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Simon Wright

Simon Wright (54) studierte an der Universität von Bristol Chemie und Biochemie. Anschließend arbeitete er ab 1986 als Patentanwalt in einer Kanzlei in London. 1990 qualifizierte er sich als britischer Patent und Markenrechtsanwalt, im Jahre 1992 zum Europäischen Patentanwalt. Seine Spezialgebiete sind Biowissenschaften und Biotechnologie. 1994 wechselte er zu J A Kemp und wurde 1999 Partner der Kanzlei.

Vor kurzem entdeckte Simon seine künstlerische Ader wieder und begann mit abstrakter Malerei auf Acryl zu experimentieren. Diese (manchmal schmutzige) Technik bedeutet, verschiedene Farben vor, während oder nach dem Auftragen miteinander zu vermischen, je nachdem welches Ergebnis man erzielen möchte. Man kann die Farben mit verschiedenen Techniken fließen lassen, zum Beispiel durch Kippen oder das Ausnutzen der Gravität. Dieses Bild wurde mit Hilfe seiner Tochter angefertigt, Helen (17 Jahre, die gerade einen Abschluss in Kunst absolviert hat)

Seit 2008 ist Simon ein sehr engagiertes Mitglied des **epi** – als Mitglied im Vorstand, dem Disciplinary Committee und SACEPO. Momentan ist er Ratsmitglied, Mitglied im By-Laws Committee sowie Sekretär des Biotech Committee.



Cover:

Lion's mane

Acrylic Pour (2019)

Simon Wright

(European Patent Attorney, GB)

Simon Wright (54) studied chemistry with biochemistry at Bristol University, joining the private practice patent profession in London in 1986. He qualified as a UK patent and trade mark attorney in 1990, becoming a European Patent Attorney in 1992. He practises in the life sciences and biotechnology arena. He joined J A Kemp in 1994 and became a partner in 1999.

He rediscovered his artistic side recently and started experimenting with acrylic pour painting. This (sometimes messy!) method involves mixing the different paints before, during or after application on the canvas or board, depending on the result required. One can then make the colours flow together with a variety of techniques, although often just tilting and using gravity works. This artwork was made with the help of his daughter, Helen (aged 17, who has just sat her A level art examination). Simon has been actively involved in the **epi** since 2008 (serving on the epi Board, Disciplinary committee and SACEPO). He is currently a member of epi Council and the By-Laws committee, and Secretary of the Biotech Committee.

Simon Wright (54 ans) a étudié la chimie et la biochimie à l'Université de Bristol, et est entré dans la profession de conseil en brevet en 1986, dans un cabinet londonien. Il a obtenu l'examen de conseil en brevets et marques britannique en 1990, puis est devenu mandataire en brevets européens en 1992. Il est spécialisé dans le domaine des biotechnologies et des sciences de la vie. Il a rejoint le cabinet J A Kemp en 1994 et en est devenu associé en 1999. Il a redécouvert récemment son côté artistique et s'est essayé à la technique de peinture acrylique par « pouring ». Cette technique (parfois salissante !) consiste à mélanger différentes peintures avant, pendant ou après application sur une toile ou sur un panneau en bois, en fonction du résultat recherché. Il est ainsi possible de faire couler plusieurs couleurs ensemble selon une variété de techniques, même s'il suffit souvent d'incliner les pots de peinture et de laisser faire la gravité ! Il est généralement impossible de savoir à quoi ressemblera le tableau final, il faut donc souvent procéder par tâtonnement.

Simon est très actif au sein de l'**epi** depuis 2008 (en tant que membre du Bureau, de la commission de discipline et du SACEPO). Il est actuellement membre du Conseil de l'**epi**, de la Commission du règlement intérieur, et secrétaire de la Commission pour les inventions en Biotechnologie.

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Editorial

The sun rises in the East (and sets in the West)



Marc Névant

An article published a couple of months ago on the website ‘wired’ (www.wired.com) details China’s broad ambitions in AI. In 2017 the Chinese government announced a new artificial intelligence strategy that aims to rival the US in the crucial technology by 2020. The latest data on the output of US and Chinese AI researchers suggest China

is on track: an analysis by the Allen Institute (www.alleninstitute.org) showed that China’s share of top AI publications is rapidly approaching that of the US; if current trends continue, the two nations will produce an equal share of top AI publications by 2020.

Almost at the same time WIPO reported¹ in 2018 that Asia-based innovators filed more than half of all international patent applications. There was a significant growth from China (+9.1%), India (+27.2%) and Korea (+8%). The top 10 applicant list comprises six companies from Asia, two from Europe and two from the US, with China-based telecoms giant Huawei Technologies leading the way by far (almost twice as many applications as runner-up Mitsubishi Electric).

¹ https://www.wipo.int/pressroom/en/articles/2019/article_0004.html

² The current draft is available at <https://patentepi.com/r/epo-strategic-plan-2023-draft>

This “shift of innovative activity from West to East” (to use the words of WIPO Director General Francis Gurry) seems all the more unavoidable that innovative cooperation within European countries – which we called for in a previous editorial – appears to be at a standstill. Recent decisions from governments across the European Union – including the pathetic and endless tragicomedy surrounding the (non) Brexit – gives the feeling that being a team player is no longer a prerequisite for Union members. It is therefore doubtful that the trend of more IP rights stemming from Asian innovators can be reversed, at least from a European perspective.

In this gloomy context, the European Patent Organization might be – to some extent – a source of inspiration for our European leaders. The Strategic Plan 2023² should normally be adopted by the representatives of the 38 member states on the Administrative Council in June this year, i.e. within a very reasonable time frame (based on European standards), namely less than one year, after Mr. Campinos took over as president of the European Patent Office. The Strategic Plan, on which our Institute has provided comments and suggestions, aims not only at securing long-term sustainability for the EPO, but also at delivering quality services in an (always more?) efficient way. In this respect we note that the number of grants has dramatically increased over the last ten years, from roughly 52,000 in 2009 to nearly 128,000 last year (source: EPO Annual Report 2018). We genuinely wonder how EPO Examiners can (and will) manage to deliver an ever increasing number of high quality “products” (read: searches, grants and refusals), even with state-of-the-art IT tools. This, in our view, will be the real challenge of the Strategic Plan 2023.

M. Névant (FR), Editorial Committee

Nächster Redaktionsschluss für 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 **12. Juli 2019**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

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 **12 July 2019**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

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 **12 juillet 2019**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Report from the 86th Council Meeting in Sofia on 11th May 2019

Lindsay J. Casey (IE), Editorial Committee

Officers attending the Meeting were The President, Francis Leyder (BE); Vice-Presidents, Heike Vogel-sang-Wenke (DE) and Barbara Kunič Tešovič (SI); Deputy Secretary General, Antonius Tangena (NL); and Treasurer, Peter Thomsen (CH).

The President opened the Meeting and welcomed the participants. The President advised that the Secretary General, João Pereira da Cruz (PT), was unable to attend and the Deputy Secretary General was in his stead.

The Scrutineers for the Meeting were Atanas Tsvetkov (BG) and Valentina Nesheva (BG)

The Agenda was adopted with some slight changes. Topic "Double written approval system" from item 11 was postponed. Item 11 was completed by a motion. Item 16 was re-timed.

Minutes of C85

The Minutes of the 85th Council Meeting were taken as read. The Deputy Secretary General advised that there were no matters arising. The Minutes were approved without amendment.

Report of the Board and President

The President referred to his Report submitted in advance of the Meeting and to the Minutes of the 103rd Board meeting held on 29.03.2019. There followed some discussion on matters in the Report which was subsequently approved.

Committee Elections

The following members were nominated and elected:

Electoral Committee:

Markus Müller (CH); Peter Barrett (GB); and Arni Vilhjalmsón (IS);

Litcom Committee:

Annemie Jaeken (BE) substitute member;

Disciplinary Committee:

Giuseppe Mazzini (IT) and Ferry A.T. van Looijengoed (NL).



Report of the Secretary General

The Deputy Secretary General referred to the Secretary General's Report submitted in advance of the Meeting. On a specific point, he advised that the **epi**'s trademark will be renewed. Following some points of clarification, the Report was approved.

Annual Report 2018

The Deputy Secretary General, in presenting the Report, noted that **epi** is an Institute that brings together almost 12 500 European Patent Attorneys from 38 European countries. The 40-year anniversary of **epi** was celebrated in Malta with many guests from the patent world, including EPO President Benoît Battistelli and the (new) President of the Boards of Appeal, Carl Josefsson. The commemorative booklet with a brief description of all EPC countries with photographs of their Council members was also presented. In relation to the Unitary Patent (UP) and Unified Patent Court (UPC), there were no real developments in 2018. The United Kingdom



ratified the UPC Agreement in 2018, but Germany has not yet deposited its ratification instrument due to the pending complaint before the German Constitutional Court, in which it was argued that the UPC is in violation of the German Constitution.

There followed a brief discussion in relation to the presentation of documents for meetings such as Council meeting. It was agreed that, where a document submitted to the Secretariat was only in pdf format, it would be OCR'd for ease of searching. The Report was approved.

Treasurer's Report

The Treasurer's Report had been made available in advance of the Meeting. The Treasurer noted that the Annual Financial Report for 2018 has been prepared and reviewed by the external and internal auditors. 2018 ended with an overall almost balanced result of +2 k€ compared to a planned budgeted deficit of -42 k€. In relation to financial assets, the Treasurer reported that 2018 had been very difficult lead-

ing to a lower than expected income from interest and similar sources as well as the need for a substantially increased depreciation of financial assets at the end of 2018 on bonds and stocks in an amount of approximately 68 k€. Most of this depreciation arose from not realized losses and as the markets have made a significant recovery since January 2019, the actual value of the financial assets is currently much higher. He noted that Council meetings as well as Board and Presidium expenses have been essentially in line with expectations.

The Treasurer also remarked that there were higher IT costs than had been anticipated. However, there was no need to amend the Budget as agreed at C85.

With the introduction of the new rules relating to the payment of Members' Annual Subscriptions, it was noted that the number of unpaid subscriptions had been significantly reduced.

The Treasurer also advised that the EPO had agreed to continue to pay for EQE travel costs.

There was then a lengthy debate on the relatively new topic of Certificates of Good Standing. In the absence of an agreed procedure, such requests to date have been refused. However, it was believed that they would become a requirement in the future. The Treasurer also proposed that there should be a fee of 120€ for such requests to cover the cost of the research associated with, and the preparation of, a Certificate. There then followed a robust debate including opinions on whether a fee should be levied. The following Motions were placed before the Meeting with their results:

1. *Should Council vote on issuing Certificates of Good Standing? (For:54, Against:46, Abstention:8, Total votes: 108)*
2. *Should **epi** issue Certificates of Good Standing according to which Disciplinary Proceeding under the EPC are or are not pending against a Member requesting the Certificate, the Certificate being made available only to that member? (For: 90, Against: 23, Abstention: 9, Total votes: 122)*
3. *Should **epi** levy a fee and in particular a fee of 120€ for the Certificate? (For: 92, Against: 15, Abstention: 9, Total votes: 116)*

The Treasurer also reported that **epi** is a subsidiary organ of the EPO being accountable to the Administrative Council.

The Treasurer also advised that the legal status of **epi** is still being examined by the Presidium and the legal staff of **epi** the question being: is **epi** an international organisation like, for example, the EPO? An initial opinion would indicate that it is.

The Treasurer advised that approximately 213 members benefited from the Professional Liability Insurance scheme with an annual premium amount of approximately 140 k€.



It was also noted that a contract had been signed with a selected external company offering an online voting tool for use outside physical Council meetings including Council elections. Council Members were advised that a (free) online voting test would take place on 20.05.2019 and that Council members should participate paying particular attention to the instructions provided at that time.

There is to be a review of the Travel Expenses policy and how it operates. A Working Group on the travel expenses (REVEX) has been established (members: Claude Quintelier (BE), Jean Beissel (LU), Timothy Powell (GB), Mihaela Teodorescu (RO), Marco Opresnik (SI) and Francis Leyder (BE) supported by Susanne Ullmann and Helga Krüger (**epi** Secretariat).

Since its inauguration in 2016, **epi** has been an official supporter of the International Inventor Assist Program (IAP). The Treasurer reported that while **epi** members were active in providing pro bono assistance, the relatively high level of official fees for filing such applications before the EPO was a significant negative impact on the success of the program. It was noted that the official fees at USPTO were considerably lower due to the availability of a substantial discount for natural persons and SMEs which reduction can be as high as 75% when compared with the "normal" fee.

The Treasurer's Report was approved.

Internal Auditors' Report 2018

The Internal Auditors' Report (Hansjörg Kley (CH) and Philippe Conan (FR)) was made available in advance of the meeting. The Report noted that the bookkeeping was in order and they expressed their gratitude to the Treasurer and to the accounting team for this achievement despite some unfavourable technical conditions. They especially appreciated the reports made by Helga Krüger (**epi** Secretariat) for the Committees.

epi-Finances Committee Report

The Report had been made available prior to the Meeting. The Chairman, Michael Maikowski (DE), reported that all was well in **epi** and he thanked the Treasurer for his assis-

tance in the preparation of the Report. He also noted that, given the considerable increasing workloads of the Secretary General and the Treasurer, we can no longer expect those positions to operate on an entirely 100% voluntary basis.

In addition, and following on from the Internal Auditors' Report, Council agreed to cancelling the following earlier Council Decisions:

- (a) C73 (Hamburg), Decision 7; and
- (b) C77 (Milan), Decision 14

to be replaced by a new Decision C86 (Sofia), Decision 15 as follows:

- 1 *the main currency of epi is the Euro. epi can invest up to 500 000€ in one or more currencies other than the Euro. When determining the maximum amount of the admissible foreign currency investments, a netted consideration taking into account counterbalancing foreign currency hedging transactions is admissible. However, the netting may only be taken into account for the duration and amount in respect of which effective hedging of the foreign currency risk is guaranteed. Since the conclusion of any hedging transactions entails an additional counterparty default risk in the event of the insolvency of a business partner, the maximum amount of the underlying and hedging transactions in foreign currencies is limited to 1 000 000,00€ before netting;*
- 2 *epi can invest up to 1 500 000,00€ in a professionally managed asset management system of which the main aim is a constant level of return and in which risks of volatility are low;*
- 3 *the assets invested through a professional asset manager are not subject to the limits on maximum foreign currency investments set out under Section 1;*
- 4 *the treasurer is responsible year-round for compliance with the above conditions set out in sections 1 and 2. The Treasurer must report at least by 30 June and 31 December annually to the Board.*

For:	95
Against:	3
Abstention:	19
Total votes:	117





Board and Treasurer's liabilities

The Annual Accounts were approved and the liability of the Board and of the Treasurer were discharged.

By-Laws Committee's Report

The Chairman, Pascal Moutard (FR), presented his Report. The Committee recommended that Article 10.11 of the By-Laws be amended to read:

In accordance with Articles 9(2) and 10(2) of the Discipline Regulation respectively, it shall draw up respective lists of Professional Representatives and submit them as appropriate to the President of the European Patent Office and to the Chairman of the Administrative Council.

Council approved this amendment.

Report of the Reporting Groups

The Chairman, Luis Alfonso Durán Moya (ES), reported that, inter alia, the amount of time, effort and dedication required of both the Secretary General and the Treasurer has increased significantly. It is perceived that it may be difficult in the future to find suitable Secretary General and Treasurer candidates who will have the time and expertise to fulfil the current and future requirements of these offices. The voluntary nature of the office of Secretary General and/or Treasurer has the effect of substantially delaying the implementation of significant changes/improvements resulting in an undesirable effect in the overall performance of the Secretariat. Thus, the Committee recommends that the Secretariat should include the post of Executive Director (ED). The ED should have the necessary skills and experience to have overall responsibility for the running of the Secretariat and report directly to the Presidium.

There then followed discussion in which Chris Mercer (GB) advised as to how CIPA functioned. Olga Sirakova (BG) noted as to how AIPPI functioned. It was important that for the successful recruitment of the ED, the job description was clearly of considerable relevance and the individual should be outside the profession. Council approved the recruitment of an ED.

Amendment of the Terms of Reference of the Nominations Committee

The Chairman, Claude Quintelier (BE), outlined the perceived problems associated with the Rules for Election to Council

and in particular moving the deadline date defining the right to vote and the number of seats per state. Following discussion, Council agreed to amend the Rules so that all persons entered in the list of Professional Representatives on the last working day before 01.12 of the year preceding the voting (the pre-election year) will have the right to vote.

Election of the Nominations Committee

The Terms of Reference for the Committee included, inter alia, the requirement that the Committee would consist of a maximum of 6 members being current or former members of the Presidium, be elected by the Council, and not standing for election to the Board. In addition, the Nominations Committee should be active in the selection process and ensure that the candidates for Vice-President and Deputy Secretary General and Deputy Treasurer have the capacity and availability to succeed in their respective positions thus ensuring continuity within the Board.

Following a brief discussion the following were deemed elected to the Nominations Committee: Sylvain Le Vaguerèse (FR), Paul Georg Maué (CH), Chris Mercer (GB), Laurent Nuss (FR), Claude Quintelier (BE), Mihaela Teodorescu (RO)

EPPC Report

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

Pieter Vandersteen (BE) has resigned from all committee memberships including the EPPC and the Pharma The-

A very interesting, entertaining and thought provoking Seminar entitled „Inventive step and recent case law at the EPO“ was held on Friday, 10 May, with approximately 140 attendees and presented by Daniel Xavier Thomas. Details of the presentation can be found on the **epi** website for **epi** members after login as follows: <https://patentepi.com/r/pre-council-seminar>



matic Group. The Chairman expressed his appreciation for Pieter's contributions.

The ICT Thematic Group met with the EPO's Directors in the area of ICT on 30.10.2018. The meeting continued to strengthen the already good relationship of the Directors with **epi** in the area of ICT. **epi** was represented by a total of 15 members; the EPO was represented by 19 members, including the COO in the ICT field, Grant PHILPOTT.

Other aspects of the activities of the EPPC were presented and can be seen in its Report.

The Chairman also noted the possibility of filing 4 amicus curiae briefs in relation to G1/19 (The exclusion of certain aspects of computer-implemented inventions from protection to be studied by the ICT Thematic Group); G2/19 (Is Haar, where the BoA is located, in or outside Munich to be studied by a Working Group within the EPPC); G3/19 (Patent-eligibility of plants obtained by essentially biological processes to be studied by a joint Working Group of Biotech and EPPC); and Double Patenting (which may be assigned the EPO reference G4/19 to be studied by the joint Working Group of Biotech and EPPC).

It was agreed that The Secretariat would shortly open 4 new threads for discussion on **epi** Forum in relation to these briefs.

Council approved the election of Michel Gilio (BE) to the EPPC and Alain Werner (FR) to the EPPC Pharmaceutical Thematic Group.

Editorial Committee

In the absence of the Chairman, Lindsay J. Casey (IE) submitted an oral Report on the activities of the Committee including reporting on some of the results of a recent **epi** Information Survey. Briefly, from a membership of approximately 12500, 817 replies were received. More input, and in particular regular input, from members was requested. However, Cees Mulder (NL) noted, with some concern and disappointment, that he had submitted articles for possible publication without receiving an acknowledgement. It was agreed that this would be examined and resolved as quickly as possible and an apology for this oversight was offered and which was graciously accepted. In addition, a new format for **epi** Information would be presented in the next edition of the Journal.

Professional Education Committee (PEC)

The chairman, Paolo Rambelli (IT) presented his Report. Among the items in the Report, the PEC largely shares the conclusions and comments in the position paper issued by the **epi** Members of the EQE Examinations Board (EB), that favours abandonment of the pre-Examination. However, it would appear that abandonment, at present, is not a real option and the following PEC view on this issue is driven by the assumption that the pre-Examination is to stay. The cur-

rent pre-Examination could be improved to better test the knowledge of the candidates. The PEC Report gives suggestions for such changes including the desire to have a syllabus for the pre-Examination that would reflect the true knowledge requirements required by a candidate.

The Future of the Profession

The Deputy Secretary General provided some comments noting that a number of the ideas discussed in C65 (Helsinki) are in the response presented to the EPO strategic plan. The following in particular were noted:

- specialized training for specific technical areas, like pharma, chemistry, telecom, ICT etc.;
- how to do the follow-up of the Candidate Support Programme, i.e. make a permanent training programme available for all EPC countries;
- work with EPO, local patent attorneys and national patent offices on the promotion of the patent system primarily to companies with emphasis on how to obtain patent information using, for example, esp@cenet; and to increase collaboration with, and training of, academics on how to use the IP system.



A work sharing platform could help to establish networks across countries to help those who have too much work by employing those who have not enough work.

The Deputy Secretary General then presented a list of the Decisions that had been taken which are available for **epi** Members on the **epi** website (after login).

The President then closed the Meeting having thanked our Bulgarian colleagues Samuil Gabriel Benatov, Milena Lubenova Georgieva-Tabakova, Ivanka Slavcheva Pakidanska and Radislava Andreeva Kosseva.

After the Meeting, Council Members adjourned to the Restaurant Chevermeto for an evening of good food, wine and a demonstration of Bulgarian folk dancing in which many members and guests enthusiastically participated.

The following day, some members and guests enjoyed a very interesting and informative morning tour of Sofia entitled *Serdika is my Rome*.

Canadian Professor Seeks Interviewees

Study Proposes to Examine the Culture and Norms of Patent Attorney Practice

Professor Wissam Aoun (University of Windsor Faculty of Law, Canada) has spent the last several years studying the patent profession from an international comparative perspective. He will be spending the summer of 2019 visiting at Oxford University and the Max Planck Institute for Innovation & Competition in Munich and continuing his research into the European patent attorney profession.



**Professor
Wissam Aoun**

Professor Aoun's project proposes a qualitative exploration of the norms and culture of the patent profession. The purpose of this work is to better understand how the culture and regulation of patent professionals, through which the majority of patent applications must pass on their way to and through the patent office, influences the norms, rules and processes surrounding patent application preparation and prosecution. This includes an examination of how patent professionals are educated and trained, how they approach the art of patent application drafting, what they believe the role is in representing their clients and in furthering a greater public interest.

This Project also proposes a normative orientation directed towards the issue of patent quality, and the question of how the norms and culture of patent practice effect patent quality.

This Project also proposes a normative orientation directed towards the issue of patent quality, and the question of how the norms and culture of patent practice effect patent quality.

Methodologically, this study will utilize semi-structured interviews asking patent professionals questions revolving around the following issues:

- What is an 'invention'? Is the invention synonymous with the claims?
- Where does the invention exist? Who is responsible for 'locating' the invention? The attorney/agent? The applicant? The patent office? Courts?
- How do you approach the exercise of claim drafting? How do you approach drafting a claim set, and correspondingly, the independent and dependent claims? How do you approach drafting the detailed description?
- How did you learn claim drafting? Who taught you the 'art of claim drafting'?
- How do you view your role vis-à-vis the patent office (and patent examiners)?
- What do you believe the applicant's goals or objectives are in terms of acquiring protection for their invention through the patent system? What is your role in furthering that objective?
- What does 'patent quality' mean to you? What is your role or obligation, if any, in promoting 'patent quality'?
- What do you view as the ethical or professional obligations you owe to the public (if any at all)?

Professor Aoun is actively seeking individuals who might be interested in participating in this study. Interested attorneys are encouraged to email Professor Aoun at waoun@uwindsor.ca for more information on participation.



Patent practice

Foreign Filing License

The Third Revision of the Patent Law of the People's Republic of China and Its Implementing Regulations in view of its Ruling about Confidentiality Examination (= Foreign Filing License) and comparison of the Chinese regulation with the situation in Europe

P. Rosenich (LI), Chair Disciplinary Committee

Introduction

For European Patent Attorneys it is often difficult to adapt their activities also in view of laws in other jurisdictions. However in certain circumstances this is of outmost importance, as today's IP-Management focuses often worldwide and not only on limited European Countries. On the other hand R&D is often also spread over various countries including Peoples Democratic Republic of China. This is because many European firms do have also subsidiaries in

China, where production and R&D may occur. Such R&D activities are often consolidated between the Chinese Subsidiaries and the Mother Company in Europe. From this follows that often inventors cooperate over the borders.

When it comes to inventions which should be filed in Europe or elsewhere it should be noted that various countries have special laws regarding the first filing of such Patent Applications.

This is true for many states in the world. This article deals with the particular situation in China in detail and gives a rough overview about the situation in Europe.

This article is based on an article of CNIPA of 17.07.2013 and on careful talks with several Chinese Patent Attorney Colleagues

Paris Convention

Certainly Paris Convention allows in principle to file patent applications in any Member States by any members of Member States, however it does not hinder Member States to use restrictive rules, when it comes to inventions which have been invented in said Member States.

Currently, countries like China, the United States of America, India, Singapore, Australia, New Zealand, United Kingdom, France, Germany, Italy, the Netherlands, Israel and Russia all have confidentiality examination or prosecution procedures for applications to foreign countries.

That means that in those countries the State rules that inventions "which belong to these states" may be restricted when it comes to be filed in foreign countries.

Often these restrictions are in view of defense or weapons or energy. Those states often require having a first look into a new invention, before they would allow an inventor to file such inventions also abroad. In rare circumstances such States may also reject the right to file in a foreign country.

In the Third Revision of the Patent Law of the People's Republic of China and Its Implementing Regulations China adopted improved rules in this respect.



Paul Rosenich

The Patent Office (CNIPA, SIPO) of the People's Republic of China initiated the revision process in 2005, conducted comprehensive researches, and released the first draft of the amendments for public comments in August 2006. The newly revised patent law came into force on 01.10.2009.

SIPO submitted equally the Draft Amendment for Review of the

Implementing Regulations of the Patent Law of the People's Republic of China to the State Council in February 2009. The revised Implementing Regulations came into force on 01.02.2010, by which stage, the third revision to the Patent Law and its Implementing Regulations had been completed.

The main points of the revision to the patent law

The main points include the following: enhance the threshold of patentability; provide regulations on the protection of genetic resources; improve industrial design system; improve the confidentiality examination system for applications to a foreign country; invalidate the designation of foreign-related patent agencies; increase SIPO's/CNIPA's responsibility for the distribution of patent information; endow the right holders of industrial design the right of offering to sell, introduce a pre-litigation preservation measures, and

include the cost of the right holder incurred for stopping the infringing act to the calculation of damage compensation; codify prior art defense; allow parallel import; provide exceptions of drug and medical apparatus experimentation; improve the compulsory license system, and so on.

Confidentiality Examination (foreign filing license)

Out of the main points of the revision this article concentrates on the confidentiality examination system for applications to a foreign country.

The confidentiality examination system has existed since the implementation of China's patent law in 1985.

During past practice up to 2009, problems were spotted with the above mentioned provisions. Firstly, the then active prescription on filing an application first in China left the applicants with no flexibility of choice; secondly, no legal liability was provided for filing first to a foreign country in violation with Article 20 of the Patent Law; thirdly, there was also confidentiality examination for applications of industrial design, which is actually not necessary; and fourthly, the procedure of confidentiality examination needed some improvements. In order to solve these problems, for the third revision, the following amendments were made:

- A) The wording of filing first the application in China was changed to must go through confidentiality examination first;
- B) It was prescribed clearly that there is no confidentiality examination for industrial designs;
- C) It was clearly prescribed the legal consequence of filing in a foreign country without confidentiality examination, which is that the Chinese patent application won't be granted in China, and criminal liability will be prosecuted under the condition of divulgence of national secrets;
- D) Improved procedures of confidentiality examination were provided.

The provisions of the revised Patent Law and its Implementing Regulations

As long as the invention-creations are finished in China, no matter the applicant is a Chinese entity or an individual, or a foreign entity or a foreign individual, the application must go through confidentiality examination in SIPO/CNIPA.

But take into consideration that in some circumstances, applicants wish to apply for a patent in foreign countries first, or don't intend to apply in China at all, the revised Patent Law doesn't require the applicant to file a patent application on the same invention-creation in China.

For those who wish to apply patent applications directly to foreign countries, the applicants shall however first submit to SIPO/CNIPA a request for confidentiality examination and a description of the technical solution/invention.

First filing in China and subsequent filing abroad

If the applicants however wish to file an application in China first, and then in foreign countries, the applicants can submit the request for confidentiality examination together with the application documents, or after the application date. However this has to be accomplished before the applicants file the application in foreign countries.

Besides, where applicants file with SIPO/CNIPA an international PCT patent application in Chinese or English, it is automatically deemed that the applicants submitted a request for confidentiality examination at the same time.

After receiving the request for confidentiality examination or after receiving a PCT Patent application, SIPO/CNIPA will send a notification of confidentiality examination to the applicants if SIPO/CNIPA believes that the application for invention or utility model might involve with State security or major interest, and therefore needs to be kept secret. Otherwise, if the applicant doesn't receive the notification of confidentiality examination within four months from the date of submitting the request, it is deemed that the applicant can file applications in foreign countries.

For those applications of which the notification of confidentiality examination has been sent, SIPO/CNIPA will make timely decision on whether the application shall be kept secret. If the applicant hasn't received the decision made by SIPO/CNIPA within 6 months from the date of submitting the request, it's deemed that the applicants are allowed to file applications to foreign countries.

Past practices prove that the procedure of confidentiality examination doesn't pose irrational hindrance to the applicants for applications to foreign countries. For those who submit the request for confidentiality examination together with the application documents, SIPO/CNIPA sends the notification of either approving or suspending to file applications to foreign countries usually together with the notification of the receiving of the application. Statistics show that, for those who submit the request for Confidentiality Examination after applying patent application in China or submit the request in the form of technical solution descriptions, the average pendency is 30 days from submitting the request to issue the first notification. The average pendency for confidentiality examination of international patent applications is 2 to 3 weeks, which is far shorter than the prescribed timeline of 4 and 6 months.

That means that, if an applicant of a Chinese patent application who also requested a Confidentiality Examination foreign filing license can file a foreign patent application

within a few weeks after he filed the Chinese patent application. Certainly then the Paris Convention Priority Claim may be filed, so that nothing is lost because of the delay.

One may think, that a Chinese patent application might be dropped anyway after a foreign filing license was received could not be punished by losing the Chinese patent application. However it is to be reminded that the interests of a State may change – that means that inventions which were not to be kept secret in past years might fall under secrecy obligations in the future. Hence if a foreign filing was done before SIPO/CNIPA decided, a criminal act of transferring secret information to a foreign country might have happened. But even if the foreign filing license was given, a prior filing in a foreign State does constitute an infringement of the law. The consequences of such infringement can not be fully predicted, as the relevant law and view of Courts may change over the time.

In a nut shell

Applicants whose invention was finished in China need to request and receive a foreign filing license before they file a patent application outside China.

Comparison of the above presented law and practice with the situation in Europe

Among the Member States of the EPC applicants find basically three categories of States:

- A) States with a similar regulation as in China, namely insofar as the States takes its right to check applications first to see their contents before applicants move further. In these states basically – like in China – all inventions which have been made in said countries or which have been made by companies of these countries or by citizens of these countries, have to be filed with the national patent office first (either as a national application or as an European Application or as a PCT-Application): BG,FR,GR,IT,PL,PT,ES,HU,CY;
- B) States with a more liberal regulation – insofar, as this regulation orders applicants only in certain circumstances to file first in said countries; especially when the application contains a state secret, is related to defense or is security relevant. (certainly in cases of doubt applicants treat applications in such countries about the same as under A): AL,BE,DK,DE,MK,FI,HR,LT,LU,MT,NL,NO,RO,SE,SK,CZ,TR,UK;
- C) States with a very liberal approach; with no restrictions as to the rights of applicants to file first also in foreign countries: EE,IE,IS,LV,MC,AT,SM,CH,RS,SI.

More details about the EPC-Member States can be taken from the information in the EPO-brochure "National law relating to the EPC" (19th edition), Section II, column 2, as of page 71).



Case Law

Bombshell Decision

T 2101/12 (Vasco) questions the technical/non-technical distinction

F. Hagel (FR)

By issuing decision T 2101/12 (Vasco) on January 24, 2018¹, the Technical Board of Appeal 3.5.06 unleashed a bombshell. In this decision, BOA 3.5.06 takes issue in blunt language with the exclusion of non-technical elements from the definition of the state of the art of Article 54(2) EPC asserted in decision T 172/03 (Ricoh) delivered by the Technical Board of Appeal 3.5.01² and with the incorporation of such restriction referring to the Ricoh decision in the Guidelines for Examination G-VII, 2.

Key points of the Vasco decision

The Vasco decision relates to the provision of electronic signature for documents. In the observations annexed to the summons, the Board had opined that the documents previously cited did not support a lack of novelty, set aside these documents as the most suitable starting point for the assessment of inventive step, and stated instead that the most suitable starting point should be “common general knowledge”, described as the process in a notary’s office.

The appellant challenged this statement, pointing out that it did not comply with the above-mentioned exclusion of non-technical elements affirmed in decision T 172/03.

¹ This decision has been signaled by Michael Fischer in an article published in epi Information 3|2018 “Dealing with Non-Technical Features before the EPO”.

² Board of Appeal 3.5.01 handles most cases relating to computer-implemented inventions.

The Vasco decision contains a potent rebuttal of this exclusion, set out in Sections 6.5 through 6.7, with the statement in Section 6.6 that *“the interpretation of Article 54(2) EPC given in T 172/03 is incorrect”*. Quotations from the decision:

- *“The wording of Article 54(2) EPC is clear and requires no interpretation”. It “contains no limitation” excluding “a non-technical process such as the signing of a contract at the notary’s office”.*
- This wording *“is unambiguous in that it contains an unqualified “everything” (made available to the public, etc)”*;
- *Article 54(2) EPC defines what should be understood as “state of the art”, and because it is a definition one cannot first ignore the definition by saying that the term “state of the art” should be interpreted in some sense, and only then start to read the definition in the light of that interpretation. This is exactly what is done in T 172/03”.*

This strict interpretation of Article 54 EPC is clearly at odds with T 1784/06 Comptel, which states in Section 2.4 that *“the restriction of substantive patent law to technical subject-matter is so self-evident that the founding fathers of the EPC did not even mention that requirement in the original (1973) version of Article 52(1) EPC.”*

- *“If some generally known information is useful, even it should be designated “non-technical”, there is no reason why the skilled person would ignore it.”*
- *“The statement in Catchword 2 of T 172/03 is not part of established jurisprudence. [...] this limited view on prior art has not been mentioned in the summary of the pertinent case law give in T 154/04 DUNS, which G 03/08 has referred to for its summary of the case law.”*

In view of its literal, unrestricted interpretation of Article 54(2) EPC, Vasco defined the skilled person as a person having legal skills, in marked departure from the dual definition set out in T 1463-11 (Cardinal Commerce) which has assumed a notional business person providing business requirements to a technically skilled person.

The Cardinal Commerce decision offers in Sections 14-17 a discussion regarding such a business person. It accepts that in the real world, there may be a “real business person” who is not unaware of technology and that a business person unaware of technology may be viewed as “artificial” but asserts: *“that is the price to be paid for an objective assessment”* implying *“a separation of business considerations from technical”* in line with

the principle set out in decision T 644/00 Comvik. This conclusion is in this author’s view highly debatable: why should the concern about an objective assessment lead to select an artificial business person, rather than a real business person not unaware of technology? Logically, an assessment will be all the more objective as the skilled person is more “real” i.e. close to a real-life skilled person. If an artificial business person is to be selected rather than a real business person for consistency with the Comvik principle, this – judging the tree from the fruit – raises doubts as to the practical value of the Comvik principle.

In addition, a clear drawback of the two-layer definition of the skilled person of Cardinal Commerce is that it entails a significant increase of complexity, generating additional issues and uncertainties regarding the scope of knowledge of the business skilled person and its interaction with that of the technical skilled person.

Other noteworthy points in Vasco include the following:

- The best starting point was defined by Vasco as the common general knowledge and considered so well known by the Board that it did not require to be documented.
- The Board refused the appellant’s request to submit the issue to the Enlarged Board of Appeal.

There is a head-on conflict between the Vasco decision and the Ricoh decision and the conflict relates to such a key part of the EPC as the definition of the state of the art of Article 54(2) EPC and, at least as importantly, to its interpretation, raising generally the topic of admissible interpretation methods of the EPC and more specifically of the restriction(s) a Board of Appeal may add in its interpretation of the EPC. Sharp disagreement between Boards of Appeal regarding issues of such utmost importance should absolutely be resolved. Unless Board of Appeal 3.5.01 which issued the Ricoh decision changes its position so as to resolve the matter, a referral to the Enlarged Board of Appeal would be warranted. As the Board has denied applicant’s request to submit the matter to the Enlarged Board of Appeal, the only way available is a referral by the President of the EPO.

It is to be noted that Guideline GVII, 2 which incorporates the Ricoh interpretation of Article 54(2) EPC has not been amended so far. This is odd in this author’s view since the Guideline has been explicitly challenged by a Board of Appeal decision. It would seem necessary for the information of the readers to at least mention the Vasco decision.

Beyond this issue, it is this author’s view that the Vasco decision raises broad ramifications.

The technical/non-technical distinction, a grey area

First, it questions the technical/non-technical distinction which is the mainstay of the doctrines applied by the EPO in the patentability assessment of computer-implemented inventions in accordance with the “any hardware approach” set out in the PBS and the Hitachi decisions, approved by the Enlarged Board of Appeal in decision G 03/8, and in the assessment of inventive step in accordance with the problem-solution approach, especially the Comvik approach.

It is to be stressed that while the Vasco decision explicitly challenges the distinction technical/non-technical applied in the Ricoh decision by the addition of a restriction to the definition of the state of the art in Article 54 EPC, it also, as noted above, implicitly challenges the two-layer definition of the Cardinal Commerce decision for the skilled person involved in the assessment of inventive step under Article 56 EPC.

A remarkable paradox regarding the technical/non-technical distinction is that, while the scope and meaning of “technical” is so central in EPO doctrines, there is no positive definition for the term “technical” in the case law of the Boards of Appeal. Article 52(2) EPC in combination with the “as such” restriction of Article 52(3) EPC sets forth a list of excluded categories. It can be said that such categories are “non-technical”, which provides a negative definition for “technical” inventions. However, the list of Article 52(2) EPC is not limitative, so that there is no certainty that any category of invention not listed in Article 52(2) EPC will be considered “technical”.

It is apparent in this respect that the developments of the internet and the application of computer technology and digitization to all areas of human activity makes increasingly blurry or inadequate the distinction between “technical” and “non-technical”. This is reflected in decision T 844/09 Paypal, which states that non-technical features may contribute to inventive step if they combine with technical features. Moreover, decision T 0144/11 (Security rating systems/Sato) of Board of Appeal 3.5.01 issued in August 2018, i.e. after the Vasco decision, offers a vivid admission of this blurry distinction by describing it as a “grey area” (Section 2.6).

Importantly, the Vasco decision does not discuss the scope of what is technical or not, it makes the distinction *irrelevant* to the definition of the state of the art in Article 54 EPC and to the definition of the skilled person in Article 56 EPC. To use a metaphor, this is like cutting the Gordian knot resulting from the ill-defined distinction between “technical” and “non-technical”.

Second, as the Vasco decision offers a stern rebuttal of the addition of a restricting condition to Article 54 EPC i.e. the exclusion of non-technical information from the scope of the state of the art, it could be argued that the “any hardware approach”, whereby compliance with Article 52(2)/52(3) EPC is shifted to the assessment of inventive step under Article 56 EPC, implies likewise the addition of a restricting condition to Article 56 EPC, namely, the condition of “technical content”. Such addition could then be criticized as a violation of the EPC on the basis of a stricter interpretation of the EPC.

While the Vasco decision itself does not take issue with the “any hardware approach” and asserts compliance with Comvik and these doctrines are “established jurisprudence” of the Boards of Appeal, it is this author’s view that the Vasco decision raises issues of principle and revisiting these doctrines deserves consideration.

This is all the more so as that recent decisions involve a growing complexity and resulting uncertainties and are a tough read even for seasoned professionals. An example is the decision T 1992/10 SAP.

The above-noted introduction in Cardinal Commerce of an “artificial” business person unaware of technology rather than a “real” business person raises concerns as to the quality of the assessment process.

Moreover, the definition of a non-technical feature is mitigated according to Paypal depending on whether this feature is combined with technical features. In other words, the qualification of a feature as non-technical becomes itself subject to a technical/non-technical distinction, a process which could be likened to a fractalization, i.e. the application of an initial distinction pattern to one of the elements produced by that initial pattern.

This author wishes to share other general reflections regarding the “any hardware approach”.

Article 56 EPC turned into a catch-all tool

A general comment regarding the term “technical” and the “technical content” assessed in the assessment of inventive step of Article 56 EPC according to the “any hardware approach” is that the CII-related categories excluded under Article 52(2) EPC are indeed disparate (mathematical methods, business methods, presentations of information, software). The negative definition of the term “technical” is thus made up of an addition of disparate negative definitions, and as such it is a weak definition.

Looking at the exclusions listed in Article 52(2) EPC, it can be stated that the policy objectives underpinning the exclusions are diverse. In the case of the digital implementation of a business or legal method, as illustrated in the Vasco

decision, the policy objective is to deny patentability to a straightforward implementation. In such a case, the assessment of inventive step makes sense. However, in the case of a mathematical method, the policy objective is to preclude a preemption of the method in every field of use, irrespective of whether the claimed method is innovative over the conventional method. In this case, the assessment of inventive step, taken strictly, is not an adequate tool. The relevant issues in this case are those covered by Articles 83 and 84 EPC: clarity, support in the description, sufficiency of description. Non-compliance with Articles 83 and/or 84 EPC may be decided in cases such as the lack of a detailed description of the implementation, a “broken chain” including a step relying on human intervention involving the subjectivity of a user, the absence of a specific field of application.

As these issues are conflated into the assessment of inventive step, it is not uncommon to find decisions in which defects such as mentioned above, while they do not depend on a comparison with the state of the art and relate to the description, lead to the conclusion that there is no inventive step. Such a conclusion has even been found in the case of a Rule 45 notification stating that a search of the state of the art was not possible.

Such reasoning relies on a link between the assessment of exclusions under Article 52(2) EPC and the notion of “technical problem” used in the problem-solution approach. According to this reasoning, for an invention to be eligible under Article 52(2) EPC, there has to be a “technical problem”. It is the author’s view that this overstretches the “technical problem” beyond its meaning in the context of the problem-solution approach. According to this approach, the technical problem is defined by reference to the closest state of the art, and according to EPO policy, it may have to be reformulated if the closest state of the art is different from that initially considered in the application. In other words, it depends on a view of the claimed invention through the prism of the closest state of the art. On the other hand, in the assessment of exclusions under Article 52(2) EPC, it makes sense to take into account all elements showing that the invention is eligible, such as the statement of a specific field of use, the description of specific implementations and the practical effects and/or advantages of the invention (which may refer to state of the art the applicant is aware of), irrespective of their relevance to a “technical problem” specifically linked to the closest state of the art. The assessment of eligibility under Article 52(2) EPC should thus focus on the description, not on the state of the art found as a result of a search carried out after filing. This is why Articles 83 & 84 EPC issues are usually relevant to the assessment of Article 52(2) EPC.

The global result is to turn Article 56 EPC into a catch-all tool. A negative implication is that while compliance with

Articles 83 and 84 should be given close attention in CII cases, their conflation into Article 56 is not conducive to such review.

Another negative implication is that it inevitably creates a disturbing gap with the case law of Member States. The courts of Member States are bound to decide on the grounds raised by the parties. When a party in a CII case challenges the validity of patent claims on the basis of the national counterpart of Article 52(2) EPC, the court has to make a decision on that ground. This happened in a decision of the Paris Appeal Court of December 16, 2016 (*Dassault Systemes vs. Sinequa*) in infringement proceedings involving a patent on a search engine. The Paris Court invalidated the patent on the basis of Article L.611-10.2 CPI, the French counterpart of Article 52(2) EPC. This decision is noteworthy in that the patent at issue was the French part of a European patent and thus offers a modicum of judicial oversight of great interest to which the EPO and the Boards of Appeal should heed, and this applies as well to court decisions of other Member States dealing with CII-related European patents.

It is also worth noting that the “any hardware approach” policy of the EPO was firmly rejected at the 2017 AIPPI World Congress – Sydney on October 17, 2017. Resolution #4 adopted by the Congress reads as follows *“Eligibility of a CII for patent protection should not depend on the prior art or any assessment of novelty or inventive step.”*

A recent example of the scant attention to Article 83 & 84 EPC issues is provided by the Guideline issued in October 2018 in relation to artificial intelligence cases. This document is only concerned with inventive step and totally silent on these issues. It is this author’s view, however, that such issues are indeed significant albeit not always readily apparent.³

The problem-solution approach in CII cases

These issues are compounded by the systematic use by the EPO of the problem-solution approach. This approach is strong but as any tool, its validity is not universal.² Its structured reasoning sequence works quite well when there is a clear, undisputable closest state of the art and provides an efficient safeguard against hindsight-guided reasoning, likely to occur when the examiner has broad discretion in assembling state of the art items. But there are not infrequent cases for which it is unsuitable: this happens for the so-called “problem inventions” i.e. cases

³ In contrast, the “2019 Revised Patent Subject Matter Eligibility Guidance” issued by the US Patent and Trademark Office includes a section dealing with compliance with Article 112(a) and (b), the US equivalent to Articles 83 & 84 EPC.

⁴ The claim that there is no invention if there is no inventive step as assessed under the problem-solution approach brings to mind this self-ironical definition of intelligence attributed to Alfred Binet, one of the creators of the IQ test: “Intelligence is what my tests measure”.

in which the problem is new and unobvious. Or it entails difficulties of its own making when there is no undisputable closest state of the art.

The field of CII offers a challenging area for the problem-solution approach, as strikingly illustrated by the Vasco decision. The conflation of the assessment of Article 52(2) EPC with Article 56 EPC entails the combination of a technical/non-technical distinction with the problem-solution approach, generating difficulties in particular for the definition of the field of the invention; the definition of the skilled person (two-layer definition of Cardinal Commerce); the selection of a closest state of the art.

A contribution on the same topic by Alasdair Kennington in the form of a three-part article published in **epi** Information 2016-1 to 3 “A Review of the “Problem and Solution” Approach to Inventive Step under Article 56 EPC” points out an issue arising from the Comvik approach which allows a non-technical feature – to be disregarded in the assessment of inventive step – to be shifted to the definition of the technical problem. The author warns in this respect that the technical problem must be known or obvious, otherwise the technical problem may provide a pointer to the solution and the reasoning is tainted with hindsight.

US case law on eligibility of CII inventions has come much more restrictive

The “any hardware approach” and the notion of “technical content” were developed by the Boards of Appeal in the early 2000’s. At that time, the meaning of the term “technical” did not raise the uncertainty which is experienced today as a result of the global digitization of all human activities and of the spread of internet. This period also saw a surge of business method patenting in the US as a result of the 1998 State Street Bank decision of the US Court of Appeal for the Federal Circuit (CAFC). This may have been a significant factor in the creation of the EPO doctrine of the “technical content” replacing the assessment of Article 52 EPC and its conflation into the assessment of inventive step, since the emphasis on “technical content” was seen as a bulwark against a flood of business method applications.

Since then, the US approach to CII inventions esp. business methods has swung from one extreme to the other with the Mayo/Alice decisions of the US Supreme Court. The principles set out in Alice do not match the “any hardware approach” of the EPO : the assessment of eligibility under 35 USC 101 of US patent law is separate from that of obviousness under 35 USC 103. However, judging from the case law of the CAFC and the rate of rejection of CII patent applications and invalidation of CII patents by the PTAB, the threshold of eligibility in the US and at the EPO for CII cases are by and large not so different now.

A review of the CAFC decisions implementing Alice shows that the eligibility assessment focuses on the content of the patent/patent application, paying special attention to detailed information regarding specific use, detailed implementations, practical results. This assessment thus relies on issues which could be linked to 35 USC 112(a) and (b), the US counterpart for Articles 83 and 84 EPC. As mentioned above, the recently published guidance of the US Patent & Trademark Office includes a section dedicated to these issues.

Conclusion

Decision T 2101/12 (Vasco) takes issue in blunt language with decision T 172/03 (Ricoh) having excluded non-technical information from the state of the art defined in Article 54 EPC and with Guideline GVII-2 as well. Consistent with this position, the Vasco decision departs from the two-layer definition of the skilled person implemented in decision T 1463/11 (Cardinal Commerce). More generally, the Vasco decision may be understood as advocating a strict interpretation of the EPC.

It has been put forward in this contribution that the Vasco decision questions the technical/non-technical distinction which is the mainstay of the EPO doctrines regarding the patentability assessment of CII inventions in accordance with the “any hardware approach” and the conflation of a “technical content” condition with the problem-solution approach systematically applied for the assessment of inventive step.

Recent Board of Appeal decisions show a pattern of increased complexity and introduce artificial notions such as the two-layer definition of the skilled person. The problem-solution approach entails difficulties of its own making particularly when applied to “mixed inventions”.

It is this author’s view that the Vasco decision should be reckoned with to trigger reflections on the current EPO policies and their desirable evolution. It has been stressed that the current policy turning Article 56 EPC into a catch-all tool tends to distract attention to Articles 83 & 84 EPC issues, which are typically relevant to the assessment of exclusions under Article 52(2) EPC. This assessment should thus focus on the content of the patent application, without taking into account the state of the art found as a result of the search, and such focus should be reflected in the Guidelines.

The Patenting of Mathematical Methods at the EPO

New EPO Guidelines for Examination

Dr. D. Herrmann (DE), Editorial Committee

The EPO has just completely revised its Guidelines for Examination regarding “mathematical methods” (EPO GL 2018, G–II, sections 3.3 to 3.3.2), which especially apply to simulations, designs, models and artificial intelligence. These substantial revisions are mainly based on the decisions T 1227/05 and T 1358/09 by the Boards of Appeal of the EPO and are further accompanied by other recent decisions. The revised EPO Guidelines and several decisions are analyzed herein. The EPO has now specified the circumstances in which features of a mathematical method are considered “technical features” and hence relevant for the assessment of the inventive step. A general trend appears to emerge at the EPO, which the new EPO Guidelines for Examination aim to account for. This trend is essentially in line with the practise at the Federal Court of Justice in Germany. The basis of this trend is now at stake due to the referral G 1/19 pending at the Enlarged Board of Appeal of the EPO, which might change the patent landscape in these fields of technology.

Mathematical methods play an important role in many different areas of technology: simulation, design, modelling or control of technical devices or processes, media enhancement or analysis, speech recognition, encryption/decryption of data, DNA analysis and medical applications are only a few examples. Artificial intelligence and machine learning are based on computational models and algorithms for classification, clustering, regression and dimensionality reduction, such as neural networks, genetic algorithms, support vector machines, k-means, kernel regression and discriminant analysis. Such computational models and algorithms are of mathematical nature. Hence, the below also generally applies to such emerging technologies.

According to Art. 52 (2) a), (3) EPC and the established practice of the EPO, mathematical methods *as such* are not considered to be technical and are thus excluded from patentability. However, this exclusion only applies if a claim is directed to a purely abstract mathematical method, i.e. if the claim does not require any technical means, such as a computer. If the claim is directed to subject-matter involving the use of technical means, then this subject-matter has technical character as a whole and is thus not excluded from patentability under Art. 52 (2), (3) EPC. Once it is established that the claimed subject-matter as a whole is not excluded from

patentability and is thus an invention in the sense of Art. 52(1) EPC, the claimed subject-matter is examined with respect to the other legal requirements, in particular novelty and inventive step.

The long-established standard practice of the EPO requires that, in order to involve an inventive step, claimed subject-matter must solve a technical problem with technical means in a way which is not obvious.

With regard to the patentability of mathematical methods, this meant and still means that features of a patent claim which relate to a mathematical method, such as calculations or operations of an algorithm, are analysed to determine if, in the



Dr. Daniel Herrmann

context of the claimed subject-matter, they are of technical character, i.e. if they contribute to producing a **technical effect**. If they do not make such a technical contribution, they are not taken into account during the assessment of inventive step, in accordance with the examination approach of the widely known COMVIK decision **T 641/00** of the EPO Boards of Appeal, and hence cannot support the presence of an inventive step. Normally, the EPO adds such non-technical features to the formulation of the objective technical problem to be solved, which is given to the skilled person as a kind of desired goal when starting from the closest prior art.

When looking at mathematical methods, the particularly relevant question is which criteria a mathematical method-related claim has to fulfil in order for the features of the mathematical method to be recognized as “technical features” that contribute to the technical character of the claimed subject-matter, so that it is to be taken into account when assessing inventive step.

In the revised Guidelines, the EPO appears to have the intention to re-formulate the technical effect requirement by stating that the contribution made by the features of a mathematical method to the technical character of the claimed subject-matter is to be assessed by taking into account whether these features, in context of the claim, fulfil one of the following two alternative requirements:

- the features serve a **technical purpose**, by its **application to a field of technology**,
- and/or
- the features are **adapted to a specific technical implementation**.

I. “Technical Purpose/Application”

The above first alternative is discussed in this section I. A **technical purpose or application** may make features relating to a mathematical method technical and hence relevant for the assessment of inventive step. However, the EPO emphasizes in the revised Guidelines that a generic purpose, such as “simulating or controlling a technical system” is not sufficient to confer technical character to a mathematical method, but rather that the technical purpose must be a specific one. Moreover, the mere fact that the mathematical method may possibly serve a technical purpose is not sufficient, either. That is, the claim must be **functionally limited to a specific technical purpose**, either explicitly or implicitly, which is based on the decision **T 1227/05** by Board 3.5.01 (see the headnote and reasons 3.1 therein). This is in line with a general understanding by the EPO, namely that a technical effect must be objectively, reliably and causally linked to a claimed feature (EPO GL 2018, G-II, sections 3.3.2 and 3.7), even though this does not appear to be stated in this exact manner in a decision by the Boards of Appeal of the EPO.

According to the revised EPO Guidelines, this functional limitation to a specific technical purpose could be achieved by establishing a sufficient link between the technical purpose and the mathematical method steps, for example, by specifying how the input and output of the sequence of mathematical steps relates to the technical purpose so that the mathematical method is causally linked to the technical effect.

How this can be done in practice is shown by the case underlying **T 1227/05**, which is also discussed in the EPO Guidelines (see EPO GL 2018, G-VII, section 5.4.2.4).

I.1 The Decision T 1227/05

The purpose of the patent application underlying this decision was to simulate or model the performance of a circuit under the influence of a $1/f$ noise and the proposed solution was based on the notion that $1/f$ noise can be simulated by feeding suitable random numbers into the circuit model.

An appeal was lodged against the examining division's decision to refuse the application with a claim directed to a method with mathematical steps for simulating a circuit

subject to $1/f$ noise on the grounds that the simulation method according to claim 1, as it then stood, constituted a mental act or mathematical method as such and was therefore excluded from patentability under Article 52(2) EPC as a non-invention.

In an annex to summons, the Board remarked that a computer-implemented embodiment of the method would overcome the non-invention objection (Art. 52 (2), (3) EPC). The inventive step assessment though could only consider features which contributed to the technical character of the simulation method. So what particularly needed to be examined was whether the mathematical formulae in the independent claims could contribute to a technical character.

In simplified terms, claim 1 of this case was the following (see EPO GL 2018, G-VII, section 5.4.2.4 and section III of **T 1227/05**):

A computer-implemented method for the numerical simulation of (the performance of) an electronic circuit subject to $1/f$ noise, wherein:

- (a) *the circuit is described by a model featuring input channels, noise input channels and output channels;*
- (b) *the performance of the input channels and the output channels is described by a system of stochastic differential equations;*
- (c) *an output vector is calculated for an input vector present on the input channels and for a noise vector y of $1/f$ -distributed random numbers present on the noise input channels; and*
- (d) *the noise vector y is generated by the following steps:*
 - (d1) *setting the number n of random numbers to be generated;*
 - (d2) *generating a vector x of length n of Gaussian-distributed random numbers;*
 - (d3) *generating the vector y by multiplying the vector x with a matrix L defined according to equation E1*.*

Equation E1 was explicitly specified in the claim.

As background information (see EPO GL 2018, G-VII, 5.4.2.4), this claim is directed to a method carried out by a computer for the numerical simulation of (the performance of) an electronic circuit subject to $1/f$ noise, which is one of the main sources of noise in electronic circuits. Features (a)-(c) specify the mathematical model used in

the numerical simulation. It involves a noise vector y of $1/f$ -distributed random numbers, i.e. random numbers having a particular statistical property typical of real (physical) $1/f$ noise. Steps (d1)-(d3) define the mathematical algorithm used for generating these random numbers. According to the description, this mathematical algorithm is particularly efficient in terms of computation time and storage resources required to generate the random numbers needed for the simulation.

The Board was also convinced that the claimed features relating to the mathematical method would allow for a resource-efficient simulation. The Board commented, however, that a technical advantage cannot be acknowledged based on the mere observation that a claimed method runs faster than a "conceivable" reference method. As it would always be possible to conceive of a slower reference method, a mere speed comparison would not a suitable criterion for distinguishing between technical and non-technical procedural steps (reasons 3.2.5). This comment by the Board is controversial and obviously hard to digest by software programmers.

The Board argued that beyond its implementation, a procedural step may contribute to the technical character of a method only to the extent that it serves an **adequately defined technical purpose** of the method (reasons 3.1).

In this context, the Board noted that the metaspecification of an (undefined) technical purpose (simulation of a "technical system") would not be considered adequate. However, the board was persuaded that the above underlined purpose of the method, namely simulation of a circuit subject to $1/f$ noise, constitutes an adequately defined technical purpose for a computer-implemented method, provided that **the method is functionally limited to that technical purpose** (see reasons 3.1 and headnote). In the case of this decision, the stated purpose - simulation of a circuit subject to $1/f$ noise - was established in the further steps of the claimed method. On the basis of the physical and mathematical derivation specified in the description, it was verifiable that the random numbers generated according to the claims actually introduce $1/f$ noise into the circuit simulation. The board was therefore persuaded that the independent method claims are, beyond the mere purpose limitation, functionally limited to the numerical simulation of a noise-affected circuit (reasons 3.1.2).

As the algorithm defined by steps (d1)-(d3) requires less computer resources than other known algorithms, in the context of the claimed method being functionally limited to the numerical simulation of a noise-affected circuit, this results directly in a reduction of the computer resources required for the claimed technical purpose, namely the numerical simulation of an electronic circuit subject to $1/f$ noise, which is the achieved technical effect. According to the Guidelines (see EPO GL 2018, G-VII,

section 5.4.2.4), one should note that if the claim were not limited to the numerical simulation of an electronic circuit subject to $1/f$ noise, the mathematical algorithm defined by steps (d1)-(d3) may not be considered serving any technical purpose and may thus not be considered to contribute to the technical character of the claim, because requiring less computer resources than another mathematical algorithm being on its own not sufficient in this respect according to the above comment by the Board in **T 1227/05** (reasons 3.2.5).

Interestingly, the Board also noted that while the invention may be preceded by a mental or mathematical act, the claimed result must not be equated with this act. The above claim would rather relate to a simulation method that cannot be performed by purely mental or mathematical means, not to the thought process that led to that simulation method (reasons 3.2.1).

Moreover, the Board made important observations with regard to simulation (and design or model) software, which, especially today, are generally applicable to the patenting of mathematical methods.

The Board noted that a simulation performs technical functions typical of modern engineering work. It provides for realistic prediction of the performance of a designed apparatus, such as a circuit, and thereby ideally allows it to be developed so accurately that a prototype's chances of success can be assessed before it is built. The technical significance of this result increases with the speed of the simulation method, as this enables a wide range of designs to be virtually tested and examined for suitability before the expensive apparatus fabrication process starts. Without technical support, advance testing and/or qualified selection from many designs would not be possible, or at least not in reasonable time (see reasons 3.2.2, headnote). Such simulation methods could also not be denied a technical effect merely on the ground that they do not yet incorporate the physical end product (see headnote).

For these above reasons, in the Board's view, all steps relevant to circuit simulation - and that includes the mathematically expressed claim features - contribute to the technical character of the claimed simulation method and have to be taken into account when assessing inventive step, in particular non-obviousness (reasons 3.2.4 and 4).

On the one hand, the decision **T 1227/05** has been confirmed in several decisions by the EPO Boards of Appeal, such as **T 1784/06** and **T 988/12**.

The application underlying **T 988/12** related to a method for simulating and analyzing one or more scenarios for a 4G broadband service to be deployed and the decision emphasized that this purpose would cover both business scenarios and technical scenarios and would thus be an

inadequately defined technical purpose which does not necessarily render technical the features relating to the simulation.

On the other hand, several decisions questioned whether it is sufficient that the technical purpose be “adequately defined” and the claim limited to that purpose, as **T 1227/05** appears to suggest. Such doubts were expressed in **T 1630/11** (point 7.1 of the reasons), **T 1265/09** (point 1.13 of the reasons, penultimate paragraph) and **T 531/09** (point 3 of the reasons). In this context, it is, however, important to note that **T 1227/05** does not appear to suggest that a mere technical purpose limitation in the claim suffices. Rather, the claimed operations must credibly lead to the claimed technical purpose. In case of **T 1630/11**, however, this question was left open because the Board considered that the technical purpose of the claimed simulation was in any case not adequately defined. Claim 1 was concerned with simulation only insofar as it specified the execution of a multi-processor specification developed as a graphical program. According to the Board, the claim was not concerned with the “simulation” of any specific such processor, nor any specific class of processors.

Patent practitioners can therefore conclude from decision **T 1227/5** and the discussion in the EPO Guidelines that method claims directed to a mathematical method should contain an adequately defined technical purpose and that the mathematical method is to be functionally limited to that purpose. By this functional limitation to the technical purpose, the features relating to mathematical method contribute to the technical character of the claimed subject-matter and become relevant for the assessment of inventive step.

I.2 Examples in the EPO Guidelines for Technical Purposes/Applications

In the revised Guidelines, the EPO provides a list of examples of technical applications providing such technical purposes for the features relating to the mathematical method:

- controlling a specific technical system or process, e.g. an X-ray apparatus or a steel cooling process;
- determining from measurements a required number of passes of a compaction machine to achieve a desired material density;
- digital audio, image or video enhancement or analysis, e.g. de-noising, detecting persons in a digital image, estimating the quality of a transmitted digital audio signal;
- separation of sources in speech signals; speech recognition, e.g. mapping a speech input to a text output;

- encoding data for reliable and/or efficient transmission or storage (and corresponding decoding), e.g. error-correction coding of data for transmission over a noisy channel, compression of audio, image, video or sensor data;
- encrypting/decrypting or signing electronic communications; generating keys in an RSA cryptographic system;
- optimizing load distribution in a computer network;
- determining the energy expenditure of a subject by processing data obtained from physiological sensors; deriving the body temperature of a subject from data obtained from an ear temperature detector;
- providing a genotype estimate based on an analysis of DNA samples, as well as providing a confidence interval for this estimate so as to quantify its reliability;
- providing a medical diagnosis by an automated system processing physiological measurements;
- simulating the behavior of an adequately defined class of technical items, or specific technical processes, under technically relevant conditions

The revised EPO Guidelines emphasize that whether a technical purpose is served by the mathematical method is primarily determined by the direct technical relevance of the **results** it provides.

The revised EPO Guidelines also again remind that a technical nature of the data or parameters used for a mathematical method does not necessarily imply that the mathematical method contributes to the technical character of the claimed subject-matter (**T 2035/11**, **T 1029/06**, **T 1161/04**).

However, the revised EPO Guidelines also state that, in the context of computer-aided design of a specific technical object (product, system or process), the determination of a technical parameter which is intrinsically linked to the functioning of the technical object, where the determination is based on technical considerations, is a technical purpose (**T 471/05**, **T 625/11**).

According to an example provided by the revised EPO Guidelines, in a computer-implemented method of designing an optical system, the use of a particular formula for determining technical parameters, such as refractive indices and magnification factors, for given input conditions so as to obtain optimal optical performance makes a technical contribution. As another example, determining by iterative computer simulations the maximum value that an operating parameter of a nuclear

reactor may take without risking rupture of a sleeve due to stress makes a technical contribution.

In contrast, where the computer-aided determination of the technical parameters depends on decisions to be taken by a human user and the technical considerations for taking such decisions are not specified in the claim, a technical effect of improved design cannot be acknowledged since such an effect would not be causally linked to the claim features (**T 835/10**).

According to other examples provided by the revised EPO Guidelines, if a computer-implemented method results merely in an abstract model of a product, system or process, e.g. a set of equations, this *per se* is not considered to be a technical effect, even if the modelled product, system or process is technical (**T 49/99**, **T 42/09**). For example, a logical data model for a family of product configurations has no inherent technical character, and a method merely specifying how to proceed to arrive at such a logical data model would not make a technical contribution beyond its computer-implementation. Likewise, a method merely specifying how to describe a multi-processor system in a graphical modelling environment does not make a technical contribution beyond its computer-implementation.

I.3 T 0489/14 - Referral to the Enlarged Board of Appeal (G 1/19)

In the case underlying T 0489/14, the claims of the main request were directed to a computer-implemented method of modelling pedestrian movement in an environment, wherein the environment was not further specified, and the claim was focused on operations of simulating movement of pedestrians through the environment.

On the one hand, the Board tended to consider the features relating to the simulation as mental acts, and thus as non-technical features, and the computer implementation of the simulation as the only technical aspect of the claimed method, which would, however, render the claimed subject-matter obvious over a general-purpose computer (see reasons 5 to 8, 12 and 17). In particular, the Board argued that a technical effect would require a **direct link of the simulation with physical reality**, such as a change in or a measurement of a physical entity (reasons 11 and 23).

On the other hand, the Board also acknowledged the findings of T 1227/05 and concluded that the features relating to the simulation would be technical if one followed T 1227/05 (see reasons 13 to 15 of T 0489/14).

However, the Board was not fully convinced by the reasoning provided in T 1227/05, which is outlined in section I.1 above, and considered the computer-implemented

simulation as a tool to only assist the engineer's cognitive process of verifying a design of a circuit, which, in the Board's view would be a fundamentally non-technical process. Further, the Board focused in T 0489/14 a lot on the argument, that a computer-implemented simulation method would provide a greater speed for the testing of designs, when arguing that any computer algorithm would be faster than a mental execution (see reasons 15).

Overall, the Board concluded that both, the question of patentability of simulation methods would be a point of law of fundamental importance and the Board's intended deviation from the interpretation and explanations of the EPC given by T 1227/05 would justify a referral of the following questions to the Enlarged Board of Appeal, which is presently pending under the case number G 1/19:

1. In the assessment of inventive step, can the computer-implemented simulation of a technical system or process solve a technical problem by producing a technical effect which goes beyond the simulation's implementation on a computer, if the computer-implemented simulation is claimed as such?
2. If the answer to the first question is yes, what are the relevant criteria for assessing whether a computer-implemented simulation claimed as such solves a technical problem? In particular, is it a sufficient condition that the simulation is based, at least in part, on technical principles underlying the simulated system or process?
3. What are the answers to the first and second questions if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design?

It will be highly important for the patent practice, as well as interesting from the legal point of view, to follow how the Enlarged Board will view the referral as such, the argumentation provided in T 0489/14 (especially in relation to T 1227/05), and the above posed questions.

II. "Technical Implementations"

The above second alternative is discussed in this section II. The revised EPO Guidelines continue with outlining an alternative path according to which a mathematical method may also contribute to the technical character of the invention independently of any technical application when the claim is directed to a **specific technical implementation** of the mathematical method and the mathematical method is particularly **adapted** for that implementation in that its design is motivated by technical considerations of the **internal functioning** of the computer, which is based on **T 1358/09** by Board 3.5.07

(see reasons 5 therein). According to the single example provided by the revised Guidelines, the adaptation of a polynomial reduction algorithm to exploit word-size shifts matched to the word size of the computer hardware is based on such technical considerations and can contribute to producing the technical effect of an efficient hardware implementation of said algorithm.

II.1 The Decision T 1358/09

The invention of the application underlying this decision is concerned with the computerized classification of text documents. This is done by first building a "classification model" and then classifying documents using this classification model. The classification model is built on the basis of a set of documents which have been previously classified into a number of predefined classes. In particular, once the classification model has been built, an unclassified document is classified by representing it as a vector in the same vector space and determining the subspace to which the vector belongs. The document is then classified into the class corresponding to this subspace (T 1316/09, reasons 3).

The Board argued that classification of text documents would certainly be useful, as it may help to locate text documents with a relevant cognitive content, but in the Board's view this does not qualify as a technical purpose in the sense of section I above. Whether two text documents in respect of their textual content belong to the same "class" of documents would not be a technical issue and the Board also referred to the decision T 1316/09, which held that methods of text classification per se did not produce a relevant technical effect or provide a technical solution to any technical problem.

In T 1358/09, the Board agreed with the appellant in that a human being would not apply the claimed classification method to perform the task of classifying text documents. The Board further accepted that the proposed computerized method may be faster than classification methods known from the prior art.

Interestingly, the Board emphasized that not all efficiency aspects of an algorithm are by definition without relevance for the question of whether the algorithm provides a technical contribution. In this context, this decision specifies the above (see section I) mentioned statements made in reasons 3.2.5 of decision T 1227/05. If an algorithm is particularly suitable for being performed on a computer in that the **algorithm design was motivated by technical considerations of the internal functioning of the computer**, it may arguably be considered to provide a technical contribution to the invention and the Board also referred to the decision T 258/03 (reasons 5.8), which refers to decision T 769/92 (headnote I). However, such technical considerations would have to go beyond merely finding a

computer algorithm to carry out some procedure and the Board also referred to the decision G 3/08 (reasons 13.5 and 13.5.1), which commented on decisions T 769/92 and T 258/03.

In the present case, T 1358/09, the Board considers that no such technical considerations would be present. According to the Board, the claimed algorithm would not go beyond a particular mathematical formulation of the task of classifying documents. The aim of this formulation would clearly be to enable a computer to carry out this task, but no further consideration of the internal functioning of a computer could be recognized by the Board.

Important for patent practitioners is also the observation by the Board according to which it would be an inherent property of deterministic algorithms to provide reliable and objective results and that the mere fact that an algorithm leads to reproducible results would not imply that it makes a technical contribution (reasons 5.6).

According to the Board, the only implementation features specified in the claim of this case are references to the method being "computerized" and the text documents being "digitally represented in a computer". However, the Board found that these technical implementations of the mathematical algorithm would be obvious.

The decision T 1358/09 was supported by other decisions, such as T 2418/12 and T 22/12, wherein the latter rephrased the above condition by stating that if the design of an algorithm were motivated by a problem related to the internal workings of the computer, e.g. if it were adapted to a particular computer architecture, it could, arguably, be considered as technical (reasons 2.8).

Overall, it appears to be more difficult to fulfil the requirement of the "technical implementations", because advantages of algorithms normally reside in the particular coding involved which, however, can and should usually be executed in the same manner by any computer, which may be one reason, why the Guidelines are quite silent on examples for this requirement.

III. Parallels with Federal Court of Justice Case Law in Germany

The above trend of the EPO Boards of Appeal appear to be in harmony with the decision of the Federal Court of Justice in Germany (X ZB 1/15 – Flugzeugstand, 2015) on the subject of mathematical methods.

The matter at the heart of the decision of the Federal Court of Justice concerned the refusal of a German patent application, whose independent claim was claiming a method for determining a state of an airplane.

The state was a position, a velocity and an attitude of the airplane. The independent claim further specified several mathematical operations including determining a number of measured values relating to the state of the airplane and processing the measured values in a particular manner using a Kalman-Filter to estimate the state of the airplane. The crucial aspect of the invention was the selection and computing of the data, which were fed to the Kalman-Filter, wherein the Kalman-filter was advantageously fed by a smaller number of values, because this reduces the time needed for data processing.

The Court starts the analysis with the well-accepted requirement that features of a mathematical method, as any other claimed features, must contribute to a technical solution of a specific technical problem to be patentable (see headnote a) and reasons III.1 to III.2.a)). The Court also noted that technical activity involves working with natural forces, wherein laws of nature are usually described by mathematical methods. According to the Court, the application of such mathematical methods for achieving a specific technical success or result would be technical and a mathematical method could only be considered non-technical if, in context of the claimed subject-matter, the method did not relate to any purposely applied natural forces (see headnote b) and reasons III.2.b)).

The Court found that the claimed mathematical operations, which were not disclosed in the prior art, would sufficiently relate to purposely applied natural forces, because the increased speed in data processing obtained by these features would serve the purpose to more reliably estimate the state of the airplane and would hence directly affect the functioning of the system which is used to estimate the state of the airplane (see headnote c) and reasoning III.3.a)). In this context, the Court also emphasized that an inventive step must not be denied based only on the reason that no advantage can be identified, i.e. that the invention is a mere alternative compared to the prior art (see headnote d) and reasons III.3.b)).

Therefore, the Federal Court of Justice in Germany also looked at the advantages provided by the mathematical operations and whether these advantages directly translated to a technical effect, here a different functioning of the technical system which estimates a state of an airplane. While the terminologies used by the Federal Court of Justice in Germany and the Boards of Appeal of the EPO for their assessments of technical contributions of mathematical methods are different, the Court and the Boards, as exemplified by **T 1227/05**, are imposing quite similar requirements on claim language for features of mathematical methods to be considered technical, and hence relevant for the assessment of inventive step.

Conclusion

In summary, if a mathematical method does not serve a technical purpose and if the claimed technical implementation does not go beyond a generic technical implementation, the mathematical method is to be expected to not contribute to the technical character of the invention (EPO GL 2018, section 3.3).

Thus, patent practitioners should adapt their drafting of claims which contain features relating to a mathematical method by either incorporating an adequately defined technical purpose or by incorporating an adaptation of the mathematical method to a specific technical implementation (like a “fingerprint” of the underlying hardware in the mathematical method). For an adequately defined technical purpose, it may not suffice to merely include the purpose limitation relating to simulating a (specific) technical device, but rather the stated purpose should also be established in the further steps of the claimed method, so that a functional limitation to this technical purpose is credible. An advantage associated within the mathematical method may then arguably directly result in a technical effect.

The revised Guidelines indicate a specifying, or even tightening, of the criteria applied by the EPO that features relating to a mathematical method must fulfil in order to be treated as a technical feature and hence relevant for the assessment of the inventive step. Even though the employed terminology is different, the case law by the Boards of Appeal, which led to these revisions of the Guidelines, and the decisions by the Federal Court of Justice in Germany formulate similar criteria for the patenting of mathematical methods. The basis of these criteria is now at stake due to the referral G 1/19 pending at the Enlarged Board of Appeal of the EPO. In case G 1/19 leads to a stricter legal view deviating from T 1227/05, then applicants might consider filing less patent applications about computer-implemented simulation or design methods with the EPO and might prefer to choose the GPTO instead.

Breeding Issues: Fruits of Crossing the Administrative Council – Part I

H. Sendrowski (DE)

These are busy times for the Enlarged Board of Appeal (EBA). Within two months, three Technical Boards of Appeal (in cases T 489/14, T 318/14 and T 831/17) have referred questions under Art. 112 (1) (a) EPC, and now the President of the EPO has also referred "a case" (see EPO web communication of 29 March 2019), treated at the EBA under the caption "G 3/19". The President feels compelled to react expeditiously to an alleged legal uncertainty caused by decision T 1063/18. In this decision the Technical Board of Appeal held, in no unclear terms, that the Administrative Council acted *ultra vires* when introducing a new rule in the Implementing Regulations and therefore patents cannot be refused (or revoked) by invoking this rule.

This article attempts to elucidate ways of easing what appears to be a veritable disagreement between the Board of Appeal on one side and the Office, its Administrative Council, most Member States, the European Parliament and Commission and a number of vocal NGOs on the other side. As the legal field ploughed by decision T 1063/18 is rather special (exemptions from patentability for plants exclusively obtained by essentially biological processes), the article refrains, for the benefit of a larger audience, from taking one side or the other with regards to the correctness or desirability of decision T 1063/18. Instead it merely explores the means available for the Member States and parties to cope with the situation.

In the first part, the questions referred by the President will be analysed for their compatibility with Art. 112 (1) (b) EPC. As will be argued below these questions are unlikely to achieve what is necessary to reconcile the Board of Appeal with the relevant political actors. In the second part, alternatives to a Presidential referral are discussed, i.e. participation of the President (or a delegate of his) to individual appeal proceedings, a referral to the ECJ and amendments to the EPC.

Before addressing the President's questions in more detail, a brief summary of the technical and legal background is unavoidable.

According to Art. 53 (b) EPC, European patents shall not be granted in view of (1) plant varieties or (2) essentially biological processes for the production of plants. In joint

decisions G 2/12 and G 2/13 the EBA had decided that product claims to plants other than individual plant varieties are in principle allowable, even if the only known means at the filing date for producing such plants is an essentially biological process, which *eo ipso* is not patentable. In reaction to these decisions, the European Parliament in Resolution 2015/2981(RSP) called "on the Commission to clarify the scope and interpretation of [the Biotech] Directive 98/44/EC ... in order to ensure legal clarity regarding the prohibition of the patentability of products [sic] obtained from essentially biological processes." The European Commission subsequently published a corresponding Notice (2016/C 411/03). The EPO Administrative Council, pressed by the EU Member States, amended the Implementing Regulations and *inter alia* introduced R. 28 (2) EPC which prohibits the grant of patents directed to plants or animals exclusively obtained by means of an essentially biological process.

In the case underlying decision T 1063/18 the examining division had refused a patent invoking said R. 28 (2) EPC. The Technical Board of Appeal found that the Rule was irreconcilably at odds with the interpretation of Art. 53 (b) EPC rendered by the EBA in decisions G 2/12 and G 3/12. The Board saw no reason to deviate from the EBA's interpretation. In what appears to be a first, the Board invoked Art. 164 (2) EPC to decide that R. 28 (2) EPC cannot take away what Art. 53 (b) EPC as interpreted by the EBA gives; a decision holding the subject-matter of a claim to be within the exception to patentability of R. 28(2) EPC is to be set aside. Without any recourse to the EBA the Board held the Administrative Council not competent to amend the EPC, here Art. 53 (b) EPC, by amendment of the Implementing Regulations, here R. 28 (2) EPC, and rejected the idea of the EU Commission having any say in the interpretation of the EPC or of EU law such as the Biotech Directive. The Commission's Notice had no legal authority.

Under these circumstances, it comes as no surprise that the EPO and Member States chose not to accept this lying down and accused the Board of causing legal uncertainty. They saw a remedy to this situation in a presidential referral to the EBA. Thus, hereinafter some aspects that could influence the outcome of referral proceedings are discussed and alternative ways for resolution are examined.

Under Art. 112 (1) (b) EPC the President may, to ensure uniform application of the law or if a point of law of fundamental importance arises, refer a point of law to the EBA where two Boards of Appeal have given different decisions on that question.

The President has submitted two questions (see <https://www.epo.org/law-practice/case-law-appeals/eba/pending.html>), both of which can be answered by yes or no, but the second one is only raised in case the first question is answered to the positive. The questions are:

1. Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?
2. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?

Who may – or actually should – ask which questions to whom and at what point in time has been a recurring issue at least since medieval times (see *Wolfram von Eschenbach*, Perceval, books V and IX). It is thus of little surprise that this topic received intense attention at the time of drafting the EPC. A right of the President to submit questions had been foreseen already in the earliest preparatory documents (BR/11/69), and already at that time the scope of this right was contentious: The early drafts contained explicit provisions for allowing a Presidential referral in two situations: either a question could be referred any time except where such question arises in proceedings on a case, or a referral would be admissible where two Boards of Appeal have given different decisions on a point of law. During deliberations, the first alternative was criticised due to concerns that the EBA should not, as a court-like institution, have to deliberate abstract questions. For such questions the President can make full use of the EPO's legal department. Furthermore, it was feared that if the EBA gave an opinion without an actual appeal case and is later confronted with the same questions in a referral by a Board of Appeal, then the EBA might be biased in favour of adhering to the pre-formed opinion (BR/12/69, sec. 55). It was never doubted that the President should have the possibility of recourse to the EBA where the Boards of Appeal would maintain divergent opinions on questions of law. The more widely drafted right of the President was, however, deliberately deleted during the September 1971 Luxembourg conference (BR/132/71, sec. 45).

In view of the clear intention of the legislator as derivable from the wording of the Convention itself and from the *travaux préparatoires*, the EBA summarised in decision G 3/08 that the President may refer questions under Art. 112 (1) (b) EPC only if the absolute preconditions are fulfilled: (1) The President must refer a point of law that is of fundamental importance instead of a merely abstract one and (2) there must be a current, continuing divergence of decisions given by the Boards of Appeal. Hereinafter, it will be first discussed if the questions referred by the President are indeed focused to a fundamental point of law. After that, admissibility of the President's questions will be analysed in view of the criterion of persistent case law divergence.

In lieu of a legal definition in the EPC itself, a recurrent definition used by the German Federal Constitutional Court (FCC) may serve as an indicator of a generally accepted definition (see, for example, BVerfG 2 BvR 2157/15, sec. 22). According to the FCC a question of law is of fundamental importance if all of the following criteria are fulfilled: The question must be relevant to a decision; it is in need of clarification and capable of clarification; it may arise in an indefinite number of other cases (see also G 1/13 sec. 2); its answer is doubtful, for example because different views were held on this point; and a clarification by the supreme court had not yet taken place by the time the judgement under appeal was delivered.

The Technical Board in decision T 1063/18 has denied that a question of fundamental importance has arisen in the context of the amendment of R. 28 EPC. The Board explained that the situation was that of an *acte éclairé*, a clarification by the EBA had already taken place: The EBA had interpreted Art. 53 (b) EPC, and "any interpretation of the EPC by the EBA implies that the law should always have been read in conformity with that interpretation."

A finding of an *acte éclairé* requires a cautious approach. A decision by the EBA is merely a text, and, as Socrates observed (see *Phaidros*, 276c), written words cannot defend themselves by argument and cannot teach the truth effectually, a text "always needs its father to help it". Thus even where the EBA had rendered an interpretation of the EPC there remains a need to let the EBA speak again, if only to complete or correct the written thoughts. The desire to hear the EBA again on a subject must, however, be balanced with the vocation of the Boards of Appeal to decide matters; they are the first – and only – judicial instance vested with the power to settle an appeal, so they ought to make full use of their powers. Balancing these demands another Board in decision T 297/88 developed some non-limiting criteria when a re-referral to the EBA appears to be advised:

- (i) The reasoning of the EBA was so deficient that doubts as to the accuracy of the decision as such are inevitable. This condition is obviously not met in the present case, because not only was the Board satisfied that it can fully comprehend and follow the reasoning of the EBA, also the EU Commission and the Administrative Council have not lamented any profound confusion in the EBA's reasoning.
- (ii) The reasoning of the EBA was based on false assumptions and, therefore, doubts are raised as to the conclusion reached. This criterion is invoked by the EU Commission who bases its Notice on an analysis of the *travaux préparatoires* relating to the Biotech Directive. The Board in decision T 1063/18 even conceded that the EBA probably would have taken the Notice into consideration; but the Board concluded that the EBA would not have decided any different.
- (iii) Although the conditions were right and the reasoning was conclusive, legal and/or technical developments have occurred after the previous EBA decision which may make it desirable, in the public interest, for the question to be re-examined by the EBA. This condition requires further inspection.

Introducing a new Rule to the Implementing Regulations could be qualified "legal development". The Administrative Council invoked its right to amend the Implementing Regulations in order to bind the Boards of Appeal to a change in law ("for practical application of the Convention, only the interpretation of its provisions laid down in the Implementing Regulations is binding", see CA/56/17 sec. 24), thereby trying to effectively remove the basis of the EBA's reasoning.

The Board found that an amendment of the Implementing Regulations does not constitute a development requiring another referral of a question already answered by the EBA: Once the meaning of an Article of the EPC has been established by an interpretation of the EBA, this meaning "cannot be overturned by a newly drafted Rule of the Implementing Regulations, the effect of which is to conflict with this interpretation" (see, for example, T 39/93 sec. 3; G 1/88 sec. 4; G 2/95 sec. 1; G 6/95 sec. 4; G 2/07 sec. 2.2; J 14/91 sec. 2.2).

This reasoning, albeit in strict accord with well established case law, is not beyond doubt. The Administrative Council is not only competent to amend the Implementing Regulations, it is also competent to amend, inter alia, Art. 53 of the Convention to bring it "into line with European Community legislation relating to patents" (Art. 33 (1) (b) EPC). This provision has been introduced during the Diplomatic Conference of 29 November 2000. According to the *travaux préparatoires* (MR/2/00) the new power

invested in the Administrative Council was intended to allow "any consensus achieved at EU level to be directly echoed in the EPC", avoiding the need for a new Diplomatic Conference. Thus, where the Administrative Council intends to bring the EPC into line with EU law such as the Biotech Directive, it may amend both the Implementing Regulations and the Convention itself. Focusing exclusively on the order of precedence of potentially conflicting provisions is thus not sufficient. It is possible that the Administrative Council, intending to change the provisions of the EPC, merely erred in amending the Implementing Regulations instead of the Convention itself. In this situation, it would have been incumbent on the EBA to rule if the Administrative Council benefits from the legal principle that the true will and not its erroneous expression is decisive ("*falsa demonstratio non nocet*"), and if the Administrative Council should be granted any deadline for correcting such error in formal implementation of its true will. For reasons elucidated in the second part of this article it is unlikely that the Administrative Council would act within its competence when amending Art. 53 (b) EPC to bring it in line with present R. 28 (2) EPC. This expectation does, however, not take away from the proposition that the competence of the Administrative Council is a fundamental point of law suitable for a referral to the EBA.

Another type of legal development could also be taken into consideration. The national laws of some Member State (DE, FR, IT, NL) have been changed in accordance with the Commission Notice, repeating the changes introduced by R. 28 (2) EPC. According to Art. 31 (3) of the Vienna Convention, recourse may be had to (any) subsequent practice in the application of a treaty which establishes the agreement of the parties to the treaty regarding its interpretation. It is important to note that the "subsequent practice" need not be implemented by all Member States as long as it is discernible that there is indeed an agreement of some sort. However by decisions G 2/12 and G 2/13 the EBA have already rejected that an accord of the Member States could be identified from the isolated changes in national laws. The Board in decision T 1063/18 therefore could rely on authority when disregarding these developments.

The criteria (i) - (iii) are not exhaustive. **The European Patent Organisation operates in a political context and recognises that it does so (CA/123/00). A question law is also of fundamental importance if a legal opinion held by the Boards and the EBA is contradicted for weighty reasons.** The expression of differing views is not limited to opinions expressed by the courts, it also includes opinions expressed in literature. Thus the EU Commission Notice is not by its very nature irrelevant. It is not decisive that the Notice cannot have any binding effect on the Boards, nor that the Commission is not called to authoritatively interpret EU law or to represent

the EPC Member States. Instead, the Notice should be treated at least as an educated opinion on the EU legislator's intentions. And the opinions expressed in the Notice were not apparently isolated but received further (political) support, for example by the EU Council (OJEU 2017/C 65/02). Of course, the Notice itself and the support it received are not legal developments, they are entirely of political nature. However, it is a daily task of the Boards to hear arguments from interested parties, to deal with the merits of such arguments and to weigh them when arriving at a conclusion.

In summary, the questions asked by the President are not abstract ones, they are not already finally decided by the EBA (no *acte éclairé*) and there is a legitimate interest to have these questions answered.

This finding, however, does not help in the present Presidential referral. **Even if the President's questions are worth being dealt with at the EBA, admissibility of a referral depends on that the President – instead of a Board of Appeal – is entitled to submit these questions.**

In addition to there being a point of law of fundamental importance, the President's right according to Art. 112 (1) (b) EPC depends on at least two Boards of Appeal having given different decisions on that question. The EBA has commented extensively on this limitation of the President's right: A "presidential referral is not admissible merely because the European Parliament and Council have failed to adopt a directive or because consistent Board rulings are called into question by a vocal lobby", "the right of referral does not extend to allowing the President, for whatever reason, to use an Enlarged Board referral as a means of replacing Board of Appeal rulings with the decision of a putatively higher instance" (G 3/08 sec. 7.2.7). For a Presidential referral to be admissible it is mandatory that "two Boards of Appeal have given different decisions on the questions referred" (G 3/08, sec. 3). The EBA has particularly emphasised this aspect: a "referral is justified only if at least two Board of Appeal decisions come into conflict with the principle of legal uniformity. The object and purpose of Article 112(1)(b) EPC is to have an Enlarged Board decision re-establish legal uniformity when it has clearly been disrupted, not to intervene in legal development" (G 3/08, sec. 7.3.1). "Decisions of other (national) courts are not relevant when examining the admissibility of a referral" (G 3/08, sec. 5). The ambit of a Presidential referral can only be to remove a conflict in case law where such conflict makes it "difficult if not impossible for the Office to bring its patent granting practice into line with the case law of the Boards of Appeal" (G 3/08, sec. 7.2.6). Thus a mere unwillingness of the Member States, the Administrative Council or the EPO to abide with an interpretation of the EPC by a single Board or by the EBA is not sufficient.

In the light of these explanations, admissibility of the President's questions is legally doubtful.

For the first question the President invokes an actual divergence of case law. Specifically it is argued that decision T 1063/08 (and T 39/93 cited therein) differs from decisions T 272/95 and T 315/03. The President interprets the latter decision as agreeing that the Administrative Council may, by amendment of the Implementing Regulations, restrict (the questions euphemistically insist on using the term "clarify") the scope of Articles of the Convention. However, both decisions only touched this question and found that the respective provisions of the Implementing Regulations were not in material conflict but could be interpreted in accordance with the corresponding Article of the Convention. Thus, the arguments relied on in the present referral are in essence based on obiter dicta (against admissibility of such referrals *Moser in Beier/Haertel/Schricker*, Münchner Gemeinschaftskommentar zum EPÜ, Art. 112, sec. 30). Until decision T 1063/08 the Boards never had to decide if the Administrative Council may overturn an EBA's interpretation of an Article by means of amending the Implementing Regulations.

It is also argued that decision T 1063/08 diverges from an earlier EBA decision (G 2/07). Given the clear systematic separation of Boards on Appeal and Enlarged Board of Appeal (see Art. 15, 20, 21, 112 and 112a EPC) it is not prima facie convincing to argue that a divergence between one Board of Appeal decision and an earlier EBA decision is a divergence in Board of Appeal decisions.

However, the President's right to a referral must not be unduly restricted. The intention of Art. 112 EPC was always to safeguard uniformity of Board of Appeal decisions. Such uniformity must be apparent to ensure confidence of the users (applicants and opponents) of the European patent system and of the general public alike. Otherwise doubts would remain whether decisions depend on the preferences of the Board of Appeal in charge of a case, thereby thwarting legal certainty. Thus, even a divergence in obiter dicta (see G 3/93, sec. 2) or between Board of Appeal and EBA can legitimise a referral under Art. 112 (1) (b) EPC. And in a situation like the present where so much is at stake for applicants, care must be taken not to overdo insistence on formal admissibility.

In summary, the first question referred seems admissible. For the second question, however, admissibility seems to be unattainable due to a lack of anything that could be interpreted as a divergence in case law. The Board in decision T 1063/18 meticulously adhered to the interpretation of Art. 53 (b) EPC given by the EBA. In the referral itself no attempt was made to argue an existence of divergence. Instead, admissibility was invoked because

the second question is directly related to the first one, or because the second question is admissible under Article 112(1)(b) EPC by analogy. Both arguments are hardly convincing.

For the first argument a comparison between a referral and opposition proceedings is enlightening. An opposition is admissible in total where one ground for opposition has been admissibly raised. The topic of an opposition is always a singular one: to revoke or not to revoke a patent. Independent questions referred to the EBA are, however, by definition not singular. Thus, each question must be admissible independent of all others. Otherwise the President could circumvent the clear intention of the legislator not to busy the EBA with abstract questions by raising one admissible question and insisting that all other questions are thematically linked thereto.

The second argument – admissibility by analogy – basically is that a question is admissibly referred not because the conditions of Art. 112 (1) (b) EPC are met, but because the circumstances are similar enough to those of an admissible case. This argument hinges on an evaluation of the term “enough”. A minimum requirement to meet this criterion is that the law objectively needs to be completed. Where it is found that the legislator did not want to link a legal effect to some setting, it is of no importance that this setting is to some degree similar to another setting that comes with the coveted legal effect.

Regarding the right to a referral, the legislator made a clear systematic distinction between the Boards of Appeal and the President: The Boards may refer “any [!] question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes” to ensure uniform application of the law or if the question is a point of law of fundamental importance. The President, however, may only refer a point of law to the EBA where two Boards of Appeal have given different decisions on that question, even if the question is a point of law of fundamental importance (see *Moser in Beier/Haertel/Schricker*, Münchner Gemeinschaftskommentar zum EPÜ, Art. 112, sec. 28; *Günzel/Kinkeldey in Benkard*, EPÜ, Art. 112 Rn. 6). The wording of Art. 112 (1) (b) EPC thus clearly and correctly reflects the intention documented during the genesis of the EPC to prevent the President from referring questions unless there is a divergence of case law.

The political actors may be dissatisfied with the Board's failure to refer a question already decided by the EBA. However, in view of a so far unambiguous case law the Office is faced with no difficulty to align its patent granting process with the case law of the Boards of Appeal. Or, using the words of the EBA: “A discrepancy between office practice of the EPO and the case law of the Boards

of Appeal is not in itself sufficient to justify a referral by the President of the EPO to the Enlarged Board of Appeal, if the practice of the EPO is not warranted by the case law” (G 4/98, sec. 1.1).

It may be argued that the conflict between the existence of the words of Rule 28 (2) EPC and the case law of the Boards of Appeal creates a sufficient difficulty. But upon closer inspection this alleged conflict does not exist. In a society adhering to a separation of powers, the executive must apply the law as interpreted by the courts even if the executive and/or legislative does not like the interpretation. It is to be kept in mind that the executive is not bound to the “letters of the law”. What is decisive is the will of the objective legislator. It is the prerogative of the judiciary to define the meaning of the law; the executive has to act according to this definition (unless in cases of manifest unrighteousness of the law and/or its interpretation). Admittedly the EPC does not contain a provision for having an Article or Rule annulled by the Boards. However, where the Boards have decided that there is no room for application of R. 28 (2) EPC, the EPO is no longer bound to nor may it apply this Rule in examination and opposition proceedings.

It may also be argued that the EPO is not bound by decision T 1063/18 except for a single patent granting process, for all other patent grant and revocation processes R. 28 (2) EPC would still be applicable. Such argument would constitute a gross neglect of the function of the Boards of Appeal in the concert of powers under the EPC. First of all the argument is not special to the decision in question. Following this argument, the EPO would be liberated from applying any case law whatsoever, it could intentionally refuse patents as it sees fit and leave it to the Boards to correct any errors. This is at odds with the Rule of Law. Second, where the judiciary has given an interpretation of the EPC that is generally applicable, then all cases currently pending before the EPO must be treated according to said interpretation (see G 9/93 sec. 6.1, affirmed in G 3/97 sec. 7). In the present case this means that R. 28 (2) EPC is devoid of substance: it is a string of words without effect.

The President may propose that decision T 1063/18 is an isolated one and that it is to be expected that it will be overruled either by the EBA or by subsequent Board of Appeal decisions. However, neither does this alter the criteria for admissibility for a referral nor does it liberate the EPO from adhering to the Board's interpretation of the EPC. The mere hope (or conviction) that some future Board might decide in conflict to decision T 1063/18 is not equivalent to the presence of a conflict as stipulated by Art. 112 (1) (b) EPC. Even where it later turned out that decision T 1063/18 were indeed an isolated decision the President would not be entitled to a

referral, because legal development would have made this decision obsolete. Then a *fortiori* the President is not entitled to a referral where legal uniformity has not been disrupted yet.

Furthermore the chances for a change of view by the Board are negligible. The issue in question, i.e. the applicability of R. 28 (2) EPC, arises only in a special technical setting, i.e. plant breeding. According to the business distribution scheme all decisions based on R. 28 (2) EPC will be dealt with by the same Board. Given that the present decision was rendered by the Board in an enlarged composition according to Art. 21 (3)(b) EPC and Art. 9 RPBA, it is difficult to nourish any expectation that the Board in a different composition will come to a divergent conclusion. The President and the Administrative Council have no say in the allocation of duties to the Boards of Appeal as this is handled autonomously by the Praesidium of the Boards of Appeal, extended to include all Chairmen (R. 12b (4) EPC). Moreover, if the Administrative Council were to amend the Implementing Regulations in order to interfere with the establishment of the business distribution scheme (for example to transfer plant breeding cases to another Board), this could only be justified with great difficulty, to say the least (cf. Art. 23 (3) EPC). And the present referral would still remain inadmissible as the amendment of the business distribution scheme would not create *per se* divergent case law.

The instrument of a referral might have been used in order to obtain an obiter dictum by the EBA (see G 3/08, sec. 10 and 11). However, little would be obtained by such approach. According to the EPO's statement of 29 March 2019, the Presidential referral is intended to find "a solution in the short term following the decision T 1063/18." If the EBA does accept the referral, then the Boards of Appeal as well as the President and the Administrative Council will have to adhere to any interpretation handed down by the EBA, and it is so far difficult to see why the EBA should deviate from its reasoning developed in four earlier cases. If, however, the EBA hands out an obiter dictum, then the content is not binding for the Boards of Appeal or the EPO. And if the EBA merely explains that no difference exists between its prior decisions and the Board's decision T 1063/18, then nothing is gained either.

Part II of this article will be published
in **epi** Information 3/2019



Educational events

Continuing Professional Education (CPE) seminars 2019

Opposition and Appeal – registration available soon

The “Opposition and Appeal” seminars will provide you with an intensive and practical overview of all relevant legal and practical issues concerning opposition and appeal proceedings before the European Patent Office. The seminar also includes an update on the revision process of the Rules of Procedure of the Boards of Appeal.

25 June 2019	Cambridge (UK)	epi roadshow supported by the EPO
26 November 2019	Hamburg (DE)	epi roadshow supported by the EPO

Case Law

The “Case Law” seminar will provide you with an overview of the most recent key decisions and developments in the EPO’s board of appeal case law. This collection of lectures offers a range of subjects, including procedural and substantive topics, and with a mixture of general-interest and more field-specific topics. The seminar also includes the demonstration of a mock EPO Oral Proceedings.

6 June 2019	Warsaw (PL)	epi roadshow supported by the EPO
12 September 2019	Stockholm (SE)	epi roadshow supported by the EPO
11 October 2019	Istanbul (TR)	epi roadshow supported by the EPO
15 November 2019	Milan (IT)	epi roadshow supported by the EPO

epi Seminar “Opposition and Appeal” in Madrid

C. Mulder (NL) and M. Müller (DE)

On 27 November 2018, Marcus Müller (Chairman of EPO board of appeal 3.3.02) and Cees Mulder (European patent attorney and professor of European patent law in a global context at Maastricht University) gave a successful Opposition and Appeal seminar in Madrid for an audience of around 60 patent attorneys and patent attorney trainees. The seminar was moderated by Francisco J. Sáez.

The cycle of **epi** Opposition and Appeal seminars supported by the EPO started in December 2013 in Milano on request of Paolo Rambelli (Chairman PEC). Since then the seminars have been given more than 15 times at various locations all over Europe (including Barcelona, Budapest, Copenhagen, Dublin, Eindhoven, Hamburg, Helsinki, London (2x), Madrid, Munich, Oslo, Rome, Stockholm, Warsaw and Zürich).

The format of the seminar is that Marcus Müller takes the lead in presenting the seminar and that Cees Mulder acts as an aside with questions and remarks. The interaction between the speakers encourages the attendees to also ask questions. This makes the seminars very vivid and stimulating for the audience as well as for the speakers.

In the morning, the seminar focuses on opposition proceedings with topics such as admissibility, extent of and grounds for opposition, late filings, amendments of the European patent and oral proceedings. The afternoon session is devoted to appeal proceeding including a discussion of the new Rules of Procedure of the Boards of Appeal (which will enter into force in January 2020) and how these new Rules of Procedure work out in practice. Other issues that are discussed in the afternoon are, e.g., prohibition of reformatio in peius and petition for review.



Cees Mulder

European patent attorney (since 1999)
Professor of European Patent Law in a Global Context at Maastricht University (since 2017)
Partner of DeltaPatents (2001-2009)
Philips Electronics (1982-2001)
Author of various methodology books relating to the preparation for the EQE



Markus Müller

Chairman of board 3.3.02 of the European Patent Office (since April 2018)
Technically qualified member of board 3.3.09 (2010-March 2018)
Patent examiner at the European Patent Office (2000-2009)
European Patent Attorney (trainee) at AkzoNobel (1997-2000)

Marcus Müller and Cees Mulder are the authors of the book: **“Proceedings Before the European Patent Office – A Practical Guide to Success in Opposition and Appeal”**. The second edition of the book covering the new Rules of Procedure of the Boards of Appeal, will be issued by Edward Elgar in January 2020.

A lot of practical and tactical advice is given by the two speakers. For instance, Cees Mulder gives practical advice how to behave and act in oral proceedings and how to draft patent applications with the aim of preventing problems later on in opposition and appeal proceedings.

Usually, the seminars are moderated by the local **epi** PEC member. The **epi** organises the event in a friendly and professional manner. In 2019 more Opposition and Appeal seminars have been scheduled: EPO in Vienna (5 February), Riga (7 May), Cambridge (25 June) and Hamburg (26 November).

After entry into force of the new Rules of Procedure of the Boards of Appeal, it is the intention of the **epi** and EPO to continue the cycle of opposition and appeal seminars in 2020 in new cities as well as in previous venues to give patent attorneys insight in the profound impact profound of the new the Rules of Procedure.

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PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2020

- Der Kurs versteht sich als letzte Etappe vor der Eignungsprüfung und als Ergänzung zu den eigentlichen Ausbildungskursen.
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben der Teile A bis D und die Instruktion der Prüfungstechnik und -strategie durch erfahrene Europäische Patentanwälte.
- Die Aufgaben können nach Wunsch auf deutsch, englisch oder französisch bearbeitet werden, Modul 2 wird auf deutsch durchgeführt.
- Die Bewertung erfolgt vertraulich anhand der bei der Eignungsprüfung angewandten Kriterien. Eine schriftliche Korrektur wird abgegeben, Fragen an die Tutoren sind möglich.
- Der Kurs ist aus drei zeitlich getrennten Modulen aufgebaut (Module 1 und 3, jeweils einschliesslich Modul 2, können auch einzeln belegt werden) und umfasst je die Teile A bis D der Europäischen Eignungsprüfung.
- Teilprüfungskandidaten können auch einzelne Teile (A, B, C oder D) belegen, wobei die Kursgebühr entsprechend reduziert wird.
- An den Modulen 2 und 3 können auch Resitter teilnehmen (auch an einzelnen Teilen), deren nicht bestandene Prüfungsarbeiten (2019) wir im Rahmen von Modul 3 schriftlich kommentieren.

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Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu den Prüfungsaufgaben des Jahres 2018. Die eingegangenen Arbeiten werden schriftlich korrigiert, bewertet und den Kandidaten wieder zugestellt, die Kandidaten können nach Erhalt der Korrekturen den Tutoren Fragen stellen und an Modul 2 teilnehmen.

Anmeldeschluss Modul 1 (und 2): 01.06.2019

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Vorstellen von Prüfungstechnik und -strategien für die einzelnen Teile. Besprechung der Fragen zu Prüfungsaufgaben 2018 und, wo erwünscht, Fehleranalyse der Kandidatenarbeiten.

Modul 3 (Anfang November 2019)

Die Kandidaten können zur Vorbereitung an Modul 2 teilnehmen. Modul 3 umfasst die Durchführung einer simulierten, dreitägigen Prüfung mit den Prüfungsaufgaben von 2019. Die an Modul 2 erarbeitete Strategie kann gezielt in Modul 3 geübt werden. Die Lösungen der Kandidaten werden korrigiert, bewertet und den Kandidaten zugestellt. Die Kandidaten können nach Erhalt der Bewertung zu ihren Aufgaben den Tutoren Fragen stellen.

Anmeldeschluss Modul 3 (und 2): 01.09.2019

- **Kursgebühr Modul 1 (inkl. Modul 2 für alle Teile A-D):** CHF 600.-
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CEIPI

Kursangebot zur Europäischen Eignungsprüfung (EEP) 2020

Für die EEP 2020 organisiert das CEIPI ein umfassendes Kursprogramm auf der Basis von hochwertigem, exklusiv verwendetem Unterrichtsmaterial:

I. Seminar zur Vorbereitung

auf die EEP Vorprüfung 2020

vom 4. bis 8. November 2019 in Strasbourg

Anmeldung bis 13.09.2019

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am 23. und 24. Januar 2020 in München

Gezielte Vorbereitung auf die Praxis

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Anmeldung bis 11.12.2019

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für die Aufgaben A+B, C und D

der EEP Hauptprüfung 2020 in Strasbourg

Kurs A+B: 20. September 2019

Kurs C: 21. September 2019

Kurs D: 18. – 19. September 2019

Anmeldung bis 17.07.2019

Gebühr: Kurs A+B oder C: 600 €*,

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Aufgaben A+B und C: 18. bis 22. November 2019

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Teil A+B oder C können einzeln belegt werden,

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EQE Training Courses in Maastricht

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

Since 2014, Maastricht University has been preparing candidates for the European Qualifying Examination (EQE). This training is for candidates who already have a basic understanding of European patent law. One of the cornerstones of our courses is the interactivity: two tutors and group sizes limited to 16 participants stimulate the exchange of ideas and learning from each other.

The Pre-Exam methodology encompasses a 2-day workshop focusing on Claim Analysis, followed by a 1-day workshop for the Legal Questions of the Pre-Exam. The training for each of the main exam papers starts with a 3-day workshop (A and B are combined). For each of the courses, we have developed new methodologies to solve the current papers using a pragmatic and efficient approach. After providing some background and theory, the most important aspects of the methodologies are illustrated by solving cases. Materials are provided electronically before the course to reduce the books needed and to facilitate electronic note-taking.

Following each of the training courses, access is provided to Maastricht University's electronic learning environment for online support from fellow students and the tutors all the way up to the EQE. The presentations, cases and model solutions are also available for subsequent study. Assignments are set to improve the skills of the participants and to boost their confidence. Discussion of experiences and possible answers are encouraged.

Training for the Pre-Exam

Pre-Exam - Claim Analysis

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

Workshop duration: 2 days: Monday 4 and Tuesday 5 November 2019. Online learning trajectory: from December 2019 to March 2020: 7 assignments will be set out.

Pre-Exam - Legal Questions

The legal questions of the Pre-exam require you to quickly and correctly apply your legal knowledge to a legal situation presented in each of the 10 questions. The one-day course will teach you a practical methodology for answering multiple-choice legal questions.

Workshop duration: 1 day: Wednesday 6 November 2019. Online learning trajectory: from December 2019 to March 2020: 6 assignments will be set out.

For detailed information of and registration for the Pre-Exam courses, see:

www.maastrichtuniversity.nl/education/course/eqe-pre-exam-training



Cees Mulder



Nyske Blokhuis

Training for EQE Papers A and B

In Paper A, a set of claims and the introductory portion of a European patent application have to be drafted. In Paper B, a response to a communication from the examining division has to be drafted, while taking account of the cited prior art and the instructions from the client. The training covers the skills needed to tackle both electricity-mechanic and chemical aspects of the current combined-technology papers. The methodologies borrow from real-life skills and approaches to drafting applications and answering office actions to provide an intuitive approach. We apply them step-by-step as a group to A and B papers and cases covering combined-technologies, focussing on the parts of the answer where most of the marks can be gained.

Workshop duration: 3-days: Monday 18 - Wednesday 20 November 2019. Online learning trajectory: from October 2019 to March 2020: 8 assignments (1 A and 1 B case, 2 full A/B papers with combined-technologies, 1 full A and 1 full B chemistry paper, 1 full A and 1 full B electricity-mechanics paper); one of the assignments will be marked by one of the tutors.

Training for EQE Paper C

In Paper C, a notice of opposition has to be drafted following the grant of a European patent. In the course, a newly developed, simple and efficient methodology for tackling Paper C will be taught, which has been successfully applied by many of our previous candidates. The methodology will be put into practice with various example cases.

Workshop duration: 3-days: Monday 21 - Wednesday 23 October 2019. Online learning trajectory: from October 2019 to March 2020: 8 assignments (6 C cases and 2 full C Papers); one of the cases will be marked by one of the tutors.

Training for EQE Paper D

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

Workshop duration: 3 days: Monday 7 - Wednesday 9 October 2019. Online learning trajectory: from October 2019 to March 2020: 8 assignments (6 with a set of Part I questions, 1 Part II case and one full Part II paper); one of the assignments will be marked by the tutor.

Final face-to-face session

For the participants in the courses for EQE Papers A/B and for Papers C and D, there will be an opportunity to attend a final face-to-face question-and-answer session with the tutors in January 2020. The goal is to test exam readiness and to fine-tune the individual exam approach. In preparation, an answer to an EQE exam paper can be handed in, which will be corrected and commented upon by the tutors.

For detailed information of and registration for the Main Exam training courses, see:

www.maastrichtuniversity.nl/education/course/eqe-exam-training

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



Committee Reports

Report of the European Patent Practice Committee (EPPC)

C. Mercer (GB), Chair



Chris Mercer

This report covers the period from the last Council meeting in Helsinki to the Council meeting in Sofia.

The EPPC is the largest committee of the **epi**, but also the one with the broadest remit: it has to consider and discuss all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT and (3) the future EU

Patent Regulation, including any revision thereof, except all questions reserved for the Biotech committee.

The EPPC is presently organised with seven permanent subcommittees (EPC, Guidelines, MSBA, PCT, Trilateral & IP5, Quality, Unitary Patent and Patent Documentation). Addi-

tionally, ad hoc working groups are set up when the need arises. Four thematic subcommittees have also been set up (Mechanics, Pharma, ICT and Chemistry). Members of EPPC are also delegates to various meetings organised by the EPO, including meetings under the SACEPO banner.

Membership

Pieter Vandersteen (BE) has resigned from all committee memberships. He was a member of EPPC and he is thanked for his active service.

The BE Council members will propose a BE candidate for election to EPPC.

Pieter was also a member of the Pharma Thematic Group. In light of his resignation, it is proposed that Alain Werner (FR), who was the candidate with the next most votes at the election at C83 (Warsaw), should replace Pieter. Council is requested to agree to this replacement.

Meetings – Past

A report on the following two meetings was not available for the last report of EPPC.

18-22/06/2018 – WIPO-PCT Working Group

The official report on this meeting is attached (Document EPPC 1*) (it was only issued in January this year). Manolis Samuelidis as chair of the PCT sub-committee attended Monday to Wednesday. Users were invited to take the floor and present their opinion on correction of erroneously filed application documents. On behalf of **epi**, Manolis made the attached PowerPoint presentation (Document EPPC 2*). A PowerPoint presentation regarding the subjects covered by the PCT sub-committee is available as Document EPPC 3*.

30/10/2018 – ICT Thematic Group

The ICT group met with the EPO's directors in the area of ICT on October 30, 2018. The meeting continued to strengthen the already good relationship of the directors with the **epi** in the area of ICT. The **epi** was represented by a total of 15 members; the EPO was represented by 19 members, including the COO in the ICT field, Grant Philpott. A specific list of attendees can be taken from the attached minutes of the meeting (for which acknowledgement by the EPO is pending) available as Document EPPC 4*.

The main discussion in the meeting revolved around the past amendments to the Examination Guidelines 2018 in the relevant sections for examination of ICT inventions, in particular mathematical methods, artificial intelligence, algorithmic inventions, and related fields. In many cases, the discussion resulted in the EPO's acknowledgement of the potential need to improve the wording of the guideline amendments, so as to clarify certain passages and ensure a consistent examination amongst all mixed-type-claim fields. Such amendment will become part of the 2019 Guidelines.

As further item of discussion a perceived increase in the number of unsubstantiated novelty rejections was raised by the **epi** delegation.

Lastly the EPO gave a status update on the examination backlog and its QC actions in relation to examination quality. In the period between the Helsinki Council meeting and the Sofia Council meeting, EPPC members attended the following meetings.

12/11/2018 – Meeting with VP1

A delegation of EPPC members, together with our VP, Heike Vogelsang-Wenke, met with the outgoing VP1, Mr. Casado, at the new EPO building in The Hague. A report on this meeting is present in the attached report of the EPC sub-committee prepared by its Chair, Marjut Honkasalo (Document EPPC 5*).

* All documents are available at
<https://patentepi.com/r/report-epc-0219>

16/11/2018 – Meeting with Biotech Boards of Appeal

As liaison member with the Biotech Committee, I attended a meeting of representatives of the Biotech Committee with the members of the Boards of Appeal dealing with biotech inventions. A report of this meeting will be found in the report from the Biotech Committee.

21/11/2018 – SACEPO-WPG

As usual, **epi** was well represented at a meeting of the SACEPO Working Party on Guidelines (WPG). **epi**'s preparations for this meeting are extensive and are handled with great efficiency under the leadership of the Guidelines sub-committee's chair, Anette Hegner. Available as Document EPPC 6 is a report of all the activities of **epi** concerning the Guidelines. The attachments to the report are available as Documents EPPC 7 to 17*.

23/11/2018 – Meeting with Members of the Boards of Appeal

A delegation from **epi**, headed by our Vice-President Heike Vogelsang-Wenke, attended a meeting with the President of the Boards of Appeal and a number of his senior staff. We received a detailed update of the operation of the Boards. The main features were that:

- The AC has approved a number of increases in the appointments to the Boards, both in 2018 and 2019, so that the staffing numbers of the Boards should increase significantly;
- The number of appeals has increased, although it was difficult to see any particular trend; and
- The average pendency time has increased, but it was expected that this would reduce as the new appointments come on line.

There was also a discussion of the new Rules of Procedure, which were further discussed later (see below).

05/12/2018 – Consultation on New Rules of Procedure of the Boards of Appeal (RoPBA)

The Boards of Appeal held a consultation on the proposed new RoPBA in Room 102 of the Isar Building of the EPO. It was well attended. Heike and I were invited to be panel members for the event. It was chaired by Sir Colin Birss. There were formal presentations by members of the drafting committee, then discussions with the panel members and questions from the floor. It was a very interactive event and a number of points against certain aspects of the new RoPBA were made.

Following the meeting, the BoA drafting committee has worked on further revisions to the RoPBA and these have been presented to the Board of Appeals Committee (BOAC) of the AC. It is expected that the new RoPBA will be approved by the AC in June and will come into force on 1st January,

2020. It appears that the only significant change from the previously-published version is that the period for responding to an appeal will be extensible.

07/12/2018 – Case Law Seminar

Members of EPPC have been assisting PEC by presenting topics at a series of Case Law Seminars. These seminars are presented by two **epi** members and two Board of Appeal members and include a mock oral proceedings.

11/12/2018 – Litigation Committee

As liaison member with the Litigation Committee, I attended the meeting of this committee. A report of this meeting will be found in the report from the Litigation Committee.

17/01/2018 – SACEPO-WPR

The members of the EPC subcommittee attended this meeting. A report of the meeting is in attached Document EPPC 5. A relevant document referred to in that report is available as Document EPPC 18*.

24/01/2019 – Quality Subcommittee Meeting

A report on meeting of the Quality Subcommittee, prepared by its Chair, Bogoljub Ilievski, is available as Document EPPC 19. The documents referred to in the report are available as Documents EPPC 20 to EPPC 22*.

21-22/02/2019 – Committee on Patent Law

A copy of the agenda for the meeting is attached as Document EPPC 23. The main point of discussion was the patentability of plants produced by essentially biological means, which will be discussed the Council meeting in Sofia (see below).

22/02/2019 – SACEPO-WPG (Biotech)

A special meeting of SACEPO-WPG took place and is reported on in Document EPPC 6*.

26-27/02/2019 – EPPC Meeting

A full meeting of EPPC and all the thematic groups was held in the Isar Building at the EPO on 26th and 27th February. A copy of the agenda is available as Document EPPC 24. Due to a computer failure, the Minutes of the meeting are not yet available but will be provided as soon as possible. On 26th February, the meeting consisted of "normal" EPPC business. On 27th February, the meeting was joined by the President of the Boards of Appeal, Mr. Josefsson, and a number of senior members of the Boards of Appeal. The meeting started with a presentation of the general situation at the Boards by Mr. Josefsson. This was followed by a general question and answer session. Mr. Josefsson did not want to discuss in detail the proposed new Rules of Procedure as they were at that stage undergoing revision. The meeting then split into four groups according to EPPC's four thematic groups and there was in each group a lively discussion between the Appeal Board members and the members of the thematic groups, supplemented by members of EPPC

who are not members of the groups. The meeting with the President and members of the Boards was very fruitful.

21/03/2019 – SACEPO-PDI

epi has four delegates to SACEPO-PDI. A personal report from one of the present members is available as Document EPPC 25*. As can be seen from the report, this is a very interesting meeting but is a little removed from the normal activities of patent attorneys. **epi** has a strong representation on SACEPO-PDI but the delegation can be varied if there is any **epi** member who has expertise in the areas covered by SACEPO-PDI and wishes to join the **epi** delegation. If there is anyone on Council or anyone known to a Council member who fits these criteria, please contact me at eppc@patentepi.com.

03/04/2019 – G4(?) /19 Telecon

A Working Group has been formed to prepare an **epi** amicus curiae brief relating to a yet-to-be-received reference to the Enlarged Board on double patenting. There will be a presentation about this at the Council meeting. The questions which it is believed will be referred to the Enlarged Board are shown in Document EPPC 26*.

Meetings – Future

25/04/2019 – G4(?) /19 Meeting

The Working Group on double patenting will meet on this date to provide a framework for **epi**'s brief.

02/05/2019 – Meeting with VP1

A meeting has been arranged to meet the new Vice-President – Patent Granting Process in the new EPO building in The Hague. No agenda is yet available but the main purpose is to start or re-start the meetings of the Thematic Groups with the directors in DG1.

09/05/2019 – SACEPO

The main meeting of SACEPO will take place on the above date and I will attend as part of **epi**'s delegation.

Actions

The main activity of EPPC in the near future will be to deal with the four referrals to the Enlarged Board. G1/19 will be dealt with by the ICT Thematic Group. G2/19 will be dealt with by a Working Group which I will chair. G3/19 will be dealt with by a joint Working Group of Biotech and EPPC. G4/19 will be dealt with by the Working Group referred to above. Presentations on the four referrals will be made at the Sofia Council meeting so that we can have an indication from Council as to the direction to be taken for each amicus brief. The questions for each referral are shown in Document EPPC 26. A copy of the presentation for G2/19 is available as Document EPPC 27*.

* All documents are available at <https://patentepi.com/r/report-eppc-0219>

Report of the Online Communications Committee (OCC)

J. Gray (GB), Chair

OCC and its members have remained busy in the last period. Following Council's endorsement of the proposed submission to Mr Campinos' Strategic Plan, the EPO president opened the consultation on the strategic plan more widely. Our detailed comments were submitted following a broader response from our president.

Four of us OCC members are also members of the SACEPO working group on the electronic patent process (e-SACEPO or SACEPO-EPP). For C85 we reported on the special meeting of SACEPO-EPP about eDrex. On 30 January 2019 there was the regular annual meeting of SACEPO-EPP.

They were very similar to the comments input to the Strategic Plan. A significant element was on the topic of outages which had been experienced by EPO users between Christmas and New Year. The EPO offers some fulsome apologies, and it is to be hoped that ears and eyes are wide open now to the concerns that had already been identified and highlighted at the previous Council. We look forward to action on the number of fronts, especially, for example, improving legal certainty about when deadlines will and will not be extended under Rule 134 (1) EPC, second sentence.

For this meeting JG provided detailed questions/comments and these were very well received, and a good template for preparation for future meetings. SACEPO-EPP working group also includes representatives from attorney national associations, industry and paralegal associations, and everyone benefits from this contact.

SACEPO-EPP meetings also fall within a rolling cycle of meetings of the working group on rules SACEPO-WPR and the working group on patent documentation and information, SACEPO-PDI. There is a good continuity and flow of ideas between these groups, not only within **epi** but also via overlapping membership at the EPO side and the SACEPO Secretariat.

OCC receives a steady flow of experiences from users of the different online systems, mostly of course "horror stories" or cautionary tales and limitations of the EPO systems. Mostly, however, these are received through EPPC or the Presidium, Council members, i.e. "those in the know" about **epi** organisation. We aim to raise awareness for OCC activities among the membership at large.

In this regard, OCC member Florian Stöckle organised a survey among **epi** members on the experience of video-conferencing with the EPO and an excellent 553 responses were received.

Future consultations are being considered around members' usage of online systems, especially with a view to what members do for back-up/contingency.

OCC is also considering issuing guidance to **epi** members on "preparedness" for when things go wrong.

Council is informed OCC members have been actively supporting EPPC in its liaison with WIPO/IB on the subject of their online filing systems (ePCT) and particularly on the subject of turning off fax. (Whether this activity needs to be reflected in amended Terms of Reference of OCC will be kept under review.) In the meantime, given that no system can be perfectly robust, another line of investigation is the potential for collaboration between authorities such as WIPO and EPO and national offices, so that each can serve in some way as a backup to the other.



John Gray

* Annexes:

- OCC1 Letter from F Leyder to EPO President's Strategic Review
 - OCC2 EPO minutes of SACEPO-EPP meeting 30 January 2019
 - OCC3 EPO update on current status of online filing and other systems
 - OCC4 EPO update on E-business user support
 - OCC5 EPO update on patent information services
- available at <https://patentepi.com/r/report-occ-0219>

Report of the Disciplinary Committee about its annual meeting in Sofia

P. Rosenich (LI), Chair

After some discussion phases in the past years since last Council the work at DC continued as it is legally provided for. No bigger problems or difficulties have popped up.

DC-Contacts with the epi Presidium

A) Non Attendance at the last Board Meetings

Because there was no need for discussion with the Board and no agenda points regarding Discipline scheduled the DC-Chair did not attend the last Board Meetings.

B) Attendance at the Council Meetings

The DC Chair Paul Rosenich has attended the last Council meetings including the Sofia Council.

C) Invitation of President and Vice-President to address DC-Meeting and inform about DB and DBoA decisions.

While most of the DBoA Decisions refer to EQE-Matters and DB-Decisions are often not published it is of importance for the DC to learn how the higher ranking Disciplinary Bodies decide about cases which have been treated at DC-level beforehand. This is an integrative element of development of the Disciplinary Law and Practice.

It is reminded that the DB as such is – like the DC - also a first instance Disciplinary Body however it is composed of epi and EPO Members and may order more severe sentences than the DC. Francis Leyder and Heike Vogel-sang-Wenke attended the Sofia Meeting of the DC and the President presented his views about certain problems he recognized. Many of those problems – as far the Disciplinary Committee is concerned – are already addressed by it. So does the DC register all cases in order to be able to refer to past decisions against the same Member if necessary. Further a database of decisions is created to help the Chambers in following the case law. Also the requirement of secrecy within the DC between Chambers has been lifted in cases where a Chamber has a reason to look into another case which is related to their current case. The President and DC Chair agreed that efficiency in the proceedings is important and the early delivery of decisions is necessary. The DC does deliver its decisions between 9 and 15 months after a claim was filed.

Annual Meeting of the DC

A) Back to Back organization with epi Council Meeting

In order to save travel costs and organizational manpower DC agreed with the Presidium to use this new format back to back for organizing the DC meeting. In years where the DC is not freshly appointed such combination of meetings are technically possible. The next meeting, at which the DC will be newly appointed and hence can not be combined with the Council it will be held in Portugal – as so far the DC was not in this Member state.

It was current practice of the DC to visit different Member States in order to make itself also visible for the local epi-Members. The DC does also meet with local representatives of the profession in order to exchange opinions on disciplinary Questions. In Sofia Samuil Benatov of Sofia attended a dinner meeting for that purpose. Unfortunately as it was reported, Bulgaria does currently not have a national patent attorneys organization, as most of the other Member States have.

B) Agenda of the Sofia DC Meeting

Joint Dinner Meeting of the Members of the Chambers. Here the Chambers could discuss/deliberate their Cases and make themselves familiar with other internal topics.

Report and Discussion from the Chair about the past year.

Report and Discussion from the Working Group on Guidelines. Here it was reported and presented that Templates and Guides have been prepared to ease the work of the Chambers. Also a Mock Case presented by Wolfgang Poth was discussed.

Presentation and Discussion of interesting cases. About three points fell under this discussion point and allowed all Members to share their opinions. For the DC this is of importance as on the one hand it wants to operate under a unified view taking into account all national views on questions of Discipline.

Update on the amendments of the Regulation on Discipline and Additional Rules of Procedure of the Disci-

plinary Committee. While the Regulation on Discipline is not a topic where the DC is decisive, the Additional Rules of Procedures are important to allow the DC to operate efficient and fair. A number of improvements have been elaborated and presented by the DC-Secretary Tuna Yurtseven who lead a respective Working Group. The internal discussion is now open.

Report about Case Management by the Registrar. The Registrar Vernessa Pröll requested all Chambers to deliver together with their decision also an abstract of it. This will efficiently help the Working Group for the Database of Decision. This Working Group is composed of John Grey (GB), Wolfgang Poth (DE) and Thierry Debled (FR). They have been again entrusted with reading all decisions in the respective languages (GB,DE,FR) and providing abstracts for those decisions which have not yet been listed.

C) Need for appointment of new Members to DC

Italy and Netherlands lost its DC-Representatives, as they had to step back.

DC noted with satisfaction that Council appointed new representatives of those Countries to the DC: Giuseppe Mazzini (IT) and Ferry A.T. van Looijengoed (NL)

Interesting Complaints:

A) Non Representation

A Complainer said that he was not properly represented during Oral Proceedings and therefore lacked the right to be heard. This because the Complainer believed that the appointed European Patent Attorney did not properly represent the Complainers case at the Oral Proceeding. Chamber Westerholm takes care of this case.

B) Request for Mediation

A Complainer requested DC to mediate between his interests and an European Patent Attorney who has withdrawn from representation immediately after he has received some critics from his client/the Complainer. Depending on a response of the Complainer on clarifications questions by the Registrar a Chamber will be entrusted in due course.

This case shows a practical problem, which might be more often in real life:

For skilled patent attorneys and long standing epi Members it is not so difficult to find a competent European Patent Attorney for a particular work in a particular technical field.

However for clients or "newcomers to the IP-world" this might be somehow difficult.

On the one hand for the DC it is impossible to help applicants in their application work before the EPO on the other hand it seems not possible either to name specialized epi Members to such desperate clients. Eventually epi Council wants to look into this problem and think it over on how an objective presentation of qualification could be made, so that clients could better than with the existing Membership list find their way to an optimal representative.

It might be worth to mention in general that a European Patent Attorney who wants to resign as representative of a client has to do everything to preserve his client's rights before taking action and resigning as representative in order not to damage the client's interests. This might also include substantive work for the case (e.g. filing an application, responding to an office action, etc.) in case the client would suffer irrevocable damages if the representative would not do the work. Such aspects will be taken into account when determining the time period the client reasonably should have to find a new suitable representative. During which time period a current representative eventually has to continue to work for the client, ie should eventually resign from his representation only after careful considerations.



Paul Rosenich

C) Received Number of Complaints (and other requests)

2017: five complaints and five other requests
2018: five complaints and four other requests
2019: two complaints and one other request

None of these cases led to a decisions which was published so far.

Report of the epi-Finances Committee

M. Maikowski (DE), Chair

The 82nd Meeting of the **epi**-Finances Committee took place in Berlin on 8 and 9 April 2019. The Treasurer and Deputy Treasurer attended as invited guests, as did the Internal Auditors.

The Treasurer reported on the financial position of **epi** as of the end of 2018. The Committee notes with approval the out-turn of a small surplus as being somewhat better than the budgeted loss for the year.



Michael Maikowski

The Committee notes the likely financial impact of significant numbers of candidates succeeding in the 2018 EQE. The Committee also congratulates the successful candidates.

IT costs in the Institute have increased in recent months. The Committee is satisfied with the explanation that many of the increased costs

are one-offs and/or result from depreciation of purchased assets. However the Committee generally urges the Treasurer to try and ensure that trends in income and expenditure are consistent with one another, and of low volatility.

The number of Members paying their subscriptions late has decreased in 2019 compared with previous years. The Committee notes this development with approval.

The Committee also is encouraged that significant numbers of Members pay their subscriptions using PayPal or credit cards.

The Committee again discussed a double written approval proposal but deferred any decision for the time being, pending progress in the appointment of an Executive Director.

This person would be responsible for supervising and managing the Secretariat, and discharging several robes currently undertaken by the Treasurer and Secretary General. The work of these officers has become increasingly complex in recent years. **epi** can no longer expect Members to take on such responsibilities on a voluntary basis. In view of this the Committee strongly supports the proposal to appoint an Executive Director, accepting that in the long run this may give rise to an increase in the subscription fee in order to cover costs.

Requests for the provision of certificates confirming that no disciplinary complaints are proceeding against individual members are sometimes received. They require considerable effort on the part of the Secretariat and the Treasurer to deal with. The Committee therefore approves the Treasurer's proposal for **epi** to charge a minimum of €120 for each certificate, in order to cover the costs involved.

The Committee discussed a proposal to discount the subscription fees payable by Members in the year of passing the EQE. On balance the Committee does not support this proposal, in view of the administrative complexity that is likely to be involved.

The Committee received an interim report from Mr Quintelier on the progress of the Working Group Reviewing Reimbursement Rules and Processes.

The Committee reviewed draft Decision C86 put forward by the Internal Auditors, and supports the proposal to approve this decision (which should replace Decisions C77 (Hamburg) and C73 (Milan)).

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

1. Patentability of plants and animals – T1063/18 and G 3/19

Our committee reported **T 1063/18** in **epi** information 1/2019. This decision concerns the appeal by the applicant against the decision of the Examining Division to refuse European patent application no. 12 756 468.0 (publication no. EP 2 753 168 A1) for the sole reason that the claimed subject-matter was "found to be within the exception to patentability according to Article 53(b) EPC and Rule 28(2)" (here: plants exclusively obtained by means of an essentially biological process).

The Technical Board of Appeal (TBA) 3.3.04, in an enlarged composition consisting of three technically and two legally qualified members, held that Rule 28(2) EPC (see OJ 2017, A56) is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal (EBA) in decisions G 2/12 and G 2/13. In these decisions, the EBA had concluded that the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC did not have a negative effect on the allowability of a product claim directed to plants or plant material.

TBA 3.3.04 stated that Rule 28(2) EPC could not be interpreted in such a way that it was not in conflict with Art. 53(b) EPC as interpreted earlier by the EBA, i.e. the conflict could not be resolved by way of interpretation. The Board also saw no reason to deviate from the interpretation of the EBA. The Board concluded that, in view of Article 164(2) EPC, the articles of the Convention prevailed and decided to set aside the decision under appeal and to remit the case to the Examining Division for further prosecution.

The Biotech Committee analyzed and agrees with the well-founded decision in **T 1063/18** and believes that it is actually the only one that could reasonably be reached. In particular, one aspect is made clear by decision **T 1063/18**: the exclusion of product claims directed to plants or plant material directly obtained and/or defined by an essentially biological process in the sense of Article 53(b) EPC cannot be achieved by amending the Regulations to the Convention. Such an exclusion could only be the consequence of a further development in the jurisprudence of the EBA or of a revision of the European Patent Convention, e.g. Article 53(b) EPC, by a Conference of the Contracting States. Also in another plant case under appeal as **T 2734/18** (EP 2 825 024), Board

3.3.04 issued a preliminary opinion on 29 March 2019 with the same conclusion as in **T 1063/18**.

In the meanwhile with **G 3/19**, a referral to the EBA is now pending. Pursuant to Article 112(1)(b) EPC, the President of the EPO has submitted questions to the EBA which relate to the patentability of plants exclusively obtained by essentially biological processes and to the above-mentioned decision **T 1063/18**. In the referral the President of the EPO seeks the EBA to clarify the applicable legal framework.

The EPO in its press release regarding **G 3/19** of April 5, 2019 mentions that it reacts to the concerns expressed by the Contracting States, the user community and representatives of civil society who are worried about legal uncertainty resulting from decision **T 1063/18**. It is also mentioned that the President of the EPO considers the referral to the EBA as an important step on the way to restore legal certainty in the interest of the users of the European patent system and the general public. Also it is mentioned that, the possibility of a referral to the EBA was presented end of March 2019 at a meeting of the Administrative Council and met with broad support.

The following points of law have been referred to the EBA by the President of the EPO in G3/19:

1. Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?



Ann De Clercq

2. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?

The **epi** Biotech Committee together with EPPC will prepare an amicus brief in name of **epi** for G 3/19. A short presentation was given at the council meeting to highlight the issues at stake in this referral

Further, an EPO Notice dated 9 April 2019 announces the staying of proceedings due to the referral **G3/19** as the President of the EPO has decided that, having regard to the potential impact of the referral, all proceedings before the EPO examining and opposition divisions in which the decision depends entirely on the outcome of the EBA's decision will be stayed ex officio until the EBA issues its decision. Search proceedings will not be affected. This concerns patent applications or patents in which the claimed subject-matter encompasses a plant or animal exclusively obtained by means of an essentially biological process. Patent applications or patents claiming other plant-related inventions will not be affected. If proceedings are stayed, the responsible examining or opposition division concerned will inform the party or parties thereof. At the same time, communications setting time limits for the party/parties to react will be withdrawn by the examining or opposition division, and no further communications to this effect will be dispatched. Once the EBA has given its decision, a further communication will be issued concerning the resumption of proceedings. This notice is immediately applicable.

The Biotech Committee will keep on following up this topic and provide its comments.

2. Overview of patentability of plants in the Member States

The Biotech Committee is following further national developments and will soon report an updated overview of the patentability of plants in the member states.

3. Guidelines for Examination – biotech issues

The Biotech Committee was represented in a discussion of the Guidelines for Examination at the SACEPO Working Party on Guidelines on 22 February 2019. The biotech committee also presented its comments on Rule 28(2) EPC and relating disclaimer parts of the Guidelines. The

EPO is requesting whether the biotech committee wishes to propose further examples now or for the next version of the GL amendments. The Biotech committee will make suggestions if deemed appropriate. Given **T 1063/18**, our committee submitted that the need to remove subject-matter as referred to in Rule 28(2) EPC - by disclaimer or otherwise – de facto no longer has any legal basis and should be removed from the Guidelines for Examination and that this decision should be mentioned in the Guidelines.

4. Meetings with attendance of the Biotech Committee

On **8 January 2019** the **epi** Biotech Committee held a web meeting to prepare for the SACEPO meeting WP on Guidelines reported here below. All biotech passages in the guidelines were assembled and the recommendations were passed on for discussion in the meeting.

On **22 February 2019** the **epi** Biotech Committee was represented in a discussion of the Guidelines for Examination at the SACEPO Working Party on Guidelines (Jan Desomer, Gabrielle-Leissler-Gerstl and Martin Wilming attended this meeting).

On **19-20 February 2019** Gabrielle Leissler-Gerstl, a legal adviser of the **epi** secretariat and Francis Leyder attended the CPL meeting during which the patentability of plants produced by essentially biological methods was discussed.

On **2 May 2019**, Ann De Clercq attended an **epi** delegation meeting with new VP1 Stephen Rowan and Razik Menidjel wherein amongst others it was discussed to continue holding the meetings with the DG1 Biotech Directors.

5. Next meeting

The Biotech Committee will continue to deal with all questions relating to biotech and related life sciences inventions as well as topics referred to it by EPPC or other channels. The next meeting of our committee is still to be scheduled in 2019. A meeting with the EPO Biotech Directors will also be scheduled for this or next year.



General Information

epi Board

Präsident / President / Président

BE – LEYDER Francis

Vize-Präsidentinnen / Vice-Presidents / Vice-Présidentes

DE – VOGELSANG-WENKE Heike

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87th Council Meeting on 23 November 2019 in Lisbon (PT)

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