epi®

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

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Information

June 2018 2|18

Cover:
Man with blue hair
This picture painted by Michiel Cramwinckel (NL) (European Patent Attorney, NL), was part of the **epi** Artists Exhibition 2018 at the EPO, Munich

Michiel Cramwinckel

Michiel Cramwinckel ist seit 1995 zugelassener Vertreter vor dem Europäischen Patentamt . Michiel leitet heute seine eigene Patentanwaltskanzlei, nachdem er für mehrere multinationale Unternehmen wie DSM und Shell als Patentanwalt gearbeitet hat. Neben der Patentarbeit beschäftigt er sich mit der Malerei, zeichnet, fotografiert und entwirft verschiedene Arbeiten auf dem Tablet. Seine Kunstwerke wurden mehrfach bei privaten Ausstellungen in den Niederlanden ausgestellt. Einige Beispiele seiner Kunstwerke können unter folgender Adresse betrachtet werden: https://tumbir.com/blog/cramkiki.

Michiel Cramwinckel is a European Patent Attorney since 1995. Michiel runs its own patent firm after having worked as an in-house attorney for multinationals like DSM and Shell. Next to the patent work he makes paintings, drawings, photographs and mixed work on the pad. His art work has been exhibited several times at informal exhibitions in The Netherlands. Some examples of his work can be viewed on https://www.tumblr.com/blog/cramkiki.

Michiel Cramwinckel est mandataire en brevets européen depuis 1995. Il dirige son propre cabinet, après avoir travaillé dans le département brevets de multinationales comme DSM et Shell. En plus de son activité professionnelle, il paint dessine, est photographe et réalise d'autres œuvres variées avec sa tablette numérique. Ses œuvres ont été exposées à plusieurs reprises dans des expositions informelles aux Pays-Bas. On peut admirer certaines des ses œuvres à l'adresse : https://www.tumblr.com/blog/cramkiki

Table of Contents

Editorial

M. Névant (FR), Editorial Committee

Hasta la vista, baby!

Marc Névant

Some of our not-so-young readers might wonder whether the title catchphrase has anything to do with the song "Looking for a new love" by R&B singer Jody Watley (I can already imagine some eyebrows raised: Jody who?). As a matter of fact, it does not! Rather this catchphrase comes from the (famous) movie Terminator starring Arnold Schwarzenegger.

This movie is interesting on several accounts, notably the following two.

To start with, it has to be noted that, against all odds, "Schwarzie" has become an environmental activist, and his actions going back to the days when he was "Governator" of California speak for him. As we all know innovation, notably with respect to green technology, is essential to establishing new patterns of production and consumption. A recent article published in PNAS reports that scientists from the University of Portsmouth "accidentally" discovered a super plastic-eating enzyme that could help recycle the ever-growing mountain of discarded plastics in a more environmental-friendly manner (the current approach essentially involves incineration). More generally, a 2015 report from OECD shows that the growth in environmentally-related patents is faster in some countries than the growth in overall innovation. The report also shows that Europe was the place where the most granted "green" patents were actually worked.

Another interesting point arising from the movie is that light is cast on a post-apocalyptic future where the machines have taken control. To some extent this movie, like other anticipation/science-fiction movies, e.g. A.I. directed by Spielberg, raises concerns on our "relationship" with computers and on the way artificial intelligence will drive our lives in the coming years. Patenting artificial intelligence is also a challenge for practitioners and for patent offices. A conference was recently hosted by the EPO on this topic, where in a series of presentations and panel discussions participants discussed various solutions for providing applicants with a solid framework for patenting AI inventions. A report on the conference can be found in this issue of **epi** information. There is no doubt in our mind that challenges associated with the 4th Industrial Revolution will be addressed by the parties involved.

On these thoughts, we wish all our readers a very pleasant summer.

We'll be back!

*PS: this issue features for the first time a "comment" function for the electronic version of **epi** Information enabling our readers to comment on some of the contributions published. Do not hesitate to use it!*

Nächster Redaktionsschluss für **epi** Information	Next deadline for **epi** Information	Prochaine date limite pour **epi** Information
Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **17. August 2018**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.	Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **17 August 2018**. Documents for publication should have reached the Secretariat by this date.	Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de **epi** Information est le **17 août 2018**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Celebration of the 40th anniversary of epi

M. Névant (FR)

A day before the 84th Council meeting took place a meeting was held to celebrate the 40th anniversary of our Institute. The event which was moderated by our President, Francis Leyder, featured distinguished speakers.
Mr. Battistelli, the President of the European Patent Office, was given the floor first. Mr. Battistelli gave a presentation on the latest developments at the EPO, and stressed how important the relationship and cooperation between the **epi** and the EPO had been over the years.

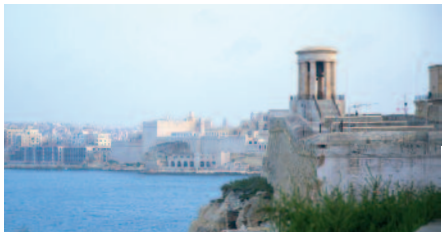
The floor was next given to Mr. Warr, the Director General of Commerce of the Maltese government. Mr. Warr gave a presentation on the changes in IP law having taken place in Malta since the country joinied the EU in 2004.

Mr. Duran, the Chair of the **epi** Reporting Group, then gave some highlights on the role of **epi** and presented the reforms undergone the past 3 years as a result of decisions taken by the **epi** Council.

Finally the floor was given to Ms. Augustyniak who qualified as professional representative 3 years ago and was then part of the Candidate Support Project. Ms. Augustyniak gave her views on i.a. (continued) education and IP awareness, and on the future of **epi**.

A gala dinner was organized to conclude the day, during which Mr. Leyder, Mr. Battistelli and Mr. Cardona (the Maltese minister of economy) gave speeches. Pictures of the event are included below.





Report from the 84th Council meeting in Valetta on 14th April 2018

M. Névant (FR)

The President opened the meeting at 9.40 am. The revised agenda was adopted. The English version of the minutes of the previous Council meeting, C83, was amended to read in decision 7: "Council approves the proposal of PEC of an **epi** 3 year training plan for **epi** students provided the mock-EQE is implemented if financially sustainable". The amended minutes of C83 were then adopted.

Matters arising from the minutes of C83

The Secretary General informed Council that the possibility of having the minutes of Council meetings available in English only, was still being studied.

Report of the Board

The President referred to the documents sent to Council members in advance of the meeting.

Report of the President and Vice-Presidents

The President referred to the document sent to Council members in advance of the meeting.

Vice-President Kunič Tesović presented a proposal for implementation of a web-based, work-sharing platform: patent firms and/or individual representatives could post on the

platform an advertisement either to offer or to seek patent-related work. This is known in Germany as "Kollegenarbeit". The proposal was well received by Council; its implementation will be studied in collaboration with i.a. the Editorial Committee.

Report of the Secretary General and annual 2017 report

Before commenting on his report, the Secretary General gave the floor to Ms. Selda ARKAN (TR) who gave a eulogy in memory of Council member Mr Sertac KOKSALDI (TR) who passed away on 18th January 2018. Council then observed a minute of silence.

The Secretary General then referred to the documents sent to Council members in advance of the meeting. The Secretary General in particular drew the attention of Council on a change of venue for the 2019 autumn Council meeting, which will take place in Lisboa instead of Monaco.

Reports of the Treasurer, Internal Auditors and epi-Finances Committee

1/ The Treasurer then referred to his previously circulated report. **epi** concluded 2017 with an overall result of + 71 k€, to be compared with a planned budgeted deficit of -33 k€. Higher than planned costs incurred for IT (in particular for the new bookkeeping software launched last October, as reported in **epi** information 4/2017) were offset by a marked decrease in expenses related to Presidium, Board and committee meetings.

2/ The Internal Auditors reported that the audit for fiscal year 2017 had been done by applying the rules of the German Commercial Code ("Handelsgesetzbuch", HGB). The auditing firm came to the conclusion that the bookkeeping was in order and complied with the rules of the HGB. No further specific remarks were made by the **epi**-Finances Committee.

3/ The Treasurer also presented the financial outlook for 2018. Based on a snapshot of the situation as of March 27, 2018, the Treasurer indicated that there was no need in his view to revise the budget agreed during C83 in Warsaw (a planned deficit of 42 k€). High expenses were again to be expected for IT and Finance & Law, notably because of (i) the intended implementation, within **epi**, of the General Data Protection Regulation (GDPR) which will enter into force on May 25, 2018, and (ii) the need for further external support/opinions on tax and legal status questions.

4/ In line with a proposal of the external and internal auditors, the Treasurer requested that the decision taken by Council in Hamburg (C73) be clarified. According to that decision the Treasurer can invest up to 500 k€ in non-Euro currencies, however the decision does not mention whether non-Euro currencies include those which are fully hedged/secured against the Euro. Hence Council was invited to vote on a proposal to clarify that the amount of investments in non-Euro currencies do not include currencies which are fully hedged/secured against the Euro. The proposal was adopted by a large majority of Council members.

5/ The Treasurer further reported on the planned amendment of Rule 154(1) EPC to be presented to the Administrative Council of the EPOrg (AC). In its meeting of February 20, 2018 the Committee on Patent Law (CPL) suggested

improving the wording of Rule 154(1) – which had already be streamlined following discussion with the EPO Legal Division - to include more details, in particular with regard to the applicable timelines for paying the annual subscription. The revised wording of Rule 154(1) proposed by the Treasurer was as follows:

> *"(1) The entry of a professional representative shall be deleted from the list of professional representatives if he so requests or if, despite a reminder, he fails to pay the applicable annual subscription to the Institute within five months from either:*
> *(a) 01 January for members being on the list on that date; or*
> *(b) the date of entry for members having been entered on the list after 1 January of the year for which the subscription is due."*

Council approved the revised wording. It was hoped that the amendment to Rule 154(1) EPC could be presented to the AC before the end of the year.

6/ The Treasurer also informed Council members that with regards to the professional insurance liability (framework contract with RMS/Lloyds) premium amounts of about 125 k€ had been collected as of April 2018 (an amount of 200 k€ needs to be collected by October 2018 otherwise **epi** will have to pay for the difference). It was reminded that information on the framework contract was available on the **epi** website (https://patentepi.com/en/professional-liability-insurance/product-information.html).

7/ There was a lively exchange of views between the Treasurer and the Chair of the Disciplinary Committee (DC),

regarding the use of the budget of the DC. Mr. Axel Casalonga (FR) suggested that the overall budget of the DC be split to distinguish between expenses related to the handling of complaints on the one hand and expenses related to meetings on the other hand. Both the Treasurer and the Chair of the DC thanked Mr. Casalonga for his proposal which was easy to implement.

Discharge of Treasurer and Board for fiscal year 2017

After hearing the report of the Treasurer and the comments of the Internal Auditors and of the **epi**-Finances Committee, Council discharged the Treasurer and the Board for fiscal year 2017.

Report of the By-Laws Committee

The Chair of the By-Laws Committee (BLC) reported on the activity of the Committee since the last Council meeting. The BLC notably addressed the following topics:

- incompatibilities between certain committees or bodies of the **epi**;
- final amendments to article 18 BL;
- proposal from the Internal Auditors to amend article 20.1 BL;
- proposal to amend article 15.4 BL to inform all **epi** members after each Council meeting.

Amendments to articles 15.4, 18 and 20.1 BL were thus presented to Council and were all adopted.

Amendments to the Terms of Reference of the BLC, PEC (Professional Education Committee), PCC (Professional Conduct Committee) and SAC (Studentship Admissions Committee) were also presented to Council. These amendments, intended to take into account the above-mentioned incompatibilities, were all adopted by Council.

Election of Committees

Council elected 3 additional full members of the Harmonisation Committee, four substitute members of the **epi**-Finances Committee, as well as the Turkish member of the European Patent Practice Committee.

Reports of Committees

1/ The Chair of the Professional Conduct Committee (PCC) referred to the document sent to Council members in advance of the meeting (proposal to amend the **epi** Code of Conduct, the aim being to take into account the fact that European Patent Attorneys may represent clients before the Unified Patent Court). Mr. Axel Casalonga (FR) drew the attention of Council to the fact that there seemed to be a loophole in the UPC Code of Conduct (CoC): the CoC shall indeed apply to representatives under article 48(1) or (2) of the Agreement on a Unified Patent Court, which article 48(2) de facto excludes European Patent Attorneys who do not "have appropriate qualifications such as a European Patent Litigation Certificate".

The Chair of the PCC invited Council members to send comments on the proposed amendments by May 31, 2018. A dedicated forum will be available to that effect on the **epi** website.

2/ The Chair of the Disciplinary Committee (DC) gave a presentation on the structure of the DC from its origin back in 1978 to nowadays where the Committee comprises 11 Chambers each comprising 4 members (a president, a rapporteur, and two members one of whom is a substitute). There are currently 5 Chambers having English as official language, 3 Chambers having French as official language, and 3 Chambers having German as official language.

3/ The Chair of the EPPC referred to the documents sent to Council members in advance of the meeting (a draft mem-

orandum on the rules of procedure of the Boards of Appeal). Highlights of the memorandum include:

- **epi** agrees on the principle that a preliminary opinion from the Board should be compulsory;
- **epi** believes that the basis for appeal proceedings should be broadened;
- **epi** fears that the proposed judicial review (of the first instance decision) will only be a legal review;
- **epi** notes that substantial burden is placed on appellants, yet nothing is said about case management by the Boards;
- **epi** also notes with regret that almost no transitional provisions are foreseen.

The draft memorandum was approved by Council.

4/ The Chair of the Editorial Committee presented a draft communication plan prepared together with the Presidium and in particular with the Immediate Past President, Tony Tangena. The plan is intended to increase the awareness of various stakeholders towards the Institute's activities. The plan is also intended to reach a larger audience within the profession by delivering quality content in **epi** Information (reports on law changes, case law, litigation etc.).

5/ The Chair of the Reporting Group pointed out that there was a need to improve the interaction between Council members and suggested the following points for implementation:

- creation of a "national forum" for each constituency (based on the experience of the Italian constituency);
- forwarding to all **epi** members a summary of topics to be discussed at the next Council meeting so that each constituency can gather the views of their members.

Information was also given that a working group had been created to make proposals so that the Secretariat is better adapted to address the current needs and requirements of the various **epi** bodies and committees. The working group was in the process of collecting information from the Secretariat staff.

Closing of meeting

Council thanked the Maltese delegation members with acclamation for their efforts in organising a very successful meeting. The President then closed the meeting at 5:00 pm.







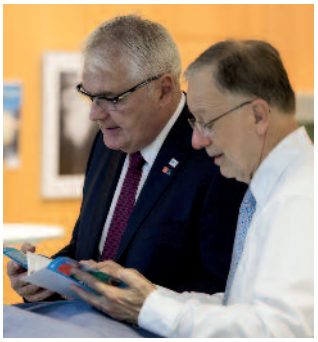


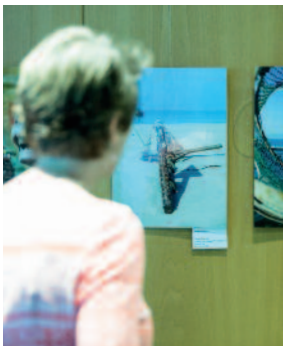
Opening of the epi Artists Exhibition

S. Liebig, **epi** Secretariat









The 11th **epi** Artists Exhibition was opened in the Foyer of the EPO (PschorrHöfe) in Munich on 11 June 2018.

Mr Francis Leyder, **epi** President and Mr Željko Topić, Vice President DG4 from the EPO welcomed the artists and their guests by honouring the interesting and numerous contributions and by emphasising the ability to combine their professional as well as their artistic perspective within their artworks.

21 creative spirits among the **epi** members are presenting their artworks. The contributions range from paintings to photographs, jewellery, patchwork quilts and porcelain.

More than 150 guests joined the event and the **epi** was very proud to welcome most of the participating artists on-site. The opening gave space for many fruitful discussions and exchange of ideas and the premises of the EPO were once again full of warm atmosphere.

The great popularity of this exhibition proves that the **epi** Artists Exhibition has become a tradition in the cultural life of the **epi** and the EPO.

The **epi** thanks all artists providing their contributions and is very honoured by its extraordinary talented members.

epi is very much looking forward to continuing this successful tradition in 2021!

Report of the Online Communications Committee (OCC)

J. Gray (GB), Chair

Introduction

The main task of the Online Communications Committee is to cooperate with the EPO in the areas of digital information processing & communications, including for example the online filing systems. The emphasis from our side is on data security and integrity, legal certainty, minimization of accidental losses of rights, and ease of use.

- **epi** members can help in this work by bringing experiences and/or concerns to our attention, via the email address OCC@patentepi.com, or directly with any OCC member.

Changes in EPO systems are continuing, but not always on the predicted timescale, and sometimes with shifts in direction. Guiding principles adopted by OCC in the past include: a preference that the online systems should implement faithfully the EPC and not impose additional formal requirements; that rules applied by the computer and/or human systems of the EPO should be transparent and accessible to users, not only officers; that system design and documentation should take into account who are the real "hands-on" users in members' offices, and not assume that every interaction will be by the responsible and highly qualified attorney.

Pilot programme for OOXML (.docx) filing

A first pilot phase for filing specifications and other documents in OOXML format took place in 2017, but was terminated, after encountering a number of issues. A second phase of pilot has been due to start at any moment, but, at the time of writing (May 2018) is still delayed. In the meantime, the Schedule of Fees has already been amended to provide discounts for users of the new format, but these will not enter into force until the DOCX filing service is technically ready.
Features of the OOXML filing scheme expected in the finished version are:

- New filing fee structure:
  - €250 paper
  - €120 PDF
  - €90 docx
- Templates will not be required
- Unicode fonts will be required
- OLE embedded objects allowed
- Reduced grant fee if all subsequently filed documents are filed in this format
  - €100 reduction for docx compliant cases from 1/7/18 ("carrot")
  - €100 increase for non-compliant cases from 1/7/19 ("stick")
- This reduced grant fee will also be available for applications pending already. For example, we expect that, for a case where a Rule 71 (3) EPC communication has already been received, filing the claims translations in XML is enough to secure the discount at the grant stage. Exact conditions to get grant fee reduction/avoid surcharges still need to be clarified.

The more **epi** members participate in this pilot, the better.

- More information is at https://www.epo.org/applying/online-services/improving/docx-filing.html

Electronic notification from EPO to applicants (Mailbox, Myfiles, etc.)

The EPO recognises, that if users are expected to use electronic filing and, soon, to file DOCX to assist EPO, it would be fair if the EPO issues similar editable content in its own communications and publications back to users. It was felt that the current electronic Mailbox works well for those who use it, but with flaws and limitations. At a SACEPO-EPP meeting in January, the EPO shared its vision for the future of "eNotifications":

- Communications can be notified electronically to all parties
  - Applicant, Proprietor, Opponent, Appellant
  - Professional representative, Association
  - Legal practitioner, Employee
- Communications can be notified electronically for all procedures
  - EP, Euro-PCT, UNIP
  - Opposition, Appeals
  - PCT-RO, PCT-ISA, PCT-IPEA
- Both companies and individuals can have several eNotification inboxes
- Customers can decide per application to receive eNotifications

New Online Filing System – Closure of eOLF

The majority of EPAs use eOLF for online filing, and eOLF can also be used for a wide range of national and PCT procedures in many member states. The online filing system "CMS" has been tried and available for some years, but a new system, provisionally titled "**online filing 2.0**" is being prepared for launch.

This "new online filing" system should be in testing soon, to go live early in 2019. Once the EPO judges that the CMS/new online filing has sufficient functionality, a transition ("sunset") period of two years will be triggered, after which **eOLF will no longer be supported**. Conversely, users will not want to switch to the new system, until it does everything reliably, that eOLF currently does. Bearing in mind the number of IT systems and training requirements associated with a transition to a new online filing system in all the firms and offices of **epi** members, OCC considers that two years is not a long time.

OCC will be consulting to determine the minimum functionality to be provided by the new online system, before the sunset period on eOLF should be triggered.

- Do you currently rely on OLF for national and PCT procedures, or only EPO procedures?
- Does your national IPO provide adequate online services separate from eOLF?
- Is your national office supporting implementation of its procedures through the new online filing system?

National offices should be urged to integrate with CMS/Online Filing 2.0 as a matter of priority. Also of value would be for national offices to integrate with the Federated Register (for those offices that have not yet done so).

Rescue/emergency filing – closure of EPO fax filing

It has long been the aim of the EPO to eliminate fax machines from its operation. It has equally long been the position of **epi** that fax filing should be maintained as an option, especially for "emergency" or "rescue" situations, in case of local computer/Internet failures. OCC does not consider it productive to pretend that fax filing is the only solution possible for "rescue" situations, in perpetuity. In fact, fax communications can be difficult to arrange in the modern age of telephony over Internet. However, the EPO clearly does not yet offer alternate solutions that could replace fax as a backup. For example, the Web Form Filing not only depends on the Internet, but does not cover several time-critical procedures before the EPO. Furthermore, the EPO "does not practise what it preaches". In many procedures and situations, the EPO invites facsimile as a preferred means of communication, and EPO officers recommend facsimile as a backup, precisely in cases where online filing encounters difficulty.

OCC will work on this topic to define the criteria by which "rescue" mechanisms can be judged, before any reconsideration of the proposal to close fax filing. In the meantime, OCC understands that proposals to close fax filing facilities will not be brought forward again, until this contradictory situation has been eliminated (see Electronic Notification as a topic, above).

Other topics

For the sake of brevity this report does not go into detail on further topics, but merely lists them as follows:

- PDF creation problems and risks (e.g. using Amyuni vs a user's preferred software)
- Assembling experience on videoconference techniques
- Support Litigation Committee in relation to UPC Systems, for example testing of the opt-out mechanism
- Register Alert functionality and reliability
- Data and data exchange formats (e.g. to interface with applicant/firm portfolio management systems)
- EPO "account management" functions (for example changing parties on multiple cases, changing representation , recording ownership etc.)

Contributions from **epi** members on any of the above topics will be received with interest, or new topics relating to the practicalities of communication with the EPO and /or UPC, WIPO and national bodies.

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

Ann De Clercq

As announced in our report in **epi** information 1/2018, a delegation of our committee has met with the EPO Biotech Directors on 6 February 2018. The Minutes of said meeting are published in this issue of **epi** information.

Delegates of our committee have also been invited to a "User Life Science Groups - Liaison Meeting on 16 November 2018 with the corresponding boards of the Boards of Appeal of the EPO – 2018" with Mr Carl Josefsson, President of the Boards of Appeal of the European Patent Office. CIPA Life Science Committee and the UNION Lifescience Group have also been invited to participate in this common meeting with all boards dealing with "life science", i.e. 3.3.01 (chairman: Albert Lindner), 3.3.04 (chairwoman: Gabriele Alt) and 3.3.08. (chairman: Beat Stolz). We look forward to this meeting and are preparing topics to be discussed. For **epi** the attendants will be Ann De Clercq (Chair **epi** Biotech Committee), Chris Mercer (our liaison to EPPC and Chair of EPPC) and Heike Vogelsang-Wenke (associate member and liaison with **epi** Presidium and Vice-President **epi**).

Our committee is also preparing additional topics for its next committee meeting which is proposed for 11 September 2018 in Munich. We are already following up matters regarding the Nagoya Protocol, antibody patenting, plant patenting, noting where the Guidelines for Examination need further amendments on Biotech matters. Any other topics that come up for discussion related to Biotech or referred to it by EPPC or other channels, such as Biotech **epi** practitioners will also be taken up at our next meeting.

The meeting with the Biotech EPO Directors may from 2018 onwards be jointly organized with the meeting with the PAOC EPO Directors and EPPC. This is explained in the minutes of the meeting with the EPO.

The Biotech Committee welcomes any **epi** member wishing to become an associate member who has a solid background in biotech and wishes to contribute to ongoing discussions in biotech patent matters. An email can be sent to the Chair of Biotech or the **epi** Secretariat for applications.

Report of the Biotech Committee Meeting with EPO directors

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

PO Internal Re-structuring

Suzanne Herrera gave a presentation with slides about the restructuring of the EPO and the centralised opposition procedure. There has been a reorganisation into 3 sectors: HBC (healthcare, Biotechnology and Chemistry), ICT (Information and Computer Technology) and M&M (Mechanics and Mechatronics). The opposition directorate in HBC has about 273 examiners and 49 formality officers.

DG1 has about 4,500 oppositions per year, but their relatively low frequency eroded legal expertise and there is a need for procedural efficiency, even after training. There was an uneven distribution of cases which led to issues with quality. The EPO wants to improve quality, efficiency and timeliness. So there has been a selection of a pool of specialised Examiners, and 30% of their work will now be oppositions. The Primary Examiners during examination are therefore now unlikely to be on the Opposition Division.

At the moment it is probably taking about 22 months to deal with an opposition, but the EPO want to reduce this to about 15 months by 2020. The opposition training has been improved and redesigned.

The search and examination Directorates have now been merged and new teams created with new Team Managers. Each Directorate has its own small team of Formalities Officers. There are therefore bigger units, with greater support for Examiners. They also have Experts with specialist knowledge.

UDEC

Mr. Schauwecker gave a presentation on UDEC. There has been broad user consultation, with a special consultation meeting in The Hague. Obviously, if cases start go through faster then applicants may need more flexibility, hence the idea of postponed examination. The consideration was to implement it in Q3 of 2018, but in the mean-

time the Office has decided to allow more time for discussions with users and member states.

Future EPO-epi meetings

Mr. Stamatopoulos mentioned that there will also be a meeting of the **epi** with the directors in Chemistry and Pharmacy: as there is significant overlap, he was wondering whether we should combine the meetings in future. He thought there could be a common meeting maybe once a year, perhaps starting with everyone, and then later splitting into two groups (Pharmacy/Chemistry and Biotechnology).

1. Plants and animals – amendments Rule 27 and 28 – amendments Guidelines for Examination:

Mr. Fernandez Branas is the Director of 1120 in charge of this area in Munich. There is still a small number of cases in The Hague with Sönke Holtorf. Proceedings had been stayed in November 2016 on about 185 cases and the new Rules came into effect on 1 July 2017. Examination had been resumed in about 140 cases now. There have been 1 refusal and 2 grants and other applications are awaiting response from applicants. The Guidelines were amended last November 2017. Plants produced by classical mutation techniques or by New Breeding Techniques will not be considered to fall under the exception of Rule 28(2) however a disclaimer will be required. Rule 28(2) EPC is applicable to all new and pending applications. As for plant parts (such as seeds, stem), especially propagation parts, these are patentable (or not) according to whether the plant of origin is patentable (or not), e.g. a seed from a transgenic plant will be regarded patentable under the new Rule 28(2) EPC. The Guidelines are quite clear but will be clarified further in the next edition for example regarding the use of disclaimers. The use of a disclaimer to remove plants produced exclusively by essentially biological processes should be non-problematic after G1/16). Mutant cases are those involving classical mutants (radiation, chemical mutation) and those produced by new breeding techniques (e.g. CRISPR, Zinc finger nucleases, etc.). It is unknown whether certain cases will go to the Boards of Appeal for testing the new Rules.

2. Marker panels

These concern new markers which may be situated in an array; Often such markers are already used in the art for the same purpose and the provision of alternative markers for said purpose is considered obvious unless the applicant can show some surprising effects over the prior art for the claimed panel.

3. New types of plausibility

No new Guidelines. Prior art and application are to be analysed on the same level. **epi** can send the EPO examples in case Examiners would be using "plausibility" in a wrong way.

4. Antibodies

No new developments or Guidelines. There is no real important case which has changed the EPO's practice. It was confirmed that it is not required to have actually made the antibody to a new and inventive target for the antibody to be patentable (in terms of sufficiency).

Claims defined by epitope might be objected to as being unclear (what is an epitope?) as experiments may vary.

5. Deposit of biological material

a. Although the deposit information is often mentioned in the specification, filling in the form correctly does assist the Receiving Office to locate the information which is required by Rule 31 1 (c) EPC.

b. Unfortunately, all Belgian collections are pooled under the 'central' address of the Brussels BCCM. This creates ambiguities between the address mentioned on form RO134 and the address given in the European application. The EPO will usually request clarification by requesting to fill in form RO134 manually. It was mentioned by **epi** that problems also arise with the DSM collection. Form RO/134 is designed/maintained by the PCT authority (IB, WIPO in Geneva). The EPO has informed WIPO a long time ago and WIPO needs to act.

6. Summaries of informal interviews

There was an interesting debate over how much information should go on the public file, following an Examiner interview (either in person or by telephone).

The examination timeliness in the biotech area is about 25 months vs the DG1 timeliness of 22 months, but is improving constantly (note this is a median figure, not the average).

The **epi** made a plea for Examiners not to amend the specification (the Druckexemplar) when issuing the Rule 71(3). We need to be particularly careful about what is said about prior art in the description, one member saying that he simply incorporates, into the description, the abstract for a patent publication and the title for a scientific literature article.

7. Topics from other meetings:

a. Stem cells
Most cases with June 2003 and later filing dates are now allowable. Previously the cut off date had been in 2008 (based on the SBP). The cells sector receives about 400 filings per year (all types of cells and cell culture processes).

b. Sequence listings
The OJ notice on Sequence Listings will be updated in the future.
Examiners may add the alignment on ad hoc basis upon

request by the applicant, because the EPO can attach the database results. This is similar to the translations that an Examiner relies upon when citing a document in a non-official language. However it will not be done systematically.

c. Pharmacogenomics
There is nothing new.

d. Medical use claims
There used to be a discrepancy between biotech and PAOC regarding the exact wording of dependent claims (second medical use claims) but this has now been harmonised.

e. Non-Unity
This is only raised in the clearest of cases. The EPO encounters now fewer cases where unity is objected to claims encompassing hundreds of sequences. It is thought also that the practice is more consistent. The average number of cases with Non-Unity is higher in Biotechnology than in other areas across the EPO. EPO receives very few protests cases during the PCT phase.

f. Added matter
A not allowable example of claim amendment was given: it is not allowable to combine claims 2 and 3 when each of dependent claims 2 and 3 were separately dependent upon claim 1. It was noted that in a lot of US originating cases there are no multiple dependencies because that is the US style of drafting (and the US Patent Office objects to multiple dependent claims).

g. Guidelines
Nothing to report.

8. Any other business

The EPO asked what the growth areas are. The EPO mainly sees growth in bio- and medical informatics and medical devices and for these cases the nature of the first claim may determine the group or Directorate to which the case is assigned. The EPO has already implemented cross-over of technical expertise, and there are now mixed examining divisions for these types of cases (e.g. a BIO expert and a Computer expert).

The EPO will give us the new unit directorate numbers and the indication of the technical area.

The meeting then concluded.

Report of the Harmonisation Committee (HC)

F. Santi (IT), Secretary

This report completed on 18th May 2018 covers the period since the previous report dated 5th February 2018. The Harmonisation Committee deals with all questions concerning the worldwide harmonisation of Patent Law, and in particular within the framework of WIPO.

36th Trilateral Heads of Office meeting

The 36th session of the Trilateral Heads of Office meeting was held in Hakone, Japan on the 2nd March 2018. **epi** was not represented.
Topics discussed also included substantive patent law harmonization: the Trilateral Industry representatives reported on the progress of their work on a proposal for a package of internationally harmonised norms (on the grace period, conflicting applications, the definition of prior art and prior user rights), indicating they aim to arrive at a successful conclusion by late 2018.

IP5 Industry Consultation Group (ICG)

The IP5 Industry Consultation Group (ICG) is a new initiative to enhance the IP5 Offices' consultation process with industry further, and is comprised of representatives from the IP5 Offices, IP5 Industry and WIPO IB.

The group met in Tokyo on 1 February 2018 to discuss amongst others the work of the IP5 Patent Harmonization Expert Panel (PHEP).
Unity of invention: IP5 Industry appreciated the effort of IP5 Offices for alignment of practices of international applications. IP5 Industry requested that practices of national/regional phase should be in line with practices of international phase.

Citation of prior art: IP5 Industry and the IP5 Offices reaffirmed that eliminating the burden on applicants, which results from citation requirements in each of the IP5 Offices, remains a high priority for IP5 Industry.
Written description/sufficiency of disclosure: IP5 Industry supported the idea proposed by IP5 Offices to develop common case examples for each Office's guideline.
Future work: IP5 Offices and IP5 Industry will discuss new topics for PHEP in advance of the IP5 Heads of Office Meeting with Industry in June 2018. IP5 Industry requested that PHEP focus on harmonizing procedural issues.

The meeting papers, including presentations on ongoing projects, are available on the joint web site of the 5 offices: http://www.fiveipoffices.org/industry-consultation/ICG/2018icg.html

Report from PfQ Meeting on 23rd April, 2018 in Munich

B. Ilievski (MK), Chair EPPC Subcommittee Quality

The annual EPO-/**epi** Partnership for Quality Meeting between EPO/**epi** took place in main EPO building on 23rd April. 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 EPPC chairs and members of the EPPC quality-committes and was headed by the EPPC Chair Chris Mercer and Chair of Quality Sub-Committee Bogoljub Ilievski. The delegation from the EPO included Directors from Operational Support and Legal/International Affairs and was headed by Vice-President Raimund Lutz.

The meeting opened with an overview of the EPO's recent structural re-organization. The participants welcomed the merger of the EPO's User Support and Quality Management departments with the objective to reinforce the link between user needs, EPO services and quality. These measures have all contributed to a steady increase in the users' satisfaction with the searches (74% in 2011, 83% in 2017), examinations (71% in 2011, 76% in 2017) and the services offered by formalities officers (74% in 2011, 89% in 2017).

Further presentations covered ongoing quality improvement measures and efforts to improve timeliness. EPO also informed about numerous developments as Data acquisition, Classification, Search and documentation tools, Translation options.

The **epi** delegation expressed appreciation for the EPO's commitment to practical engagement with the user community, particularly the in-depth exchanges with EPO legal and operational experts. Participants also congratulated the EPO on its recent ISO 9001:2015 recertification and complimented the Office on its first ever Quality Report. The second Quality report was published on 19.06.2018 and can be already found on the EPO website.

On the other side, the EPO highly stressed the importance of user feedback, remarking the valuable contributions provided by the **epi** in this regard. The **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. As the meeting also aimed to address users' needs, a large part of time was devoted to discussing points raised by the **epi** delegation and concerns the timeliness, user satisfaction survey and 9-12-15 plan and early certainty that may put more pressure on examiner work and can affect the quality. The quality issues anonymously raised by some **epi** members were also discussed.

User feedback is a core element of the EPO's Quality Management System (QMS). It supports informed decision-making and enables EPO management to better understand which areas of the EPO's work users are happy with and which aspects they think could be improved. For that reason, if you have any questions/concerns/issues you would like to raise/input relating to the quality of EPO's products and services please send an email to eppc@patentepi.com.

Next Board and Council Meetings

Board Meetings

101st Board Meeting on 25 July 2018 in Munich (DE)

Council Meetings

85th Council Meeting on 10 November 2018 in Helsinki (FI)

Continuing Professional Education (CPE)

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

Opposition and Appeal

27 November 2018	Madrid (ES)	**epi** roadshow supported by the EPO

Unitary Patent and Unified Patent Court

postponed	Bologna (IT)	**epi** roadshow supported by the EPO

Case Law

25 June 2018	Düsseldorf (DE)	**epi** roadshow supported by the EPO
23 July 2018	Basel (CH)	**epi** roadshow supported by the EPO

CEIPI

Kursangebot zur Europäischen Eignungsprüfung (EEP) 2019

Für die EEP 2019 organisiert das CEIPI ein umfassendes Kursprogramm auf der Basis von hochwertigem, exklusiv verwendetem Unterrichtsmaterial:

I. Seminar zur Vorbereitung auf die EEP Vorprüfung 2019 vom 5. bis 9. November 2018 in Strasbourg
Anmeldung bis 14.09.2018
Gebühr: 1 700 €*

II. „Last-minute Intensivkurs" für die EEP Vorprüfung 2019
am 24. und 25. Januar 2019 in München
Gezielte « last-minute » Vorbereitung auf die Praxis der Vorprüfung
Anmeldung bis 12.12.2018
Gebühr: 750 €*

III Einführende „Methodik"-Kurse für die Prüfungsaufgaben A+ B, C und D der EEP Hauptprüfung 2019 in Strasbourg
Kurs A+B: 21. September 2018
Kurs C: 22. September 2018
Kurs D: 19. – 20. September 2018
Anmeldung bis 18.07.2018
Gebühr: Kurs A+B oder C: 600 €*,
Kurs D: 900 €*. Jeder Kurs (A+B, C, D) kann einzeln besucht werden.

Einführungskurse zur EEP 2019 werden im Frühherbst 2018 in englischer und französischer Sprache ebenfalls in Paris angeboten. Informationen über: sylvie.kra@ceipi.edu

IV. Seminare zur Vorbereitung auf die Prüfungsaufgaben A+ B, C und D der EEP Hauptprüfung 2019 in Strasbourg
Aufgaben A+B und C: 19. bis 23. November 2018
Aufgabe D: 7. bis 11. Januar 2019
Anmeldung bis 01.10.2018
Gebühr: 1 700 Ř für Seminar ABC bzw. D*
Teil A+B oder C können einzeln belegt werden, Gebühr je 875 €*

V. Spezieller Kurs zur Prüfungsaufgabe C für „Resitter" am 30. November und 1. Dezember 2018 in Strasbourg
Anmeldung bis 18.10.2018
Gebühr: 850 € (inklusive C-Book)

VI. „Last-minute Intensivkurse" für die Prüfungsaufgaben A+ B, C und D der EEP Hauptprüfung 2019 in München
Kurs A+B: 21. und 22. Januar (nachmittags) 2019
Kurs C: 22. und 23. Januar (morgens) 2019
Kurs D: 24. und 25. Januar 2019
Anmeldung bis 12.12.2018
Gebühr pro Kurs: 750 €*

**Ein reduzierter Package-Preis gilt für Teilnehmer, die sich für das gesamte Kursangebot für eine oder mehrere Prüfungsaufgaben anmelden.*

Ideas for reform of the EPC – the inaugural lecture of Prof Cees Mulder (Professor at the University of Maastricht,NL)

M. Nollen (BE)

In 2001 four patent attorneys left the Philips patent department to set up a new firm that would give training courses for the EQE in addition to the more conventional private practice work. One of them was Cees Mulder, who had been engaged in the internal course for the EQE together with Derk Visser. Whom of the many colleagues within the Philips patent department, including myself, had foreseen that Cees would end up as a professor in patent law?

Looking backwards, the career path of Cees may seem as a clear road from spin-wave theory in physics via Philips research and the patent department into the procedures of the PCT and the EPC to become professor. But as we know too well from our practice, with hindsight nearly everything seems obvious. Whatever, Cees certainly deserves his appointment as a professor that follows his engagement in EQE trainings, other courses, several books and also his contribution to the law and practice.

In his inaugural lecture of 18 May this year, Mulder provides a review on the various patent harmonization treaties. He starts with the Paris Convention and then continues with the eight harmonization treaties in the period of 50 years since 1960. His overview provides a good background for all of us that are almost daily users of PCT and EPC, understand the relevance of TRIPS and may have heard of other treaties such as the Strasbourg Convention, the Community Patent and the Patent Law Treaty. As Cees explains, do not worry about all of these and do not think that you should follow another training (for instance from Cees). These other treaties did not make it into reality. Some are historically relevant, others may be forgotten. The one that would deserve more attention or even a revival is the Patent Harmonisation Treaty. As Mulder explains, it would have been a major breakthrough for worldwide patent harmonization. Unfortunately, it was not signed in the end. The USA withdraw from the negotiations thereon, and rather put its agenda forward within WTO to arrive at TRIPS.

All the initiatives for patent harmonization since TRIPS did not succeed, for which reason Mulder gave his lecture as title "The Patent Deadlock". Is that an issue? Yes, says Mulder, as there is no harmonization in relation to vital substantial issues such as novelty, inventive step and the protection for traditional knowledge, genetic resources and folklore. And then he puts the ball at the EPO, as in his view, Europe traditionally leads harmonization and the EPO had adopted such a strict approach that it effectively blocks further harmonization. Where traditionally the USA opposed against further harmonization in view of its first-to-invent system, this has been abandoned in the meanwhile.

Mulder suggests the introduction of a grace period of 12 months for inventors, the removal of computer programs from the list of non-patentable subject matter and add the possibility to review substantive issues to the petition for review by the Enlarged Board. And this all will be addressed in a proposal for revision of the EPC that he intends to elaborate as a professor. I am looking forward to his proposal and hope that it will also fit the needs of the start ups and other innovative SMEs.

The inaugural lecture of Prof Dr Mulder (in English) can be found at: https://cris.maastrichtuniversity.nl/portal/en/publications/the-patent-deadlock(49dd9bd0-81f1-4eb8-8c50-cb3c9817b270).html

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
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Tel.: +49 (0)89 2399-5231
Fax: +49 (0)89 2399-5148
legaldivision@epo.org
www.epo.org

Thank you for your cooperation.

Short note on Conference regarding Patenting Artificial Intelligence held at EPO in Munich on 30.5.2018

ICT Thematic Group of the EPPC (collective article)

The first EPO Conference dealing with patenting Artificial Intelligence was held in Munich on May 30, last.

Various contributions were given by patent practitioners in IP Firms and Industries, as well as by EPO directors and Artificial Intelligence Experts.
Starting from the latter, explanations were given as to what kind of Artificial Intelligence (AI) we can have, namely three levels of AI:

1. Artificial Narrow Intelligence (AI) dedicated to specific task;
2. Artificial General Intelligence (AGI) which is capable of transferring knowledge from one domain to a new domain;
3. Artificial Super Intelligence (ASI), which is theoretically capable of surpassing human intelligence

Today, we are seeing tangible results from the first type of AI only. For the AGI, we have scientific studies but no more, and the ASI is still science fiction.
There is a diffused sentiment that the trend is that software will widely become AI, which in turn will become super-software (everywhere – in every field of technology, well beyond ICT).
Some speakers pointed out that the patent system had 20 years to adapt to software patents, but for AI there are perhaps 5 years only, so we have to tackle this challenge now. Patents granted now will most likely be very foundational, could have very far-reaching impacts on competition, etc. – discussion should not only take place within patent office but within the society, comprising discussion on ethics.
The Directors of the EPO showed that the EPO has provided so far a predictable approach to ICT innovations, and it is preparing for a rapid AI patents growth. To this end, an understanding of technicality and ICT procedures is vital, and this is why the EPO has set up

- Interdisciplinary technical divisions of three examiners for each application;
- Annual improvements to CII content of the Guidelines.

Concerning the latter, the November 2018 edition of the Guidelines will feature new sections on mathematical methods and AI.
Concerning again the work on the Guidelines, the ICT Unit Director Grant Philpott thanked the ICT Thematic Group of the **epi** European Patent Practice Committee for having proactive and fruitful discussion on the matter each year. In fact, this recognition was given while introducing one of the member of the ICT thematic group who was invited due to the above close collaboration, and spoke in a panel about issues in patenting AI focusing on how the concept of equivalence may change both during examination and in infringement court proceedings.

Further, the EPO explained that 50 examiners have deep knowledge in AI only, while 1080 examiners in ICT are learning to be experts. This will guarantee that a sufficient number of EPO examiners will have the knowledge to search and examine in this fields.
As a proof of the work in the filed by the EPO, posters were shown in a separate room for the following AI patents: US9431003, EP3010585, EP2421439, EP3023911, EP2965267.

In the discussion on prosecution by the various panels, some tips were given:

- More discussions with inventors what are the technical effects/technical features, and when drafting consider feature by feature to determine whether to generalize or to be more specific or more concrete, with details;
- Use available claims formats considering distributed character of the AI software; focus on implementation/use case specific solutions and do not expect to obtain protection for very general solutions;
- Use the "chemistry approach":
  - perform comparative tests over the whole claimed range to confirm the technical effect and advantage over the prior art
  - introduce as many results as possible in the application,
  - provide supplementary material,
  - utilize product by process claims (method of producing a product).

On the more theoretical and futuristic side, the following issue are at stake:

- who is the inventor, a person or AI?
- reverse engineering more and more difficult – how to detect infringement?
- what kind of claims one should have;
- a balance between content and costs will be more and more difficult: patent applications should be more detailed, carefully define terms, and have a wide variety of applications
- how to rebuild portfolio, partnerships and cross licensing;
- who is a skilled person: a combination of person and AI? Or should it be a skilled AI?

Finally, the issue of adequacy of the present patent protection was discussed, and suggestions for changes were given, such as having a patent grant within 12 to 18 weeks for start-ups and removing the 18 months' delay to publish applications.

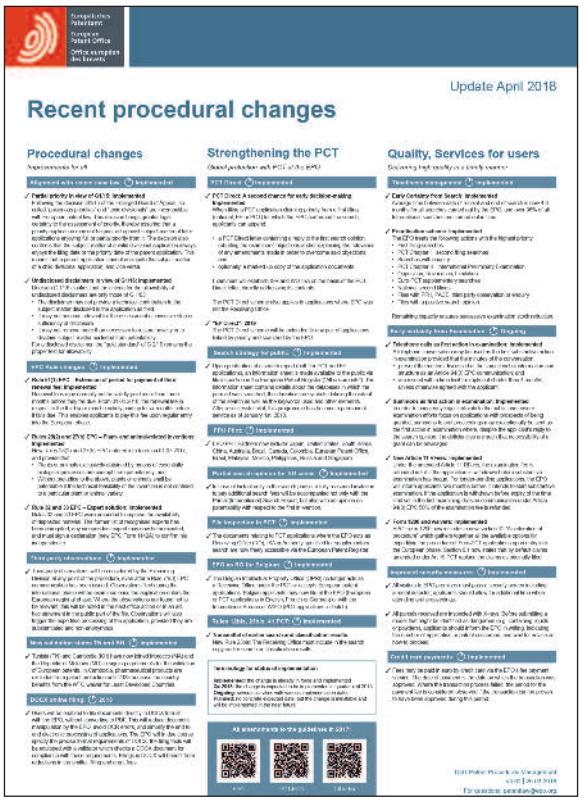
Grant Philpot announced that in November in the Hague there will be a similar conference for patenting block chains, before closing the Conference.

Recent Procedural Changes at the EPO

At least once a year, DG1 Patent Procedures Management at the EPO issues a very useful poster on which it sets out changes in EPO procedures and practices which have been implemented in the previous year. This poster is uploaded on the **epi** website and can be found for **epi** members after login at https://patentepi.com/en/epi/download/6d031db1-63f5-4c04-9770-84d0b6d131c2/Poster_RecentProceduralChanges_April%202018.pdf. This draws attention in a readily-accessible way to things which any practitioner ought to know.

Highlights of this year's poster include notifications of a change in Rule 51(1) regarding payment of the 3rd year renewal fee, for which **epi** and others have been asking for many years, a change in practice regarding third party observations, the implementation of PCT Direct and the introduction of the ability to pay EPO fees by credit card. The poster also provides an easy way to follow amendments to the Guidelines.

It is well worthwhile to obtain a copy and hang it up in your office for easy reference.



Prepare yourself and be ready for the UPC

A. Casalonga (FR)

Axel Casalonga

Where do we stand with the UPC Agreement?

It is well known that the Agreement shall enter into force within 4 months from the date where at least 13 Contracting Member States, including France, Germany and the UK will have ratified the Agreement (article 89 UPCA).
At present (may 2018), 16 Contracting Member States, including France and the UK, have ratified. Ratification by the UK on 26 April 2018 is an important step toward entry into force of the UPC Agreement.
However Germany is still missing.

In the mean time, a Protocol on Provisional Application (PPA) has been drafted and should enter into force before the UPC Agreement. It was namely considered necessary to create the main organs of the UPC before entry into force of the Agreement.
The provisional Protocol will allow this to be made before effective entry into force of the UPCA. This is the case for example for the Registry, the Administrative Committee, the Advisory Committee, as well as the appointment of the judges.
The total duration of the Protocol should be of 6 to 8 months, giving sufficient time for those preparations.
Only two Contracting Member States are lacking for an entry into force of the Protocol.

At present, the ratification process of the UPCA in Germany has been suspended, waiting for a decision of the German Constitutional Court. If the Court would accept to consider the arguments filed with the complaint, the delay could be more than 1 year.
If, on the contrary, the court would reject the complaint as inadmissible, without detailed study, Germany could ratify the UPC Agreement very quickly, as long as the provisional Protocol is in force as explained above.

However, it is probable, in that case, that Germany would delay the final step of ratification of the UPCA so as to allow entry into force of the Protocol first. It would namely be complicated if the UPCA would be ratified by Germany, triggering the 4 months period for effective entry into force while the Protocol would not be into force. The 4 months period would probably be too short to completely prepare all necessary organs of the UPC.

What should one do today so as to be prepared for any event?
Two points should be considered already now:
1. Understanding and preparing the opt-out procedure
2. Practicing the IT-Court Management System (ITCMS)

I. The opt-out procedure

During the entire transitional period (possibly extended), Article 83-3 provides for the possibility to opt-out from the exclusive competence of the Court. Contrary to Article 83-1 which concerns the normal transitional period and is limited to infringement actions and revocation actions, Article 83-3 clearly concerns the entire range of competence of the Unified Patent Court including therefore not only infringement actions and revocation actions but also other possible actions such actions for declaration of non-infringement or actions for provisional and protective measures and injunctions.
Of course, the opt-out possibilities provided by Article 83-3 do not apply to Unitary patents.

Which kind of right can an opt-out cover?

The opt-out can relate to any published European patent application, any granted European patent (excluding Unitary patents), any supplementary protection certificate issued for a product protected by a European patent (excluding such supplementary protection certificates issued for a product protected by a Unitary patent).

The opt-out covers all Contracting Member States designated in the published European patent application or in the granted patent: it is not possible to limit the opt-out to only certain designated countries, unless a designation would have been positively withdrawn by the applicant before grant of the European patent.

A particular situation which must also be considered is the case where the same European patent or the same European patent application has different proprietors for different designated countries, as is authorized by the EPC (Articles 59 and 118 EPC as well as Rule 72 EPC).
In that case, a registered opt-out will nevertheless cover all designated countries. As a matter of fact, Rule 5-1(b), specifies that: *"an Application for opt out is made in respect of all of the Contracting Member States for which the European patent has been granted or which have been designated in the patent application"*. This particular situation should be considered as similar to a co-ownership of the patent. Therefore, according to Rule 5-1(a), the opt-out application must, in that case, be lodged by all proprietors. Failure to do so will result in an invalidity of the registered opt-out.

Who can apply for an opt-out?

Only the proprietor or applicant (all of them in case of multiple proprietors or applicants) can apply for an opt-out. It is not possible for a licensee to lodge an Application for opt-out. Even with the authorization of the proprietor, the exclusive licensee is not entitled to lodge an Application for opt-out.

If a licensee wishes to protect its activity by an opt-out, he will then have to contact the proprietor and ask him to lodge an Application for opt-out. The same is true for the case the licensee would like to withdraw an opt-out to be able to bring an action before the UPC.
It is advisable to provide specific clauses in a licensing agreement for organizing these opt-out options which are not available to the licensees in the same way as infringement actions.

A further difficulty may arise when the person lodging an application for opt-out is not the proprietor or applicant recorded in the register of the European Patent Office or the relevant national patent office. This may be the case when the European patent application or the granted European patent has been assigned by the initial applicant or proprietor to another person and none of the parties has registered the assignment.
Rule 5-1(a) in conjunction with Rules 8-5(a) and (b), solves this difficulty by providing that it is sufficient to show that the person lodging the application for opt-out is "entitled to be registered" as applicant of the European patent application or proprietor of the European patent under the law of the Contracting Member State in which the European patent has been validated. It must be reminded that, for countries like France, Germany or United Kingdom, where the validation does not require any translation, payment of renewal fees is equivalent to validation.

Consequently, when lodging an Application for opt-out, it will be sufficient (and required according to Rule 5-3(e)), to file a declaration stating that the person lodging the Application is "entitled to be registered in the national patent register". Since the European patent usually designates several European countries, the declaration should precisely indicate that this entitlement relates to all designated states. Otherwise, it could be argued that the declaration is insufficient.

The specific situation of supplementary patent certificates (SPC):

If an SPC was granted before the Application for opt-out or the Application to withdraw an opt-out, the Application for opt-out must be made both by the proprietor of the European patent and by the holder of the SPC, if different from the proprietor. The holder of the SPC may for example be a licensee.
If the SPC is granted after the opt-out has been registered, the opt-out will apply automatically also to the SPC. The holder of the SPC, if different from the proprietor of the European patent, will have to simply accept the decision of the proprietor of the European patent (see Rule 5-2(a).

The basic principle for opt-out and withdrawal of opt-out, relating to supplementary patent certificates (SPC), is that they follow the European patent to which they relate.
Therefore, an Application for opt-out or an Application to withdraw an opt-out, shall extend to any supplementary patent certificate (SPC) based on the European patent (Rule 5-2). It is not possible to opt-out for an SPC corresponding only to some parts of a European patent (for example to some claims of a patent) while keeping another SPC without opt-out.

Of course, no opt-out can be obtained for a supplementary patent certificate based on a Unitary patent.

When to apply for an opt-out?

An application for opt-out may be lodged at any time after a European patent application has been published. It is possible to lodge an Application for opt-out as long as the patent is in force and even 5 years after its expiry since the status of limitation for an infringement action is of 5 years and a revocation action may still be filed within this time period.
However, in all cases, the application for opt-out must be lodged before the last day of the transitional period provided in Article 83 of the Agreement.

It is not possible to lodge an Application for opt-out before publication of a European patent application. This has no practical consequences, since it is not possible for a third party to engage a revocation action before the Unified Patent Court as long as the patent is not granted.

An opt-out Application must also be lodged before any action is engaged at the UPC (Rule 5-7). Such action may relate to the patent application (for compensation derived from provisional protection) or to the patent which is the object of the Application for opt-out. It may also relate to any supplementary patent certificate based on that patent, for example an action for a declaration of invalidity of any supplementary patent certificate based on the European patent. (Rule 5-2)

If a third party has filed a revocation action or an action for a declaration of non infringement before the central division of the Court, an opt-out is not anymore possible and will be automatically ineffective.

How to apply for an opt-out ?

Rule 5-3 lists the necessary content of an Application for opt-out:

Name, postal address and electronic address of each proprietor or applicant of the European patent or application and

of the holder of any supplementary protection certificate, details and number of the patent or patent application (one Application for opt-out is required for each patent; a list of patents and patent applications may however be indicated when using the IT system of the UPC), details and number of any supplementary patent certificate.

If the Application is not lodged directly by the proprietor or applicant of the European patent or application but by a representative acting on behalf of said proprietor or applicant, the name, postal address and electronic address of this representative must also be indicated.

If the representative is a lawyer or a European patent attorney with an appropriate qualification, as defined in Article 48 of the Agreement, no specific mandate or authorisation should be required when lodging the Application to opt-out.

A mandate for lodging the Application to opt-out is required and must be lodged with the Application if the Application is lodged on behalf of the proprietor or applicant of the European patent or application by a person who does not fulfils the requirements of Article 48 of the Agreement (see § 16 below).

If the person lodging the Application is not, at the time the Application is lodged, the registered proprietor on the relevant patent register i.e. on the national patent register of each designated States (in the case of an application for opt-out concerning a granted European patent) or on the European patent register, (in the case of an application for opt-out concerning a pending European patent application), a declaration must be lodged according to which the person lodging the Application is entitled, at the time the Application is lodged, to be registered as proprietor on all the relevant patent registers.
In case of several proprietors or applicants, a declaration is required for each proprietor or applicant.

If the Application to opt-out is lodged by a representative on behalf of the proprietor or applicant, the declaration may be made by the representative.
Of course, in that case the representative making the declaration engages his or her responsibility. It may me safer for the representative to have each proprietor or applicant execute the declaration.

In practice, the Application must be made on line using the specific official form of the Case Management System (CMS).

No court fee is required.

Period of effectiveness of an opt-out

When the UPC Agreement is in force, the legal effect of an opt-out begins with the entry on the Register. If a correction is lodged with the Register to amend the indications which have been lodged initially, the opt-out is only effective from the date of entry of the correction in the Registry.

If the opt-out relates to a granted patent and if the opt-out is not withdrawn, its legal effect ends only at expiry of the patent and 5 years after this expiry since an action for financial compensation can be engaged within the 5 years of the period of limitation.
If an opt-out relates to a published European patent application, the legal effect of the opt-out also begins with the entry on the Register.
The opt-out registered for a patent application will automatically continue with the corresponding granted patent as long as the patentee does not request a Unitary patent.

If a Unitary patent is requested, an opt-out which had been registered for the pending European patent application, will automatically be deemed as withdrawn. It is not necessary for the patentee to inform the Registry: In practice, the EPO is automatically informing the UPC Registry via the UPC IT Case Management System (ITCMS)

The effects of an opt-out:

According to the Drafting Committee, Art 83 of the Agreement together with Rule 5 must be interpreted in such a way that an opt-out registered for a given patent application or patent, forbids to bring any action concerning this patent application or patent before the UPC. Third parties have to file several revocation actions before national courts if the European patent designates more than one Contracting Member State.

The withdrawal of an opt-out

Rule 5-8 provides for the possibility to withdraw an opt-out which has been registered with respect to a patent or a patent application. The withdrawal shall apply compulsorily to all Contracting Member States. It shall also apply to any supplementary patent certificate based on the European patent. The withdrawal has to be made by lodging at the Register a specific Application to withdraw. Only the proprietor or applicant is allowed to lodge such specific Application to withdraw.

No fee is required for withdrawing an opt-out.

The Application to withdraw may be lodged at any time during the entire period of effectiveness of the opt-out, except if an action has already been brought before a national court, as stated in Art 83-4 of the Agreement. The same applies in the case this national court action is terminated, as expressly mentioned in Rule 5-9. In such a case, the Application to withdraw is ineffective even if it has been entered into the Registry. The action before the national court must be any action over which the UPC has jurisdiction: it can be an action for infringement, an action for declaration of non infringement, a revocation

action, an action for provisional measures and injunction, an action relating to the use of an invention before grant of the patent or to the right based on prior use of the invention.
Other actions relating to patents and supplementary patent certificates, over which the Unified Patent Court has no jurisdiction, may have been engaged or terminated before a national court without preventing an Application to withdraw of being effective: for example actions to claim property of a patent or actions relating to the scope and validity of patent licenses or assignment agreements.
The requirements for the Application to withdraw an opt-out are the same as for requesting an opt-out.
The Application to withdraw must contain the same indications as an Application to opt-out.

Effects of the withdrawal

The withdrawal of an opt-out is effective from the date of entry in the register. Therefore, from that date, the exclusive competence of the UPC is fully restored and any action concerning the European patent must be brought before the Unified Patent Court and not any more before a national court.
When an action filed before the UPC shortly after the withdrawal of an opt-out, relates also to compensation or damages, the Court shall nevertheless apply the UPC Agreement to determine the damages compensating infringement acts occurred when the opt-out was effective. (i.e. before the withdrawal of the opt-out).

The withdrawal of an opt-out is a non reversible step. As a matter of fact, according to Rule 5-10, after an effective withdrawal of an opt-out for a given patent or patent application, a new opting out is not anymore possible for this same patent or patent application.

Representation

Representation is not compulsory for lodging an Application for opt-out or an Application to withdraw an opt-out or any Application for correction.

However, the Application for opt-out or to withdraw an opt-out may be lodged on behalf of the patent proprietor or the owner of the patent application by an appointed representative who may be any person.

Rule 5-4 specifies three categories of such persons:

In a first category are representatives defined in Article 48 of the UPC Agreement, i.e. lawyers authorized to practice before a court of an UPC Contracting Member State or European Patent Attorneys with appropriate qualifications such as the European Patent Litigation Certificate as defined in Article 48(2) of the Agreement. Those representatives may be appointed to lodge an Application to opt-out or an Application to withdraw an opt-out and no specific mandate or authorisation should be required therefore as indicated in Rule 5(3)(b)(i).

In a second category are European Patent Attorneys as defined in the EPC or lawyers qualified in an EPC Contracting State, entitled to act as professional representatives in patent matters and having their place of business in that State (Article 134(8)EPC).

In a third category are any other persons, including lawyers qualified in a country outside the EPC countries and national patent attorneys.

All representatives belonging to the second and third categories must provide a specific mandate from the proprietor of the European patent or applicant, authorizing the lodging of the Application to opt-out as indicated in Rule 5(3)(b)(ii) and this mandate is to be lodged together with the Application. The same applies for an Application to withdraw an opt-out.

Specific provisions before entry into force of the Agreement

According to the provisions of the Protocol on Provisional Application (PPA) of October 2015, certain parts of the UPC Agreement will come into force beforehand. This is the case for the Registry.

Therefore, as provided in Rule 5-13, it is possible to lodge an Application for opt-out and have it accepted by the Registry during a sunrise period, before entry into force of the UPC Agreement.
It seems that the Registrar, before accepting such an Application, will not inform the person having lodged the Application of any missing or incorrect requirement. Self checking is therefore important since it is always possible to lodge a correction with the Registry.
All Applications for opt-out duly registered before entry into force of the UPC Agreement will be treated as entered in the Registry on the date of entry into force of the Agreement.
Thanks to this provision, applicants of European patent applications as well as proprietors of European patents already granted have the possibility of subjecting their patent applications and patents to an opt-out as provided in Article 83-3 of the Agreement from the date of entry into force of said Agreement.
For example, a patent proprietor wishing to avoid a revocation action filed by a third party before the UPC against a certain patent, has the possibility to opt out this specific patent before entry into force of the Agreement.

In view of the broad wording of Rule 5-12, it seems possible, during the sunrise period, to lodge an Application to withdraw an opt-out already provisionally registered before entry into force of the Agreement. The previous application to opt-out is namely only effectively registered

on the date of entry into force of the Agreement. Before that date, this opt-out does not legally exist.
All Applications filed during the sunrise period must be considered as purely provisional. Consequently, if an Application to withdraw an opt-out already provisionally registered, is lodged during the sunrise period, it will still be possible to lodge a new Application for opt-out concerning the same patent. And this new application for opt-out can be lodged before expiry of the sunrise period or afterwards, when the UPC Agreement has come into force.

This is an exception to the normal situation, according to which a new application for opt-out made after an Application to withdraw is not possible.

II. The ITCMS

All procedural steps before the UPC will have to be performed through the IT system of the Court, the so-called Court Management System (CMS).
It is already possible to access to the ITCMS by logging on the Web site of the UPC.

At present, unfortunately only a few training possibilities are opened.
Those are the registration of a representative and the Applications for opt-out and withdrawal of opt-out.
Nevertheless, it is advisable to prepare and lodge Applications on the ITCMS already now, so as to gain experience of the system.

The core of Rule 137(5) EPC is non-unity, not forbidding claims for unsearched subject-matter

P. de Lange (NL)

Abstract

Summarizing Rule 137(5) first sentence as forbidding amended claims that relate to unsearched subject-matter, is too imprecise. The rule combines two elements, by referring to subject-matter which is both (i) unsearched and (ii) lacks unity of invention with the originally claimed invention. In this article I provide an analysis of the rule's scope, discussing amongst others a subtle but important change in the Guidelines 2017 concerning Rule 137(5). I conclude that for applicants (and patent attorneys), only the "non-unity" element (ii) is of practical relevance. It turns out that the "unsearched" element (i) is primarily for use by the EPO. Furthermore, because the rule's original purpose was quite limited (and the Board's case law keeps it that way), the rule forbids claim amendments only in specific cases. In particular, the rule forbids fewer amendments than the Guidelines suggest. Finally, provided that the "non-unity" element is applied correctly, the case law of the Boards about the "unsearched" element has become overly complex.

Introduction

Rule 137(5) first sentence (hereinafter: s1), stipulates that *amended claims "may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept."* For Rule 137(5)(s1) to apply, the amended claims must relate to subject-matter that is both (i) unsearched and (ii) lacks unity of invention[1] with the "originally claimed invention or group of inventions". Each of these two elements individually specifies a case wherein amended claims are allowable. Hence, under Rule 137(5)(s1), claim amendments are allowed if (i) they relate to searched subject-matter or (ii) have the unity of invention (or both). Of course, even if a claim amendment is allowed under Rule 137(5) first sentence, the amendment can still be forbidden under the second sentence of Rule 137(5), or e.g. under Article 123(2) EPC.[2] In this article, I will discuss two main difficulties of interpreting the rule, namely the meaning of "unsearched" and "originally claimed invention or group of inventions". The requirement of "unity of invention" is of course difficult in its own right. However, this substantive requirement is exactly the same under Rule 137(5)(s1) and Article 82. It is also of a more technical nature than the mentioned two difficulties. Therefore, I will not discuss it in this article.[3] I will simply assume that the amended claim relates either to the same invention (unity of invention present) or to a different invention (no unity of invention) compared to an original claim.[4]

The root cause for these two difficulties in making sense of the rule is the history of the rule. Rule 137(5)(s1) was added to the EPC in 1995 to repair a deficiency in the then still recent decision G 2/92. However, not every patent attorney and Examiner may still know the latter decision by heart.

1 Rule 137(5)(s1) uses the same phrase "to form a single general inventive concept" as Article 82.

2 This article focuses on the first sentence of Rule 137(5) and in this way complements the article of Robin et al. in **epi** Information 2012(2), p. 44-47 which discusses Rule 137(5) in general. See also the presentation of E. Weinberg and Y. Robin for Examination Matters 2017, available at epo.org, with useful references to the case law.

3 The interested reader is referred to the article of Robin et al. in in **epi** Information 2012(2), p. 44-47.

4 Article 82 EPC in fact refers to a "group of invention so linked as to form a single general inventive concept". I will treat such a group of inventions as one invention in this article.

Accordingly, I will start my analysis of the purpose (and scope) of the rule with G 2/92.

The purpose of Rule 137(5) first sentence

The starting point of Rule 137(5)(s1) is G 2/92. G 2/92 was the result of a referral by the President of the EPO. The referral was about the case wherein an application is filed with claims for inventions A and B, and the applicant does not pay the additional search fee for invention B, when invited to do so under Rule 64(1). The EPC then does not explicitly provide for any consequences during examination. The referral asked essentially whether the applicant can have the application examined in such a case if he restricts the claims to the unsearched invention B only.[5] The Enlarged Board decided in G 2/92 that this was not possible and held that "an applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division [pursuant to Rule 64(1) EPC 2000] cannot pursue that application for the subject-matter in respect of which no search fees have been paid."

The holding of G 2/92 is hence restricted to cases wherein an invitation to pay additional search fees was issued. G 2/92 therefore does not apply in cases wherein the invention B is not in the claims as filed (e.g. all claims as filed are for invention A) and the application is amended (after receiving the search report) by dropping the existing claims and replacing them by claims for invention B taken from the description. This would provide an easy way to circumvent G 2/92. Precisely to address this possible way to circumvent G 2/92, the EPO introduced Rule 86(4) EPC 1973, now Rule 137(5)(s1).[6]

Rule 137(5)(s1) was intended to complement G 2/92, not to replace it.[7] Accordingly, Rule 137(5)(s1) does not cover the cases that are already dealt with by G 2/92. Hence, Rule 137(5)(s1) is not the legal basis for objecting to claims, if the objection is based on the non-payment of a requested additional search fee. This is confirmed by established case law (Case Law of the Boards of Appeal 2016 (CLBA) IV.B.5.3.1, T 1285/11, r. 2; T 442/11, r. 2.2.4) and is followed in the Guidelines paragraph H-II 7.2 where G 2/92 is discussed.[8] Hence, Rule 137(5)(s1) provides an addition to G 2/92, with the somewhat unfortunate circumstance that G 2/92 was never codified. Accordingly, Rule 137(5) is in fact incomplete.
From the above follows that Rule 137(5)(s1) is intended to cover only subject-matter taken from the description.[9] Nevertheless, the wording of the rule does not refer to the description. I will therefore first show that the effect of the rule is precisely so, because the rule refers to unity of invention with "the originally claimed invention or group of inventions". The reasons are as follows.

Non-unity in Rule 137(5) first sentence

As said, Rule 137(5)(s1) allows amended claims if they have unity of invention with the *"originally claimed invention or group of inventions"*. Unity with one of the original claims is sufficient.[10] This is so even if the original claims relate to multiple inventions, because each original claim is part of the "originally claimed group of inventions".[11] Since any original claim has unity of invention at least with itself, Rule 137(5)(s1) applies only to subject-matter taken from the description. Furthermore, an amended claim based on subject-matter taken from the description is still allowed under Rule 137(5)(s1) if it has unity of invention with any of the original claims. In this way, the wording of the rule is fully in line with the rule's purpose to complement G 2/92.
Rule 137(5)(s1) refers to the "originally claimed" invention(s), not to the inventions that are searched. This makes sense, because as discussed Rule 137(5)(s1) is not intended to give effect to a restriction of the search under Rule 64 EPC (which is what G 2/92 does) or under Rules 62a and 63 EPC (which is the purpose of the second sentence of Rule 137(5) EPC).[12] Therefore, unity of invention with any of the original claims is sufficient, irrespective of whether that claim was searched.

In view of the above, the Guidelines are incorrect when referring to subject-matter which "does not combine with the originally claimed and searched invention" (GL H-II 6.2, emphasis added).[13] In the same vein the Guidelines are imprecise when stating that Rule 137(5)(s1) "should be construed as permitting any limitation of searched subject-matter which is unitary with the originally claimed subject-matter" (GL H-II 6.2, emphasis added). In case of an amended claim which is based on a claim which was not searched under Rule 64, G 2/92 applies, not Rule 137(5)(s1).[14]

The Guidelines 2017 about Rule 137(5) first sentence: important changes

However, the Guidelines were changed in the 2017 update by adding a paragraph. This new fourth paragraph of

5 The claims directed to invention B only can of course not be refused under Article 82 EPC.
6 Notice of the EPO about the new rule in OJ 1995, p. 420, §2. According to T 708/00, r.5-7 (OJ 2004, p. 160), rule 137(5)(s1) must be interpreted "in a manner favourable to the applicant" and in line with the rule's purpose as given in that Notice. See also T 274/03, r. 4 and 5.
7 See e.g. T 708/00, r. 7.
8 GL H-II 7.2 "Rule 137(5) cannot be invoked. It does not apply when the applicant has not paid the [additional search fee]." GL H-II 6.2 about Rule 137(5)(s1) on the other hand does not contain an explicit statement of this important limitation of the rule; it is only said that the situation "is different" from that discussed in H-II 7.2.
9 Hence, the paragraph of the Guidelines (H-II 6.2) discussing Rule 137(5), first sentence, is correctly titled "Subject-matter taken from the description".
10 T 708/00, hn. 1 and r. 8
11 There is a difference in use of the term "group of inventions" in Rule 137(5)(s1) and Article 82. Article 82 allows a patent application to relate "a group of inventions so linked as to form a single general inventive concept", i.e. to one inventive concept. Rule 137(5)(s1) does not require such a link between the inventions of the group of inventions. That a group of inventions can be multiple inventions is also clear from T 0129/14, r. 5.1.
12 T 333/10, r. 3.7 seems incorrect in referring to lack of unity of invention with the claims as searched. However, the underlying case was unusual already from the analysis of Art. 82 in the search report.
13 The same applies for GL B-II 4.2.
14 Similarly, if the amended claim is based on a claim not searched under Rule 62a or 63, the second sentence of Rule 137(5) applies rather than the first sentence. See OJ EPO 2009, 533, pt. 7.4.

GL H-II 6.2 is a great improvement and provides a rather accurate yet concise statement of how Rule 137(5)(s1) is to be applied.
The new fourth paragraph of GL H-II 6.2 reads:

"[In] order to assess whether or not amended claims fulfil the requirements of Rule 137(5), first sentence, the examining division needs to establish first whether or not the subject-matter to which they relate has or should have been searched (see B-III, 3.5) and second whether or not an objection of lack of unity would have been raised if the amended claims had been present in the set of claims on file at the time of the search." (GL H-II 6.2)

An important change is that this new paragraph refers to the "claims on file at the time of the search". Two things can be noted. First, any claims excluded from the search (e.g. under Rule 64) are still "on file" at the time of the search. Second, the paragraph refers to the claims at the time of the search and not to the claims as filed, while Rule 137(5)(s1) refers to "originally claimed" inventions. I will first discuss why the Guidelines are correct in this, especially for Euro-PCT applications. Thereafter, I will the discuss the other element of Rule 137(5)(s1), namely "unsearched".

Relevant claims for Euro-PCT applications

Rule 137(5)(s1) refers to the "originally claimed" invention. However, the rule intends to ensure payment of appropriate search fees to the EPO. Hence, in case of a Euro-PCT application for which a supplementary European search is carried out, the claims as pending at the time of the supplementary European search under Rule 164(1) are relevant. These may already have been amended during the international phase (Article 19 and 34 PCT), under Rule 159(1) and/or under Rule 161.

For Euro-PCT applications wherein the EPO was the International Searching Authority (ISA),[15] the claims on file at the time of the "search" are relevant, but this can still refer to the international search and to any search incident under Rule 164(2) EPC. Because the EPO can issue an invitation to pay an additional search fee at either stage, and because G 2/92 applies equally to non-payment of a requested additional search fee at either stage (GL H-II 7.2, T 129/14), unity of invention with one of the claims on file at the time of either search should in my opinion be sufficient. This is also consistent with the fact that Rule 137(5)(s1) does not apply to amendments made prior to any search incident under Rule 164(2) EPC (GL H-II 6.2, last paragraph).

An example of Rule 137(5) for Euro-PCT applications

The result is that Rule 137(5)(s1) should not always be applied as it wording suggests. An example with a Euro-PCT application can illustrate this. Consider for instance a Euro-PCT application with the USPTO as ISA and with claims as filed directed to invention A. The application is amended with the response under Rule 161 EPC to have only one claim for an invention B taken from the description. If the applicant reverses after the supplementary ESR to the claims for invention A, i.e. the claims as filed and as searched by the ISA, this must still be objected to under Rule 137(5) because the claims as filed are not the "originally claimed invention" in the sense of Rule 137(5)(s1). Moreover, the claims as filed are "unsearched" in the sense of Rule 137(5)(s1) even though the were searched by the USPTO as ISA.
This brings me to the second topic to be discussed: the interpretation of "unsearched" in the case law of the Boards and in the Guidelines.

What does "unsearched" mean in Rule 137(5)?

The Guidelines rephrase the "unsearched" element of Rule 137(5)(s1) as a check whether the subject-matter of the amended claims "has or should have been searched" (GL H-II 6.2). The alternative "should have been searched" is an addition compared to the wording of Rule 137(5)(s1) and makes the application of the rule more applicant-friendly. Before discussing whether this addition is necessary, it is important that recall that the "non-unity" element already makes that Rule 137(5)(s1) only forbids amendments that involve a switch to an invention taken from the description. Hence, the "unsearched" element must have a function of allowing such a switch in some cases. Frankly, allowing such a switch is exceptionally applicant-friendly and indeed it is allowed only in exceptional cases. Namely in the cases wherein an Examiner has generously searched for prior art not only for the claimed invention(s), but also for a further invention only described in the description. If later the claims are directed to that searched invention from the description, this must be allowed under Rule 137(5)(s1).[16] The "unsearched" element furthermore gives freedom to Examiners to allow an amended claim if they know that they have carried out a search its subject-matter, irrespective of whether the amendments involves a switch to an invention taken from the description or not.[17]

No need for additional consideration of "should have been searched"

According to the Guidelines, amended claims are also allowed if the amended claims "should have been searched". This is in line with established case law (CLBA IV.B.5.3.2). The addition is however superfluous. In particular, claims that the "unity" element of Rule 137(5)(s1) and claims that "should have been

15 I disregard the other cases wherein no supplementary European search report is drawn up (GL B-II 4.3.1).

16 By analogy, there is no legal basis for the Examining Division requesting an additional search fee if it considers that Search Division failed to note a lack of unity of invention. On the other hand, correctness of an invitation to pay a search fee is to be reviewed by the Examining Division, see e.g. T 631/97 followed in e.g. J 3/09, T 1285/11, T 2248/12 and T 0129/14. In the same way, Rule 137(5)(s2) applies only if the subject-matter is not searched in accordance with Rule 62a or Rule 63, i.e. does not apply if the restriction of the search was based on incorrect application of these rules.

17 Rule 137(5)(s1) is not a rule giving a discretionary power to Examiners

searched" are the same. This is so, because in the context of Rule 137(5)(s1), the phrase "should have been searched" can only relate to the question to what extent the Examiner must search for prior art not only for the claims but also for embodiments in the description. For the "should have been searched", the Guidelines refer to GL B-III 3.5, where it is said the search should cover the subject-matter to which the claims might reasonably be expected to be directed after amendment. This is based on Article 92 EPC, which provides that the search report shall be drawn up "with due regard to the description" (GL B-III, 3.1). However, this criterion begs the question what "reasonably expected" amendments are. In my view, these are amendments that relate to the same invention as the subject-matter claimed at the time of search. On the other hand, an amendment involving a switch to a different invention taken from the description can not be said to be reasonably expected. However, this is precisely the same distinction as set by the "unity" element of Rule 137(5)(s1) between allowable and non-allowable amendments. Therefore, the additional allowed case of amendments relating to subject-matter that "should have been searched" as mentioned in GL H-II 6.2 and CLBA IV.B.5.3.2, is superfluous, because it is already covered by the "unity" element of the rule.[18]

The above analysis of the "non-unity" element does not mean that Examiners must carry out a search of (all) the embodiments in the description that relate to the claimed invention(s) already when drawing up the search report. They can also do so later, when amended claims are filed that directed to such embodiments, namely as additional search during examination.[19]

From the above, it follows that the "unsearched" element of Rule 137(5)(s1) can be understood as simply an applicant-friendly exception providing that in case the EPO carries out a search for an invention only described in the description (without being required to do so), the claims can later be directed to that searched invention.[20] This primarily enables the EPO to allow amended claims under Rule 137(5)(s1). However, the applicant can also invoke the element, if the record shows that the invention in the description was actually searched[21], e.g. in the search opinion or in the "Information on Search Strategy" sheet.[22]
Hence, Rule 137(5)(s1) can be summarized as forbidding amendments involving a switch to inventions that are taken from the description and that were hence not in the claims pending at the time of search by the EPO (the "non-unity" element), unless the EPO has actually carried out a search those inventions in the description (the "unsearched" element).

A difficult case: one broad claim with many embodiments in description

Rule 137(5)(s1) as summarized above can however be easily circumvented by filing an application with a single broad claim 1 and many embodiments in the description.[23] The embodiments lack unity of invention with each other. Depending on the circumstances of the case, the embodiments may however very well have unity of invention with claim 1. Can the claims then be amended to each of these embodiments? T 736/14 can possibly be used to prevent this. Therein the Board held that that for one application (and one examination fee), only one invention is to be examined.[24] Hence, after the applicant has amended the broad claim and directed it to a first embodiment taken from the description, he can no longer switch to a second or further embodiment taken from the description under T 736/14.

Conclusion

Rule 137(5)(s1) can be summarized as forbidding amendments directing claims to inventions that are taken from the description and that were not in the claim set pending at the time of search by the EPO (the "non-unity" element of the rule), unless the EPO has actually searched those inventions in the description (the "unsearched" element). Even though the "non-unity" element of the rule does not refer to subject-matter taken from the description, the interpretation follows from the clear and limited purpose of Rule 137(5)(s1) to prevent circumvention of G 2/92 by putting inventions in the description rather than in the claims (OJ 1995, p. 420). The two elements are also linked: the "non-unity" element implicitly specifies to what extent the EPO is required to search the description (under Article 92). The "unsearched" element allows applicants to benefit from the case that the EPO searched inventions in the description without being required to do so. It also enables the EPO to allow amended claims if sufficient prior art is on file.

Finally, Rule 137(5)(s1) is merely an addition to G 2/92. Hence, currently only the addition is codified in the Rules. The holding of G 2/92 is (still) not. Possibly Rule 137(5)(s1) could be amended in due time to codify G 2/92 (and improve clarity as well). Until that time, the fourth paragraph of GL H-II 6.2 (added in 2017) provides an accurate statement of how the rule is to be applied. However, although the reference to subject-matter which "has or should have been searched" therein accurately reflects current case law, the alternative of "should have been searched" is superfluous.

18 None of the decisions cited in CLBA IV.B.5.3.2 for supporting the addition of "should have been searched" is convincing. T 2334/11 and T 345/13 refer to GL B-III 3.5, which leaves open the question what amendments can be reasonably expected. In T 789/07, the requirement of unity of invention was also complied with, making the analysis of "unsearched" *obiter dicta*.
19 See e.g. T 264/09 wherein the Board admitted the amendment but left open whether an additional search was necessary and remitted the case to the Examining Division.
20 This exception may apply equally to optional features in claims. Furthermore, even if an optional feature is not actually searched, an amendment to make it mandatory can not be objected to under Rule 137(5)(s1) if the feature relates to the same invention as the claimed subject-matter. See also Y. Robin, epi Information, 2016(4), p. 39-41.
21 There is a difference between the search and the search report. The search report (e.g. Form 1503) only refers to the claims, but an Examiner can still search for prior art for embodiments in the description.
22 OJ 2017, A106.
23 This scenario is also discussed in GL B-III 3.5.
24 T 736/14, r 3.2.1, basing this quite general rule G 2/92, r. 2. In that case, an additional search fee was paid, and the applicant submitted a Main Request directed to invention A and an Auxiliary Request for invention B.

Common General Knowledge in the Age of the Internet

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While the Boards of Appeal have rendered over the last years a series of decisions that define when an Internet publication is considered to be part of the prior art (and the Guidelines have been continuously updated), there do not appear to be any decisions that adapt the common general knowledge (CGK) to information that the skilled person does not have in his mind but is easily retrievable for him via the Internet. The situation is different in the UK in which decisions have been rendered that extend in the assessment of inventive step the common general knowledge to such information. The author of this article suggests that this should also apply in the assessment of sufficiency of disclosure.

Mr Justice Sales argued in Teva UK Limited & Anor v AstraZeneca AB [2014] EWHC 2873 (Pat):

"The authorities indicate that CGK includes not just information directly in the mind of the notional skilled person, but such information as he would be able to locate by reference to well-known textbooks. This guidance needs to be adapted and kept appropriately up to date for the procedures for dissemination of scientific knowledge in the age of the Internet and digital databases of journal articles. Searches of such databases are part and parcel of the routine sharing of information in the scientific community and are an ordinary research technique. In my view, if there is a sufficient basis (as here) in the background CGK relating to a particular issue to make it obvious to the unimaginative and uninventive skilled person that there is likely to be – not merely a speculative possibility that there may be – relevant published material bearing directly on that issue which would be identified by such a search, the relevant CGK will include material that would readily be identified by such a search."

This passage has even been incorporated into the UK Manual of Patent Practice[1] and therefore does not seem to be an outlier decision. Currently, there is no corresponding decision from the Boards of Appeal. However, it is encouraging to see that the EPO seems to be aware of this case law and wants to turn our attention to it since it published in "Case Law from the Contracting States"[2] a summary of the following decision "Patents Court, 12 May 2016 – GlaxoSmithKline UK Ltd v Wyeth Holdings LLC [2016] EWHC 1045 (Ch)" which confirms the findings made in the passage cited above.

At issue was Wyeth's European patent (UK) 2 343 308. Henry Carr J referred to the legal principles in respect of common general knowledge set out by Arnold J in KCI Licensing v Smith & Nephew [2010] EWHC 1487 (Pat), and approved by the Court of Appeal at [2010] EWCA Civ 1260. He then referred to the passage cited above from the judgment of Sales J in Teva v AstraZeneca [2014] EWHC 2873 (Pat). Henry Carr J agreed with this analysis. This passage did not mean that all material available online constitutes common general knowledge. Rather it indicated that material which the skilled addressee knows to be available online and which is generally accepted as a good basis for further action (such as material which might be found offline in a textbook or a key journal article) may constitute common general knowledge.

It should be mentioned that the first decision mentioned above has already received a lot of attention by its incorporation into the Manual of Patent Practice and has been discussed in several Internet blogs[3]. However, the decisions above fail to say anything regarding the common general knowledge when assessing sufficiency of disclosure (Art. 83 EPC). Let us recall:

"Although the skilled person for the purpose of Art. 56 and Art. 83 has the same level of skill, the knowledge for both purposes is different (T60/89). The skilled person when assessing inventive step is aware of the common general knowledge in the art at the relevant date and has all prior art in the relevant technical field at his disposal (G-VII, 3). The skilled person when assessing sufficiency of disclosure of a patent has knowledge of the invention as disclosed, i.e. knowledge of both the prior art, the problem and its solution, and is aware of documents cited in the patent and the common general knowledge in the art (T 6/84, T 171/84)."[4]

While the common general knowledge was adduced in the decisions above for the assessment of inventive step, the author of this article is of the opinion that the findings

1 https://www.gov.uk/guidance/manual-of-patent-practice-mopp/section-3-inventive-step

2 Supplementary publication 6, Official Journal 2017, Case Law from the Contracting States to the EPC https://www.epo.org/mobile/law-practice/official-journal/2017/etc/se6.html

3 http://ipkitten.blogspot.ch/2014/09/the-skilled-person-more-knowledgeable.html

4 Visser, D., "The Annotated European Patent Convention", 24th edition, H. Tel, Publisher B.V., p. 178

above should be applied a fortiori when common general knowledge is adduced in the assessment of sufficiency of disclosure because in this case the skilled person even knows the solution (the wording of the claim) to the problem. In such a case, the skilled person may particularly easily find out how to carry out the invention by entering e.g. method steps of terms of the claim in a search engine to find pertinent information that allows him to carry out the invention.

The basic principle set forth in T 206/83 (cited by 59 subsequent decisions) says that "Information which can only be obtained after a comprehensive search is not to be regarded as part of common general knowledge." This principle is still valid today. But information that could only be found using a comprehensive (and cumbersome) search before the age of the Internet can easily be found nowadays in the age of the Internet. Should the description not disclose how, for example, a step in a method is to be performed or if an uncommon expression of a claim is not defined in the description, but the skilled person could have found out easily via an Internet search before the priority/filing date how to perform this step or the meaning of the expression, then the information obtained by the Internet search should also be considered to be part of the common general knowledge or (if we do not want to extend the definition of common general knowledge as it currently is) at least to be information that was readily available to the skilled person before the priority/filing date and that can be adduced for the requirement of Art. 83 EPC. Of course, the problem remains that is has to be proven that this information was indeed readily available over the Internet before the priority/filing date (and that the skilled person was aware of that) which may, as the circumstances require, not be an easy task.

Since the author of this article basically agrees with the findings made in the two decisions from the UK cited above, he encourages professional representatives to submit corresponding arguments – be it within the discussion of inventive step or sufficiency of disclosure – before the Boards of Appeal to see if the Boards of Appeal follow the path taken by the UK.

Any feedback is welcome. Please send it to:
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User Driven Early Certainty

C. Mercer (GB)

Late last year and in the earlier part of this year, there was a great deal of activity regarding a proposal from the EPO which eventually received the name "User Driven Early Certainty" ("UDEC"). The main part of this was a proposal that applicants should be allowed to delay the start of examination by up to three years. It was, in effect, a proposal that the EPO should operate a sort of deferred examination system.

History

Deferred examination systems have been known for a long time. Perhaps the best known one is the German system where an applicant has a period of seven years from the date of filing in which to request examination and pay the examination fee. Examination can be started before the end of the seven years, for instance by a third party paying the examination fee.

When the EPC was originally drafted, there was a question as to whether the EPO should have a deferred examination system. The answer to that the question was "no" and the EPO was set up with its present system, where examination of EP-direct applications must be requested and the examination fee must be paid within 6 months of the publication of the search report and examination of EP-PCT applications must be requested and the examination fee must be paid, in most circumstances, on entry to the European regional phase. Under this system, the applicant has no control over when examination begins. This is entirely dependent on when the EPO takes up the application for examination.

Chris Mercer

There had been arguments that, some time ago, there was, in effect, a deferred examination system because the backlogs at the EPO were so large that there was a considerable time between the payment of the examination fee and the beginning of examination. However, any effective deferment of examination was under the control of the EPO, not the applicant. In light of this, some parties argued that it would be better to have a deferred examination system where the deferment is, at least partly, under the control of the applicant.

There was a discussion of introducing deferred examination during the discussions leading to EPC 2000 but, again, it was decided not to do so. However, the topic still did not go away.

In 2009, the topic was again discussed after the Danish, German and Dutch delegations to the Administrative Council ("AC") submitted a proposal to amend Rule 70. This proposal still required that the search and written opinion on patentability ("Extended European Search Report" or "EESR") had to be produced and made available, whether or not the examination was deferred.

The proposal acknowledged that there would be an effect on third parties and proposed that third parties should be given the right to request examination and that such examination would be put on a fast track. The applicant would have to pay the examination fee but the third party would have to provide observations under Article 115 EPC and, in order to avoid abuse, to pay a fee.

At that time, it was also discussed whether it should be possible to defer the production of the EESR. The proposal acknowledged the drawback (an increase in legal uncertainty for third parties because no search report would be available) and suggested limiting the deferral of the EESR to applications for which a search report already existed from a first filing.

In the Committee on Patent Law ("CPL"), which advises the AC on patent law, there was no support from delegations for the idea of deferring the search. It was also agreed that, if deferred examination were to be introduced, the deferral period should be as short as possible, i.e. three to five years, and a review clause would be necessary.

A paper by the EPO proposing a deferred examination system (but not a deferred search system) was presented to the AC. The EPO put forward various reasons why such a system would be useful. **epi** provided comments to the AC on the proposal. The AC was not convinced, as can be seen from the Summary of Decisions of the 120th meeting of the AC, where it was stated that:

> *"26. On the basis of the information set out in the document, the outcome of the discussions of the Committee on Patent Law and the Budget and Finance Committee, and the comments of the delegations, the Council concluded that the work regarding the possible introduction of a system of deferred examination of European patent applications should not be pursued further for the time being."*

However, yet again that was not the end of the matter. In 2013, the discussion began again. **epi** was informed by the EPO that the EPO had resumed studying the possibility of introducing deferred examination. The triggering factor was that there were, allegedly, more than 400,000 cases waiting for examination, a large backlog. The EPO appeared to believe that this figure could be significantly reduced in the future with deferred examination.

In response to a request for comments, **epi** pointed out that, since 2009, numerous changes had been made to the processing of applications at the EPO. In 2010, it had been made mandatory to file a response under Rule 70a or 161(1). Third parties therefore had available the applicant's reaction to the EESR, even if examination had been delayed because of the backlog. Since this is the last opportunity for the applicant to amend the description, claims and drawings of his own volition, it provided useful information to third parties as to the possible outcome of substantive examination.

The EPO had also introduced Early Certainty from Search ("ECfS") and set priorities for both search and examination. One consequence of ECfS was that the start of examination of an application was delayed, unless the application was ready for grant after the EESR (positive opinion) or unless the applicant requested acceleration under the PACE system. It was also the case that submission of substantiated, non-anonymous, third party observations triggered accelerated examination of the application.

For these and other reasons, **epi** could not see that there was any need to introduce a system of deferred examination.

Yet again, after further consideration, the EPO decided to drop the proposal for a deferred examination system. However, yet again, deferred examination did not go away but resurfaced for other reasons.

Between 2013 and 2017, the EPO extended ECfS to Early Certainty from Examination ("ECfE"). The idea of this was to reduce the average time for examining an application to 12 months. Some applicants argued that this was not a good thing and so asked the EPO whether it would be possible to defer examination of some or all of their applications. Thus, on the basis of a request from outside the EPO, the EPO raised yet again the question of whether to introduce a system of deferred examination.

The Most Recent Proposal

In the first proposal in this round of which **epi** became aware, it was presented in the autumn of 2017 as "Early Certainty with Flexibility". Over the rest of 2017 and the beginning of 2018, the title of the proposal changed and eventually settled as "User-Driven Early Certainty" ("UDEC"). The content of the proposal also changed in response to user comments. The EPO also held a hearing of interested parties, including **epi**, at which the proposal was discussed.

The basic structure of the proposal was that an application, whether EP-direct or EP-PCT, would proceed as before up to the payment of the examination fee. Thus, as usual, the EESR would be produced and the applicant would have to file a response to the written opinion. The applicant would also have to pay the examination fee in good time according to the present rules.

The new part would begin with the payment of the examination fee by the applicant. At this stage, the applicant could file a request to postpone examination for up to three years. The applicant would have been able to lift the postponement on request. Apart from the examination fee, no other fee would have been required.

The new part also included the option for a third party to file substantiated, non-anonymous, third party observations. The effect of doing so would have been to lift the postponement and accelerate the examination of the application. No fee would have been required for lifting the postponement.

One of the EPO's arguments was that all other IP5 Offices provide for postponement of examination, but it remains unclear why the EPO proposal differed from the three year postponement from filing that the other IP5 Offices offer.[1]

The advantages to the EPO are obvious. The EPO could avoid the examination of applications in which applicants lose interest during the deferment. Since examination of less promising applications is likely to start later, it is likely that more applications will be abandoned before examination starts. Moreover, the more promising applications, which the EPO believes would be subject to earlier examination, would allegedly be prosecuted more carefully and so could proceed faster to grant or refusal. The overall effect of this could have been that the backlog will be reduced or at least more evenly distributed. Moreover, as there were no fees involved in the proposal, the EPO considered that it could have been introduced as a change in practice with no need for a change of any rules.

There may be advantages for the applicant, who may have more time: for marketing and commercialization; to determine whether the invention is commercially viable before committing to greater costs; for determining the final choice of countries in which the patent is to be validated; to identify which of potentially a number of inventions in an application should be pursued; and to decide whether to file divisionals and, if so, how many and when.

However, there are clearly disadvantages for third parties. The period of legal uncertainty would be extended by several years. There may be a need to take action to lift the postponement, for instance if a freedom-to-operate (FTO) investigation is being carried out. If third party observations need to be filed, it may be necessary to carry out prior art searches and evaluate the results so that substantiated observations can be prepared. The mere fact that third party observations would need to be filed would allow the applicant to gain useful commercial information from them, a fortiori as these would need to be non-anonymous (although it would be possible to file "Strawman" observations).

At the hearing held by the EPO, all of these points were discussed and a variety of views were put forward. Some parties were overall in favour and some were completely against.

After the hearing, the matter went again to the CPL in the spring of 2018, where there was a significant debate. However, the debate clearly went against the proposal, to such an extent that the Chair of the CPL took the unusual step of issuing a written note of the proceedings and the outcome. In light of this, the proposal was not presented to the next meeting of the AC and so, again, it seems to be no longer under consideration.

However, as we can see from the above, it is a topic which never seems to die. It keeps coming back. Perhaps, by the time any further consideration is given to the idea, the backlogs will be so reduced that there is no incentive for the EPO to introduce such a system? There are many applicants in some geographical or technical areas who are in favour of some sort of deferred examination and perhaps they will argue for reconsideration? Perhaps parties who are usually not applicants will argue against raising it again?

So, at present, no change but keep your eyes and ears open![2]

1 In the Australian system of examination deferral for five years from the filing date, the Patent Office retains the right to set a deadline in a direction to request examination.

2 If you have views on deferred examination and would like to communicate them to **epi**, please send an email to eppc@patentepi.com.

On the level of the appeal fee

J. Boff (GB), Chair of the EPO Finances Committee

Jim Boff

New appeal fees came into effect 1st April 2018.[1] An accessible appeal fee system is an essential part of providing justice, and serves a quality control function.

Article 6 § 1 of the ECHR provides the right to a fair hearing in the determination of civil rights and obligations. The right of access to a court must be *"practical and effective"*. The practical and effective nature of this right can be impaired, for instance, by excessive court fees.

The 50% increase of the appeal fee implemented in 2014 (CA/D14/13) had a significant effect on the number of appeals. It dramatically reduced *ex parte* appeals. During the last full year before the increase (2013), 24.6% of refusals of applications were appealed (*ex parte* appeals), but in 2016, there were only 17.1%, i.e. a drop of 30% in *ex parte* appeals (see Table 1). It is unclear whether the increase in appeal rate in 2017 represents a partial recovery from the shock of the fee increase, or a change in the nature of refusals.

Table 1
Ex parte appeal rates – 2010-2017

Year	*ex parte* appeals	From number of refusals	Appeal rate	
2010	1241	4945	25.1%	
2011	1310	5125	25.6%	
2012	1241	5125	24.2%	
2013	1200	4881	24.6%	
2014	996	4211	23.7%	Appeal fee increase introduced 1st April 2014
2015	864	4613	18.7%	First full year following appeal fee increase
2016	934	5464	17.1%	
2017	1081	5206	20.8%	

The amended Rules Relating to Fees froze the appeal fee for SMEs, natural persons, non-profit organisations, universities and public research centres at the previous appeal fee level. This freeze is welcome for small entities and individuals: but it is at first sight perplexing in its application to larger entities. It is not immediately clear what the rationale is for a system in which a business having 250 employees and a turnover of €50m[2] has to pay the increased appeal fee: whereas a university with a faculty of around 2,400 and total revenues of over $4 billion[3] can pay the frozen appeal fee.

Part of the reasoning behind the appeal fee increase was to provide increased cost coverage for the costs of running the Boards. Leaving aside the question of whether cost coverage is an appropriate measure to be applied to a judicial and quality control function, the cost coverage calculations used in deciding on the fee increase appear erroneous, in not taking into account fee income related to the fact of the appeal.

When a patent application is refused, or a patent revoked, and there is no appeal, then the Office and the Member States receive no further income from that application or patent.

When there is an appeal against a refusal or a revocation, the Office receives internal renewal fees, or a share in national renewal fees, during the pendency of the appeal.
Where a decision to refuse an application or to revoke a patent is overturned following appeal, then the Office gets grant fees (for applications) and benefits in a share in ongoing national renewal fees.

This additional income is income the Office and Member States would never have had, had the appeal not been filed, and so should be taken into account in assessing cost coverage.

Taking these factors into account, and with some reasonable (conservative) assumptions where numbers are not available, the cost coverage of the Boards of Appeal ***prior to the change in appeal fees*** appears to have been more than double the 6.8% quoted in CA/102/17[4] which was the basis for the decision to raise the appeal fee.

The cost coverage for *ex parte* appeals (for which extra income is the direct result of an appeal)

1 Amended Article 2, paragraph 1, item 11, of the Rules relating to Fees http://www.epo.org/law-practice/legal-texts/official-journal/2018/01/a4.html
2 Criterion under 2003/361/EC referred to in Rule 6(5) EPC
3 Name withheld to excite your curiosity
4 http://www.epo.org/modules/epoweb/acdocument/epoweb2/295/en/CA-102-17_en.pdf

would be considerably higher (possibly over 40% for successful *ex parte* appeals).
The increase in appeal fees will increase cost coverage still further.

Conclusions

In considering any future increase in appeal fees, calculations of cost coverage should take into account all income related to the fact of appeal, and not simply the appeal fee paid.

If differential fees are to be applied, it is more logical to provide a lower appeal fee for ex parte appeals in comparison with inter partes appeals, than to provide differential fees on the basis of criteria that provide benefits not only to SMEs, but also to selected large entities that can well afford to pay their way.

PCT-Direct Service

K. Adamczyk and H. van Driel (NL), European Patent Attorneys

Abstract

The EPO Academy and the EPI have organized conferences called "Guidelines2Day", which are repeatedly held in several locations throughout Europe. The session in The Hague, which took place on the 13th of March this year, was well visited. It provided an opportunity to professional representatives to discuss new developments in EPO procedures with the EPO and with representatives from the EPI. One of the topics that were addressed was the PCT-Direct Service.

The PCT Direct service was introduced for applications claiming priority from an application searched by the EPO. In particular, it is suitable for applicants interested in a positive Written Opinion of the International Search Authority (WO-ISA) in cases where the EPO has raised objections in the search opinion for the priority application. During the Guidelines2Day session the recently announced new practice of the PCT Direct Service was discussed. According to the enhanced PCT Direct Service the International Search Report (ISR) and the WO-ISA should address directly amendments in the PCT application with respect to the priority application, provided these are properly indicated in the PCT Direct Letter, and arguments and observations made by the applicant in the PCT Direct Letter. In this letter we discuss the status of the PCT Direct Service.

Benefits of examination in the international phase

Traditionally, examination only started after the request for examination was filed. In case of a PCT application, this was typically 3 to 4 years after the priority date. Since 2005, each international search report is accompanied by a written opinion that is de facto a first examination report.

A positive written opinion in the international phase, either together with the International Search Report or after International Preliminary Examination, often results in a relatively easy and fast grant of a European patent. This is particularly the case when the European Patent Office (EPO) acts as International Search Authority (ISA). If all objections can be overcome in the International phase, the European Examiner can issue an intention to grant as first communication after conversion of the PCT-application into a European patent application. Additionally, a positive ISA-WO may be helpful for other purposes, such as for a relatively easy and fast grant during other national or regional phases or for convincing financiers.

However, in particular for PCT applications claiming priority and due to a somewhat limited number of communications in the PCT phase, it may be difficult to get a fully positive WO-ISA.

Making use of the priority application

Many applicants file a PCT application as a second application at the end of the priority year. The fees for a PCT application are relatively high. By doing so, the maximum lifetime of a patent can be extended with one year. Furthermore, one may evaluate the patented invention on the basis of a search report for the priority application. The idea underlying the new PCT-Direct Service is to stimulate applicants to amend the PCT application relative to the priority application, such that the filed PCT application (including the claims) addresses objections raised in any search report and written opinion for the priority application.

Procedural implementation of the PCT-Direct Service

The main changes in the PCT Direct Service clarify the formal steps that should be taken. Informal comments should be filed in the form of a "PCT Direct letter" together with the international application and should aim at overcoming the objections raised for the priority application, in

particular by explaining how the amendments made compared to the priority application and remedy the objections and/or refuting them.

Formally, the priority application is an independent application from a later PCT application, and at the time of preparing a written opinion of the PCT application, the search opinion for the priority application is not public. Therefore, there was no way for the examiner preparing the PCT-written opinion to acknowledge a response of the applicant. Therefore, the applicant could not be sure beforehand whether the Examiner had taken into account any arguments made in the "PCT Direct Letter". Indeed, often it seemed that the ISR-WO neglected or overlooked amendments made in the description of the application and arguments made in the "PCT Direct Letter". In this way, the PCT Direct Service seemed of no use to the applicant.

In order to solve this, the EPO has announced[1] the procedure to follow. In the new practice, informal comments filed under PCT Direct must be *self-contained*. This means that third parties must be able to fully understand these comments as they stand. The reason for this requirement is that the search report, the search opinion or any other submissions that are part of the file of the earlier application may not be publicly available. The applicant needs to clearly indicate in the letter the amendments made in the PCT application by using track changes with respect to the priority application. Furthermore, when reference is made to the search opinion in the PCT Direct letter, the applicant is advised to append the search opinion to the Letter. It is noted, that in accordance with the PCT provisions on file inspection, PCT Direct letters will be available to the public on WIPO's PATENTSCOPE.

During the Guidelines2Day sessions held (we attended on March 13 in The Hague), it was stated that if these requirements are met, the ISR and the WO-ISA will acknowledge the PCT Direct Letter. In particular, the amendments made on filing the PCT application, as well as the arguments and observations made by the applicant in the PCT Direct Letter, will be directly addressed. If needed, the Written Opinion may indicate the status of the objections raised in the search opinion for the priority application with direct reference to the search opinion.

New practice: enhancing the PCT-Direct Service

When the EPO indeed handles the PCT Direct Letter as promised, the PCT Direct Letter will give another opportunity to move towards a positive opinion. As such, the ISR and WO-ISA can provide a better basis for proper and early decision-making for further steps to be taken in the PCT procedure. A positive outcome in the international phase enhances the chances for expediting the prosecution in the European phase and may also support access to Patent Prosecution Highway pilot with partner offices.

Clearly, usefulness of the PCT-Direct Letter will depend on the applicant. An applicant may still want to be careful in not giving away positions and arguments in the PCT Direct Letter during the international phase, especially when this would not be absolutely necessary or when this would be prejudicial for legal positions in all relevant national phases or jurisdictions. Even more, not all applicants have the same desire for an early certainty of patentable subject-matter. But the applicant takes then the risk that he will be invited for Oral Proceedings during the European examination as the EPO considers that it takes too long to bring the application in a form ready for grant.

We may summarize the changing environment, as is also proclaimed by one of our colleagues Joost Grootscholten[2], as follows: "*A PCT application provides clear opportunities for using PCT direct service and PCT Chapter II procedure in order to establish an advantageous position at the end of the International Phase in the International Preliminary Report on Patentability (IPRP). Opportunities to proceed to an advantageous position will be less frequent during the European Procedure for the EPO due to an increasing pressure on the efficiency of the EPO. That's why the use of PCT direct and PCT Chapter II procedure becomes more and more important.*"

Conclusion

The new PCT-Direct practice has entered into force on 1 April 2017 and applies to international applications filed on or after that date. Filing a PCT Direct letter for an International Search at the EPO has become more attractive for PCT applications, as the EPO now guarantees that the Examiner should consider in the ISR-WO the PCT Direct Letter, including amendments and the arguments submitted. It has to be seen whether the EPO in practice sticks to its promise to take the content of the PCT Direct letter into consideration for the ISR and WO-ISA. Moreover, this service is only provided to the applications, wherein the priority application was searched by the EPO.

1 OJ EPO 2017, A21

2 Private communication

Structure and Function: Key Criteria in Evaluating Description Requirements for Harmonization of the US and European Patent Systems

E. Bruno and C. Tunstall

When pursuing patent protections in both the US and Europe (EPO), users experience tensions between the two systems which complicate the related drafting and prosecution processes.

These tensions are due to the fact that standards and criteria to evaluate patentability in the US law[1] and EPC are not only different, but also very often subjective and rooted in the local practice and, therefore, are difficult to understand for a practitioner from a different jurisdiction.

The above situation leaves an applicant from a different jurisdiction in dismay, escalated because the tension arises when it is too late to modify the description to include additional information. Therefore, the applicant is often left the impossibility to pursue intended embodiments without an understandable explanation as the requested information often stems from a subjective evaluation performed from the point of view of a different patent practice.

Some commentators suggest that these tensions are inevitable due to the intrinsic differences between the two patent systems.[2] However, both the US and EPC patent systems already include criteria that are both objective and objectively verifiable and that apply to all embodiments and aspects of an invention independently from the technology, that are consistent between the systems, and that provide direct reference to elements of the description and claims.

In particular, structure, function, and the correlation between the two are criteria that are used in the US and EP patent systems to evaluate support, clarity and added matter and that also provide the core for evaluating novelty and obviousness/inventive steps of an invention.

In a world where the five major patent offices have been spending significant efforts and resources to harmonize different patent systems[3], a further development of the existing guidelines using those criteria would be, therefore, highly desirable as it would allow users of different jurisdictions to better understand what is required when drafting and prosecuting patent applications directed to international protection.

Structure and function in the form of "identifying characteristics" are criteria for evaluation of written description requirement and added matter in the US

The US written description requirement requires that the patent applicant is in full possession of the claimed subject matter on the application filing date.[4]

The standard to evaluate written description in the claims is *"whether the specification conveys with reasonable clarity… [that] applicant was in possession of the invention as now claimed."*[5]

This standard is also applied when one evaluates whether an amendment of the claims violates the prohibition against added matter according to US patent law[6] (according to US patent law, prohibition against added matter in the specification and prohibition against added matter in the claims have different legal bases.[7])

The *"convey possession"* standard, however, is highly subjective as, in absence of specific criteria, the related application to a specific fact pattern highly depends on the point of view of the person performing the analysis.

Various criteria are used to determine whether the specification conveys possession of the invention as claimed, the criteria being a non-exhaustive list of items all making reference to specific elements of the specification.

"Identifying characteristics" is among those criteria, and refers to complete or partial structure, other physical and/or chemical properties, functional characteristics when

1 35 USC and 37 CFR, and related caselaw
2 See, for examples, Steve Hansen's "Patent 'Trolls': Effects of the U.S. Written Description Requirement and Continuation Practice" (https://hanseniplaw.com/patent-trolls-effects-of-the-u-s-written-description-requirement-and-continuation-practice/), Martin D. Hyden and Theresa M. Weisenberger's "Intermediate Generalization: Amending European Patents and Applications Under Article 123(2) EPC" (http://www.finnegan.com/files/upload/Newsletters/Full_Disclosure/2014/March/FullDisclosure_Mar14_4.html), and Jens Viktor Nørgaard and Rebecca M. McNeill's "Considerations for US Patent Attorneys When Drafting Patent Applications to Maximize Prosecution Opportunities in Europe" (http://www.mcneillbaur.com/docs/Considerations-for-US-Patent-Attorneys-When-Drafting-Patent-Applications-to-Maximize-Prosecution-Opportunities-in-Europe.pdf)
3 See http://www.fiveipoffices.org/activities/harmonisation.html
4 See *TurboCare. v. General Electric Co., 264 F.3d 1111, 1118 (Fed. Cir. 2001)*
5 *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983); *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) also MPEP 2163.02
6 See *TurboCare. v. General Electric Co., 264 F.3d 1111, 1118 (Fed. Cir. 2001)*
7 35 USC 132 and 35 USC 112(a), respectively

coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.[8]

Identifying characteristics are, in particular, applied in Step 3 of the methodology below used to determine compliance of the claims with 35 USC 112(a) "written description"[9]:

1. Determine what claim as a whole covers;
2. Review the entire application to understand support including each element and / or step;
3. Determine whether there is sufficient written description to inform a skilled artisan that the applicant was in possession of the claimed invention as a whole at the time the application was filed.

As an explanation of "identifying characteristics" by example:

> "If the application … does not disclose the complete structure (or acts of a process) of the claimed invention as a whole, determine … other relevant identifying characteristics…
>
> For example, if … strong correlation between structure and function, one skilled in the art would be able to predict … the structure of the claimed invention from a recitation of its function"[10]

The above criteria have been confirmed by the Federal Circuit in its decision Amgen v. Sanofi decision[11], in which the Court rejected the so called "newly characterized antigen test". In so doing the Court stated that

> Both in this case and in our previous cases, it has been, at the least, **hotly disputed** that knowledge of the **chemical structure** of an **antigen** gives the required kind of structure-identifying information about the **corresponding antibodies**. Because the scientific premise behind the "**newly characterized antigen**" test stated in the instruction in this case was **neither "generally known" nor "accurately and readily" ascertainable**, we cannot take judicial notice of the premise **and displace the required fact finding with what amounts to a rule of law.**"[12],

thus confirming the 'identifying characteristics" as reference criteria for written description analysis in the US.

Therefore, due to an internal harmonization of the requirements for support required at and after filing in the US system, the criteria of structure, function, and their correlation allow a user to evaluate if a given embodiment is described adequately enough to be pursued in the application both at the time of and after the time of filing.

Accordingly, in the US, "identifying characteristics", if correctly applied in accordance with MPEP, would:

- minimise added matter issues as the added matter is a corollary of written description[13];
- apply to all the embodiments/aspects of the invention – virtually all inventions can be described as variants/properties or uses;
- be objective and objectively verifiable during prosecution (differently from, for example, "convey possession" which is a subjective standard).

The "identifying characteristics" are also consistent with corresponding criteria in different jurisdictions and in particular before the EPO to a certain extent as it will be shown in the following sections.

Structure and function in the form of "variants and related properties and uses" are criteria to evaluate support under Article 84 EPC

In the EP system, the requirement of support in the description has a legal basis in Art 84 EPC which indicates that *"the claims shall …be clear and concise and be supported by the description."*

The EPO guidelines provide criteria to evaluate compliance of a description with the requirement of Art. 84 EPC. In particular, in the Guidelines[14], it is stated that

> "Most claims are generalizations from one or more particular examples. … The applicant should be allowed to cover all obvious modifications of, equivalents to and uses of that which he has described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, he should be allowed to draw his claims accordingly."[15]

Thus, description of **variants** covered by the claims and related **properties** or **uses** in accordance with EPO Guidelines does:

8 See MPEP 2163.I, and MPEP 2163.02 *"'Identifying characteristics are also used to determine: Whether the specification conveys with reasonable clarity … applicant was in possession of the invention as now claimed' (Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563 - 64 Fed. Cir. 1991)"*

9 MPEP 2163.II

10 MPEP 2163.II (emphasis added)

11 *Amgen Inc. v. Sanofi, Aventisub LLC*, 2017 U.S. App. LEXIS 19416 (Fed. Cir. Oct. 5, 2017)

12 Id above p. 17

13 *TurboCare v. General Electric Co.*, 264 F.3d 111, 1118 (Fed. Cir. 2001) "The written description requirement and its corollary, the new matter prohibition of 35 U.S.C. 132, both serve to ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date."

14 Guidelines for Examination in the European Patent Office" (Nov. 2016), http://documents.epo.org/projects/babylon/eponet.nsf/0/0791474853510FFFC125805A004C9571/$File/guidelines_for_examination_en.pdf

15 "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part F, Chapter IV, Section 6.2; emphasis added.

- Minimise added matter issues in connection with generalisation at least to a certain extent since after filing Art 123(2) EPC prevails (see however discussion of added matter below);
- Apply to all the embodiments/aspects of the invention - virtually all inventions can be described as variants/properties or uses
- Be objective and objectively verifiable during prosecution - to a certain extent since what is a "variant" can be subjective
- Be consistent with criteria of different jurisdictions and in particular the US system at least to a certain extent.

In particular, the EPO variant criteria provide strong parallels with the corresponding criteria used to evaluate support in the US system, as will be evident from the following side-by-side comparison.

- EPO: if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, [then] he should be allowed to draw his claims accordingly.[16]
- US: if [there is] strong correlation between structure and function, one skilled in the art would be able to predict … the structure of the claimed invention from a recitation of its function."[17]

Therefore, EPO variants covered by the claims and related properties or uses provide an EPO version of the US identifying characteristics.

The US structure and function, however, appear preferable for users because they are more objective and are easily recognisable, verifiable, and portable between different types of inventions, as well as different aspects of one invention.

A further elaboration of the "variants and related properties or uses" (referring to structure/function of the variants) would help users (in particular US users) draft applications in a way that will smoothen prosecution.

Such an elaboration would also allow, as will be shown herein, a better interplay with the evaluation of the clarity requirement under Article 84 EPC and the added matter requirement under Article 123(2) EPC (which is also performed, at least to a certain extent, using structure, function and related relationship as evaluating criteria as more extensively discussed below).

Structure and function are criteria to evaluate clarity under Article 84 EPC

The clarity predictability requirement of Article 84 EPC is barely discussed in the EPO Guidelines. The case law of the EPO Boards of Appeal, however, provides criteria which makes direct reference to elements of the description and claims and, in particular, to structural and functional features of the invention as described/claimed.

The book "Case Law of the EPO Boards of Appeal"[18] indicates that, in case T 361/88, the board distinguished between two types of functional features:

> "the first type of *functional feature* is related to process steps which are *known* …and may easily be performed in order to obtain the desired result;
>
> the second type of functional feature consists of process steps defined by the result which is aimed at. This is also allowable as long as the man skilled in the art knows, without exceeding his normal skills and knowledge, what he has to do in order to obtain said result."[19]

Additional EPO case law on clarity/predictability under Article 84 EPC makes reference to structure/function:

> T68/85: "8.4.3 On the other hand, the effort to define a feature in functional terms must stop short where it jeopardises the clarity of a claim as required by Article 84 EPC… [demanding] not only that a skilled person be able to understand the teaching of the claim but also that he be able to implement it.
>
> In other words, the feature must provide instructions which are sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable experiments" (on the predictability requirement of Article 84 EPC – Clarity).

EPO case law on the clarity/predictability requirement of Article 84 EPC makes reference to structure/functions:

> T720/92: "3.1.3 … (v) … The person skilled in the art should …understand what is meant by the language of a claim without ambiguity and without complicated, time-consuming investigations, i.e. without undue burden.
>
> This applies also to functional features, i.e. features which become manifest only on exposure to qualifying conditions …; the acknowledgement of their clarity depends on the amount of verifying input necessary to conclude whether or not a functional parameter is met."

EPO case law on the clarity /predictability requirement of Article 84 EPC makes reference to structure/ function:

16 See "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part F, Chapter IV, Section 6.2
17 MPEP 2163.II
18 https://www.epo.org/law-practice/case-law-appeals/case-law.html
19 "Case Law", page 256.

> T720/92 (continued): In areas where experimentation is required, clarity can … be recognised only if with usual methods or methods disclosed in the application, possibly together with common general knowledge, the skilled person is in a position to purposefully design embodiments of the invention by routine experimentation.
>
> That is, clarity cannot be recognised if verification of a functional feature involves the working out of experimental activities or even strategies which are not disclosed in the application and are not within common general knowledge, thus imposing on the expert an undue burden."

In determining the clarity of functional features, the importance of the ability of the skilled person to purposefully choose the right structure and the right values for parameters has long been recognized:

> T0361/88: "3.2.2. As regards the features 'extended slowly and at low tension', it is considered that the man skilled in the art, … is able… to choose the right values for the extension speed and the tension dependent on the other parameters of the process and adapted to the filaments treated, to obtain the result aimed at."

If choosing the right structure and selecting the appropriate values for parameters presents the skilled person with an undue burden, then clarity is not acknowledged:

> T0754/13: "2.3.9 … According to the jurisprudence the skilled person must be in a position to ascertain where the boundaries of the scope of claim 1 are and not only to verify whether or not he is infringing the process of claim 1. In the present case he does not know these boundaries from the definitions of claim 1 and to determine the same he is confronted with a small research program, which is an undue burden, as considered by the Board."

A synthesis of these Article 84 cases on the clarity/predictability requirement leads to the conclusion that a *functional feature* (a feature which becomes manifest only on exposure to qualifying conditions) is clear if the skilled person – is able, without undue burden, to *select the right structure* or – choose *the right values for parameters* so that the function will be achieved under those qualifying conditions.

In other words, the functional feature is clear if it is possible to predict with reasonable effort which of the structural and parametric variants allowed by the claim also give rise to the functional requirements of the claim.

There are similarities between the assessment of support and clarity under Article 84:

- EPO Guidelines on Support (Art. 84): In particular, if it is *reasonable* to *predict* that *all the variants* covered by the claims *have the properties or uses* the applicant ascribes to them in the description, he should be *allowed* to draw his claims accordingly.

- EPO case law on Clarity (Art. 84): If it is *possible* to *predict* with *reasonable effort* which of the *structural and parametric variants* allowed by the claim also give rise to the *functional requirements* of the claim, the functional feature is clear (and the applicant should be *allowed* to draw his claims accordingly).

Therefore, structural and parametric variants related features or combination of features and related functional properties:

- provide criteria in EPO case law to evaluate the Predictability Requirement of clarity of Art. 84 EPC, which

- make direct reference to elements of the description/claims, and

- have similarities to criteria for the Support Requirement of Art. 84 EPC, i.e. "all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description"

Guidelines (with respect to clarity/predictability) could be drawn to:

- indicate that it must be possible to predict which of the structural and parametric variants allowed by the claim also have the functional properties of the claim[20] (see T720/92),

- complement the Guidelines concerning the Support requirement indicating that

- indicate that it must be reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them.[21]

An introduction of those guidelines, which are based on EPO case law, would guide users to draft applications in a way that would:

- apply to all the embodiments/aspects of the invention – as they refer to variants and related features/properties and uses, and

- be objective and objectively verifiable during prosecution – in view of direct reference to features and properties /uses.

20 See case T720/92
21 "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part F, Chapter IV, Section 6.2

Structure and function are criteria to evaluate added matter under Article 123(2) EPC

The "gold standard" before the EPO for evaluating added matter is: *"if the overall change in …content…results in .. information which is not directly and unambiguously derivable from …the application, even when account is taken of matter which is implicit to a person skilled in the art"*[22]

However, whether or not a specific subject matter can be derived "directly and unambiguously" from a specific description is a conclusion in the eye of the beholder, and different conclusions are reached by different examiners performing the analysis.

The criteria used for the general application of the "gold standard" are based on i) general reference to "information" presented in the application and ii) "implicit disclosure"[23], with very narrow applicability of iii) common knowledge[24]. No reference is made under the "gold standard" to specific elements of the description.

Reference to specific elements of the description can be found only in examples provided in and specific case law cited by the Guidelines. For example: replacement/removal of a feature (H-V.3.1), additional features (H-V.3.2), intermediate generalizations (H-V.3.2.1), deletion of part of the claimed subject-matter (H-V.3.3), disclosed disclaimer (H-V.3.5). The EPO standard to evaluate added matter makes no reference to specific elements of the specification unless the evaluation is performed in connection with specific fact patterns.

The absence of a direct connection of the general EP criteria for added matter to specific elements of the description makes the related application arguable, subjective and open to interpretation unless the analysis is performed in connection with the specific fact patterns of the provided examples and case law.

Take, for example, case G1/93 (EPO). In this case, the Board remarked:

> "Whether or not the adding of an undisclosed feature limiting the scope of protection conferred by the patent as granted would be contrary to the purpose of Article 123(2) EPC … depends on the circumstances.
>
> If such added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to the patentee contrary to the above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter in the sense of that provision. …
>
> If, on the other hand, the feature in question merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such feature cannot reasonably be considered to give any unwarranted advantage to the applicant."[25]

An integration of the EPO Guidelines along this line, providing general criteria for evaluation of the effect of undisclosed added feature with indications making specific reference to elements of the description, would make the analysis more objective. The tests set forth in the examples and case law already provide those indications.

However, an effort could be made to use them in a more general test, complementing the specific tests already in existence. Such a general test would provide valuable guidance for drafters and examiners for all those situations where the specific tests are not applicable, or when the applicability of the tests for specific fact patterns is arguable (e.g., an amendment resulting in the addition of one or more features and the removal of one or more features). Such a test would also provide an important tool for harmonization if it is formulated with criteria that have elements in common with the US system.

One already existing test, using "structure and function" as reference criteria, is the test for intermediate generalization. In fact patterns where generalization is sought, extracting a specific feature may be allowed *"only if there is no structural and functional relationship between the features."*[26], and replacing or removing of a feature from a claim does not violate Article 123(2) if the skilled person would directly and unambiguously recognise that *"(ii) the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve"*[27].

Notable case law includes:

> EPO Case T284/94: "An amendment of a claim by the introduction of a technical feature taken in isolation from the description of a specific embodiment is not allowable under Article 123(2) EPC if it is *not clear beyond any doubt* for a skilled reader from the application documents as filed that the subject-matter of the claim thus amended provides a complete solution to a *technical problem unambiguously recognisable* from the application. Thus a generalisation of an embodiment can be allowed if the underlying recognizable function for that embodiment is still performed by the generalised features." (emphasis added)

22 "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part H, Chapter IV, Section 2.2
23 *Id.* at Section 2.3
24 *Id.* at Part H-IV, Section 2.2 and Part G-VI, Section 2
25 G 0001/93, Reasons for the Decision #16
26 "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part H, Chapter V, Section 3.2.1
27 *Id.* at Section 3.1, re: replacement/removal of a feature

> EPO Case T1067/97: "If a claim was to be restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. An amendment of this nature would *only be justified in the absence of any clearly recognisable functional or structural relationship among said features*." (emphasis added)

Therefore, based on the above, if a feature is added to a claim, then other features functionally related to the added feature should be added as well. In other words, an amendment can be allowed if it ensures that the underlying recognizable function is still performed by the features added to the claim. A synthesis of these Article 123(2) cases leads to the conclusion that whenever a function is recognisable to the skilled reader from the application as originally filed and in the light of common general knowledge, the feature or combination of features that is responsible for that function may be introduced into a claim without contravening Article 123(2) EPC.

Additional case law of the Boards of Appeal has recently criticized the test for intermediate generalization, in particular taking issue with the arbitrariness of the assessment of essentiality and with the ability of the essentiality test to be equally applicable to additions as well as removals.

EPO case T1852/13:

> The Enlarged Board of Appeal discarded the approach based on the essentiality of the invention adopted in decision T 73/88 in relation to the validity of priority and established a criterion similar to the gold standard (see point 2.2.4 above). The concerns of the Enlarged Board of Appeal regarding the arbitrariness of the assessment of essentiality can also be applied to instances where amendments have been made. As a result, the Board agrees with decision T 910/03 that the ratio decidendi of opinion G 2/98 advocates no further application of the essentiality test. (commenting on G2/98 related to essentiality and priority, emphasis added)
>
> ….
>
> It is also questionable whether the essentiality test actually maintains the legal certainty of third parties; the statements made in point 8.3 of opinion G 2/98 instead suggest that criteria that are based on essentiality reduce legal certainty. The gold standard is also superior to the essentiality test in that it represents a uniform benchmark for all amendments and is equally applicable to removals and additions. (commenting on decision T404/83, emphasis added)

In this connection EPO case T1852/13, while affirming the gold standard, also acknowledges the difficulties of its application and the need for objective criteria, as the lack thereof is the apparent basis of the Board's position on the "essentiality test".

EPO case T1852/13:

> "The difficulty in applying the gold standard in specific cases has led to a number of attempts being made to introduce examination criteria that are specific and easy to apply. The problem with these "tests" is that they are based on individual cases which turn considerations relevant to the decision into generalized criteria. The validity of such generalizations is then not usually questioned. Outside the area of overlap in which the test leads to the same conclusions as application of the gold standard, however, there may be areas in which the test produces different results. Considerable caution should therefore always be taken when using such tests.
>
> "The Enlarged Board of Appeal described this approach as "problematic" because there were no suitable and clear objective criteria for distinguishing between technical features which were connected to the function and the effect of the invention and technical features in which this was not the case, so there was therefore a risk of arbitrariness (see point 8.3 of the Reasons for the Decision)..(commenting on G2/98 and the essentiality test as applied to priority, emphasis added)

We note that the above passages of T1852/13 essentially confirm the premises of this paper and essentially affirm the need of uniform and objective criteria that are universally applicable to all fields and all situations.

It is apparent to the authors of this paper that an introduction of guidelines using structural and parametric variant-related features (or combination of features) and related functional properties as criteria would provide criteria that respond to the needs indicated by T1852/13 further elaborating the test of intermediate generalization, possibly replacing and/or further clarifying the indication concerning the "essentiality".

In general, new guidelines that provide more guidance by using structure/function and related relationships would guide users to draft applications in a way that would also minimise added matter issues later during prosecution – in view of the presence of corresponding criteria in guidelines/case law for evaluating support under Article 84 EPC and added matter under Article 123(2) EPC.

Articulation of the existing EPO analysis for support, clarity and added matter in terms of structure and function and related relationship would allow an internal harmonization of the related criteria

Contrary to what happens in the US, the EPO added matter requirement has a legal basis[28] different from

the legal basis for support in the description[29]. The texts of Article 123(2) EPC (added matter) and Article 84 EPC (support) do not cross-reference one with the other. Under Article 123(2), "*[t]he European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.*", while under Article 84 EPC "*the claims shall …be clear and concise and be supported by the description.*"

The two requirements, however, both require an evaluation of the description and as such shall in practice be coordinated in evaluating what is described, conveyed or disclosed by the description. The coordinated application of Article 84 EPC and Article 123(2) EPC is discussed in the EPO Guidelines[30]. It concerns support and extent of generalization permissible under Article 84 and indicates that *"the applicant should be allowed to cover all obvious modifications of, equivalents to and uses of that which he has described. …. After the date of filing, however, he should be allowed to do so only if this does not contravene Art. 123(2)."*[31]

Therefore, in the EPO procedure, the mechanics of the legal reasoning concerning the description and what the description supports involve an evaluation of the extent of generalization allowed by Article 84 EPC (and logically also Article 83 EPC) together with an evaluation of its limits provided by the constraints of Article 123(2) EPC.

In this evaluation, Article 123(2) EPC and related rules and case law provide negative criteria defining the limits of support, while Article 84 EPC and related rules and case law provide positive criteria defining what instead is supported and the extent of generalization allowed. Accordingly, Articles 123(2) and 84 (as well as 83) EPC are in fact the "yin and yang" of the evaluation of added matter in Europe. In stark contrast with the US system, Article 123(2) EPC *per se* only provides limits, but not criteria, to positively identify modifications which are supported in the description.

Therefore, when analyzing amendments for added matter, the criteria of Article 123(2) EPC should be applied to define what is added matter, but at the same time it would be useful if criteria analogous to those of Article 84 EPC (and Article 83 EPC) could be applied during the same evaluation to determine when new features do not constitute added matter.

28 Article 123(2) EPC
29 Article 84 EPC
30 "Guidelines for Examination in the European Patent Office" (Nov. 2016), Part F, Chapter IV, Section 6.2
31 Id.

Articulation of the existing EPO analysis for support, clarity and added matter in terms of structure, function and their correlation would allow harmonization of the criteria with the US system

If the EPO Guidelines would adopt the US criteria of "structure, function, and their correlation" for support, clarity and added matter, then not only would the EPO criteria be harmonized with the US criteria, but they would also provide harmonization within the EPO Guidelines themselves, avoiding conflicts between different EPC rules. This would simplify the process for trans-national applicants by a reduction of conflicting rules.

Conclusions

Modification of the EPO Guidelines to emphasize use of structure, function, and their correlation in the analysis of written description would benefit understanding of the EPO criteria by US applicants and provide a convergence of the EPO practice with US practice.

More notably, we are not advocating for the adoption of any specific tests or specific wording of the rules, as these may vary in view of an ever evolving case law for each jurisdiction. Instead, we are advocating for a change in mindset, to take into account the need to develop a objective and universally applicable set of criteria/tools that can be used to articulate those tests in a way that makes them understandable to all applicants, including applicants from jurisdictions that do not share the same backgrounds and traditions.

Any efforts in this direction would help the development of a common language of patent practice, and would contribute to achieve an increased understanding of the requirements of the EP system by all users and, ultimately, promote harmonization across jurisdictional boundaries.

Abstract

Structure and function are key criteria in developing the legal reasoning in the US and Europe as well as many other jurisdictions. Development of guidelines articulating and explaining legal requirements in terms of structure and function would be understandable to all applicants, including applicants from jurisdictions that do not share the same backgrounds and traditions, as based on objective and universally applicable set of criteria/tools.

Any efforts in this direction would help the development of a common language of patent practice, and would contribute to achieve an increased understanding of the requirements of the EP system by all users and, ultimately, promote harmonization across jurisdictional boundaries.

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