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Cover:

### **Eruptive Erwartung**

This picture painted by  
Hannes Rass  
(European Patent Attorney, DE)  
was part of the **epi** Artists  
Exhibition 2015 at the EPO, Munich

## Hannes Rass

1937 Birth in Weiden / Opf.  
1957-1963 Studies of electrical  
engineering at the  
Technical University  
of Berlin  
1964 Beginning of the  
professional activities  
in Munich  
1972 German Patent  
Attorney examinations

Artistic spheres of activity:  
Book-objects, interventions in texts  
and print works, painting, collages,  
wood-sculptures.

The displayed artwork is a work in  
gestural duct in a mixed-technique  
on carton

1937 Geburt in Weiden / Opf.  
1957-1963 Studium der Elektro-  
technik an der  
Technischen Universität  
Berlin  
1964 Beginn der beruflichen  
Tätigkeit in München  
1972 Deutsche  
Patentanwaltsprüfung

Künstlerische Betätigungsfelder:  
Buchobjekte, Eingriffe in Texte und  
Druckwerke, Malerei, Collagen,  
Holzskulpturen.

Das hier gezeigte Bild ist eine Arbeit  
in gestischem Duktus in Mischtech-  
nik auf Karton.

1937 Naissance à Weiden / Opf.  
1957-1963 Études du génie  
électrique à l'Université  
technique de Berlin  
1964 Commencement de  
l'activité professionnelle  
à Munich  
1972 Examen Allemand en  
tant qu'avocat des  
brevets.

Domaines d'activité artistique:  
Livre-objet, interventions dans les  
textes et oeuvres imprimées, peintures,  
collages, sculptures en bois.

L'image présentée est une œuvre  
de style gestuel dans les matières  
mêlées sur carton.

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## Editorial\*

T. Johnson (GB), Editorial Committee



Terry Johnson

We have often been struck by the phenomenon of what one could call the “amazing awareness syndrome”. By this is meant that having just acquired a new car, for example, you as owner become aware that the roads are full of the same model of car as your new one, when before your purchase you had hardly noticed that model at all. We

could itemise other examples of the syndrome, for example elections. Many of our members have recently experienced regional or national elections in their particular Member State. And there are more to follow, not least in Germany and Great Britain. Our members will also

be aware that our Institute is not alone, for we have recently had an election of our own. We now have, as in say France, a newly elected governing body, in our case Council which held the first meeting of its three-year term in April in Munich, see the Report of the meeting elsewhere in this issue. There is a saying in English that “a new broom sweeps clean”. There is also a Chinese tradition of having a national tomb sweeping day. We are sure, however, that our Institute is rather livelier than a tomb, being vibrant and healthy, and that the outgoing Council left the Institute in good shape, with no need for subsequent sweeping. However, we are confident that our new President, Francis Leyder and his team, aided by the various Committees of the Institute, will have constructive new aims and initiatives for the benefit of us all. We wish the new Council well in its endeavours for the next three years, at the end of which we are sure that there will be no tomb to sweep!

\* This Editorial was written before the General Election in the UK.

Nächster Redaktionsschluss für epi Information	Next deadline for epi Information	Prochaine date limite pour epi Information
Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der <b>epi</b> Information ist der <b>16. August 2017</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>16<sup>th</sup> August 2017</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>16 août 2017</b> . Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.



## Report from the 82<sup>nd</sup> Council Meeting in Munich on 24<sup>th</sup>-25<sup>th</sup> April, 2017

T. Johnson (GB)

The following is a brief report of the main topics considered during the subject meeting. The report does not constitute in any shape or form the Minutes of the meeting.

The meeting was opened by President Tony Tangena who, as the meeting was the first following the election, welcomed the new Council, particularly newly-elected members, and thanked the previous Council for its support and service over the previous three years.

Mr. Müller reported that 50% of candidates for election to the new Council had provided cvs, and that there was a 76% turn-out.

The Minutes of the previous meeting, C81 in Berlin, were approved with minor changes.

The Secretary General reported that the Secretariat was functioning well, and that the website was up and running, was in good shape and was well-visited. Upgrading of the website was work-in-progress of the Editorial Committee. The report was approved by Council.

The Treasurer reported that income had increased and expenditure decreased owing largely to IT costs being down and from savings on printing and postage as **epi** Information was now online. Council thanked the Treasurer for his assiduous attention to foster the financial health of the institute, he in turn thanked the Finance Committee for its important work in monitoring the finances and for their support.

Council then discharged the Treasurer for 2016.



Council then voted in favour of discharging the outgoing Board en bloc for 2016.

Council then elected the new Board for 2017-2020.

There were two candidates for President, Francis Leyder (BE) and Chris Mercer (GB). Each gave a brief oral address to Council to supplement their respective previously-circulated written cvs.

Council voted. Francis Leyder was elected President, and took the chair. He thanked Tony Tangena for his service to the **epi**, and presented him with a small gift in token of that service. Tony thanked the team that had supported him, and wished the new President and Board well.

Council then elected the following:

as Vice-Presidents:

Heike Vogelsang-Wenke (DE)

Barbara Kunič Tešović (SI)

As Secretary-General: João Pereira da Cruz (PT)

As Deputy Secretary General: Tony Tangena (NL)

As Treasurer: Peter Thomsen (CH)

As Deputy Treasurer: Paolo Rambelli (IT)

Peter Thomsen then gave a brief outline of future projects, including bringing the date for payment of members' annual subscriptions forward from 1<sup>st</sup> May to 1<sup>st</sup> April, with consequent changes in late payment rules, and professional liability insurance for members.

Council approved the package, then Peter Thomsen reported on the possible new scheme for professional liability insurance which would be applicable for all members in all Member States via a Lloyd's broker, as distinct from the existing scheme available via Axa for excess claims. The Lloyd's scheme would (i) cover all EPAs and EPA-supervised trainees, (ii) cover all EPO and NPO work (with NPO work being removed from cover at a reduced premium), and (iii) cover TM and Design work for an additional premium.

The basic premium would be calculated on annual turnover per **epi** member net of official fees, the coverage being for claims between 0.5m and 5m Euros per year.

Peter Thomsen advised Council that Lloyd's were able to bring the scheme into effect for the current Council term, but required a premium of 200,000 Euros per year. There could be a 'gap' for the current year, which could be covered by transfer from Axa at no additional charge for a member transferring.

After a discussion, Council approved by a vote: (i) the general Lloyd's concept, (ii) to accept any financial risk to the **epi** to cover the 'gap' up to a maximum of 200,000 Euros, and (iii) that Peter Thomsen could

progress the matter with Lloyd's and to report further in due course.

President Francis Leyder then welcomed Mr. Benoit Battistelli, President of the EPO, which hosted the meeting, and invited him to address Council.

President Battistelli gave a wide-ranging address. In addition to the 38 Member States, there were now two extension states and two validation states, Morocco and



Republic of Moldova, with more in the offing, namely Tunisia, Cambodia and Laos at least. The EPO he reported is the second largest intergovernmental institution in Europe, and its 7000 employees, 4,300 of whom are examiners, work to a high quality having gained an ISO 9001 Certificate. There is a two year training programme for examiners, and there is no outsourcing of examination work. In 2016, Mr. Battistelli reported that the EPO had increased production by 8.5%, stock had been reduced by 13% and costs reduced by 20%.

Applications were up 6.2% in 2016, as were patent grants, up 40.2%.

48% of applications currently came from Member States, followed by US, JP, South Korea, and PRC. As to the PCT, Council was informed that the EPO handled 36% of ISRs and 63% of IPEAs.

Of interest to Council Mr. Battistelli reported that three studies had been commissioned to assess recent EPO achievements, namely a social study by PWC a financial study by Deloitte, and a health and safety risk study by HRSM.

As regards the Boards of Appeal, there was work being done within the current EPC to increase their independence and efficiency. They would have a new building in



Munich separate from the EPO, the new building should be ready in September or October. Moreover, the EPO would attend the 10<sup>th</sup> IP5 heads and the 6<sup>th</sup> IP5 heads/industry meetings in Malta, 30<sup>th</sup> May-1<sup>st</sup> June.

The EPO expected the UPC to come into force 3-4 months from the decision to implement it.

There was a brief Q and A session, during which Mr. Battistelli said that EPO initiatives outside the 38 Member



States were of benefit to European industry, increased local IP awareness, and local inventiveness by accepting EPs.

Council thanked Mr. Battistelli with acclamation for his address.

The 1<sup>st</sup> day ended with an address to Council by the Manager of the Secretariat, Renate Schellenberg. The Secretariat of 15 people assisted in the running of the Institute on behalf of the current 11,749 members. She introduced each staff member. Council in general and the Secretary General in particular warmly thanked Renate and her team for their work on behalf of the Institute.

The second day opened with a report by John Brown on harmonisation. The **epi** has been invited to the next IP5 meeting; two **epi** members will attend. John reported that he will also attend a seminar to be hosted by the UK IPO. The meetings are, he added, not likely to discuss the grace period, reminding Council that the **epi**'s position was (i) against, unless (ii) it was used only as a safety net in a wider harmonisation package. He thanked our in-house legal adviser Amparo Campos Coll for her input.

The Reporting Group then reported. Luis-Alfonso Durán Moya (ES) thanked past President Tony Tangena for his support, and reminded Council that the Group's mandate was

to seek to reform the **epi** to make it more efficient, and more transparent to members and outside parties. In Berlin it had been decided to set the structure of the Committees at the current meeting, and that the population of the Committees was to be decided at C83 in Warsaw. After discussion and where appropriate voting, Council decided on the structure of various Committees as follows:

Disciplinary: 38 members, no change; 1 full member per member state;

By-Laws: increase from 4 to 5 full members, 4 substitute members;

Professional Conduct Committee: 38 full members, 38 substitute members;

Online Communications: increase from 9 to 11 full members (no substitute members, associate members being possible as well as the assistance of a paralegal in relation to electronic filing, and a member for liaising with the EPPC and LitCom);

EPPC: 38 members (one per Member State) and the committee to be reorganised into 4 technological groups, namely Mechanics (10 members), Chemistry (8 members), Pharma (10 members) and ICT (12 members);

Biotech Committee: no change, to remain a separate committee of the **epi**; 1 full member per member state.

Patent Documentation Committee: dissolved (with the caveat that the Institute will continue to designate 4 members to the SACEPO/PDI working party on documentation).

Council approved the Reporting Group continuing its work until at least C83 in Warsaw.

Council then elected all the members of the Disciplinary Committee (see report on page 14 in this issue) and four for the Internal Auditors, namely Hansjörg Kley (CH), Philippe Conan (FR), Andreas Tanner (DE) and Alessandro Guerici (IT).

It was also agreed that the Institute's Code of Conduct would be revised to include reference to the UPC, the revision to be considered by Council at C83 in Warsaw. Finally, under AOB, Council decided (i) that a new member for BE should be appointed up to C83, to replace Francis Leyder, (ii) that the **epi** guidelines on non-attendance at BoA OPs should be extended to opposition and examination OPs, and that the Nominations Committee will deal with nominations for committees where an election is required.

The next meeting of Council, C83, will be in Warsaw (PL), on 18<sup>th</sup> November, 2017.

## Report of the European Patent Practice Committee (EPPC)

C. Mercer (GB), Chair



Chris Mercer

This is the first report from EPPC since Francis Leyder was elected as President and I have taken over as Chairman of EPPC. Francis was an excellent Chairman of EPPC and led us all with a great deal of energy and insight and provided us with the benefit of his encyclopaedic knowledge of everything to do with the EPC. He will

be a hard act to follow. However, I hope that, with the support of the members of EPPC, past and present, I will be able to follow Francis' lead. I have been a member of EPPC on a number of occasions in the past and have been in particular involved in the SACEPO Working Party on Rules and the meetings with the PAOC Directors (see below). I have had a great deal of experience in prosecuting applications, oppositions and appeals at the EPO and I trust that this experience will serve EPPC and, through it, **epi** well while I am Chairman.

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

The EPPC is presently organised with seven permanent sub-committees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, Quality and Unitary Patent). Additionally, ad hoc working groups are set up when the need arises. Two thematic groups have also been set up.

### EPPC Meeting

EPPC met on 25 and 26 April, right after the C82 **epi** Council meeting.

At the C82 **epi** Council meeting, Mr Francis Leyder was elected as the new President of the **epi**. Therefore, Mr Leyder stepped down as Chair of the EPPC. Mr Chris Mercer will chair the Committee until the next C83 **epi** Council meeting (to be held next 18 November 2017) where the election of the members of the EPPC will take place.

The EPPC discussed its new structure (as recently approved by the **epi** Council at its C82 meeting) and had an exchange of views with Mr John Beatty (Director Patent Procedures Management, EPO) on non-unity matters and Early Certainty. Mr. Beatty has kindly provided us with copies of the slides he presented at the meeting and these slides can be accessed by **epi** members after login at <http://patentepi.com/en/epi/forum/threads/171>. The EPPC further reviewed the PCT International Search and Preliminary Examination Guidelines. In particular, it analysed the examples concerning Unity of Invention provided in Chapter 10 with the aim of making proposals for the forthcoming Guidelines update. The Committee agreed to send further comments to Mr Emmanuel Samuelides (Chair of the PCT EPPC Sub-Committee), who committed to compile them all in a document to be sent to the EPO. Lastly, the EPPC heard brief reports on meeting held with the EPO (including SACEPO Working Party on Quality and SACEPO Working Party on Rules meetings) and prepared future internal meeting as well as further meetings with the EPO.

### PAOC Meeting

EPPC's special interest group on pharma applications held its annual meeting with the Directors of the Cluster concerned with Pure and Applied Organic Chemistry (PAOC) in Munich on 16 May 2017.

The examiners in this Cluster deal primarily with pharmaceutical chemistry but also with cosmetics and similar subjects as well as subjects overlapping with biotechnology. The EPO regards this meeting as very important, as can be seen from the fact that the meeting was attended by one Principal Director, one Director of Operations, 8 Directors and two Senior Experts. They were very well briefed and provided some very useful guidance on a number of topics. There were also 11 people from **epi**, including our President.

The organiser of this meeting, Ruurd Jorritsma, gathered a number of topics and designated one of **epi**'s members to present each topic. These were sent to the EPO well in advance so that the EPO could prepare for the meeting. As a new feature this year, the EPO sent a number of topics to us for our comments. All these topics were discussed very frankly and we are grateful to the EPO for such good discussions.

The topics discussed included Article 53(c) in relation to methods of using a sub-assembly, non-surgical methods



and the difference between cosmetic and therapeutic uses, PCT searches for methods of treatment, plausibility in pharma cases, Article 123(2) in relation to combining dependent claims and ranges, toxic priorities, procedural matters, both in general and specifically relating to opposition procedures, amendment of the description and unity of invention. A full report of the meeting will be made available as soon as possible.

### EPO-epi Partnership for Quality Meeting

The annual EPO-**epi** Partnership for Quality Meeting between EPO and **epi** took place in the main EPO building on 18th May. The meeting was held as part of the 'Quality for Partnership' program, a continuous dialogue between the **epi** and the EPO by means of which both organizations exchange their views and update each other on quality matters.

The delegation from the **epi** was composed by some members of the EPPC sub-committees EPC and Quality and was headed by the **epi** President, Francis Leyder. The delegation from the EPO included Directors from DG 1 (Operations), DG 2 (Operational Support) and DG 5 (Legal/International Affairs) and was headed by Vice-President Raimund Lutz.

The EPO highly stressed the importance of user feedback, remarking on the valuable contributions provided by **epi** in this regard. **epi** welcomed the opportunity to discuss further enhancements and seize the occasion to encourage its members to make use of the feedback mechanisms and bring their input.

The presentations and materials shown by the EPO have been kindly provided to the **epi** for further distribution among its members and can be accessed by **epi** members after login at:

<http://patentepi.com/en/epi/forum/threads/171>

### Working Group on Article 123(2) EPC

A Working Group to study the application by the EPO, in particular the Boards of Appeal, of Article 123(2) EPC has been set up. This is chaired by Conor Boyce and will be looking to find examples of good and bad application of Article 123(2). Any input to this Working Group is most welcome.

### Working Group on the Rules of Procedure of the Boards of Appeal

A Working Group to study the Rules of Procedure of the Boards of Appeal has been setup. This is chaired by myself. It is aimed at looking at the present RoP to develop suggestions for amendment in advance of any changes being made by the Boards of Appeal Committee of the Administrative Council. Any input to this Working Group is also most welcome.

If you have any questions/concerns/issues you would like to raise/input for the Working Groups relating to any of the topics referred to above, please send an email to [eppc@patentepi.com](mailto:eppc@patentepi.com).

### 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>.

## Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair



Ann De Clercq

Our committee had its last yearly meeting on 22 November 2016. The minutes of said meeting were published in the **epi** information 1/2017.

The EPO Biotech Directors have proposed to meet again with a delegation of our committee in 2017 (a date is being scheduled still).

The EC issued a notice on

3 November 2016 on certain articles of the Biotech Directive 98/44/EC relating to patentability of products obtained by essentially biological processes suggesting that the Biotech Directive should be interpreted to exclude plant products. Simon Wright attended the CPL meeting on 21 November 2016 where this notice was discussed. Our committee discussed the EC notice of 3 November 2016 at our meeting and further in detail by email.

On 24 November 2016 the EPO issued a notice informing that they would stay the proceedings of certain cases due to the Commission Notice of 3 November 2016. Such a stay is unprecedented at the EPO.

The **epi** Biotech Committee has prepared comments on the "Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions" and the "Notice from the European Patent Office dated 24 November 2016 concerning the staying of proceedings due to the Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions" which were discussed at the Manchester Board meeting.

The EPO has issued its review in preparation of the CPL meeting (CA/PL 4/17) dated March 23, 2017. **epi** comments were prepared to this EPO review and a version was approved at the Munich Council meeting as attached. These comments were presented at the CPL meeting of end April by the **epi** attendants.

### **epi** Comments on paper CA/PL 4/17

Comments by **epi** on the document CA/PL 4/17 by the President of the EPO presenting options to the Committee on Patent Law (CPL) on "Patentability under the EPC of plants and animals produced by essentially biological processes following the EU Commission Notice of 3 November 2016 on certain articles of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions"

#### A. Introduction / Preliminary Remarks

Document CA/PL 4/17 was prepared at the request of the Committee on Patent Law (CPL). The task was "to analyse the effect of the EU Commission Notice on the EPO's legal framework and practice, and to present options for the way forward, including a proposal for amending the Implementing Regulations to the EPC".

The following observation is taken as the starting point:

"To consider product claims to conventional plants (and animals) allowable under Article 53(b) EPC on the basis of decisions G 2/12 – G 2/13 [...], which could not take

into account the EU Commission Notice in the interpretation of Article 53(b) EPC, would bring the Office's practice into conflict with the interpretation of the EU Biotechnology Directive set out in the EU Commission Notice and endorsed by the Council of the EU and the European Parliament." (CA/PL 4/17, item 60)

Four options have been presented in CA/PL 4/17. **epi** favours option 1.

#### B. Comments on Option 1

In the eyes of **epi**, a continuation of the examination practice based on the interpretation of Article 53(b)

EPC established by decisions G 2/12 – G 2/13 is the way forward for the EPO until, if at all, the relevant law will eventually be amended.

**epi** would like to emphasize that

- i. A conflict with Plant Breeders' Rights was alleged, which however does not exist (cf. EU Commission Notice, Introduction, 4<sup>th</sup> paragraph).
- ii. The preparatory history leading to the EU Commission Notice does not support the view that plants should be excluded from protection.
- iii. The Expert Group on the Development and Implications of Patent Law in the field of Biotechnology and Genetic Engineering in its final report also came to the conclusion that no change is necessary.

### C. Comments on Option 3

In case it is concluded that an amendment to the Implementing Rules and the EPO examination and granting practice is necessary, the following arguments and proposals are provided for further consideration:

According to Option 3, the Implementing Regulations to the EPC are amended so as to overcome the conflict between the Enlarged Board's interpretation of Article 53(b) EPC and the EU Commission Notice. A concrete proposal to amend Rule 28 EPC is provided, i.e. by adding a section (2) reading "Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process" (Document, item 98).

The concrete wording of suggested new Rule 28(2) EPC creates the additional potential problem that it defines the plants to be excluded from patentability as being "exclusively obtained by means of an essentially biological process". In G 2/07 – G 1/08, the Enlarged Board has interpreted the term "essentially biological process for the production of plants" very broadly. It was held that the presence of additional technical steps (e.g. genetic engineering) either upstream or downstream of the steps of sexual crossing and selection does not bring a plant production process out of the Article 53(b) process exclusion (G 2/07 – G 1/08, point 6.4.2.3, penultimate paragraph). As a consequence, it cannot be excluded that an exemption of plants obtained by an essentially biological process could also affect technically produced plants (e.g. genetically engineered plants). In view of this, the considerations set out under items 71 to 77 of the Document, according to which "plants obtained by crossing and selection only"

would be excluded by the new Rule 28(2) EPC, are difficult to follow.

In view of **epi** the above-mentioned problems can be overcome by an amendment of Rule 27 and optionally Rule 28 as outlined below. The discussion on the patentability of plants is triggered by fears of classical breeders that patents will be granted with generic claims on plants that could cover plant lines the breeder needs to work with. Of particular concern in this regard are claims wherein the plants are not defined clearly enough so that the breeder may have difficulties in determining whether he works in the claim or not. The **epi** proposal addresses the concern of unclear scope of plant patents.

It should also be noted that plant breeding is a technical field that is actively changing since a few years by integrating more technological advances, and **epi** believes that the EPO should rather support the technological advancements in this field. Importantly, there is a need for patent protection for new traits the development of which requires considerable efforts and time. A protection gap in this regard should clearly be avoided.

In this regard, it should be noted that recent EPO case law has already contributed to better defining the patentability requirements for inventions relating to plant traits resulting from traditional breeding. For instance, in T 967/10 and T1988/12, the Technical Board of Appeal denied clarity of claims directed to conventionally produced plants because of lacking genetic information allowing identification of the plants. In view of this, the concerns of breeders could be alleviated by requiring that conventionally bred plants can only be patentable if the claim covers what was reasonably contributed by the inventors and if a third party can clearly and easily determine whether it is operating within the claimed scope. Hence, one measure could be to revise the Examination Guidelines of the EPO to reflect the above-mentioned case law. Optionally, Rule 27(b) EPC could accordingly be amended in the following way:

#### Rule 27 – Patentable Biotechnological Inventions

Biotechnological inventions shall also be patentable if they concern: ...

(b) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety, and if the plants or animals are characterized by genetic information as an identifiable technical feature.

To further clarify the subject matter optionally Rule 28 could be amended as follows:



## Rule 28 – Exceptions to patentability

(2) Under Article 53(b), European patents shall not be granted with respect to plants or animals at the various stages of its formation and development, and any part thereof, exclusively obtained by means of a[n essentially biological] process, which does not contain any essential technical step.

Focusing on better defining the clarity requirement for plant-related inventions would also address a point raised in the EU Commission Notice where indirectly a line for defining which products obtained by such processes shall be patentable and which not has been drawn. The above proposal uses this technical requirement for a definition of products. This would result in a legal situation which conforms with the intention of the legislator by Directive 98/44/EC as it has been construed in the Commission Notice, namely ensuring that only novel and inventive plants characterized by clear, unambiguous and verifiable technical features remain patentable.

The amendment of Rule 27 optionally could be accompanied by an amendment of Rule 28, to more clearly define what is meant by an essentially biological process – one that does not contain any essential technical step. This contributes to clarification.

With these amendments a third party would not only be able to readily determine whether it operates within the scope of the claims, but it would also be able to check much more easily whether prior art exists affecting novelty or inventive step of the claimed invention.

## D. Comments on Option 4

**epi** is not in favour of option 4 because of its lacking binding effect on the Boards of Appeal which creates legal uncertainty. However, in case a Rule change is made, **epi** is in favour of adapting the Guidelines and to clearly explain that subject-matter for which protection is sought must be defined by identifiable and unambiguous technical features which are imparted to the product by the process.

## E. Conclusion

**epi** sees two possible options for resolving the issue at stake without creating legal uncertainty for the users of the EPO and third parties:

- (Preferred) Leaving the EPC and its Implementing Regulations as is, so that the legal certainty that the Enlarged Board established by G 2/12 – G 2/13 prevails. The EU Commission Notice would have to be dismissed as insufficiently supported. The national patent law diverging from the Directive with respect to the patentability of conventionally produced plants would have to be reverted so as to be in line with the wording of the Directive.
- Address the concerns in the area by clarifying the criteria with which plants obtained by essentially biological processes should comply by amending the Examination Guidelines and optionally amending Rule 27 EPC as proposed under item 18, above.

## Report of the epi-Finances Committee

M. Maikowski (DE), Chair

The 78<sup>th</sup> Meeting of the epi-Finances Committee took place in Munich on 3 and 4 April 2017.

The Committee reviewed and approved the 2017 budget and 2016 comparison presented and explained by the Treasurer. The budget indicates a modest surplus of about 228.000€ in 2016, arising principally from the subscription increase (from 160€ to 190€); and also certain efficiency improvements. The Committee noted that in the absence of this increase a deficit of around 128.000€ would have been recorded. The subscription increase therefore appears to have been unavoidable.

The Committee noted with approval that problems caused by members who fail to pay their subscriptions have reduced significantly, owing to the increased use of electronic communications with such members.

The Committee noted the Treasurer's report that the EPO is seeking to prevent epi members from paying their subscriptions by way of EPO deposit accounts. The numbers who pay by this route are large.

The Committee discussed at length epi's possible liabilities for VAT that may be increasing in view of epi's

expanded educational activity. Mr Dörries of epi's External Auditors (Kesel & Partner) gave a presentation to the Committee on this aspect. The Committee recommends that the Treasurer keeps this aspect under review.

The Committee received presentations from RMS Risk Management Service AG, insurance brokers, on (a) epi's insurance risks and how to mitigate them; and (b) a possible professional indemnity scheme for epi members.

The latter has been the subject of investigation by a Working Party. The question of whether to progress the plans further will require a decision of Council in April. The Committee therefore recommends that the Working Party very urgently conducts further research aimed at establishing the viability of the scheme, such that the Treasurer can present a question for voting on at the April 2017 meeting of Council.



Michael Maikowski

### Next Board and Council Meetings

#### Board Meetings

Due to the new structure of the Board of the epi the dates for the Board Meetings will be determined upon consultation.

#### Council Meetings

83<sup>rd</sup> Council meeting in Warsaw (PL) on 18 November 2017

84<sup>th</sup> Council meeting in Malta (MT) on 14 April 2018

## Report from the Disciplinary Committee meeting in Dublin on 11th and 12th May 2017

M. Névant (FR)



Marc Névant

As a reminder, the Disciplinary Committee (DC) is set up by the **epi** Council, as mentioned in article 11(1) of the Regulation on the establishment of an Institute of professional representatives before the European Patent Office<sup>1</sup> (the "Founding Regulations"); members of the DC are appointed by Council each time the latter is elected (article 11(2) of the Founding Regulations).

Members of the current DC were appointed for a three-year term by the **epi** Council during the 82<sup>nd</sup> Council meeting on 25<sup>th</sup> April 2017, and met for the first annual meeting of the new 3 year term on 11<sup>th</sup> and 12<sup>th</sup> May 2017.

The general principles governing the conduct and other activities of professional representatives are laid down in the Regulation on discipline for professional representatives<sup>2</sup> (which comprises two parts: Rules of professional conduct, and Disciplinary measures) and in the Code of Conduct of the Institute of Professional Representatives before the European Patent Office<sup>3</sup>. The functioning of the DC is governed by specific rules of procedure<sup>4</sup> which have been defined by the DC in the past and which have been confirmed by the Disciplinary Board of Appeal and adopted by the Administrative Council of the EPO; this functioning will be presented in more detail in a subsequent issue of **epi** information.

The DC is a committee different from other committees that can be set up by Council (the German name indicates the difference: Disziplinarrat) in the sense that whilst Council fixes the terms of reference of "other Committees", however only the Administrative Council of the European Patent Organization can amend the Regulation on discipline and/or the Additional Rules of Procedure which are the basic laws for the DC.

The most important role of the DC is to maintain the public reputation of **epi** and to ensure that professional representatives before the EPO "exercise their profession conscientiously and in a manner appropriate to their dignity". In practice, the DC considers any alleged breach

of the Rules of professional conduct which may be brought to its notice. Further the DC publishes decisions, in order to inform the **epi** Members.

The DC consists of experienced members, the vast majority of which have served several terms; the turnover of Members in the Committee is low, hence ensuring that the role mentioned just above is carried out in a very efficient and expert manner.

The main purpose of the DC's annual meeting is to keep its members trained and this year's meeting made no exception to the rule, as situations encountered during the past 12 months were discussed to the benefit of all members and especially the new DC-members who gained a valuable insight of how disciplinary matters are handled within the Committee. In this year's meeting, Officers of the DC were elected as follows: Paul Rosenich, Chair, Werner Fröhling, Deputy Chair; Tuna Yurtseven, Secretary; Wolfgang Poth, Deputy Secretary.

The DC also reflected on the evolution of the profession as well as on the functioning of the Committee in the coming years. To this end, the members attended a training session on mediation dispensed by Mr Brian O'Byrne from the Mediator's Institute of Ireland. The members also attended a presentation from Mr Giorgio Checcacci, chair of the **epi** Professional Conduct Committee, about possible amendments to be made to the Code of Conduct in order to address activities of professional representatives before the UPC. The members also had the opportunity to exchange views with Mr Chris Mercer, former **epi** President and a member of the **epi** Reporting Group; various topics were discussed, such as for example potential improvements in the functioning of the Committee and the availability of anonymised decisions to all members. This proved to be very useful.

All in all the meeting was a success. The next meeting is scheduled to take place in Prague in May or June 2018. It is indeed the policy of the DC to meet once in all Member States in order to also make the principles of **epi** disciplinary views, practice and organs more visible at a national level.

<sup>1</sup> See EPO OJ 2017 – supplementary publication 1 – pp 114-120

<sup>2</sup> See EPO OJ 2017 – supplementary publication 1 – pp 127-137

<sup>3</sup> See EPO OJ 2017 – supplementary publication 1 – pp 121-126

<sup>4</sup> See EPO OJ 2017 – supplementary publication 1 – pp 138-147



## Open Positions in the Editorial Committee

M. Nollen (NL), Editorial Committee

The Editorial Committee of the **epi** is responsible for the website and for **epi**-Information. We form a small committee with practical tasks, and our results are visible for a big audience. There are now (max 6) **open positions** in the Editorial Committee.

### The improvements so far...

In the past three years, the Committee has been involved with major projects on both the website and **epi**-Information. A new website was constructed under our guidance. The contents of the website remain a major challenge. **epi**-Information was transformed into a digital journal. By means of guidelines and critical review of manuscripts, improvements to the quality of the journal have been made, with the goal that the journal serves permanent education of the patent attorneys and presents major positions taken by the **epi** towards the EPO and other organisations.

### The success to be pursued

Both on the website and on **epi**-Information, there is a lot of work to do, so as to achieve the goals that we have set: a useful, up-to date and attractive website, and a journal on European patent practice of the quality that our profession deserves. The focus of the Editorial Committee is on the provision of contents. Additionally, the Editorial Committee cooperates with the Presidium as necessary and particularly in relation to the **epi**'s Communication policy.

Therefore, the Editorial Committee would like to get in contact with candidate members (qualified European patent attorneys), who have a sense for editorial work and who are willing to contribute to this success. We expect:

- a sense for editorial work and a feeling for what content is of importance for fellow attorneys;
- ability and willingness to write reports or other articles for **epi**-Information;
- regularly giving feedback by email on manuscripts and on questions sent by the person in charge within the **epi**-Secretariat;
- attending committee meetings (1-2 per year).

The Editorial Committee would be pleased to include one or more members with specific experience with website design and content management.

### We offer:

- openness to new ideas and freedom to engage therein;
- a good atmosphere in the Committee (with pleasant meetings);
- focus on the contents, i.e. case law and other developments;
- support by the staff of the **epi**-Secretariat.

### We are of the opinion that the work in our Committee is attractive for:

- patent attorneys that are close to retirement and are willing to use their experience and knowledge for the benefit of the profession, without need for major travelling;
- senior patent attorneys, including group leaders in industrial practice, with the experience of reviewing and setting out frameworks, and
- young talented patent attorneys with a willingness to publish and to build up a bigger network.

Any interest can be expressed to the person in charge within the **epi**-Secretariat

Mrs Sadia Liebig

[sadia.liebig@patentepi.com](mailto:sadia.liebig@patentepi.com)

preferably before the end of September 2017. A motivation letter with CV is appreciated. Election of candidates will occur during the **epi**'s Council meeting in autumn this year.

For further questions, candidates can contact

Maarten Nollen

[mnollen@arnold-siedsma.com](mailto:mnollen@arnold-siedsma.com)

tel +32-2-7376290

## epi preparation courses for the EQE pre-examination and main examination 2018

### epi Tutorial

Get your **individual feedback** on papers A/B/C/D whenever you need it during your preparation for the EQE

- Sign in 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

Further Information is available here:

<http://patentepi.com/en/education-and-training/qualifying-as-a-european-patent-attorney/preparing-for-the-eqe.html>

### Mock EQE

The mock EQE allows 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.

### Target group

The mock EQE is intended to help EQE candidates prepare for the pre-examination and main examination.

### Venue

Will be decided at a later stage.

### Time schedule:

Can be found on the **epi** website

## Continuing Professional Education (CPE) seminars 2017/2018

### Update on forthcoming events

Some seminars are postponed to 2018.

#### Unitary Patent and Unified Patent Court

12 September 2017	Stockholm (SE)	<b>epi</b> roadshow supported by the EPO
Postponed	Lyon (FR)	<b>epi</b> roadshow
12 September 2017	Vienna (AT)	<b>epi</b> roadshow
26 September 2017	Bologna (IT)	<b>epi</b> roadshow supported by the EPO
October 2017	Bern (CH)	<b>epi</b> roadshow supported by the EPO
Postponed	Birmingham (UK)	<b>epi</b> roadshow
October 2017	Bucharest (RO)	<b>epi</b> roadshow
October 2017	Budapest (HU)	<b>epi</b> roadshow
November 2017	Warsaw (PL)	<b>epi</b> roadshow
16 November 2017	Eindhoven (NL)	<b>epi</b> roadshow supported by the EPO
December 2017	Reykjavik (IS)	<b>epi</b> roadshow
January 2018	Istanbul (TR)	<b>epi</b> roadshow
February 2018	Munich (DE)	<b>epi</b> roadshow

#### Opposition and Appeal

26 September 2017	Dublin (IE)	<b>epi</b> roadshow supported by the EPO
tbd	Budapest (HU)	<b>epi</b> roadshow supported by the EPO

Concrete dates and locations will be announced on the **epi** website.

## CEIPI preparation courses for the EQE pre-examination and main examination 2018

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 2018 for those candidates who fulfil the requirements to present themselves to the pre-examination of the EQE in 2018 (see supplementary publication 2, OJ EPO 2017).

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

The seminar preparing for the pre-examination 2018 will take place from 6 to 10 November 2017. 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 1.700\*. Closing date for enrolment is 15 September 2017. More information can be obtained from Scarlett Guillot: [guillod@ceipi.edu](mailto:guillod@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 25 and 26 January 2018. 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 18 December 2017. More information can be obtained from Scarlett Guillot: [guillod@ceipi.edu](mailto:guillod@ceipi.edu) or from the CEIPI website at [www.ceipi.edu](http://www.ceipi.edu)*

For all papers of the EQE **main examination** 2018 (A+B, C and D), the preparation programme starts with "Introductory Courses" in the early autumn of 2017, 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 2017 and for paper D in January 2018 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 2018, 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 December 2017, specifically designed for those who have failed the C-paper (more than) once.

The "Special Resitter" course is offered in Strasbourg. 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. The intensive course for papers A and B will take into account the new format of these papers as from 2017.

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

The training schedule is as follows (more extensive information is given in OJ EPO 4/2017):

### "Introductory Courses" 2017

Paper	Paris (FR)	Paris (EN)	Strasbourg (DE)
<b>A+B</b>	29.09.	29.09.	22.09.
<b>C</b>	30.09.	30.09.	23.09.
<b>D</b>	08. - 09.09.	27. - 28.09.	20. - 21.09.



Each course can be booked separately. The fee for each one-day course in Paris or Strasbourg is EUR 600. The fee for the one-and-a-half day courses in Strasbourg and Paris is EUR 900 each\*.

Closing date for enrolment is 13 July 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)

### **“Preparatory Seminars” 2017/2018:**

The A+B seminar will be held in Strasbourg, from 20 to 22 (am) November 2017, the C seminar from 22 (pm) to 24 (pm) November 2017. The A+B and the C part respectively can be booked separately.

The D seminar will be held in Strasbourg, from 8 to 12 January 2018. All these seminars are intended for those who wish to sit the EQE main examination in 2018.

The fee is EUR 1 700 for the five-day courses (ABC or D); for the A+B or the C part on its own the fee is EUR 875\*. Closing date for enrolment is 15 September 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)

The “Special C-Resitter” course 2017 will be held in Strasbourg on 1 and 2 December 2017.

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

Closing date for enrolment is 2 October 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)

The intensive course for papers A+B will be held on 23 and 24 January (afternoon) 2018 in Munich (EN, DE) and in Paris (FR). The intensive course for paper C will be held in Munich (EN, DE) on 24 (morning) and 25 January 2018 and in Paris (FR) on 26 and 27 January 2018.

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 18 December 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 3 68 858313, [christiane.melz@ceipi.edu](mailto:christiane.melz@ceipi.edu)

\* The CEIPI offers reduced package prices for candidates enrolling simultaneously for the complete range of courses preparing for one or more papers of the EQE (see our website: [www.ceipi.edu](http://www.ceipi.edu))

## EQE training courses in Maastricht

C. Mulder (NL), N. Blokhuis (NL) and N. Duhayon (BE)

Since 2014, Maastricht University offers small-scale training for candidates preparing for the European Qualifying Examination (EQE). This training is for candidates who already have a basic understanding of European patent law, and currently focuses on preparation for Paper C and Paper D and on the claim analysis part of the pre-exam.

The training for each of the papers starts with three days of workshops (two days for the pre-exam course), given in Maastricht. Various methods for tackling the relevant paper are discussed including coaching from the trainers. Access will be provided to Maastricht University's electronic learning environment for online support from fellow students and the trainers all the way up to the date of EQE. Assignments will be set out to improve the skills of the participants and boost their confidence.

Currently, we offer:

### **Training for EQE Paper D**

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

Workshop duration: 3 days:

#### **Monday 9 - Wednesday 11 October 2017**

Online learning trajectory: from October 2017 to March 2018: 8 assignments (6 with a set of Part I questions and two Part II cases); one of the assignments will be marked by the tutor.

## Training for EQE Paper C

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

Workshop duration: 3-days:

**Monday 23 - Wednesday 25 October 2017**

Online learning trajectory: from October 2017 to March 2018: 8 assignments (6 C cases and two full C Papers); one of the cases will be marked by the tutor.

The training for EQE Paper C and Paper D will be given by Cees Mulder and Nyske Blokhuis, two renowned European patent attorneys who have been giving EQE exam training for a number of years.

For the participants in the trainings for EQE Paper C and Paper D, there will be an opportunity to attend a final face-to-face question and answer session with the trainers in January 2018. In preparation, an answer to an EQE exam paper can be handed in, which will be corrected and commented upon by the trainer.

For detailed information and registration, see:  
[www.maastrichtuniversity.nl/eqe-training](http://www.maastrichtuniversity.nl/eqe-training)

## New course: EQE Pre-Exam Training: Claim Analysis part

In November 2017, Maastricht University will offer candidates preparing for the Pre-Exam a training course focussed on the claim analysis part. The teaching encompasses how to apply the theoretical concepts such as scope of protection, novelty, inventive step, clarity, and allowability of amendments in a practical way to the type of questions asked in the Pre-Exam.

Workshop duration: 2 days:

**Monday 13 and Tuesday 14 November 2017**

Online learning trajectory: from December 2017 to March 2018, a number of assignments will be set out.

The EQE Pre-Exam training will be given by Nyske Blokhuis and Natasja Duhayon.

For detailed information and registration, see:  
[www.maastrichtuniversity.nl/eqe-pre-exam-training](http://www.maastrichtuniversity.nl/eqe-pre-exam-training)

All course material and teaching will be in English.

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## 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 5.2.3 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.

# Amendment of Rule 51(2) EPC relating to the payment of renewal fees in the 6 month additional period and its consequences

Cees Mulder (NL)



Cees Mulder

**E**ffective 1 January 2017, the wording of Rule 51(2) EPC was amended to clarify when the deemed withdrawal of a European patent application ensues in case the renewal fee is not paid in due time. At the same time, the wording of the first sentence of Rule 51(2) EPC was also amended. However, the latter amendment may

have undesired consequences. In this article, the situation is analysed and a proposal for repair is given.

## Introduction

The payment of renewal fees, also referred to as 'maintenance fees' or 'annuity fees', is required to maintain a granted patent in force. Many patent laws also require the payment of such fees for pending patent applications. The renewal fees serve as a source of income for covering the costs of national and regional patent authorities that are not fully covered by other fees.

The European Patent Office (EPO) levies fees for the performance of its tasks (Article 51(1) EPC). Renewal fees in respect of European patent applications must be paid to the EPO in respect of the third year and each subsequent year calculated from the date of filing of the application (Article 86 and Rule 51 EPC). After grant of the European patent, the obligation to pay renewal fees becomes a matter of national law (Article 86(2), 141 and 39 EPC).

For historical reasons, the payment of renewal fees is treated differently from the payment of other fees under the EPC, such as, e.g., the filing fee and search fee, the designation fee and the examination fee. The latter fees fall due on a certain date which, normally, is the result of a procedural event, and the system then allows the applicant a period of time to pay the prescribed fees. The system for renewal fees is different: the renewal fee for a regular European patent application falls due on 'the last day of the month containing the anniversary of the date of filing' (Rule 51(1) first sentence, EPC). This last day of the month is the *only* day on which the

renewal fee can validly be paid without additional fee. Although the possibility of advance payment of renewal fees (Rule 51(1) last sentence, EPC) mitigates the practical difficulties arising from restricting the payment possibility to one day, the procedural requirements for paying renewal fees do not follow the general principle for fees to be paid, i.e. at the expiry of a period of time.<sup>1</sup>

## Influence of T 1402/13

In the EPC 1973, it was clear from the law when the loss of rights ensues when the deemed withdrawal of the European patent application ensues if the applicant does not pay the renewal fee in due time (Article 86(3), first sentence, EPC 1973):

*"If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn."*

The loss of rights is differently worded in Article 86(1), last sentence, EPC 2000:

*"If a renewal fee is not paid in due time, the application shall be deemed to be withdrawn."*

The Explanatory Remarks in relation to Article 86(1) EPC 2000 stated that the deemed withdrawal would still take place at the end of the six-month additional period (See Official Journal of the EPO (2007) Special edition No. 4: *Revision of the European Patent Convention (EPC 2000) Synoptic presentation EPC 1973/2000 - Part I: The Articles*, p. 86):

*"Article 86(3) EPC 1973 is also deleted and the legal consequence of a failure to pay the renewal fee in due time is added to Article 86(1) EPC 2000. It is*

<sup>1</sup> In 2015, an article was published with a detailed proposal to simplify and streamline the payment of renewal fees in the EPC (*European Intellectual Property Review* 37 (2015) pp. 644-652). By only amending a few words in Rule 51 EPC, the due date of the renewal fee and the last day of valid payment would become decoupled. It was proposed to move the 'due date' of the renewal fee to the anniversary of the filing date of the application while the concomitant renewal fee would have to be paid within one month of the due date. The result would be an elegant system where the payment of renewal fees is streamlined with the payment of the 'normal' fees. In addition, in the proposal, the payment of renewal fees for direct European patent applications as well as for divisional applications and for Euro-PCT applications would follow the same rules. In the article, advantages and disadvantages of the proposed amendments of Rule 51 EPC were discussed extensively.



*emphasised that this does not modify the current situation, and under the Implementing Regulations to the EPC 2000 the application shall only be deemed to be withdrawn if the renewal fee and any additional fee have not been validly paid within the prescribed grace period for payment (see Rule 51(2) EPC 2000)."*

The Guidelines for Examination in the EPO (2016) A-IV, 1.1.1 reflect this practice:

*"In the event of non-payment of a renewal fee by the due date (Rule 51(1)), the application is pending up to the last day of the six-month period for payment of the renewal fee with an additional fee (Rule 51(2)), and a divisional application may still be filed during this period - even if the fees are ultimately not paid. Deemed withdrawal of the application takes effect on expiry of the six-month period."*

Nevertheless, the wording of Article 86(1) EPC 2000 leaves room for interpretation. In particular, Article 86(1), last sentence, EPC 2000 seems to suggest that the deemed withdrawal takes effect on the due date. This would be consistent with the view endorsed by Opinion of the Enlarged Board of Appeal in G 4/98, wherein the principle was confirmed that the deemed withdrawal of the application takes effect at the expiry of the normal period and not at the expiry of the so-called 'grace period'. The EPO incorporated G 4/98 to this effect several times in the Guidelines for Examination in the EPO (see AIII 11.2.3, AIII 11.3.4 and EVIII 2.1.3.):

*"Any loss of rights ensues on expiry of the normal period (see G 4/98)."*

The Board of Appeal in T 1402/13 applied the principle that the deemed withdrawal of the application takes effect at the due date also to the payment of renewal fees. A consequence is that if an applicant files a divisional application in the six-month additional period but does (eventually) not pay the renewal fee for the parent application, the divisional is deemed not to have been validly filed, because the parent application was not pending when filing the divisional application.

The Boards of Appeal are not bound by the explanation of the law in the Official Journal or in the Guidelines: they are only bound by the provisions of the EPC (Article 23(3) EPC).

After the issuance of T 1402/13, the EPO was compelled to clarify the wording of the law in relation to when the deemed withdrawal ensues if a renewal fee is not duly paid. To this end, Rule 51(2) EPC was amended effective 1 January 2017 (Decision of the Administrative Council CA/D 17/16; Official Journal of the EPO (2016) A102). The amended text of Rule 51(2) EPC reads as follows:

*"If a renewal fee is not paid on the due date under paragraph 1, the fee may still be paid within six months of the said date, provided that an additional fee is also paid within that period. The legal consequence laid down in Article 86, paragraph 1, shall ensue upon expiry of the six-month period."*

The last sentence of Rule 51(2) EPC clarifies how Article 86(1), last sentence, EPC should be interpreted.

In document SACEPO/WPR 8/16 (see the Report from the European Patent Practice Committee in epi Information 1|17), the reason for the amendment was given:

*"The Office replied that the proposed amendments to Rule 51 EPC simply consist in a clarification of the current practice and stated that there is no legal impediment to the provision of different regimes in the pre- and post-grant procedure; both regimes are in line with the Paris Convention."*

## Undesired consequences of the amendment of Rule 51(2) EPC

After the amendment, Rule 51(2) EPC consists of two sentences. The amendment also includes a minor reformulation of the first sentence. In the previous version, Rule 51(2) EPC was formulated as follows:

*"If a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period."*

The first sentence of Rule 51(2) EPC after amendment is now formulated as follows (underlined words show the new text):

*"If a renewal fee is not paid on the due date under paragraph 1, the fee may still be paid within six months of the said date, provided that an additional fee is also paid within that period."*

In particular, two amendments require attention:

1. The wording 'on the due date' has been added;
2. The wording 'under paragraph 1' has been added.

Both amendments have undesired consequences.

### Item 1

The use of the word 'on' in 'on the due date' is wrong or at least confusing, because renewal fees may be validly paid in a period of three months before they fall due (Rule 51(1) last sentence, EPC). This was brought to the attention of the EPO (see the Report from the European Patent Practice Committee in epi Information 1|17):

*"SACEPO members suggested that the wording be clarified in the English text by replacing 'on the due date' with 'by the due date' in Rule 51(2) EPC. The EPO will consider the proposal further and if necessary reflect the change in the French and German translation."*

Unfortunately, the English text was not adapted, but the German text was amended to reflect the possibility of payment of the renewal fee before the due date:

*"Wird eine Jahresgebühr nicht bis zum Fälligkeitstag nach Absatz 1 entrichtet, so kann sie noch innerhalb von sechs Monaten nach Fälligkeit entrichtet werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr entrichtet wird."*

## Item 2

A specific reference to the first paragraph of Rule 51 EPC is included in the new wording of Rule 51(2) EPC. The intention for making this amendment was to clarify the wording of Rule 51(2) EPC. However, it has undesired consequences for the expiry of the 6-month additional period in three different situations.

If an applicant files a divisional application, when renewal fees are already due in respect of the parent application, renewal fees must also be paid for the divisional application, because the divisional application is 'deemed to have been filed on the date of filing of the earlier application' (Article 76(1) EPC). Rule 51(3) EPC deals with this situation:

*"Renewal fees already due in respect of an earlier application at the date on which a divisional application is filed shall also be paid for the divisional application and shall be due on its filing. These fees and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee. Paragraph 2 shall apply."*

In the last sentence of Rule 51(3) EPC, a reference is made to Rule 51(2) EPC. The consequence is that the reference to Rule 51(1) EPC in the first sentence of Rule 51(2) EPC has to be taken as the law prescribes. Therefore, the starting point of the calculation of the six-month additional period for the payment of the renewal fee (with additional fee) after filing a divisional application should be the 'normal' last day of the month following the anniversary of the parent application and no longer the filing date of the divisional application. This is the consequence of the last sentence of Rule 51(3) EPC referring to (amended) Rule 51(2) EPC which contains an explicit reference to 'the due date under paragraph 1'.

The same should apply to the situation where renewal fees are due after a successful re-establishment of rights

(Art. 122 EPC) after a refusal or deemed withdrawal of the application (Rule 51(4) EPC). The last sentence of Rule 51(4) EPC contains the same wording as that of Rule 51(3) EPC:

*"Paragraph 2 shall apply."*

The same should apply to the situation where renewal fees are due after a successful petition for review (Art. 112a(5) EPC). The last sentence of Rule 51(5) EPC contains the same wording as that of Rule 51(3) EPC.

The reformulation of the first sentence of Rule 51(2) EPC also causes a conflict in relation to Euro-PCT applications upon entry into the regional phase before the EPO. Rule 159(1)(g) EPC states:

*"pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 51, paragraph 1;"*

In the situation before the amendment of Rule 51(2) EPC, if the renewal fee has already fallen due before the entry, the six-month additional period is to be calculated from the entry date (or the 'Monday', if there is a 'week-end' extension).

With the amended wording of the first sentence of Rule 51(2) EPC, the six-month additional period for a Euro-PCT application in this situation is to be calculated from the 'the due date under paragraph 1' of Rule 51 EPC, and no longer from the 'entry date'. This may imply that the payment of the renewal fee with additional fee for a Euro-PCT application expires already shortly after the acts for entry have been completed, because the expiry of the 31-month period is no longer the starting point for the calculation of the additional period.

Despite the wording in *Notice from the European Patent Office* in Official Journal of the EPO (2016) A103:

*"The amendments do not change current practice under these provisions."*

The author is of the opinion that the 'clarifying' amendments of the first sentence of Rule 51(2) may have consequences if in a case before the Boards of Appeal, the law is read without applying it in the manner desired by the EPO in its Notice or as is in the Guidelines. Since the last sentence of Rule 51(3) EPC does not mention 'mutatis mutandis', the Board will read the text of the law literally which may result in a different interpretation depending whether the application is a direct European, a divisional or a Euro-PCT application.

As explained above, the due date for calculating the renewal fee with additional fee for a divisional application under the revised wording of the first sentence of

Rule 51(2) is no longer the filing date of the divisional but the due date of the renewal fee of the 'parent' application. In addition, there is also no *mutatis mutandis* in the last sentences of Rule 51(4)(a) and of Rule 51(5)(a) EPC. Furthermore, in Rule 159(1)(g) EPC in relation to the Euro-PCT applications entering the regional phase before the EPO, there is no mention of how to pay the renewal fee with additional fee within the six-month additional period. Also here, the amended formulation of the first sentence of Rule 51(2) EPC has to be applied.

### How to repair?

The problem could easily have been avoided if a reference to 'paragraph 1' was not included in the amended wording of the first sentence of Rule 51(2) EPC. This sentence would then read (underlined words show the new text):

*"If a renewal fee is not paid on or before the due date, the fee may still be paid within six months of the said date, provided that an additional fee is also paid within that period."*

In this proposed formulation, the wording 'on or before' is employed to indicate that renewal fee may be validly paid in a (three-month) period before it falls due (see Item 1 above).

In addition, the wording 'in due time' in the previous version of Rule 51(2) EPC, has been replaced by the clarifying wording 'on or before the due date' without adding the limiting feature 'under paragraph 1' (see Item 2 above).

In this manner, the last sentences of Rule 51(3), 51(4)(a) and 51(5)(a) EPC can be interpreted according to the

long-standing practice of the EPO in relation to the calculation of the six-month additional period. The same would be the case for calculating the 6-month additional period for renewal fees in relation to Euro-PCT applications (Rule 159(1)(g) EPC).

Note that the above text proposal derives from the wording of Article 86(2) EPC 1973 which was formulated as follows:

*"When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time."*

### Conclusion

As long as the new wording of the first sentence of Rule 51(2) EPC as amended effective 1 January 2017 is not 'repaired', applicants run the risk that a Board of Appeal reads the new wording of Rule 51(2) EPC literally and ignores the explanatory statements of the EPO that the amendment does 'not change current practice under these provisions'. As is explained in this article, the amended wording may have serious consequences for the starting point of the calculation of the additional six-month period in relation to the payment of renewal fees for divisional applications (Rule 51(3) EPC), for Euro-PCT applications (Rule 159(1)(g) EPC) as well as to the situations referred to in Rule 51(4) and (5) EPC.

### Acknowledgement

The author would like to express his gratitude to Derk Visser for his advice and stimulating discussions during the preparation of the article.

## Reconsideration of G3/93 “Priority Interval” from the Perspective of G1/15 “Partial Priority”

K. Shibata (JP)

In the past, publication of an application, used as the basis of a priority claim was believed to be a non-prejudicial disclosure under Section 6(1) of UK Patents Act 1977.<sup>1</sup> In Germany the same standard used to be applicable.<sup>2</sup> Section 6(1) of UK Patents Act 1977 is aligned with Article 4B of the Paris Convention. Furthermore, the EPO Technical Board of Appeal in T301/87 affirmed the same principle, despite the fact that the EPC contains no corresponding provision of Article 4B of the Paris Convention. However, the EPO Enlarged Board of Appeal in G3/93 subsequently specifically overruled that decision. The EPO Enlarged Board of Appeal in G3/93 held that “a document published during the priority interval, the technical contents of which correspond to that of the priority document, constitutes prior art citable under Article 54(2) EPC against a European patent application claiming that priority, to the extent such priority is not validly claimed”. There is no doubt that this judicial precedent indicated in G3/93 is applicable to “AND”-claim. However can this judicial precedent be also applicable to “OR”-claim? This question has arisen because G1/15 made the condition of the recognition of partial priority for the generic “OR” claim clear for the first time.

The author believes that the scope of the referral in G3/93 was the matter related only to a full priority. This article aims to explore differences between full priority and partial priority with the view to reconsider G3/93 from the perspective of G1/15. Incidentally, all opinions expressed in this article are the personal opinions of the author, and do not represent the opinions of the organization to which he belongs.

### 1. The implication of G1/15 Decision

The EPO Enlarged Board of Appeal in G1/15 held as follows:

“Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expres-

sions or otherwise (generic “OR”-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect”.

As seen from arguments between appellant and appellee, and amicus briefs, there were several confrontations in the background. First of all, should the “Travaux Préparatoires” prevail over case law or not? Secondly, should the same standards be used for added subject-matter and priority or not? Thirdly, should the applicant and third parties be treated equally or not?

As to the first point, the Enlarged Board of Appeal made it clear that the FICPI Memorandum (hereinafter “the Memorandum”) allows for a confirmation of the present interpretation (point 5.2 of the reasons). As to the second point, the Enlarged Board of Appeal stated that determining the subject-matter disclosed in the priority document be examined in accordance with the “gold standard” disclosure test laid down in the conclusion of G 2/98 (point 6.2 of the reasons), but pointed out that accepting multiple and partial priorities is not the same as allowing amended claims in such a manner that, after amendment, only one priority is claimed for each individual claim as indicated in Memorandum (point 5.2.1 of the reasons). As to the third point, the Enlarged Board of Appeal pointed out that accepting multiple and partial priorities does not create uncertainty for third parties (point 6.6 of the reasons).

With regard to the third point, some amicus briefs argued that an unwarranted advantage should not be given to the applicant or patentee that could diminish certainty for third parties. The Enlarged Board of Appeal pointed out that priority is a right (point 4.1 of the reasons), and held (point 4.2 of the reasons) that:

“As a matter of principle, where a right is established by an international treaty or convention, or by national law, it cannot be restricted by imposing supplementary conditions in administrative rules or guidelines or even in jurisprudence”.

The author thinks that the position taken by the Enlarged Board of Appeal is very significant.

1 Ian Muir, Matthias Brandi-Dohrn, Stephan Gruber, *European Patent Law: Law and Procedure Under the EPC and PCT*, (Oxford University Press, 2002), pp.27-28.

2 *Hakennagel*, BPatG 22.3.1995; GRUR 1995, 667.



## 2. The effect of G1/15 Decision and arising question

The G1/15 decision has resolved the problem of poisonous priority and divisional applications. However the effect of the decision is directed not only to such resolution but also to overcoming the intervening act by third parties. The priority, to the extent that it relates to the same subject-matter as the first filing, provides a sort of barrier designed to prevent third parties from interfering with the applicant's right to obtain protection for the claimed subject-matter which was first disclosed in the previous application. Here one question arises. There is no question that partial priority is valid for novelty attacks. How about for inventive step attacks?

As already mentioned, in the UK the publication of an application used as the basis of a priority claim was a non-prejudicial disclosure. Hence, partial priority was valid not only for novelty attacks but also for inventive step attacks. Also in Germany it appeared that the same standard used to be applicable according to the "umbrella"-theory. After the G3/93 Opinion was rendered, however, the UK Patents Court followed the opinion in 1995<sup>3</sup>, and the Bundesgerichtshof followed the opinion in 2001<sup>4</sup>.

G1/15 appears to assume that the Memorandum is valid as a legislative intent of Article 88 (2) EPC and also as the confirmation of the present EPC interpretation. According to the Memorandum, an "AND"-claim cannot enjoy a partial priority. On the other hand, the scope of the referral in G3/93 was "AND"-claim<sup>5</sup>, and the Bundesgerichtshof decided about "AND"-claim. Hence, these decisions are aligned with the Memorandum. However the UK Patents Court decided about the situation which appeared to concern "OR"-claim. There is some possibility that the decision by the UK Patents Court is not compatible with the G3/93 Opinion and the G1/15 decision.

## 3. Analysis of *Beloit v Valmet*

In *Beloit v Valmet* the Patents Court stated as follows:

"Claim 1 of the 899 patent was not entitled to priority. The Japanese application disclosed only two suction rolls or (solely from one cryptic sentence) a first suction roll and a second non-suction but circumferentially grooved roll. This information was not adequate support for claim 1, which encompassed cases where no suction rolls were used for transfer between the dryer sections, where the first roll was not a suction roll but

the second was, and where the non-suction roll did not have circumferential grooves".

This case seems to concern a generic "OR"-claim situation. However, the decision does not mention partial priorities at all. The scope of the decision appears to be the matter of full priority. By citing G3/93, the court stated that:

"Section 6(1) of the Patents Act 1977 did not carve out from the state of the art matter made available to the public in the priority interval just because that matter was in the priority document".

In this regard G3/93 Opinion held that:

"This also applies if a claim to priority is invalid due to the fact that the priority document, and the subsequent European application, do not concern the same invention because the European application claims subject-matter not disclosed in the priority document".

The UK Patent Courts appeared to have construed literally and strictly, the above-mentioned provision ruled by G3/93 Opinion.

## 4. Analysis of G3/93 Opinion

We must explore the contents of G3/93 Opinion. The Enlarged Board of Appeal in G3/93 ruled as follows:

"Article 4, Section A(1), Paris Convention, makes no mention of the subject-matter of the subsequent application. It is generally held that the subsequent filing must concern the same subject-matter as the first filing on which the right of priority is based [cf. R. Wieczorek, *Die Unionspriorität im Patentrecht*, Köln, Berlin, Bonn, München 1975, p. 149; G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967*, Geneva 1968, at Article 4, Section A(1), sub (i)].

Actually the same understanding was expressed by these books. Bodenhausen instructs "The subsequent filing must concern *the same subject* as the first filing on which the right of priority is based. This means that in the case of patents, utility models or inventor's certificates it must concern the same invention or innovation". Also Wieczorek instructs in the same manner at page 149 in his book.

However it is possible to find another interesting passage in Wieczorek as follows:

"Enthält die Nachanmeldung gegenüber der Erstanmeldung einen erfinderischen Überschuß, so liegt

<sup>3</sup> *Beloit v Valmet* [1995] R.P.C. 705.

<sup>4</sup> BGH, GRUR int. 2002, 146 - Luftverteiler.

<sup>5</sup> The point referred by the President of the EPO was that "does a document published during the priority interval and whose technical contents correspond to that of the priority document constitute prior art citable under Article 54(2) against a European patent application where the claim to priority is not valid because said application comprises subject-matter not disclosed in the priority document?"

Erfindungsidentität dennoch vor, wenn dieser Überschuß für jeden Fachmann naheliegend war, also keine eigene Erfindungshöhe besitzt".<sup>6</sup>

The Enlarged Board of Appeal did not appear to endorse this passage. Actually later they affirmed it by adopting the "gold standard" disclosure test in G2/98.

The Enlarged Board of Appeal in G3/93 appears to have assumed a similar "gold standard" disclosure test. The G3/93 opinion, however, does not mention "OR"-claim nor partial priority at all. Accordingly, the scope of the referral in G3/93 appears to be the matter of full priority. Here it is possible to find one clue to solve this question. 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>7</sup>

*Gosteli*, Re in 1989, even partial priority was not recognized. The Court of Appeals for the Federal Circuit stated, as the reason therefor, that a priority document must support the entire claim of a subsequent US application prescribed in 35 U.S.C. Section 119. The *Gosteli* case concerned a Markush type claim, namely "OR"-type claim. The United States does not allow multiple priorities for a single claim even if it is a Markush type claim. From the perspective of the *Gosteli* case, the scope of the G3/93 opinion seems to be only the matter of full priority. Hence, the Enlarged Board of Appeal made no mention on partial priority at all.

If so, applying strictly and literally the provision of G3/93 to the case of *Beloit v Valmet* seems not to be proper. At least, the construction of the provision by G3/93 should be modified in accordance with the decision of G1/15 which concerns a generic "OR"-claim situation.

## 5. Legislative intent concerning "OR"-claim expressed by the Memorandum

According to G1/15, the Memorandum indicates the advantages of allowing multiple and partial priorities, including the avoidance of claim proliferation and possible disadvantages in national post-grant procedures (point 5.2.1).

The Memorandum shows an example case that the principal claim of the first priority document is directed to a composition including chlorine in some form and capacity and that the description of the first priority document, including the example, does not mention any alternatives for chlorine. The example case concerns that as a conse-

quence of further experiments the applicant has found that chlorine may be replaced by bromine, iodine or fluorine, without substantial change of the technical effect, and then he files a second priority application claiming the use of bromine, iodine or fluorine as a substitute for chlorine. The second priority application contains examples of the use of all these elements.

With regard to the avoidance of claim proliferation, the Memorandum points out that if the applicant is not permitted to claim multiple priorities for one and the same claim, he will be forced to draw up four sub-claims, each directed to one of the members of the halogen group. The Memorandum also points out that many European countries, however, shows that this type of sub-claims will not be allowed because these claims will be rejected as frivolous, as just being an exhaustive list of the halogens which any school boy can find in his elementary text book.

With regard to possible disadvantages in national post-grant procedures, the Memorandum stated as follows:

"Let us now examine what happens if the applicant lets himself be coerced into abandoning the sub-claims to chlorine, bromine, iodine and fluorine, thus maintaining only the halogen claim, and his European patent later comes before a national court in a situation where an alleged infringer is able to prove that there has been public use of the invention (maybe the patentee's own use) between the second priority date and the actual filing date of the European patent application.

If, under the national law of the country concerned multiple priorities for one and the same claim are not allowed, the patent will be declared invalid, but if multiple priorities for one and the same claim are allowable, the patent will be declared valid.

Similarly, if public use of the chlorine embodiment is proved to have taken place between the two priorities dates, the halogen claim will be declared invalid in a country of the first type, and valid in its entirety in a country of the second type.

If public use of all four embodiments is proved to have taken place between the two priorities dates, the halogen claim will again be declared invalid in a country of the first type, while in a country of the second type, it will, in accordance with Art.138(2), be limited to the chlorine embodiment".

The Memorandum does not mention inventive step attacks expressly. However, the expression that "frivolous as just being an exhaustive list of the halogens which any school boy can find in his elementary text book" reminds the author that replacing chlorine with

6 R. Wieczorek, Die Unionspriorität im Patentrecht, Köln, Berlin, Bonn, München 1975, p.156.

7 *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.

bromine, iodine or fluorine is obvious. If so, there is some possibility that the Memorandum intends that publication of the invention described in priority documents is a non-prejudicial disclosure, and this idea is aligned with section 6(1) of UK Patents Act 1977 and art.4B of the Paris Convention.<sup>8</sup>

## Conclusion

If the Enlarged Board of Appeal admits that the Memorandum can be said to express the legislative intent underlying the second sentence of art. 88(2) EPC, the effect of partial priority should be construed to avoid inventive step attacks against entire generic "OR"-claim. In that case, discussion on unwarranted advantage of applicants or uncertainty for third parties may reignite.

Incidentally, with regard to discussion on the grace period, legal uncertainty is often mentioned. The patent system inherently has a waiting time from the date of disclosure of the invention to the date of publication of a patent application related to the disclosed invention. It means, during this waiting time, third parties cannot recognize whether they infringe the inventor's patent when he use the inventor's disclosed invention, whether

a patent application regarding to disclosed invention is filed or not, and how the claim of the application is drafted. The grace period system prolongs such "waiting time". However the partial priority system does not prolong such "waiting time". The third parties, who recognize the intervening exploitation of the invention by the applicant, will know the contents of the subsequent application 18 months after the priority date. The situation of third parties is not affected whether the claim of the subsequent application is the same as originally filed or is broadened compared to the original claim because they have been unable to recognize such claim until the publication. The precedent of the G3/93 opinion should be applied only to an "AND"-claim situation. With regard to an "OR"-claim situation, the precedent should not be applied it, and the determination should be made as indicated in the FICPI Memorandum.

Inventing is difficult and cannot stop with the first filing. It is therefore very common for an invention to change, and be possibly broadened during the priority year. Is it appropriate to force inventors to keep their inventions secret even after the first filing? Is it consistent with one of the basic objects of the patent system, namely to promote a rapid spread of information and technology?

At the Washington Conference on the Revision of the Paris Convention, 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.<sup>9</sup> On the other hand, the EPC did not adopt patents of addition, which was mentioned in the Convention on the Unification of Certain Points of Substantive Law on Patents for Invention signed on 27 November 1963 at Strasbourg, but rather an internal priority system. We must consider its meaning.

<sup>8</sup> In Chartered Institute of Patent Attorneys "CIPA Guide to the Patents Act 1977" 1st Edition, Sweet & Maxwell, (1980), p.28, there is the following instruction: "S.6 is to the same intent as s. 52 of the 49 Act and protects an applicant against disclosure of the invention by the applicant in the interval between the priority and filing dates. s.6 is qualified by s.130(7) and has therefore been framed to have, as nearly as practicable, the same effects as the corresponding EPC Articles. In addition, the corresponding provisions of EPCa.54 (novelty), EPCa.88(2) (multiple priority), EPCa.88(3) and (4) (substantive priority) and EPCa.89 (effect of priority) have to be construed in such a way that Article 4B of the Paris Convention is satisfied, since the preamble of the EPC states that the EPC is a special agreement within the meaning of Paris Convention Article 19". On the other hand, in Chartered Institute of Patent Attorneys "CIPA Guide to the Patents Acts" 7th Edition, Sweet & Maxwell, (2011), p.215, there is the following instruction: "As discussed in §6.04, the EPO Enlarged Board of Appeal has given a decision apparently contrary to the provisions of the section, even though that decision appears also to be contrary to the wording of the Paris Convention".

<sup>9</sup> Kazuo Shibata, "The history of partial priority system of the Paris Convention", *epi-Information*, (2016), Issue 2/16, p.63.

## Tactics for D – A methodology for EQE paper D

Authors: Cees Mulder and Nyske Blokhuis

Book Review by R. Teschemacher

Being a European patent attorney is an attractive profession and the number of candidates for the European Qualifying Examination (EQE) is high. A guide for writing Paper D cannot provide the necessary legal information and experience for writing the paper. Rather, the intention of the authors is to teach how a candidate efficiently uses his knowledge, how to write the paper, how to approach the questions and how to meet the expectations of the markers to achieve success. They are well qualified for this task. Both are national and European patent attorneys and experienced tutors giving training courses at Maastricht University. Cees Mulder also is a well renowned speaker at seminars, inter alia organised by **epi** and the EPO.

The book comprises seven parts. Part A provides general information on Paper D inter alia comprising comments from the Examination Committee which are published by the EPO in the compendia on past papers. This information helps the candidates to avoid typical and systematic mistakes reported again and again. A further chapter lists useful training material for preparing for Paper D. Additional material of this type may be found in the EPO's study guide on the EQE (6th ed. 2016, pp. 39 ff).

Part B deals with Part I of Paper D – comprising five to seven questions relating to different areas of the Examination syllabus. The authors put an emphasis on a methodology of five logical steps how to apply an abstract legal provision on a factual situation given in the question. Two examples based on concrete Part I questions explain how to use the methodology in practice.

Part C is devoted to Part II of Paper D in which the candidate has to reply in the form of a legal opinion to an enquiry from a client. The reader is given examples of crucial issues recurring in previous papers and advice how to deal with such issues. Also in respect of possible actions and suggestions how to improve the client's situations practical examples are given.

Part D gives an overview of issues regularly coming up in Paper D. A larger part deals with formal and substantive

questions of the right of priority. Part D also contains checklists for typical actions which may be appropriate suggestions in Part II of Paper D.

Part E is an analysis and solution of Part II of Paper D of 2013. The analysis uses the Stimulus-Word Technique which is intended to reveal the relevance of certain terms used in the client's enquiry for the candidate's answer. An illustrative example of a time line of the relevant events is shown which serves as a basis for determining the effective dates of the claimed-subject-matters. With the example of a marking sheet the reader learns which elements of the possible solution may earn which points or where he may lose points.

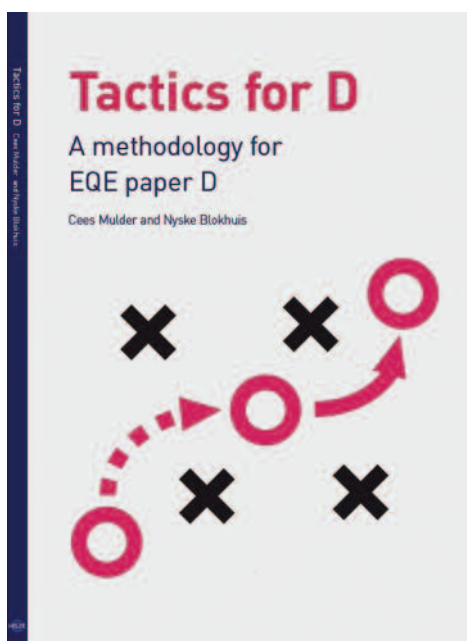
Part F gives tables for defined legal fields relevant for Paper D, listing the relevant Articles and Rules of the EPC together with the citations of the Guidelines for Examination in the EPO and the decisions of the Enlarged Board of Appeal. A similar table shows corresponding Articles and Rules of the PCT and a further one cross-references between provisions in the EPC and the Paris Convention on the right of priority.

At the end of the book, Part G provides useful indexes, a first one based on legal provisions and a second one for decisions. The third index is a keyword index.

Tactics for D is the fruit of profound practical experience with Paper D. Long before his present activities at Maastricht University, Cees Mulder had been a tutor first at CEIPI and then as a co-founder of DeltaPatents.

The book not only gives a complete picture of the requirements of Paper D, it is also full of simple practical tips, some of which may even appear self-explanatory at first glance. However, considering the mistakes actually made in the EQE and regularly reported by the Examining Committee for Paper D, such advice cannot be expressed clearly enough and repeated often enough.

Helze Publisher,  
Geldrop (NL) 2016, XI,  
144 pages, € 60.-





## A Self-Study Guide for the Pre-Examination of the EQE, Part I: The Legal Questions, Edition 2017

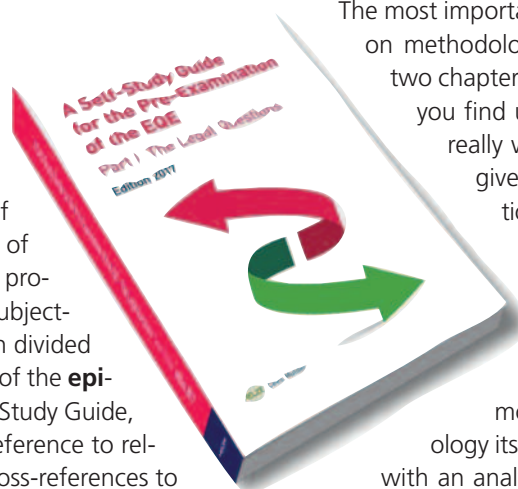
Author: Cees Mulder  
Book Review by D. Visser (NL)

Lecturer in European patent law and European patent attorney Cees Mulder has written another volume in his series of books on preparation for the European qualifying examination. His latest book is for students preparing for the legal questions of the pre-examination of the European Qualifying Examination. The quality of the book is based on the author's experience in training students, both for the D part of the main exam and for the legal questions of the pre-exam.

The major part of the Guide, 225 of the 249 pages, consists of a series of tables with an overview of the legal provisions a student should read. The subject-matter of the EPC and PCT has been divided in twelve blocks following the order of the **epi-CEIPI Study Guide**. In addition to the Study Guide, the tables in each block provide a reference to relevant parts of the Guidelines and cross-references to other blocks for most legal provisions. The tables appear to be a useful tool for a student to structure his studies. The author gives the time-honoured advice to use questions for practicing the knowledge after having studied the subject-matter of a block. A useful addition would be a demarcation between the subject-matter required for the pre-exam and that for the main exam.

The Guide recommends spending at least 400 hours on the preparation for the pre-exam. However, it does not state how much time should be allotted to the legal part. The suggested time schedule for the legal part includes 32 weeks of study and rehearsing. It would be valuable to have a breakdown of the study load, so a student can free sufficient time each week for the prepa-

ration. Moreover, a remark about the usefulness of training for a national exam could be added. A completed preparation for a serious national exam could reduce the time required for the pre-exam preparation probably by a factor of four.



The most important parts of the Guide are the chapters on methodology and on time management. These two chapters comprise only six pages in total. Here you find unique material that makes the Guide really worthwhile. The methodology chapter gives a method for analysing a legal question, searching for keywords, and finding the answer in a three-step process.

The method is clarified using a question based on the pre-exam paper of 2015. It discusses in depth how to handle dates in questions. A more in-depth discussion of the methodology itself, in particular the three-step process, with an analysis of more questions would be welcomed; the methodology chapter is just too brief.

The time management chapter gives valuable advice on how to divide the available time for the exam over the legal questions and the claim analysis. More information could be provided on how to proceed in case of emergency, such as when running out of time.

The Guide is a very useful tool for students preparing for the pre-exam. A next edition would benefit from more condensed tables and a more extended methodology part.

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5<sup>th</sup> ANNUAL CONFERENCE

# Unitary Patent & Unified Patent Court 2017

*The new Unitary Patent System on the launchpad*

WEDNESDAY 5 JULY 2017

EUROPEAN PATENT OFFICE – MUNICH



*Richard  
Hacon*  
Presiding Judge  
IPEC



*Dr. Klaus  
Grabinski*  
Judge  
FEDERAL  
COURT  
OF JUSTICE

## What is the Unitary Patent and Unified Patent Court conference?

In the frame of its 5<sup>th</sup> edition, Premier Cercle gathers the most important stakeholders who work on the UPS and the establishment of the UPC. The system's official launch initially predicted in December 2017 will be discussed by the European judges, the Committees and the Industry.

This initiative is organised in association with the **European Patent Office** on July 5, 2017 in Munich (Germany).



*Louise  
Akerblom*  
Vice-Chair  
Preparatory  
Committee  
MINISTRY OF  
FOREIGN AFFAIRS



*Hon.  
Rian Kalden*  
Judge  
COURT OF APPEAL  
THE HAGUE



*Rt. Hon.  
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Robin Jacob*  
Sir Hugh Laddie  
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