.520-529.

*Gosteli*, Re in 1989, partial constructive reduction to practice based on a foreign priority application was not recognised in contrast to the above-mentioned *Ziegler* decision. The Court of Appeals for the Federal Circuit stated, as the reason therefore, that a priority application must support the entire claim of a subsequent US application prescribed in 35 U.S.C. Section 119. *Gosteli* case was concerning Markush type claim, namely "OR"-type claim. The United States does not allow multiple priorities for a single claim even if it is Markush type claim. Nevertheless *Gosteli* Case affected that EPO disregard "umbrella" theory.



**Regarding the determination of novelty, inventive step, etc., invention A, which is the same as an invention contained in a basic application, is considered to have been filed on the filing date of the basic application. However, invention "A and B," which is a different invention, is considered to have been filed on its actual filing date.**

## Conclusion

The "fiction" theory, in which the subsequent application is deemed to have been filed at the filing date of the first application in terms of examining patentability such as novelty, has already become the de facto standard in EPO, USPTO, and JPO. The author does not intend to deny these situations. The priority system was originally designed for the purpose of avoiding self-collision rather than overcoming competitors,

although the purpose has been abandoned. Grace Period system in Japan and the United States, in reality, has taken over the purpose, which is to avoid self-collision. Grace Period system under the EPC, however, is so restricted that it does not allow applicants to avoid self-collision practically. Therefore, the priority system under the EPC should be operated in order to avoid self-collisions.

The examination that relies on "umbrella" theory may be complicated when the third party incidents occur during the priority interval. However, the author cannot overlook the intention of the delegates at Brussels Conference of Revision where the phrase "par un tiers (by a third party)" was deleted. The author wonders if the phrase "by publication or exploitation of the invention" can be interpreted as "by the publication of the invention or its exploitation by the inventor, or the applicant, himself." In this regard, two noteworthy cases, which partially applied umbrella theory to avoid self-collision, were issued even after G2/98 Opinion was rendered. One is T665/00, points 3.3 to 3.5.1 of the reasons. The Comments by the President on referral G 1/15 summarise the case as follows:

*In T 665/00 of 13.04.2005, the claim at issue was directed to subject-matter defined in terms of a range of numerical values (specific mass below 0.1 g/cm<sup>3</sup>). This had been restricted in respect of the invention disclosed in general terms in the priority document (specific mass below 0.5 g/cm<sup>3</sup>). However, the priority document also disclosed an example*



corresponding to a specific numerical value (**0.04 g/cm<sup>3</sup>**). The board took the view that the claim enjoyed partial priority for that embodiment (emphasis in original).<sup>47</sup>

The object of the alleged state of art was public use by applicant himself. Namely the alleged state of art was regarding not Art 54(3) but Art 54(2).

The other is “*Prioritätsdisclaimer*” in Germany. In a patent invalidation case in which a claim of an improvement invention in a subsequent application should have been invalidated based on the fact of publication of the basic invention during the period of priority, in accordance with the standards for determination in G3/93 Opinion, the BpatG maintained the claim of improvement invention. The proposition in “*Prioritätsdisclaimer*” decision held by BpatG was that if the priority of a previous application cannot be acknowledged because the claim comprises features that cannot be derived from the original application, but the patent is not patentable without the earlier priority, then the patent can nevertheless be maintained if it is patentable without these features, provided a disclaimer is included into the patent stating that the additional features do not support the patentability in view of the earlier priority. Actually the BpatG held as follows:

*Ist in einem Patent die Priorität einer früheren Anmeldung nicht wirksam in Anspruch genommen, weil der Patentanspruch ein Merkmal enthält, das über den Inhalt der Prioritätsanmeldung hinausgeht, und ist der Anspruchsgegenstand wegen seines späteren dem Anmeldetag beim DPMA entsprechenden Zeitrangs nicht patentfähig, kann dennoch das Patent beschränkt aufrechterhalten werden, wenn a) der Patentanspruch eine in der Prioritätsanmeldung offenbarte patentfähige Unterkombination enthält und b) in den Patentanspruch eine Erklärung des Inhalts aufgenommen wird, dass das in Rede stehende Anspruchsmerkmal über den Inhalt der Prioritätsanmeldung hinausgeht und die Patentfähigkeit bei Berücksichtigung des Zeitrangs der Prioritätsanmeldung nicht stützen kann.*<sup>48</sup>

Dr. Stephen P. Ladas made a tremendous achievement in the study of the Paris Convention and had written a wonderful book, *Patents, trademarks, and related rights: national and international protection*, published in 1930 and updated in 1975 as the compilation of his study.<sup>49</sup> In a review in the *Cambridge Law Review* in 1932, AD McNair admired Dr. Ladas’s work in these terms:

*Students of international law and of comparative law, and specialist practioners, must join in expressing gratitude to Dr. Ladas for achieving a task which by reason of the detail*

*involved and the inevitable size may at times have been tedious to the author, but which has resulted in a book whose usefulness and comprehensiveness will rank high.*<sup>50</sup>

Until the 1990s, specialist practioners at the EPO had probably inherited the intention of Dr. Ladas. In decision T301/87 (*αinterferons/ BIOGEN*), the Board of Appeals showed an interpretation of Article 4 of the Paris Convention and also mentioned the purpose thereof.

*According to the provisions of Article 4B of the P.C. “any subsequent filing” during the priority year “shall not be invalidated” by, inter alia, the publication of the invention as covered by the first filing in the priority interval. This means, particularly, that such a publication will neither destroy the novelty of the invention, for which priority is claimed in the subsequent filing, nor diminish the inventive step embodied in it, as considered at the date of the first application on which the right to priority is based (cf. Bodenhausen’s Guide to the application of the Paris Convention, BIRPI 1968, pages 40-43). This is, of course, aimed at enabling and even encouraging the inventor to make his invention known at an early stage, which is fully consistent with one of the basic objects of the patent system, namely to promote a rapid spread of information and technology. It also gives him a fair chance to make economic use of the invention within a reasonable period of time (emphasis added).*

However, the purpose of Article 4 promoting “a rapid spread of information and technology” has been disregarded later. It seems that even Dr. Ladas could not have foreseen the current chaotic situation caused by the partial priority, such as the improvement invention can be rejected due to the publication of the basic invention. His updated book, one of the best books in the study of the Paris Convention, has still few

description of partial priority. It might show that how dramatically the interpretation of partial priority has changed. In addition to Dr. Ladas, no drafters of the Paris Convention could have even guessed such drastic changes of the partial priority.

Finally, I would like readers to think about a simple question that I have not reached an answer of yet. Does the following idea make sense? Provided that element “A” was claimed in a application, element “A or B” was claimed in a subsequent application filed within the application’s priority period and a reference disclosing

element “A” had arisen between the filing date of the application and that of the subsequent application, the subsequent application enjoys partial benefits for “A” and the reference is eliminated from prior arts to the entirety of the claimed invention “A or B” in the subsequent application. And I would like to say “*Priorité Partielle! Quo vadis?*”



Stephen Pericles Ladas

Source: LADAS & PARRY LLP

47 Comments by the President Referral G1/15 (“Partial Priority”), point 73.

48 *Prioritätsdisclaimer*, BPatG 30.4.2003; GRUR 2003,953.

49 Stephen P. Ladas, *Patents, trademarks, and related rights: national and international protection*, Harvard Univ. Press Ed. Cambridge, Mass, 2nd edn 1975 (1st edn 1930, under the title, *The International Protection of Industrial Property*).

50 AD McNair, review of *The International Protection of Industrial Property*. By Stephen P. Ladas, Harvard University Press 1930, 972 pp. (\$7.50) in (1932) *Cambridge Law Journal* 242.

## Disziplinarorgane und Ausschüsse

## Disciplinary Bodies and Committees · Organes de discipline et Commissions

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de Discipline (epi)
AL – NIKA Melina AT – POTH Wolfgang <sup>oo</sup> BE – DEBLED Thierry BG – PAKIDANSKA Ivanka Slavcheva CH – REUTELER Raymond CY – ROUSOUNIDOU Vasiliki CZ – FISCHER Michael DE – FRÖHLING Werner <sup>o</sup> DK – FREDERIKSEN, Jakob EE – KAHU Sirje ES – STIEBE Lars Magnus FI – WESTERHOLM Christian	FR – ROUGEMONT Bernard GB – GRAY John GR – TSIMIKALIS Athanasios HR – KORPER ŽEMVA Dina HU – MARKÓ József IE – SMYTH Shane IS – HARDARSON Gunnar Örn IT – MURACA Bruno LI – ROSENICH Paul* LT – GERASIMOVIC Jelena LU – KIHN Pierre LV – ŠMĪDEBERGA Ināra MC – AUGARDE Eric	MK – DAMJANSKI Vanco MT – SANSONE Luigi A. NL – HOOIVELD Arjen NO – THORVALDSEN Knut PL – ROGOZIŃSKA Alicja PT – DIAS MACHADO António J. RO – TULUCA Doina RS – BOGDANOVIC Dejan SE – KARLSTRÖM Lennart SI – REDENŠEK Vladimira SK – BAĐUROVÁ Katarína SM – MARTINI Riccardo TR – YURTSEVEN Tuna**
Disziplinarausschuss (EPA/epi)	Disciplinary Board (EPO/epi)	Conseil de Discipline (OEB/epi)
<b>epi Mitglieder</b> BE – CAMPABADAL Gemma	<b>epi Members</b> DE – MÜLLER Wolfram FR – QUANTIN Bruno	<b>Membres de l'epi</b> IS – VILHJALMSSON Arni
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)	Disciplinary Board of Appeal (EPO/epi)	Chambre de Recours en Matière Disciplinaire (OEB/epi)
<b>epi Mitglieder</b> DE – LENZ Nanno DK – CHRISTIANSEN Ejvind	<b>epi Members</b> ES – MOLINÉ Pedro Sugrañes FR – GENDRAUD Pierre GB – HALLYBONE Huw George	<b>Membres de l'epi</b> GB – JOHNSON Terry NL – VAN WEZENBEEK Lambertus
Geschäftsordnungsausschuss	By-Laws Committee	Commission du Règlement Intérieur
<b>Ordentliche Mitglieder</b> FR – MOUTARD Pascal*  <b>Stellvertreter</b> AT – FORSTHUBER Martin	<b>Full Members</b> GB – JOHNSON Terry  <b>Substitutes</b> BE – LEYDER Francis DE – THESEN Michael	<b>Membres titulaires</b> IT – GERLI Paolo MC – SCHMALZ Günther  <b>Suppléants</b> FR – LE VAGUERÈSE Sylvain
Ausschuss für epi-Finzen	epi-Finances Committee	Commission des Finances de l'epi
BE – QUINTELIER Claude CH – BRAUN André DE – MAIKOWSKI Michael*	FR – LAGET Jean-Loup GB – POWELL Tim IT – TAGLIAFICO Giulia LU – BEISSEL Jean	PL – MALEWSKA Ewa RO – TULUCA Doina SM – TIBURZI Andrea
Ausschuss für EPA-Finzen	Committee on EPO Finances	Commission des Finances de l'OEB
<b>Ordentliche Mitglieder</b> BE – QUINTELIER Claude  <b>Stellvertreter</b> DE – SZYMANOWSKI Carsten	<b>Full Members</b> CH – LIEBETANZ Michael** GB – BOFF Jim*  <b>Substitutes</b> ES – JORDÁ PETERSEN Santiago IT – LONGONI Alessandra	<b>Membres titulaires</b> IE – CASEY Lindsay  <b>Suppléants</b> NL – BARTELDs Erik

\*Chair/ \*\*Secretary    <sup>o</sup>Vice-Chair / <sup>oo</sup>Vice-Secretary



Ausschuss für Europäische Patent Praxis	European Patent Practice Committee	Commission pour la Pratique du Brevet Européen
AL – NIKA Vladimir	FI – WECKMAN Arja	MC – HAUTIER Nicolas
AL – HOXHA Ditika	FR – CALLON DE LAMARCK Jean-Robert	MC – FLEUCHAUS Michael <sup>o</sup>
AT – VÖGELE Andreas	FR – LE VAGUERÈSE Sylvain	MK – ILIEVSKI Bogoljub
AT – KOVAC Werner	GB – MERCER Chris	MK – KJOSESKA Marija
BE – LEYDER Francis*	GB – BOFF Jim	NL – AALBERS Arnt
BE – COULON Ludivine	GR – SAMUELIDES Emmanuel <sup>o</sup>	NL – JORRITSMA Ruurd
BG – BENATOV Samuil Gabriel	HR – HADŽIJA Tomislav	NO – REKDAL Kristine
BG – SHENTOVA Violeta Varbanova	HR – TURKALJ Gordana	NO – THORVALDSEN Knut
CH – WILMING Martin	HU – LENGYEL Zsolt	PL – LEWICKA Katarzyna
CH – MAUÉ Paul-Georg	HU – SZENTPÉTERI Zsolt	PL – BURY Marek
CY – THEODOULOU Christos A.	IE – MCCARTHY Denis	PT – ALVES MOREIRA Pedro
CZ – JIROTKOVA Ivana	IE – BOYCE Conor	PT – FERREIRA MAGNO Fernando
CZ – BUCEK Roman	IS – FRIDRIKSSON Einar**	RO – NICOLAESCU Daniella Olga
DE – VOGELANG-WENKE Heike	IS – MARLIN Dana	RO – TULUCA Doina
DE – VÖLGER Silke	IT – MACCHETTA Francesco	RS – PLAVSA Uros
DK – CARLSSON Eva	IT – MODIANO Micaela	SE – CARLSSON Fredrik
DK – PEDERSEN Søren Skovgaard	LI – GYAJA Christoph	SE – BLIDEFALK Jenny
EE – TOOME Jurgen	LI – KEIL Andreas	SI – IVANČIČ Bojan
EE – SARAP Margus	LT – BANAITIENE Vitalija	SI – HEGNER Anette <sup>o</sup>
ES – BERNARDO Francisco	LT – PAKENIENE Aušra	SK – MAJLINGOVA Marta
ES – ARMIJO NAVARRO-REVERTER Enrique	LU – LAMPE Sigmar <sup>o</sup>	SM – TIBURZI Andrea
FI – HONKASALO Terhi Marjut Anneli <sup>o</sup>	LU – OCVRK Philippe**	SM – PERRONACE Andrea
	LV – SMIRNOV Alexander	TR – KÖKSALDI Sertaç Murat
	LV – FORTUNA Jevgenijs	TR – DERİŞ Aydin

Ausschuss für Berufliche Bildung	Professional Education Committee	Commission de Formation Professionnelle
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
AL – DODBIBA Eno	FR – COLLIN Jérôme	MC – THACH Tum
AT – SCHWEINZER Fritz	GB – GOWSHALL Jon	MK – PEPEJUGOSKI Valentin
BE – VAN DEN HAZEL Bart	GR – LIQUMBIS Alexandros	NL – VAN WEZENBEEK Lambertus
BG – KOSSEVA Radislava Andreeva	HR – PEJČINOVIČ Tomislav	NO – BERG Per G.
CH – BERNHARDT Wolfgang	HU – TEPFENHÁRT Dóra	PL – MALCHEREK Piotr
CY – THEODOULOU Christos A.	IE – LITTON Rory Francis	PT – FRANCO Isabel
CZ – HARTVICOVA Katerina	IS – INGVARSSON Sigurdur	RO – FIERASCU Cosmina Catrinel
DE – LETZELTER Felix	IT – RAMBELLI Paolo*	SE – HOLMBERG Martin
DK – STAHR Pia	LI – ALLWARDT Anke	SI – FLAK Antonija
EE – NELSAS Tõnu	LT – ŠIDLAUSKIENE Aurelija	SM – PETRAZ Davide Luigi
ES – VILALTA JUVANTENY Luis	LU – LECOMTE Didier**	TR – YAVUZCAN Alev
FI – KONKONEN Tomi – Matti	LV – LAVRINOVICS Edvards	
<b>Stellvertreter</b>	<b>Substitutes</b>	<b>Suppléants</b>
AL – KRYEZIN Vjollca	FI – NYKÄNEN Terhi	LV – SERGEJEVA Valentina
AT – MARGOTTI Herwig	FR – FERNANDEZ Francis	NL – SMIT Freek
BE – D’HALLEWEYN Nele	GB – NORRIS Tim	NO – RØHMEN Eirik
BG – BENATOV Samuil Gabriel	HU – RAVADITS Imre	PL – PAWŁOWSKI Adam
CH – WAGNER Kathrin	IE – HARTE Seán	PT – DE SAMPAIO José
CZ – LANGROVA Irena	IS – HARDARSON Gunnar Örn	RO – TEODORESCU Mihaela
DE – AHRENS Gabriele	IT – GUERCI Alessandro	SE – JÖNSSON Christer
DK – JENSEN Bo Hammer	LI – GYAJA Christoph	SI – ROŠ Zlata
ES – SÁEZ GRANERO Francisco Javier	LT – KLIMAITIENE Otilija	SM – PRIMICERI Maria Vittoria
	LU – BRUCK Mathias	TR – ATALAY Barış
<b>Examination Board Members on behalf of epi</b>		
DK – CHRISTIANSEN Ejvind		

\*Chair/ \*\*Secretary

<sup>o</sup>Vice-Chair / <sup>oo</sup>Vice-Secretary

Ausschuss für Standesregeln	Professional Conduct Committee	Commission de Conduite Professionnelle
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
AL – SHOMO Vjollca	GB – NORRIS Tim	MT – CAMILLERI Antoine
AT – PEHAM Alois	HR – BIJELIĆ Aleksandar	NL – BOTTEMA Hans
BE – VAN DEN BOECK, Wim**	HU – LANTOS Mihály	NO – FLUGE Per
BG – KOSSEVA Radislava	IE – LUCEY Michael	PL – HUDY Ludwik
CH – RÜEDI Regula	IS – JÓNSSON Thorlákur	PT – BESSA MONTEIRO Cesar
CZ – MUSIL Dobroslav	IT – CHECCACCI Giorgio*	RO – PETREA Dana Maria
DE – GEITZ Holger	LI – WILDI Roland	SE – LINDGREN Anders
DK – RØRBØL Leif	LT – BANAITIENE Vitalija	SI – MARN Jure
EE – OSTRAT Jaak	LU – KIHN Henri	SK – ČECHVALOVÁ Dagmar
ES – ELOSEGUI DE LA PEÑA Iñigo	LV – SMIRNOV Alexander	SM – BERGAMINI Silvio
FI – KUPIAINEN Juhani <sup>oo</sup>	MC – HAUTIER Nicolas	TR – ARKAN Selda
FR – DELORME Nicolas	MK – KJOSESKA Marija	
<b>Stellvertreter</b>	<b>Substitutes</b>	<b>Suppléants</b>
AT – FOX Tobias	GB – POWELL Tim	NO – SELMER Lorentz
BE – VANHALST Koen	HR – DLAČIĆ Albina	PL – KREKORA Magdalena
BG – NEYKOV Neyko Hristov	IE – O'NEILL Brian	PT – GARCIA João Luis
CH – MAUÉ Paul-Georg	IS – FRIDRIKSSON Einar	RO – BUCSA Gheorghe
CZ – ZAK Vítezslav	IT – MARIETTI Andrea	SE – SJÖGREN-PAULSSON Stina
DE – KASSECKERT Rainer	LT – DRAUGELIENE Virgina	SI – GOLMAJER ZIMA Marjana
FI – SAHLIN Jonna	LV – FORTUNA Larisa	SM – MERIGHI Fabio Marcello
FR – TARAVELLA Brigitte	NL – PETERS John	

Ausschuss für Streitregelung	Litigation Committee	La Commission Procédure Judiciaire
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
AL – PANIDHA Ela	FI – ETUAHO Kirsikka	MK – DAMJANSKI Vanco
AT – KOVAC Werner	FR – CASALONGA Axel*	NL – CLARKSON Paul Magnus
BE – VANDERSTEEN Pieter	GB – HEPWORTH John Malcolm	NO – SIMONSEN Kari
BG – GEORGIEVA-TABAKOVA	HR – VUKINA Sanja	PL – BURY Lech
Milena Lubenova	HU – TÖRÖK Ferenc <sup>o</sup>	PT – CRUZ Nuno
CH – THOMSEN Peter**	IE – WALSHE Triona	RO – PUSCASU Dan
CY – THEODOULOU	IS – HARDARSON Gunnar Örn	RS – ZATEZALO Mihajlo
Christos A.	IT – COLUCCI Giuseppe	SE – LINDEROTH Margareta
CZ – GUTTMANN Michal	LI – HARMANN Bernd-Günther	SI – DRNOVŠEK Nina
DE – PFRANG Tilman	LT – ŽABOLIENE Reda	SK – NEUSCHL Vladimír
DK – KANVED Nicolai	LU – BRUCK Mathias	SM – MASCIOPINTO Gian Giuseppe
EE – KOPPEL Mart Enn	LV – OSMANS Voldemars	TR – DERİŞ Aydın
ES – ARIAS SANZ Juan	MC – SCHMALZ Günther	
<b>Stellvertreter</b>	<b>Substitutes</b>	<b>Suppléants</b>
AT – NEMEC Harald	HR – VUKMIR Mladen	NO – THUE LIE Haakon
BE – MELLET Valérie	IE – WHITE Jonathan	PL – KORBELA Anna
BG – PAKIDANSKA Ivanka	IS – FRIDRIKSSON Einar Karl	PT – CORTE-REAL CRUZ António
Slavcheva	IT – DE GREGORI Antonella	RO – VASILESCU Raluca
CH – DETKEN Andreas	LI – MARXER Amon	SE – MARTINSSON Peter
CZ – HALAXOVÁ Eva	LT – KLIMAITIENE Otilija	SI – KUNIĆ TESOVIC Barbara
DE – MOHSLER Gabriele	LU – LECOMTE Didier	SK – BAĐUROVÁ Katarína
DK – CHRISTIANSEN Ejvind	LV – FORTUNA Jevgenijs	SM – MAROSCIA Antonio
ES – JORDÁ PETERSEN Santiago	MC – THACH Tum	TR – CORAL Serra Yardimici
FI – VÄISÄNEN Olli Jaakko	NL – STEENBEEK Leonardus	
FR – GENDRAUD Pierre	Johannes	

\*Chair/ \*\*Secretary

<sup>o</sup>Vice-Chair / <sup>oo</sup>Vice-Secretary

Ausschuss für Biotechnologische Erfindungen	Committee on Biotechnological Inventions	Commission pour les Inventions en Biotechnologie
AL – SINOJMERI Diana	FR – TARAVELLA Brigitte	MT – SANSONE Luigi A.
AT – PFÖSTL Andreas	GB – WRIGHT Simon**	NL – SWINKELS Bart
BE – DE CLERCQ Ann*	HR – DRAGUN Tihomir	NO – THORESEN Liv
BG – STEFANOVA Stanislava Hristova	HU – PETHÖ Árpád	PL – CHLEBICKA Lidia
CH – WÄCHTER Dieter	IE – HALLY Anna Louise	PT – CANELAS Alberto
CZ – HAK Roman	IS – JÓNSSON Thorlákur	RO – POPA Cristina
DE – KELLER Günther	IT – CAPASSO Olga	RS – BRKIĆ Željka
DK – SCHOUBOE Anne	LI – BOGENSBERGER Burkhard	SE – MATTSSON Niklas
ES – BERNARDO NORIEGA	LT – GERASIMOVIC Liudmila	SI – BENČINA Mojca
FI – KNUTH-LEHTOLA Sisko	LU – SPEICH Stéphane	SK – MAKELOVÁ Katarína
	LV – SERGEJEVA Valentina	SM – PRIMICERI Maria Vittoria
	MK – ILIEVSKI Bogoljub	TR – ILDEŞ ERDEM Ayşe

Ausschuss für Patentdokumentation	Patent Documentation Committee	Commission Documentation Brevets
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
AT – GASSNER Birgitta	DK – INDAHL Peter*	IE – O'NEILL Brian
	FI – LANGENSKIÖLD Tord	
<b>Stellvertreter</b>	<b>Substitutes</b>	<b>Suppléants</b>
DE – WINTER Andreas	GB – GRAY John	NL – VAN WEZENBEEK Bart
	IT – GUERCI Alessandro	

Harmonisierungsausschuss	Harmonisation Committee	Commission d'Harmonisation
<b>Ordentliche Mitglieder</b>	<b>Full Members</b>	<b>Membres titulaires</b>
BE – LEYDER Francis**	DE – STEILING Lothar	IE – GAFFNEY Naoise Eoin
CH – BRAUN Axel	ES – DURAN Luis-Alfonso	MC – THACH Tum
	GB – BROWN John*	
<b>Stellvertreter</b>	<b>Substitutes</b>	<b>Suppléants</b>
AT – FORSTHUBER Martin	FI – KÄRKÄINEN Veli-Matti	SE – MARTINSSON Peter
GB – JOHNSON Terry	FR – CONAN Philippe	TR – MUTLU Aydin
	IT – SANTI Filippo	

Ausschuss für Online-Kommunikation	Online Communications Committee	Commission pour les Communications en Ligne
DE – ECKEY Ludger	FR – MÉNÈS Catherine	NL – VAN DER VEER Johannis Leendert
DK – INDAHL Peter	GB – DUNLOP Hugh	SM – MASCIOPINTO Gian Giuseppe
FI – VIRKKALA Antero Jukka*	IE – BROPHY David Timothy**	
	IT – BOSOTTI Luciano	

Wahlausschuss	Electoral Committee	Commission pour les Élections
CH – MÜLLER Markus*	GB – BARRETT Peter	IS – VILHJÁLMSOON Árni

Redaktionsausschuss	Editorial Committee	Commission de Rédaction
DE – WIEDEMANN Albert	FR – NEVANT Marc	NL – NOLLEN Maarten
	GB – JOHNSON Terry*	

Interne Rechnungsprüfer		Internal Auditors	Commissaires aux Comptes Internes
Ordentliche Mitglieder		Full Members	Membres titulaires
CH	– KLEY Hansjörg	FR	– CONAN Philippe
Stellvertreter		Substitutes	Suppléants
DE	– TANNER Andreas	IT	– GUERCI Alessandro

Ständiger Beratender Ausschuss beim EPA (SACEPO)		Standing Advisory Committee before the EPO (SACEPO)	Comité consultatif permanent auprès de l'OEB (SACEPO)
epi-Delegierte		epi Delegates	Délégues de l'epi
BE	– LEYDER Francis	FI	– HONKASALO Marjut
DE	– LEISSLER-GERSTL Gabriele	FI	– VIRKKALA Antero
DK	– HEGNER Annette	GB	– BOFF Jim
		GB	– WRIGHT Simon
		IT	– BOSOTTI Luciano
		NL	– TANGENA Antonius
		RO	– TEODORESCU Mihaela

SACEPO – Arbeitsgruppe Regeln		SACEPO – Working Party on Rules	SACEPO – Groupe de Travail Règles
BE	– LEYDER Francis	GB	– MERCER Chris
		FI	– HONKASALO Marjut

SACEPO – Arbeitsgruppe Richtlinien		SACEPO – Working Party on Guidelines	SACEPO – Groupe de Travail Directives
DE	– LEISSLER-GERSTL Gabriele	DK	– HEGNER Anette
		GR	– SAMUELIDES Manolis

SACEPO – PDI		SACEPO – PDI	SACEPO – PDI
AT	– GASSNER Brigitta	DK	– INDAHL Peter
		FI	– Tord Langenskiöld
		IR	– O'NEILL Brian

\*Chair/ \*\*Secretary      °Vice-Chair / °°Vice-Secretary

### Vorstand / Board / Bureau Präsidium / Presidium / Présidium

Präsident / President / Président

NL – TANGENA Antonius

Vize-Präsidenten / Vice-Presidents

Vice-Présidents

DE – LEISSLER-GERSTL Gabriele

RO – TEODORESCU Mihaela

Generalsekretär / Secretary General

Secrétaire Général

PT – PEREIRA DA CRUZ João

Stellvertretender Generalsekretär

Deputy Secretary General

Secrétaire Général Adjoint

FI – HONKASALO Marjut

Schatzmeister / Treasurer / Trésorier

CH – THOMSEN Peter

Stellvertretender Schatzmeister

Deputy Treasurer / Trésorier Adjoint

EE – SARAP Margus

### Weitere Vorstandsmitglieder / Further Board Members / Autres Membres du Bureau

AL – NIKA Vladimir

AT – FORSTHUBER Martin

BE – LEYDER Francis

BG – ANDREEVA PETKOVA

Natasha

CH – LIEBETANZ Michael

CY – THEODOULOU Christos A.

CZ – GUTTMANN Michal

DE – MOHSLER Gabriele

DK – HØIBERG Susanne

ES – SÁEZ GRANERO

Francisco

FR – BAUVIR Jacques

FR – NUSS Laurent

GB – WRIGHT Simon

GB – MERCER Chris

GR – BAKATSELOU Vassiliki

HR – BOŠKOVIC Davor

HU – TÖRÖK Ferenc

IE – CASEY Lindsay

IS – JÓNSSON Thorlákur

IT – RAMBELLI Paolo

LI – HARMANN Bernd-Gunther

LT – PETNIUNAITE Jurga

LU – BEISSEL Jean

LV – FORTUNA Jevgenijs

MC – SCHMALZ Günther

MK – PEPEJUGOSKI Valentin

MT – SANSONE Luigi

NO – THRANE Dag

PL – KORBELA Anna

RS – PETOŠEVIC Slobodan

SE – ESTREEN Lars

SI – BORŠTAR Dušan

SK – MAJLINGOVÁ Marta

SM – AGAZZANI Giampaolo

TR – ARKAN Selda





**VALIPAT**

European patent **validations**

PCT **national / regional phase entries**

IP **recordsals**

Valipat seeks for its fast-growing activity of translation of specifications and claims of European patents into English, French or German

## Freelance European Patent Attorneys

- Junior, Senior or Retired Attorneys, available for free-lance work
- Fluent in source and target languages
- With specific technical fields of expertise
- Willing to help us implement our belief that translations prepared by Patent Attorneys offer the best quality assurance
- Seeking a scalable workload in a flexible remote work environment

### About Valipat

A service provider offering IP administrative support services to registered IP Attorneys only

#### Our People

4 European Patent Attorneys in the executive committee  
3 Senior Patent Attorneys in the advisory board  
80+ staff , including 35 Paralegals, Lawyers and IT Developers  
110+ carefully selected leading IP boutiques law firms in agents network

#### Our Services

30,000+ filings yearly – covering  
European patent Validations  
PCT national / regional phase entries  
IP Recordsals  
Custom paralegal support  
Renewals

Interested? Please send a resume to [hr@valipat.com](mailto:hr@valipat.com)

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

---

Redaktionsausschuss / Editorial Committee / Commission de Rédaction

Terry Johnson

Marc Nevant

Maarten Nollen

Albert Wiedemann

---

Postanschrift / Mailing address / Adresse postale

epi

Bayerstrasse 83

80335 Munich

Germany

Tel: +49 89 24 20 52-0

Fax: +49 89 24 20 52-20

Email: [info@patentepi.com](mailto:info@patentepi.com)

[www.patentepi.com](http://www.patentepi.com)



---

Layout und Satz / Layout and composition / Mise en page et ensemble

SIMIUS New Media GmbH

Lichtenbergstraße 8

85354 Garching bei München

Tel: +49 89 54 84 27 20

Email: [info@simius.de](mailto:info@simius.de)

[www.simius.de](http://www.simius.de)

© Copyright epi 2016

---

Das Institut ist weder für Erklärungen noch für Meinungen verantwortlich, die in Beiträgen dieser Zeitschrift enthalten sind. Artikel werden in der oder den Amtsprachen (deutsch, englisch, französisch) wiedergegeben, in der bzw. denen diese Artikel eingereicht wurden.

The Institute as a body is not responsible either for the statements made, or for the opinions expressed in the publications. Articles are reproduced in the official language or languages (German, English or French) in which they are submitted.

L'Institut n'est pas responsable des opinions exprimées dans cette publication. Les articles sont publiés dans celle ou celles des trois langues officielles (allemand, anglais ou français) dans laquelle ou lesquelles ils ont été proposés.

The trade mark "epi" is the property of the Institute of Professional Representatives before the European Patent Office. epi is registered internationally, as a Community trade mark (CTM) in the EU and nationally in Germany.





European Patent Institute  
Bayerstrasse 83  
80335 Munich | Germany