



Report from the 92nd Council Meeting

- | | |
|--|--|
| 11 Election to Council 2023 | 19 Paper Submitted by epi concerning new WIPO Standard ST.26 on sequence listings |
| 12 The epi Code of Conduct is now ready for UPC
by G. Checcacci | 23 epi starts educational activities on the UP and UPC |
| 13 The latest version of the Guidelines – deletion or marking of unclaimed embodiments by M. Nyberg | 26 Reports of the epi Committees |



Cover:

Beach of Ter Heijde

This picture painted by
Emil Rudolf Antonius Matulewicz
(European Patent Attorney, NL)
is part of the
epi Artists Exhibition 2021



Emil Rudolf Antonius Matulewicz

Emil Matulewicz is a European Patent Attorney at Private Practice from The Hague (Netherlands).

Emil Matulewicz paints in Delft and Rijswijk and his figurative paintings reflect his own style which does not follow an art trend but is instead based on his personality and experiences. Being in balance and harmony is central to create beauty in his paintings. The paintings have affinity with impressionism. Details are missing compared to realism. The use of colors in his fine art is influenced by expressionism, especially for his portraits. See also his website:

<https://www.emilm.com>

Emil Matulewicz ist ein europäischer Patentanwalt auf freiberuflicher Basis aus Den Haag, Niederlande.

Emil Matulewicz malt in Delft und Rijswijk. Seine figurativen Gemälde spiegeln seinen eigenen Stil wider, der nicht einem Kunsttrend folgt, sondern vielmehr auf seiner Persönlichkeit und seinen Erfahrungen basiert. Das Gleichgewicht und die Harmonie stehen im Mittelpunkt, um Schönheit in seinen Bildern zu schaffen. Die Gemälde haben eine Affinität zum Impressionismus. Im Vergleich zum Realismus fehlen die Details. Die Verwendung von Farben in seiner Kunst ist vom Expressionismus beeinflusst, insbesondere bei seinen Porträts. Siehe auch seine Website:
<https://www.emilm.com>

Emil Matulewicz est un mandataire en brevets européens exerçant à titre privé à La Haye aux Pays-Bas.

Emil Matulewicz peint à Delft et à Rijswijk. Ses peintures figuratives reflètent son propre style qui ne suit pas une tendance artistique mais est plutôt basé sur sa personnalité et ses expériences. L'équilibre et l'harmonie sont essentiels pour créer la beauté dans ses peintures. Les peintures ont des affinités avec l'impressionnisme. Les détails sont absents par rapport au réalisme. L'utilisation des couleurs dans ses œuvres d'art est influencée par l'expressionnisme, surtout pour ses portraits. Voir aussi son site web :
<https://www.emilm.com>

Table of Contents

Introduction

- 4 Editorial
- 6 Report from the 92nd Council Meeting in Munich on 7th May 2022 by M. Névant
- 11 Election to Council 2023
- 12 The epi Code of Conduct is now ready for UPC by G. Checcacci

Patent Practice

- 13 The latest version of the Guidelines – deletion or marking of unclaimed embodiments by M. Nyberg
- 19 Paper Submitted by epi concerning new WIPO Standard ST.26 on sequence listings



Education

- 23 epi starts educational activities on the UP and UPC
- 24 Preparation for the 2023 EQE on the epi-learning platform
- 25 epi Student membership
- 25 epi-learning

Committee Reports

- 26 Report of the Online Communications Committee by J. Gray
- 27 Report of the epi Harmonisation Committee by J. D. Brown
- 27 Report of the Litigation Committee by T. Walshe
- 29 Report of the Committee on Biotechnological Inventions by A. De Clercq
- 31 Report of the Professional Conduct Committee by G. Checcacci
- 31 Report of the epi-Finances Committee by C. Quintelier

General Information

- 32 epi Board
- 32 Next Board and Council Meetings
- 33 epi Disciplinary Bodies and Committees
- 37 Contact Data of Legal and Unitary Patent Division

Editorial

Titan-eqe: is the ship sinking?

M. Névant (FR), Editorial Committee

Last year's miscue in paper D1 could have been regarded as an isolated mistake in an otherwise well-functioning system (after all it was the first e-EQE ever organized). This year's blunders in the pre-EQE (an incorrect translation into German) resulted in the Examination Board awarding full marks to all candidates

for questions 11 to 15 and 20 (i.e. almost one third of the questions). This, in my view, should raise more than eyebrows.



Marc Névant

For those of our readers who are not familiar with the Xs and Os of the European Qualifying Examination (EQE), here is some must-know information:

- **epi** and the European Patent Organisation are bound to collaborate on the EQE¹;
- 3 mixed **epi**-EPO bodies oversee the preparation and conduct of the EQE²:
 - the Supervisory Board which, in consultation with the Examination Board, determines the nature, structure and number of the examination papers, and also supervises the Examination Secretariat,
 - the Examination Board (EB) which gives instructions to the members of the Examination Committees for a) preparing the examination papers, b) preparing the marking sheets and c) marking candidates' answers consistently;

- the Examination Committees (ECs) which are entrusted with the preparation of the examination papers and marking sheets, and with the marking of papers.

Until about 8-10 years ago ECs consisted of equal numbers of EPO and **epi** members³; the rule⁴ has however changed dramatically with the effect that nowadays at least 70% of EC members come from **epi**.

There is no denying that, year after year, the EQE Secretariat, the EPO IT support team and **epi** members involved in the ECs have been doing an outstanding job. So is there any reason to worry about the quality and consistency of the EQE? I am afraid that the answer to that question is probably yes.

As far as I can remember (I once was an EC member), harmonisation of the examination papers in the three official languages has always been at the centre of considerations of ECs. A special Committee, comprised of members from ECs, is dedicated to this task⁵. Typically, EC members would sit around a table and go thoroughly through each finalized paper, line by line, paragraph by paragraph, to ensure that the papers convey the same information in all three languages. Obviously this meticulous exercise is not so easy to carry out remotely and can inadvertently lead to errors (as this year's pre-exam has shown). And this is exactly where the problem lies: no physical meetings of ECs actually took place between March 2020 and a few weeks ago because EPO examiners who are EC members were grounded by their managers and not allowed to attend such physical meetings. The errors in this year's pre-EQE were therefore predictable.

1 Article 4 of the Regulation on the establishment of an institute of professional representatives before the European Patent Office

2 Article 1(6) REE

3 Article 7(3) REE

4 Rule 27(1) IPREE

5 Rule 27(2) e) IPREE

This is worrying, not only because there is today no guarantee that similar errors will not happen in the future, but also (and especially) because the bar to pass the pre-EQE or the EQE is de facto lowered: if you need 50 marks to pass a paper, and that 25 marks are automatically awarded to compensate for a mistake in that paper, it is not rocket science to appreciate that the step to pass the paper is not really high. I am not convinced that this is what the profession wants.

In addition, the lack of physical meetings also had a dramatic effect on the preparation of papers. Rumour has it that there are no spare papers (as we go to press) for the 2023 EQE, and that it has become more and more difficult to find volunteers to draft future papers.

The lack of physical meetings has also a dramatic effect on the morale and commitment of EC members, especially **epi** members who do not count the hours **on their free time** to make sure that the (pre-)EQE runs smoothly. The gloom is spreading to **epi** members, accompanied by a growing feeling that their work is not recognized for its true value, with the consequence that quite a few have chosen to become non-active members⁶ for (at least) a couple of years.

On these thoughts, I wish all our readers, on behalf of the Editorial Committee, a nice and relaxing summer break.

⁶ Article 7(2) REE



UKRAINE - YOUR
BRAND IN IP AND MORE[®]

HOW CAN YOU HELP UKRAINIAN IP COMMUNITY TODAY



scan QR code by any
option to fill a form to help



PAYPAL

#advise your clients that Ukraine remains a viable jurisdiction with promising long term prospects and significant European market share.

#continue including Ukraine in your client's IP filing strategy.

#offer internship to Ukrainian IP professionals temporarily evacuated in your area.

#shelter Ukrainian IP professionals fleeing the war in your area.

#hire Ukrainian IP professionals temporarily evacuated in your area for a temp job.

#provide a remote job to Ukrainian IP professionals displaced within Ukraine.

#make your preferred Ukrainian Agent your IP Hub to former CIS countries.

#donate to NAPA Charitable Fund to support IP practitioners in distress.

Introduction

Report from the 92nd Council Meeting held in Munich on 7th May 2022

M. Névant (FR)



1/ Meeting opening

President Leyder opened the meeting at 9.10 am and welcomed all participants. A test vote was conducted and scrutineers were appointed.

2/ Adoption of the agenda

The agenda was adopted with changes, namely

- A discussion on the situation in Ukraine will take place after item 23
- Under item 25, the report from EPPC will include a discussion on the proposed amendment of Rule 132 EPC.

3/ In memoriam

President Leyder informed Council of the passing away of Dr Helen Papaconstantinou (GR), a former Council member and former Secretary General of **epi**. President Leyder and Ms. Yazitzoglou (GR) reminded Council of Dr Papaconstantinou's career and achievements. A minute of silence was observed by Council.

4/ Confirmation of the list of nominations for Committees by-election

The Secretary General, Ms. Sirakova, confirmed the name of members having applied for a position in the By-Laws Committee and in the Electoral Committee.

5/ Adoption of the minutes of the 91st Council meeting – matters arising from said minutes and all previous Council and Board meetings

The minutes of the last Council meeting (C91) were approved. The document listing the action points arising from previous meetings and their status was noted.

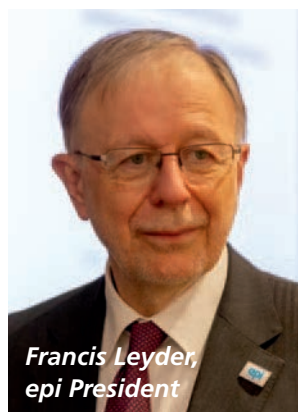
6/ Report of the President and Vice-Presidents

President Leyder referred to his report in the accumulated file, which included activities of both Vice-Presidents. President Leyder also indicated that he was disappointed that a chamber of the Disciplinary Committee issued a decision after the time limit imparted to do so.

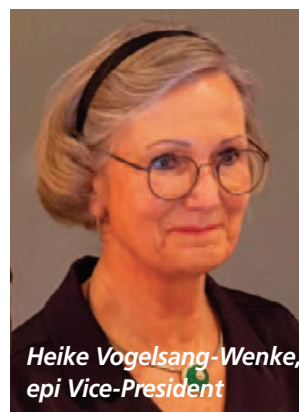
In response to a letter sent by the Dutch delegation, President Leyder noted that the agenda for the meeting had been designed such that internal matters would be discussed in the morning and more substantial, external matters would be discussed in the afternoon.

7/ Report of the Secretary General

The Secretary General, Ms. Sirakova, referred to her report in the accumulated file, and thanked the Deputy Secretary General, Ms. Augustyniak for her help. Ms. Sirakova then briefly highlighted the following information:



Francis Leyder,
epi President



Heike Vogelsang-Wenke,
epi Vice-President



- **epi** has 13,143 members as of 1st May 2022;
- the 2021 online **epi** artists exhibition drew about 12,000 visits;
- the next Council meeting (C93) will take place on 22nd October 2022;
- it is planned that Montenegro will join the EPOrg later this year.

8/ Report from the Executive Director

The Executive Director, Ms. Lissak, reported progress in the Secretariat, notably on accounting, cybersecurity and the organisational chart.

Ms. Lissak informed Council that further steps would focus on accounting, IT projects and RACI matrices (RACI stands for Responsible/Accountable/Consulted/Informed).

9/ Annual report

The 2021 annual report was presented by the Secretary General and Mr Névant (Chair of the Editorial Committee). Mr Névant mentioned that the report had a format and layout comparable to those of the 2020 report, and thanked all those having contributed to the preparation of the report, in particular Ms. Liebig from the Secretariat. Mr Névant also indicated that the report would be illustrated with photographs taken during the Council meeting. The annual report was approved by Council.

10/ Report on financial annual accounts 2021

The Annual Financial Report for 2021 was prepared and reviewed by the external and internal auditors and was discussed with the **epi**-Finances Committee. **epi** concluded 2020 with a positive result of +135 kEUR (whereas the budget had a planned deficit of -197 kEUR).

The Treasurer, Mr. Thomsen, noted that since the 2020 EQE had to be cancelled and the first eEQE took place in 2021,

epi welcomed more than 1000 new members in 2021, which was in line with the budget. In addition, subscription in **epi** studentship was above expectations.

Mr. Thomsen explained that as the pandemic was ongoing in 2021, **epi** continued its practice to offer most educational webinars for free to members and students. Some educational events could also be organized with a participation fee, that led to an income of +172 kEUR; this income covered the overall external expenses of -170 kEUR for organizing the educational webinars.

On the expenses side, spending on Council, Board, Presidium and Committee meetings was much lower than expected because no physical meeting took place and both Council meetings took place virtually. Other usual expense lines included salaries, IT and finance & law.

11/ Report of the epi-Finances Committee

The Chair, Mr. Quintelier, referred to his report in the accumulated file, in which notably:

- the income, expenditure and budget figures for 2021 reported by the Treasurer were approved;
- proposals by the Treasurer to establish post-pandemic hybrid working protocols for **epi** committees were approved.

12/ Report of the Auditors

The auditors, Messrs Conan and Kley, referred to their report and annexes in the accumulated file. The auditors were overall happy with the handling of the assessment of cost centres and the dunning process, but were concerned with the increase in the extra working hours in 2021. They made suggestions to manage overtime and to improve the payroll process, and again proposed to introduce a double signature system. The auditors also tabled motions concerning (i) the release of the Treasurer from liability for the accounting year 2021 and (ii) possible amendments of the By-Laws.

A round of exchanges followed between the Presidium, the auditors and the Chair of the By-Laws Committee. A vote on the motions then ensued.

Motion 1

Does Council agree in one vote:

- to approve of the accounts for 2021,
- to approve the administration of assets,
- the adherence to the planned budget,
- to release the Treasurer from liability for the accounting year 2021?

Council approved the motion (105 in favour, 3 against, 7 abstentions).

Motion 2

Does Council agree that an amendment of the By-Laws of the Institute is prepared being ready for vote at the Council Meeting C93, which amendment has the following objectives:

- a clear separation of powers and duties between the Treasurer, the Secretary General and the Executive Director.
- a clear definition of the powers and duties of the Executive Director regarding the employees.
- an amendment of Article 22 as proposed by the Auditors?

The motion was denied (36 in favour, 52 against, 26 abstentions).

13/ Release of the members of the Board from liability

Council released the members of the Board, and in particular the Treasurer, from liability (107 in favour, 4 against, 4 abstentions).

14/ Report on the situation of the 2022 budget

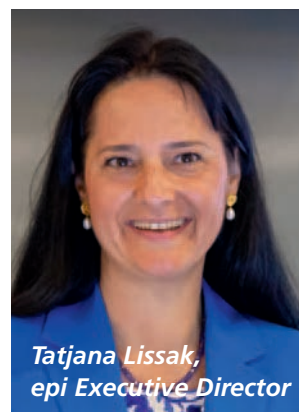
The Treasurer, Mr. Thomsen, presented a snapshot of the financial situation at the beginning of April 2022. The situation (income and expenses) seems to be in line with what was expected. There are however a number of uncertainties due especially to the high level of inflation in Europe and the effect of the ongoing war in Ukraine. An increase in energy costs and travel expenses is already noticeable.

The Treasurer also mentioned that the educational activities will focus this year on:

- the UP/UPC system with
 - essential online training (for free for members and students)
 - intermediate physical/online training
 - possibly advanced level for UPC
- a mixture of free and 'for pay' webinars
- ongoing support courses for EQE candidates.



*Olga Sirakova,
Secretary General*



*Tatjana Lissak,
epi Executive Director*

15/ Election of Committee Members

Mr. Michael Liebetanz (CH) was elected as full member of the By-Laws Committee. Mr. Peter Barrett (GB), Mr. Markus Müller (CH) and Mr. Árni Vilhjálmsson (IS) were elected as members of the Electoral Committee. Congratulations to them!

As a reminder, the detailed and up-to-date composition of all Committees is available on the **epi** website (<https://patentepi.org/en/epi-bodies/epi-committees>) and at the end of each issue of this journal.

16/ Amendment of the rules governing epi studentship

The amendment presented by Mr. Chris Mercer (Chair of the Studentship Admission Committee) was aimed at filling an unintended gap. At present, If an **epi** Student completely passes the EQE, their Studentship is automatically terminated. However, they do not automatically become full **epi** members. They need to apply to the EPO for entry onto the list and then the EPO needs to carry out the procedure for entering them onto the list. As we have noticed recently, the EPO can take some time to enter an applicant on the list. In the time between passing the EQE completely and being entered on the list, they are neither **epi** Students nor full members. In order to ensure that, at all times, they are part of **epi**, an amendment of Rule 8(1) and Rule 13 was proposed.

Council approved the amendment (108 in favour, 1 against, 4 abstentions).

17/ Amendment of Decision 3.3.4, deletion of Decision 3.3.5, adoption of ToR of a new committee, amendment of ToR of the Nominations Committee

In anticipation of the elections to Committees in the fall next year, the Secretary General and the Deputy Secretary General worked in liaison with the By-Laws Committee (as decided by Council during C91) to propose an amendment of Decision 3.3.4 which governs the election of Committee members. As a result of the amendment, Decision 3.3.5 would have to be deleted. A new Committee, called the Committees Election Committee, would be in charge of the election of Committee members. The remit of such a Committee would need to be defined in its terms of reference (ToR). In addition, the ToR of the Nominations Committee would need to be amended to take into account the remit of the new Committee.

A proposal (amended Decision 3.3.4 + ToR of the Committees Election Committee) was made available to Council members in advance of the meeting. Several comments were posted in the Forum before the meeting, and a number of other points were discussed during the meeting, resulting in a final proposal (amendment of Decision 3.3.4 + ToR of the Committees Election Committee + ToR of Nominations Committee; deletion of Decision 3.3.5) being presented for a vote.



Marc Nevant, Editorial Committee Chair



Peter Thomsen, epi Treasurer



Council approved the amendment of Decision 3.3.4 (89 in favour, 9 against, 16 abstentions), the ToR of the Committees Election Committee (86 in favour, 5 against, 7 abstentions), and the amendment of the ToR of the Nominations Committee (unanimous).

An updated version of the Collection of Decisions will be available on the website as soon as possible.

18/ Substantive patent law harmonisation

There is high pressure on Europe to adopt measures such as e.g. a grace period. In this respect a survey has been conducted by the EPO to collect the feedback of interested parties including NPOs. This topic was last addressed by Council in 2013.

During the meeting Mr. Brown (Chair of the Harmonisation Committee) reviewed the pros and cons of the various systems and proposals on the table (Rule 55 EPC, IT3¹ proposal, AIPPI proposal, FICPI proposal). A lively discussion ensued and the following motions were eventually voted on.

Motion 1

epi is opposed to any kind of grace period.

Council voted in favour of this motion (68 in favour, 32 against, 13 abstentions).

Motion 2

However, **epi** could consider a grace period as a safety net as part of a harmonised system.

Council voted in favour of this motion (88 in favour, 18 against, 5 abstentions).

19/ EQE

Mr. Reijns (member of the EQE Examination Board and of the joint EPO-**epi** Working Group on eEQE, both on behalf of **epi**) presented the proposed new concept of the EQE. The Working Group has analysed the specific competences required for each paper, to identify recurring and/or common features within the various papers. Model papers have been prepared by **epi** and EPO members, which are suitable for an online examination and which meet the current high standard. A goal is to test different types of knowledge which are expected from a professional representative, with increasing complexity over time reflecting a gradual development of competences: 2 papers could be sat after about 12 months experience, another set of 2 papers after 18/24 months, and a final set of 2 papers after 24/36 months.

Detailed information on the new EQE is available at <https://www.epo.org/learning/eqe/new-eqe.html>.

¹ IT3 stands for Industry Trilateral



It is possible to test the model papers until 15 July 2022 using the Wiseflow platform.

20/ Proposed amendments of the Code of Conduct in particular for ensuring that it covers activities before the UPC

An amendment to the Code of Conduct (CoC) was proposed to include the fact that professional representatives are bound to the CoC when representing their clients before jurisdictions including the EPO and the UPC.

Council approved the amendment (106 in favour, 2 against, 7 abstentions).

The revised CoC will normally be published in the June edition of the EPO Official Journal.

21/ Diversity and Inclusion

A proposal to adopt a policy on diversity and inclusion (D&I) was presented by the Working Group on D&I. A draft proposal had been sent to Council members in advance of the meeting, and the comments collected were taken into account to revise the text intended to be adopted. The Working Group also requested permission to continue its work until at least C93.

Council adopted the policy (85 in favour, 12 against, 10 abstentions) and agreed that the Working Group continue its work (86 in favour, 15 against, 6 abstentions).

The text of the D&I policy is available on the **epi** website (<https://patentepi.org/en/diversity-and-inclusion.html>).

22/ Request from the Dutch delegation concerning the situation in Ukraine

The Dutch delegation proposed to inform European patent attorneys how to deal with Russian and Belarusian patents and patent applications in view of the economic sanctions imposed on these countries. A draft recommendation was prepared by Mr. Checcacci (Chair of the Professional Conduct Committee), who could unfortunately not join the meeting. Council amended the proposal and adopted the recommendation (98 in favour, 3 against, 7 abstentions).

The text of the recommendation is available on the **epi** website (<https://patentepi.org/r/info-2202-09>).

23/ Update on the UPC

Mr. Thomsen (Chair of the Litigation Committee) briefly summarised what happened since the beginning of the year (entry into force of the Protocol on Provisional Application, thus of certain parts of the UPC Agreement, on 19 January 2022; inaugural meeting of the Administrative Committee on 22 February 2022; Advisory Committee established on 24 February 2022). Mr. Thomsen also reminded the audience that (i) the sunrise period (3-4 months) will be triggered by the deposit of the instrument of ratification of Germany, (ii) the UPC will become operational on the 1st day of the 4th month after Germany's ratification, and (iii) it will be possible for European Patent Attorneys with additional qualification to register as full representative under Art. 48(2) UPCA.

24/ Report from the European Patent Practice Committee

The Chair of that Committee, Mr. Mercer, referred to his report in the accumulated file, and presented a motion requesting Council to approve a statement in relation to Rule 132 EPC, to the effect that:

- **epi** appreciates that the European Patent Office (EPO) has taken note of the objections raised by **epi**'s delegates to the SACEPO-WPR and at a meeting between **epi**'s European Patent Practice Committee and DG1 against the EPO's proposal to amend Rule 132 EPC to reduce the minimum time limit from 2 months to 1 month;
- **epi** agrees with the decision of the European Patent Office (EPO) not to proceed with this proposal;
- the Council of **epi** considers that no such proposal should be reintroduced by the EPO;
- the Council of **epi** will forward this statement to the Administrative Council of the European Patent Organisation, its Committee on Patent Law and the EPO.

Council unanimously approved the motion.

25/ Review of decisions and actions and closing of meeting

The Secretary General listed all decisions made and actions taken during the meeting. President Leyder then thanked the participants and the support team before closing the meeting at 7 pm.



Election to Council 2023

Members of the Institute are invited to stand for election to the epi Council. Being a Council member means formally representing and championing the interests of the members of your constituency as well as bringing your passions and interests to the fore. You can actively shape the work and services of the Institute and have the opportunity to elect the Board of epi, being also eligible to become one of its members. It also allows you to be part of the body that is leading the epi task forces that address issues relevant to the Profession and your own constituency.

The responsibilities of a Council member are described in the By-Laws, and include attending the Council meetings, one in Spring and one in Autumn.

At the beginning of next year, the Council of the Institute is due to be elected for its new term. You can declare from 1st October 2022 – 1st November 2022 according to the Rules for Election to Council that you are ready to stand for election or for re-election to the Council. Your nomination can be done online through the **epi** website. The instructions how to log-in on the **epi** website can be found here: <https://patentepi.org/en/login>

Alternatively, if the online nomination is impossible for you, you can use the nomination paper form that will be sent to you by 1st October 2022.

The usual case is that you stand for election in your own constituency, corresponding to your address registered at

the EPO. Your constituency is the State party to the EPC in which you have your place of business or employment. Depending on the number of **epi** members in each constituency, 2, 4, or 6 council members are elected to represent the constituency, and the same number of substitute council members.

The election shall be by remote e-voting. You shall receive on 15 January 2023 at the latest, a web address for a secure website, and a personal password from our independent voting service provider.

If remote e-voting is impossible for you, the **epi** Secretariat will send you a ballot paper by post. You can request the ballot paper by returning a corresponding form that you will receive together with the paper nomination form mentioned above. The form must be received by the **epi** Secretariat at the latest on 1st November 2022.



If you have any questions, please contact the **epi** Secretariat as follows: Tel +49 89 242052 0 or email: info@patentepi.org

The epi Code of Conduct is now ready for UPC

G. Checcacci (IT), PCC Chair

After years of discussions, within **epi** and between the **epi** and the EPO, the **epi** Code of Conduct has been eventually amended. After the amendment, it is now clearly stated that application of the **epi** CoC is not limited to activities of **epi** members in respect of the EPO, but it includes also activities before the UPC. It may be useful to stress that **epi** members may act before the UPC both as representatives (Art. 48(2) UPC agreement), provided they have the necessary additional qualification, and as patent attorneys assisting a representative (Art. 48(4) UPC agreement).

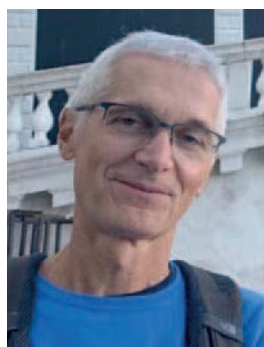
At the recent meeting C92 of the Council, a vast majority of the Council members have voted in favor of the proposed amendments and the new Code of Conduct is now in force. It will be published soon in the OJ of the EPO.

There are three parts involved in the amendments: the preamble, the definitions and Art. 6.

The preamble

The wording of the preamble has been substantially re-drafted:

This Code, adopted under Articles 4(c) and 9(3) of the Founding Regulation, contains the recommendations of the Council as to the conduct and activities of Members insofar as related to Members' profession.



Giorgio Checcacci

In this new wording, the limiting reference to the EPC has been removed, as it had no real basis: neither in the Regulation on Discipline nor in the Founding Regulation (FR) of **epi**. The correct legal bases in the FR have been explicitly added. Reference to Art. 4(c) and 9(3)¹ of the FR makes it clear what is the very nature of the Code of Conduct: a set of recommen-

dations by the Council intended to promote compliance by **epi** members with the Rules of Professional Conduct, i.e. Part I of the Regulation on Discipline. Besides, the term profession has been explicitly used, as this is the term used in the Regulation on Discipline when defining at Art. 1² the general obligations of **epi** members.

The definitions

Consistently with the new preamble, a new item has been added to the definitions, to properly identify the Founding Regulation:

"Founding Regulation"

means the "Regulation on the Establishment of an Institute of Professional Representatives before the European Patent Office", done at Munich on 21st October, 1977, and any amendment thereof, for as long as that Regulation remains in force.

Article 6

The wording of this article has been significantly amended, to take in due account that application of the CoC is not limited to activities vis à vis the EPO:

6. Relationship with Offices and Courts

In all dealings with any Office or Court or any employee thereof where the Member is entitled to act, including in particular the European Patent Office and the Unified Patent Court, a Member shall act courteously, and shall do everything possible to uphold the good reputation of this Institute and its Members.

Thus, the obligation of courtesy and the need to uphold the good reputation of **epi** have been extended to dealings with any Offices or Courts, including the EPO and the UPC.

As a code of conduct is a significant part of the definition of a profession, with this new CoC we **epi** members can proudly say that our profession is (and will continue to be) a truly pan-European profession, certainly the only one in the field of **IP**.

¹ FR, Art. 4(c): The objects of the Institute shall be to (...) (c) promote compliance by its members with the Rules of Professional Conduct, inter alia through the formulation of recommendations;

FR, Art. 9(3): The Council may, within the terms of the Regulation on Discipline for Professional Representatives, make recommendations on conduct.

² RoD, Art. 1, General professional obligations:

(1) A professional representative shall exercise his profession conscientiously and in a manner appropriate to its dignity. In particular, he shall not knowingly make any false or misleading statement.

(2) A professional representative shall conduct himself in such a manner as not to prejudice the necessary confidence in his profession.



Patent practice

The latest version of the Guidelines – deletion or marking of unclaimed embodiments

M. Nyberg (SE), Senior Patent Attorney

1 Introduction

The latest version of the Guidelines for Examination in the European Patent Office (GL) entered into force on 1 March 2022.

The first paragraph in the latest version of **GL F-IV 4.3** reads:

“Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence.”

According to the latest version of **GL F-IV 4.3** (i)-(iii) an inconsistency exists already if the description discloses

an embodiment that is not covered by the matter defined by the claims and it is required that such embodiments are deleted from the description or marked as not falling within the matter for which protection is sought.^{1, 2} This approach is supported in e.g. **T 1808/06**.

The latest version of **GL F-IV 4.3** refers to **Art. 84 EPC**, which reads:

- 1 The latest version of **GL F-IV 4.3** (iii): *“According to Art. 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description. Parts of the description that give the skilled person the impression that they disclose ways to carry out the invention but are not encompassed by the wording of the claims are inconsistent (or contradictory) with the claims.”*, underline added.
- 2 The latest version of **GL F-IV 4.3** (iii): *“The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims.”*, underline added.

"The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description."

As a contrast to the latest version of **GL F-IV 4.3** and e.g. **T 1808/06** it is argued herein that there is in fact no basis in **Art. 84 EPC** for requiring deletion or special marking of an embodiment in the description just because the embodiment is not included in the claimed matter for which protection is sought.

2 The claims define the matter for which protection is sought

Art. 84 first sentence EPC states that the matter for which protection is sought is defined by the claims, i.e. not by the description or any other part of the application. The matter for which protection is sought is not necessarily the same as the matter for which protection is granted. Similarly, the matter for which protection is sought is not the same as the extent of protection of a claim as determined under Art. 69 EPC. Indeed, it is stated *obiter dicta* in **G 1/98** that the subject-matter of a claim may not be equated with the scope of protection of a claim in an infringement situation.^{3,4} In addition, **G 1/03** refers to the preparatory work of the EPC, which indicates that the EPO is not a competent body to assess the scope of protection of a patent.⁵ In short, Art. 69 EPC is not concerned with the definition of the matter for which protection is sought that is to be examined under the EPC.^{6,7} Accordingly, the words "extent of protection" in the previous GL F-IV 4.3 have been changed to "subject-matter for which protection

is sought" in the latest version of GL F-IV 4.3, seemingly to avoid any reference to Art. 69 EPC and the language therein.⁸

Instead, Art. 84 first sentence EPC should rather be understood as an axiomatic definition according to which it is the claims and no other part of the application that define the matter for which protection is sought. In other words, according to Art. 84 EPC it is the claims that define the matter that is to be examined for compliance with the requirements of the EPC.

Thus, even if the claims should amount to pure nonsense it is still the claims and no other part of the application that define the matter for which protection is sought. Of course, no patent will be granted for nonsense claims but this is hardly because the claims do not define the matter for which protection is sought as required in Art. 84 EPC, but rather because other requirements of the EPC are not fulfilled, e.g. that nonsense claims do not define any invention as required in Art. 52(1) EPC and/or that such claims are not clear as required in Art. 84 second sentence EPC and/or that such claims are not drafted in terms of the technical features of the invention as required in Rule 43(1) EPC etc.

In view of the above it is not obvious how an inconsistency between the description and the claims can render the claims

3 **G 1/98** reasons point 3.1: "Clearly, it is not the wording but the substance of a claim which is decisive in assessing the subject-matter to which the claim is directed. However, it does not follow that the subject-matter of a claim may be equated with the scope of a claim. In assessing the subject-matter of a claim, the underlying invention has to be identified.", underline added.

4 **G 1/98** reasons point 3.3: "The referring Board saw no alternative, when examining a claim for the purpose of Article 53(b) EPC, to constructing the claim in the same way as when considering novelty and inventive step (Reasons, point 15). For the sake of clarity, it should be noted that the approach taken by the referring Board is not an "infringement test", contrary to the appellant's submissions. In order to exclude from patenting subject-matter which is not novel or inventive, all embodiments within the claims must be examined. In contrast, the question of infringement arises when a specific embodiment is alleged to be within the scope of the claimed invention. In this case, the features of the allegedly-infringing embodiment have to be compared with the features of the relevant claim according to the rules of interpretation applied by the Courts responsible for deciding on infringement cases. This may include examining whether a feature of the claim is realized in equivalent form.", underline added.

5 **G 1/03** reasons point 2.1.1: "Although the difference between the approaches may be said to originate from different patent philosophies, evaluating the interests of the earlier and the later applicant, his competitors and the public differently (van Empel, supra, point 100), the final decision opting for the whole contents approach as described above was based on two practical considerations. First, the prior claim approach entails a substantial delay in the examination of the later application, because it can only be applied after the decision giving the final drafting of the claims of the prior application. This was considered to imply an intolerable period of uncertainty, in particular in a system of deferred examination, which was under discussion at the Luxembourg Inter-Governmental Conference (Pfanner, supra, at p. 251). Second, the EPO was not a competent body to assess the scope of protection of the patent, since this had to be determined for the comparison with the later application under the prior claim approach pursuant to the applicable national law.", underline added.

6 **T 1989/18** reasons point 6: "When assessing clarity, Article 69 EPC is of no relevance since it is only concerned with the extent of protection conferred as one of the effects of an application or patent (chapter III of the EPC) whenever that extent is to be determined by whoever is competent to do so. Article 69 EPC is not by itself concerned with a requirement of the Convention to be met by an application or patent – in particular, unlike Article 84 EPC it is not concerned with the definition proper of the subject-matter sought to be protected by a claim. Moreover, even if it were possible, for the purpose of Article 84 EPC, to interpret the claims in the light of the description and drawings as provided for in Article 69 EPC in order to establish whether the conditions governing clarity have been satisfied, the board fails to see how that approach could lead to a lack of clarity of the claims (as opposed to a lack of clarity of the description) if the clear terms of the claims did not encompass subject-matter disclosed in the application or patent.", underline added.

7 See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 314: "**T 2/80** (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also **T 412/03**, **T 129/13**). In decision **T 454/89** the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision **T 760/90**", underline added.

8 The latest version of **GL F-IV 4.3** first paragraph (deletions in strike-through and additions underlined): "Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence."

objectionable under Art. 84 first sentence EPC for not defining the matter for which protection is sought, as seemingly suggested in the latest version of GL F-IV 4.3.⁹ To the contrary, according to Art. 84 first sentence it seems that the claims per definition always define the matter for which protection is sought regardless of possible deficiencies in the matter defined by the claims and regardless of the content of the description.

3 The claims shall be clear

Art. 84 second sentence EPC states that the claims shall be clear. However, there is no condition in Art. 84 EPC that associates the clarity requirement with the description. To the contrary, Art. 84 EPC only mentions the description for the additional requirement that the claims must also be supported by the description.¹⁰

This is seemingly in line with **Rule 43(6) EPC** stating that: *"Except where absolutely necessary, claims shall not rely on references to the description or drawings in specifying the technical features of the invention."*

This is seemingly confirmed by **G 1/04** stating that the features of a claim should be clear for the person skilled in the art from the wording of the claim alone, i.e. without any reference to the description.¹¹

This is further supported by several T-decisions.^{12, 13, 14}

Support for this approach can also be found in GL F-IV 4.1.¹⁵

For example, assume that an embodiment **A** is defined by a claim that is fully clear to a person skilled in the art from the wording of the claim alone. Also, assume that embodiment **A** is disclosed in the description. It is then doubted that the claim becomes unclear simply because the description discloses an additional embodiment **B** that is not covered by the claim, as seemingly suggested in the latest

version of GL F-IV 4.3 (iii).¹⁶ Similarly, if a feature **Ax** in a claim is clear from the wording of the claim alone, then it is doubted that this claim-feature becomes unclear simply because **Ax** is described in the description using words like "preferably", "may" or "optionally" or similar, as seemingly suggested in GL F-IV 4.3 (iii).¹⁷ Indeed, if a claim clearly defines embodiment **A** with feature **Ax** it seems equally clear that embodiment **A** is to be examined for compliance with the requirements of the EPC, not some other additional embodiment **B** that may also be disclosed in the description. Of course, there may be situations where the extent of protection as determined under Art. 69 EPC may be negatively or positively affected by the presence of an additional embodiment **B** in the description that is not covered by the claims. However, as noted in section 2 above, Art. 69 EPC is not concerned with the definition of the matter for which protection is sought that is to be examined for compliance with the requirements of the EPC, as is the case with Art. 84 EPC.¹⁸

⁹ The latest version of **GL F-IV 4.3** first paragraph: *"Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence."*, underline added.

¹⁰ **T 1989/18** reasons point 5: *"Article 84 EPC only mentions the description in the context of the additional requirement that it must support the claims. Under this requirement, the subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described."*, underline added.

¹¹ **G 1/04** reason point 6.2: *"In the present context, it is further to be considered that Article 84 EPC requires that the claims define the subject-matter for which patent protection is sought, and that they must be clear. It signifies that an independent claim within the meaning of Rule 29 EPC should explicitly specify all of the essential features needed to define the invention, and that the meaning of these features should be clear for the person skilled in the art from the wording of the claim alone."*

¹² **T 1989/18** reasons point 4: *"First and foremost, Article 84 EPC requires that the claims are clear, i.e. that they properly define and delimit the subject-matter for which protection is sought in understandable and unambiguous terms. Claims must be clear in themselves when being read with the normal skills including the knowledge about the prior art, but not including any knowledge derived from the description of the patent application or the amended patent (see e.g. decision T 454/89, Reasons, point 4.1 (viii))."*, underline added.

¹³ See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 314: *"T 2/80 (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also T 412/03, T 129/13). In decision T 454/89 the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision T 760/90."*, underline added.

¹⁴ See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 314: *"In T 1129/97 (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ('low alkyl') was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under Art. 84 EPC 1973 concerned only the claims, and therefore – according to the established case law of the EPO boards of appeal – required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC 1973 the description was to be used to interpret the claims. But Art. 69 EPC 1973 concerned only the extent of protection where this was at issue, e.g. with third parties, and not (as in Art. 84 EPC 1973) the definition of the matter to be protected by a claim. Confirmed in T 56/04, T 64/03, T 1265/13."*, underline added.

¹⁵ **GL F-IV 4.1** Clarity
The requirement that the claims must be clear applies to individual claims, i.e. to independent and dependent claims alike, and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim must, as far as possible, be clear for the person skilled in the art from the wording of the claim alone (see also F-IV, 4.2). In view of the differences in the scope of protection which may be attached to the various categories of claims, the division must ensure that the wording of a claim leaves no doubt as to its category.", underline added.

¹⁶ The latest version of **GL F-IV 4.3 (iii)**: *"The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims."*, underline added.

¹⁷ **GL F-IV 4.3 (iii)**: *"Moreover, features required by the independent claims may not be described in the description as being optional using wording such as 'preferably', 'may' or 'optionally'. The description must be amended to remove such terms if they make a mandatory feature of an independent claim appear as being optional."*, underline added.

¹⁸ See footnotes 6 and 7 above.

Thus, a mere inconsistency between a claim and the description as indicated above should not be enough in itself to affect the clarity of the claim, except possibly in some special cases. This understanding of clarity and inconsistencies (discrepancies) between a clear claim and the description is seemingly confirmed in case law.^{19, 20, 21, 22} After all, as noted at the beginning of this section 3, there is nothing in Art. 84 EPC that associates the clarity requirement with the description. Consequently, it seems that the clarity requirement in Art. 84 EPC cannot be invoked for requiring deletion or special marking of additional embodiments in the description simply because the embodiments are not included in the matter defined by the claims, as is seemingly mandated in the latest version of GL F-IV 4.3 (iii).²³

The above relates to clear claims. If a claim is not clear to a person skilled in the art from the wording of the claim alone then the description may indeed come into play, e.g. to interpret the claim and/or to support possible claim amendments etc. However, it seems reasonable to assume that a claim shall be clear to a person skilled in the art using common general knowledge and that any minor doubt or remote interpretation of a claim or claim feature should not render the claim unclear.

19 **T 1989/18** reasons point 5: "However, when assessing clarity, the description cannot be relied upon to resolve a clarity issue in a claim, nor can it give rise to any such issue if the definition of the subject-matter in a claim is clear per se. In particular, if the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject-matter which is not claimed.", underline added.

20 See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 310: "A discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (T 431/03) or to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader (T 1018/02, T 1395/07, T 1456/14).", underline added.

21 See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 310: "In T 2221/10 the board referred to established case law according to which the description can be used as the patent's 'dictionary' to assess the correct meaning of ambiguous terms used in claims (see in this chapter II.A.6.3.3). However, if a term used in a claim has a clear technical meaning, the description cannot be used to interpret such a term in a different way. In case of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description.", underline added.

22 See Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, July 2019 (Case Law) page 310: "In T 197/10 the board explained that if the claims are worded so clearly and unambiguously as to be understood without difficulty by the person skilled in the art, there is no need to use the description to interpret the claims. In the event of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description. Thus, in the event of a discrepancy between clearly defined claims and the description, those elements of the description not reflected in the claims are not, as a rule, to be taken into account for the examination of novelty and inventive step.", underline added.

23 The latest version of **GL F-IV 4.3 (iii)**: "The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims.", underline added.

24 **T 26/81** reasons point 4: "Starting with the interpretation of Article 84 EPC, it must be remembered that this article states a requirement in respect of the claims and not of the description. Since most claims are generalisations of examples disclosed in the description, the purpose of this provision must be seen as safe-guarding that the claims do not cover any subject-matter which, after reading the description, still would not be at the disposal of a skilled person. Undoubtedly, there may be cases where the lack of disclosure of a technical problem could lead to the conclusion that the claims lack support by the description.", underline added.

4 The claims shall be supported by the description

Art. 84 second sentence EPC states that the claims shall be supported by the description. As noted in section 2 above, the claims define the matter for which protection is sought and this is the matter that is to be examined for compliance with the requirements of the EPC, not the extent of protection of a claim as determined under Art. 69 EPC.

The reason behind the support requirement in Art. 84 EPC has been explained in case law e.g. such that Art. 84 EPC:

- safe-guards that the claims do not cover any subject-matter which, after reading the description, would still not be at the disposal of the person skilled in the art.²⁴
- ensures that the monopoly given by a granted patent generally corresponds to the invention which has been described in the application, and that the claims are not drafted so broadly that they dominate activities which are not dependent upon the invention which has been described in the application.²⁵
- is concerned with the permissible width of the claims having regard to the disclosure in the description.²⁶
- requires that the subject-matter of the claims must be taken from the description and that it is inadmissible to claim any subject-matter which is not described.²⁷

The above cited case law is also reflected in **GL F-IV 6.1** and **GL F-IV 6.3**.^{28, 29}

For simplicity, the case law and the GL referred to above may be summarized as in T 26/81 stating that: "**... the claims are not allowed to cover any subject-matter**

25 **T 133/85** reasons point 5: "Thus, the requirement in Article 84 EPC that the claims shall be supported by the description is of importance in ensuring that the monopoly given by a granted patent generally corresponds to the invention which has been described in the application, and that the claims are not drafted so broadly that they dominate activities which are not dependent upon the invention which has been described in the application.", underline added.

26 **T 301/87** reasons point 3.3: "As regards (ii), Article 84 EPC reads: 'The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description'. This requirement is on its face quite distinct from the requirement of Article 83 EPC discussed above. Essentially, this requirement under Article 84 EPC is concerned with the permissible width of the claims having regard to the disclosure of the patent in its description.", underline added.

27 **T 1989/18** reasons point 5: "Article 84 EPC only mentions the description in the context of the additional requirement that it must support the claims. Under this requirement, the subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described.", underline added.

28 **GL F-IV 6.1**: "The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (see T 409/91).", underline added.

29 **GL F-IV 6.3**: "As a general rule, a claim is regarded as supported by the description unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis.", underline added.

which, after reading the description, would still not be at the disposal of the person skilled in the art”.³⁰

In view of the reason behind the support requirement in Art. 84 EPC as indicated in case law and in the GL referred to above it seems that the extent of the description can be wider than the width of the claim without affecting the support for the claim.

For example, assume that an embodiment with an electrical motor is defined by a clear claim that is supported by the description, since the description fully discloses the embodiment with an electrical motor. It is then doubted that the claim becomes unsupported simply because an additional embodiment with a combustion engine is also disclosed in the description, as seemingly suggested in the latest version of GL F-IV 4.3 (iii).³¹ To the contrary, it seems that the embodiment with the electrical motor is expressly disclosed in the description as an alternative at the disposal for the skilled person. It is hardly the case that the embodiment with an electric motor is not at the disposal for the skilled person simply because an additional embodiment with a combustion engine is also disclosed in the description. Similarly, if a claim defines feature **Ax** it is doubted that **Ax** becomes unsupported just because **Ax** is described in the description using words like “preferably”, “may” or “optionally” or similar, as seemingly suggested in GL F-IV 4.3 (iii).³² To the contrary, it seems that **Ax** is expressly disclosed in the description as an alternative at the disposal for the skilled person.

Thus, a mere inconsistency between a claim and the description as indicated above should not be enough in itself to affect the support of the claim, except possibly in some special cases. After all, it is the claims that shall be supported by the description, not the description that shall be supported by the claims. Thus, there seems to be no basis in Art 84 EPC for requiring that every embodiment that is disclosed in the description must be included in the matter defined by the claims.³³ Conversely, if a clear claim

is supported by the description as indicated above there seems to be no basis in Art. 84 EPC for requiring any deletion or special marking of additional embodiments in the description simply because they are not included in the matter defined by the claim, as is seemingly mandated in the latest version of GL F-IV 4.3 (iii).³⁴

However, even if a mere inconsistency between a claim and the description as indicated above should generally not be enough in itself to affect the support of the claim, the claim may nevertheless be unsupported by the description if there are other issues, for example:

- if the claim is contradicted by the description (e.g. the description specifies that the invention can be used in a first data network but not in a second data network, but the second data network is nevertheless claimed);
- if the claim defines an embodiment that is presented in the description as not being part of the invention (e.g. the embodiment is described as belonging to the state of the art or as a comparative example for understanding the invention);
- if the claim lacks a feature that is presented in the description as essential for the invention;³⁵
- if there is a lack of disclosure of a technical problem;³⁶
- etc.

5 Summary and Conclusions

In section 2 above it was argued that Art. 84 EPC specifies that the claims always define the matter for which protection is sought regardless of possible deficiencies in the matter defined by the claims and regardless of the content of the description. Thus, it was questioned how any inconsistency between the description and the claims can have the effect that the claims do not define the matter for which protection is sought?

³⁰ See footnote 24 above

³¹ The latest version of **GL F-IV 4.3 (iii)**: “Example: Independent claim defines a vehicle with a broad feature of a “motor”, together with other features. The description and the drawings comprise Embodiment 1, in which the vehicle has an electric motor, and Embodiment 2, in which the vehicle has a combustion engine. During the prosecution, in order to fulfil the requirements of inventive step, the independent claim is amended to specify a vehicle employing an electric motor since the combination of claimed features using a combustion engine was anticipated by the prior art. Embodiment 2 is no longer consistent with the independent claim, unless it can be inferred from this embodiment that the combustion engine is used in combination with the electric motor. This inconsistency can be rectified either by removing Embodiment 2 from the description and drawings or by marking Embodiment 2 as not being covered by the claimed subject-matter (e.g. “Embodiment 2 is not covered by the subject-matter of the claims” or similar wording).”

³² **GL F-IV 4.3 (iii)**: “Moreover, features required by the independent claims may not be described in the description as being optional using wording such as “preferably”, “may” or “optionally”. The description must be amended to remove such terms if they make a mandatory feature of an independent claim appear as being optional.”, underline added.

³³ **T 1989/18** reasons point 13: “In view of the above considerations, the board fails to see how the aforementioned provisions of the EPC, or any others, can lead to the requirement that embodiments disclosed in the description of an application which are of a more general nature than the subject-matter of a given independent claim must constitute potential subject-matter of a claim dependent on that independent claim.”, underline added.

³⁴ The latest version of **GL F-IV 4.3 (iii)**: “The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims.”, underline added.

³⁵ See e.g. T 133/85, T 409/91, T 939/92, T 322/93, T 556/93, T 583/93, T 659/93, T 482/95, T 616/95, T 586/97, T 687/98, T 1076/00, T 637/03.

³⁶ **T 26/81** reasons point 4: “Starting with the interpretation of Article 84 EPC, it must be remembered that this article states a requirement in respect of the claims and not of the description. Since most claims are generalisations of examples disclosed in the description, the purpose of this provision must be seen as safe-guarding that the claims do not cover any subject-matter which, after reading the description, still would not be at the disposal of a skilled person. Undoubtedly, there may be cases where the lack of disclosure of a technical problem could lead to the conclusion that the claims lack support by the description.”, underline added.

In section 3 above it was noted that Art. 84 EPC does not associate the clarity requirement with the description. It was argued that the claims shall be clear to a person skilled in the art from the wording of the claims alone and that a claim will not become unclear simply because the description contains additional embodiments that are not encompassed by the claimed matter. It was concluded that the clarity requirement in Art. 84 EPC cannot be invoked for generally requiring deletion or special marking of embodiments in the description that is not covered by the claimed matter.



Mikael Nyberg

In section 4 above it was argued that for the claims to be supported by the description they are not allowed to cover any matter which, after reading the description, would still not be at the disposal of the person skilled in the art. It was further argued that a claim will not become unsupported simply because the description contains additional embodiments that are not encompassed by the claimed matter. It was concluded that the support requirement in art. 84 EPC cannot be invoked for generally requiring deletion or special marking of embodiments in the description that is not covered by the claimed matter.

It should be added that a general deletion or special marking of embodiments in the description that are not covered by the claims may result in extensive and difficult amendments with considerable work for the applicant and the EPO examiners. Indeed, embodiments and their features are often described in an entangled manner making it difficult to clearly separate one embodiment from another and/or to isolate a feature to a particular embodiment. Thus, there is a significant risk that a general deletion or marking of uncovered embodiments creates new combinations (e.g. intermediate generalizations) and/or contexts and/or meaning of terms or features that are not previously disclosed in the application, thus violating **Art. 123(2) EPC** under which the application (i.e. not only the claims but also the description and the drawings) cannot be amended such that it contains subject-matter which extends beyond the content of the application as filed. Also, a general deletion or marking of uncovered embodiments at examination may have undesirable implications post grant. The matter for which protection is sought under Art. 84 EPC is not the same as the extent of protection as determined under Art. 69 EPC, with the effect that embodiments that are not covered by the mere "wording" of the claims under Art. 84 EPC may still fall within the extent of protection under Art. 69 EPC. If such embodiments are deleted or marked as "not part of the invention" or similar at examination it may be hard to later argue that such embodiments nevertheless fall within the extent of protection, which then may be unduly restricted.

It is proposed that **GL F-IV 4.3** is revised once more.

Next deadline for epi Information	Nächster Redaktionsschluss für epi Information	Prochaine date limite pour epi Information
The Editorial Committee invites contributions for publication in the next issue of epi Information. Documents for publication or any enquiry should be sent by eMail to (editorialcommittee@patentepi.org) no later than 29 August 2022 .	Bitte senden Sie Ihre Beiträge zur Veröffentlichung in der nächsten Ausgabe der epi Information an den Redaktionsausschuss. Alle Artikel oder Anfragen schicken Sie bitte an folgende Email Adresse editorialcommittee@patentepi.org bis spätestens 29. August 2022 .	La Commission de Rédaction vous invite à lui faire parvenir vos contributions pour publication dans le prochain numéro d' epi Information. Les documents pour publication ou toute demande d'information doivent être envoyés par courriel (editorialcommittee@patentepi.org) au plus tard le 29 août 2022 .
Further information can be found in our "Guidelines for Authors" here: https://patentepi.org/r/guidelines-epi-info	Weitere Informationen finden Sie in unseren „Guidelines for Authors“ auf der epi Webseite: https://patentepi.org/r/guidelines-epi-info	De plus amples informations sont disponibles dans nos « Directives pour les auteurs » à l'adresse : https:// patentepi.org/r/guidelines-epi-info

Paper Submitted by epi concerning new WIPO Standard ST.26 on sequence listings

This paper is submitted on behalf of **epi** to the EPO

The Institute of Professional Representatives before the European Patent Office (**epi**) is the professional body representing all representatives entered on the List held by the EPO (European Patent Attorneys). Currently **epi** has about 13,000 European Patent Attorneys as members coming from each of the 38 Contracting States of the European Patent Convention (EPC) who work either in industry or in private practice.

This paper has primarily been written by the Biotechnology committee of **epi**. It is being submitted because we have significant concerns with the implementation of WIPO Standard ST.26 on 1st July 2022. **epi** has tried to engage with the EPO on several levels, and with different people and different departments, regarding the new ST.26 standard. However, we are becoming increasingly concerned that the EPO is not sharing users' concerns and any issues raised are dismissed by summarily reference to the guidance provided by WIPO. It appears that the EPO has decided that it will implement ST.26 irrespective of the potential consequences for the EPO, practitioners, and applicants alike.

Therefore, we are putting our concerns in writing, so that they are fully documented. This paper is being submitted to DG1, the legal department, and other departments so that they are all well aware, in writing, of potential issues and problems and of the concerns of attorneys.

We thus hope that the EPO will engage with us, although we realise that this is put in writing at a relatively late stage. That is primarily because few, if any, opportunities for users to put forward their concerns to the EPO have arisen. In addition, when concerns have been raised, those have been downplayed by the EPO.

General remarks

ST.26 provides a fundamental and seismic shift in the requirements for sequence listings. Its requirements are considerably different to those of present standard ST.25. One of our concerns is that it is difficult to convert sequence listings from the old ST.25 standard to the new ST.26 standard, particularly for sequence listings with a higher number of entries. This difficult conversion is time consuming and will place a considerable burden on users,

applicants and attorneys alike. This will drive up the cost of filing and prosecution of EPO patent applications with sequence listings, both for industry and other users. It will place an additional and disproportionate burden on applicants in one particular technological sector and has the potential to cause legal problems and uncertainty for many years to come.

A fundamental issue with ST.26 is that it requires additional information above and beyond ST.25. In theory, this is perhaps not a bad thing. More information, rather than less information, is better. How this is implemented, however, is key.

Priority-claiming applications

There is no transitional period. The new ST.26 comes into force on 1st July 2022. This applies to all EP applications with an International or European filing date after then, even where an earlier related application has been filed using ST.25. For example, a National patent application could have been validly filed using ST.25, and then a European patent application, filed after 1st July and claiming priority, would require a ST.26 version. Likewise, a priority-setting European patent application filed before 1st July would have a sequence listing in ST.25 format while the subsequent priority-claiming European patent application filed after 1st July would require an ST.26-compliant sequence listing. This places an added burden on applicants, particularly in order to avoid affecting the validity of the claim to priority (notably under the EPO's strict interpretation of priority).

However, we understand that the EPO is now bound by international agreements on how WIPO Standard ST.26 will be implemented with respect to new International and European patent applications.

Divisional applications – legal considerations

In contrast, the EPO is not bound to the same extent by international agreements in respect of *divisional* applications. In question 31 of its Frequently Asked Questions on the implementation of ST.26¹, WIPO confirms that

¹ <https://www.wipo.int/standards/en/sequence/faq.html>

divisional applications are “a matter of national law” and that “As this is a decision for the Office, some may decide applicants to be allowed to “carry over” the sequence listing from the parent application to the divisional”.

The Decision of the President of the European Patent Office dated 9 December 2021 on the filing of sequence listings (OJ EPO 2021, A96) is silent on divisional applications. Only the subsequent Notice from the European Patent Office dated 9 December 2021 concerning the filing of sequence listings (OJ EPO 2021, A97) expressly sets out the EPO’s position with respect to divisional applications.

It appears from this Notice, contrary to pleadings from **epi** and other user organisations, that the EPO will insist on ST.26 as the standard for all divisional applications submitted on or after 1st July 2022. The Notice alleges that

*“As an **independent** European patent application, a divisional application must also satisfy the requirements of Rule 30 EPC in conjunction with the decision of the President. Consequently, a sequence listing forming part of the description of a divisional application filed on or after 1 July 2022 must comply with WIPO Standard ST.26” (point 16; emphasis added).*

However, a divisional application is not entirely independent from its parent application. In particular, it is given the **same filing date** as its parent application. Art. 76(1) EPC states “in so far as [the requirement not to add matter] is complied with, the divisional application **shall be deemed to have been filed on the date of filing of the earlier application** and shall enjoy any right of priority” (emphasis added). The date on which the divisional application is physically or digitally ‘filed’ at the EPO is merely the date on which the application is lodged. Hence, for example, the EPO Register indicates the “filing date” for a divisional application to be same as the filing date of the parent application, not the date on which the divisional application was submitted to the EPO.

For at least this reason, we submit that the relevant sequence listing standard for divisional applications should be the standard that is required as of its true filing date (i.e. the filing date of its parent application), such that divisional applications of applications filed before 1st July 2022 should remain under standard ST.25. The EPO has the authority (and, indeed, the obligation under Art. 76(1) EPC) to do so, and can do this without affecting agreements with WIPO.

Divisional applications – added matter concerns

In addition to the general aim of reducing burden on applicants, we have serious concerns about the potential for ST.26 sequence listings filed for divisional applications (when the parent case had been filed before 1st July 2022) to add matter. Such added matter problems will be impossible to remedy. This is because ST.26, by definition, requires more information than ST.25. By requiring more information, the danger is that filing an ST.26 listing will, inherently, add matter. That is an immediate and obvious consequence of ST.26 demanding more information.

The only response we have received from the EPO is to point to Annex VII of Standard ST.26, which purports to provide guidance for how to avoid the pitfalls of added subject matter when preparing an ST.26 sequence listing. However, that Annex itself *acknowledges* that there are a number of situations in which it would *not* be possible to avoid adding matter (e.g. Scenarios 7, 19 and 20). Those situations particularly relate to alleged deficiencies in the earlier ST.25 sequence listings relating to a lack of clarity. Hence, in those situations, a mere lack of clarity in a parent application could give rise to a fundamental problem of *added matter* in a divisional application. This is unacceptable.

Similarly, there are places in Annex VII that refer to an inevitable addition of information that would not be entitled to priority (e.g. Scenarios 7 and 8; see particularly the note at the bottom of page 3.26.vii.5). In the context of a divisional application, this means *added matter*, which cannot be remedied.

Hence, applicants could be caught in an inescapable trap between the potentially conflicting requirements of Rule 30 and Art. 76(1) EPC.

This, therefore, is serious and sufficient evidence that there will be an inherent problem with some divisionals filed after the 1st July.

The EPO seems to be either unaware of this problem or would appear to be ignoring it. It is leaving it to applicants to sort out. However, this problem has the potential to create legal uncertainty for years. Divisional applications requiring ST.26 listings filed after 1st July will inevitably be vulnerable to challenge under Article 76(1) EPC, such that we can envisage patents being challenged after grant on the grounds of added matter in sequence listings. This is because it is a relatively easy attack and is worsened by the fact that the EPO’s stance on added matter under Articles 123(2)/76(1) EPC is very strict. We fear therefore that granted patents could be opposed on these grounds and that the matter may not be resolved for many years, leading to legal uncertainty.

Divisional applications – burden upon the applicant

The tables below show an analysis of WO 2021 sequence listings published by WIPO, specifically the number of SEQ IDs contained in published sequence listings and the number of pages of these sequence listings if printed using minimal margins.

publication_year	2021		
Number of SEQ IDs	Count of SEQ listings	% of total SEQ listings	
<=10	3454	29.77%	} ~50%
11-25'	2345	20.21%	
26-50	1860	16.03%	
51-100	1542	13.29%	
101-250	1317	11.35%	} ~9%
251-500	467	4.02%	
501-1000	288	2.48%	
1001-2500	126	1.09%	
2501-5000	62	0.53%	
5001-10000	43	0.37%	
>10000	54	0.47%	
(blank)	46	0.40%	
Grand Total	11604	100.00%	

Notably, approximately 50% of published sequence listings contained <=25 SEQ IDs, i.e. would be expected to present a relatively small burden upon applicants to transform from WIPO ST.25 to ST.26, potentially requiring only a few hours' work.

However, approximately 9% of published sequence listings contain >250 SEQ IDs, and almost 2.5% of published sequence listings contain >1000 SEQ IDs. The burden upon applicants of transforming those large sequence listings from WIPO ST.25 to WIPO ST.26 will be very substantial, particularly given the need for manual input and intervention during the transformation process and the need to ensure that any modifications to the sequence listing/sequence information required by ST.26 do not introduce added matter.

The table below shows the number of pages of sequence listing if printed using minimal margins, line spacing and text size², together with the corresponding excess page fees that will be due (assuming the application has >=35 pages excluding the sequence listing, which is standard for patent applications incorporating sequence listings).

publication_year	2021	-T			
Number of SEQ IDs	Count of SEQ listings	Average of Pages of SEQ listing	Average of Excess page fee	% of total SEQ listings	
<=10	3454	15.84	EUR 253.45	29.77%	
11-25'	2345	59.77	EUR 956.30	20.21%	
26-50	1860	68.74	EUR 1,099.86	16.03%	
51-100	1542	87.25	EUR 1,395.94	13.29%	
101-250	1317	218.43	EUR 3,494.83	11.35%	
251-500	467	361.33	EUR 5,781.31	4.02%	
501-1000	288	609.83	EUR 9,757.22	2.48%	
1001-2500	126	1351.54	EUR 21,624.63	1.09%	
2501-5000	62	2371.16	EUR 37,938.58	0.53%	
5001-10000	43	6100.56	EUR 97,608.93	0.37%	
>10000	54	24228.00	EUR 387,648.00	0.47%	
(blank)	46	14.74	EUR 235.83	0.40%	
Grand Total	11604	256.63	EUR 4,106.07	100.00%	

Even for applications with <=10 SEQ IDs, the average cost of excess page fees for a sequence listing incorporated into the description of a divisional application is EUR 253. For applications with 251-500 SEQ IDs, the average excess page fee is EUR 5,781, and for applications with 5001-10000 SEQ IDs, the average excess page fee is almost EUR 100,000.

Although it will be possible in some cases with relatively short sequence listings to include the ST.25 formatted sequence listing as part of the description of the divisional application, as illustrated above, the excess page fees required for the larger sequence listings (e.g. the 9% of cases with sequence listings with >250 SEQ IDs) will be very substantial, and for many cases will be an impossible burden.

This burden (and the risk that transformation to ST.26 presents) is entirely disproportionate to the benefits to the EPO and third parties. Ultimately, if the EPO wishes to make procedural changes, the impact upon applicants must be a primary consideration, particularly where there is the potential of causing/forcing the inclusion of added matter which will result in irrecoverable losses. As is stated at Art 4(3) EPC, *"The task of the [European Patent] Organisation shall be to grant European patents"*. In contrast, the current implementation of WIPO ST.26 will actively hinder the granting of European patents for affected applicants.

Divisional applications – solution adopted by the UK IPO

We would like to point out that, in the UK, the Chartered Institute of Patent Attorneys (CIPA) made representations to the UK IPO on precisely this matter. The UK IPO subsequently changed its proposed practice with regard to ST.26 and divisional applications, and now requires that *"For new divisional patent applications filed on or after 1 July 2022, the sequence listing should be supplied in the format required for the parent application"*³.

² Margins - Rule 49(5) EPC; 1.5 line spacing and text with 0.21 cm high capital letters (Courier New @ 10.5pt) - Rule 49(8) EPC; 41 lines of text possible on a single A4 page.

³ <https://www.gov.uk/government/publications/changes-for-patent-applications-with-biological-sequence-listings>

The legal basis for this is: (a) Section 15(9)(b) UKPA 1977, which states that "... the new [divisional] application shall be treated as having, as its date of filing, the date of filing the earlier [parent] application" and (b) the agreed transition from WIPO ST.25 to WIPO ST.26 being determined based on the international filing date (i.e. WIPO ST.26 is required for PCT applications having an international filing date on or after 1 July 2022)^{4,5}.

Proposals from epi

We trust that the EPO will seriously consider the following proposals to be in force as of 1st July 2022.

- 1. Establish their true filing date (in accordance with Art. 76(1) EPC) as the determinative date for which sequence listing standard is required for divisional applications, thus enabling them to use the same sequence listing as their parent application (i.e. the same approach as the UK IPO).**
- 2. Waive the late furnishing fee under Rule 30(3) EPC for providing ST.26 sequence listings on cases where a pre-existing ST.25 listing is submitted to the EPO for search purposes only.** This would offset the cost of completing the onerous conversion requirements from ST.25 to ST.26.
- 3. Waive the requirement for applicants/representatives to file a declaration that the sequence listing does not add subject matter.** This is because this requirement will be impossible to satisfy in some cases. The requirements of ST.26, with the additional information over and above ST.25, may make it impossible for an attorney to declare

that the new sequence listing does not add new matter. This would place applicants and representatives in an impossible position in which they would be pressured to declare something that they know is not true.

- 4. In the event that proposal 1 is not adopted, waive the requirement for additional page fees that are specifically incurred for the pages of an ST.25 sequence listing that are reproduced as pages of the description of a divisional application to maintain the subject matter of its parent application.**

We realise that these are significant requests. However, they are not disproportionate given the circumstances. The ST.26 standard itself was devised with virtually no applicant, representative or user input. Furthermore, the EPO has decided to implement ST.26 without serious discussion with users and, we feel, without duly taking the impact on applicants into account. We therefore present our concerns and proposed solutions in concrete terms so that the EPO is clearly aware of potential problems, and the issues that will arise for both the EPO and users alike in the future if these concerns are not resolved appropriately.

We would very much appreciate engagement with the EPO on this matter. We believe that this should be seriously considered by legal experts, sequence listing experts and senior management and Examiners before the implementation deadline of 1st July 2022. Serious engagement with users, in order to forestall potential issues which the new ST.26 standard is likely to cause, would be appreciated.

We hope that the EPO will immediately engage with users and applicants alike in order to discuss these issues and to minimise the envisaged problems.

*Written by epi Biotechnology Committee
21 June 2022*

⁴ WIPO CWS/5/22 at paragraph 44 – https://www.wipo.int/edocs/mdocs/cws/en/cws_5/cws_5_22.pdf
⁵ Paragraph 183 of document WO/GA/54/15 – https://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_54/wo_ga_54_15.pdf



Education

epi starts educational activities on the UP and UPC

A special committee of **epi** has been planning the outlines of a training on the UP and UPC which it offers its members. In an introductory video recording that is available on www.epi-learning.org, the president of **epi**, Francis Leyder, explains how this training offer is structured. It consists of three levels:

1. Essentials
2. Intermediate
3. Advanced

The first level will cover the essential knowledge that an **epi** member should have of both the UP and the UPC. It consists of two recordings of which the UP part is already available on the educational website and the recording on the UPC will follow in June. These recordings are offered free of charge.

In the intermediate level you will be provided with practical knowledge for your day-to-day work with the new system and it will become available when the EPO and/or the UPC will have completed all the necessary administrative details with regards to the formalities for requesting unitary protection and opt-outs, respectively. It will also provide you with strategic considerations, e.g. when to request unitary effect and when to file an opt-out for the UPC.



The advanced level will provide knowledge for **epi** members that will assist representatives before the UPC. It will not be a course that would enable you to obtain a European Patent Litigation Certificate, but it will provide information on the UPC Rules of procedure and tactical and strategic aspects of litigating a case before the UPC.

Levels 2 and 3 will aim at providing practical examples, case studies and discussions and will require active participation. Like the recordings that are already available, we will be offering this training through our website www.epi-learning.org, but we will also be organizing live events.

Preparation for the 2023 EQE on the epi-learning platform

To support EQE candidates and **epi** Students on their way to the European Qualifying Examination, the **epi** currently offers a number of training courses:

- **epi** Students' forum
- EQE Online Workshops
- **epi** Tutorials
- **epi** Tutor consultation hour

In addition, epi Students

- have exclusive access to a training video on patent claims on the epi-learning.org platform
- can enrol for webinars (and access recordings thereof) offered to **epi** members (such as UP/UPC).

epi Students' forum

In this forum, epi Students have the opportunity to ask questions and to discuss topics related to the European Qualifying Examination (EQE) at any time. Posting questions and answers in the forum is, by default, anonymous. epi Students are automatically enrolled and access to the forum is free of charge. Posts will be answered by an epi Tutor and will be available for all to see.

EQE Online Workshops

The EQE Online Workshops are especially designed for EQE candidates who have passed the Pre-Examination and are now preparing for the main EQE. Each online workshop comprises between 6 to 8 short online sessions in which participants will work in small groups on real examples of practical and strategic aspects of the examination paper in question. Workshops can be booked per paper.

Session Calendar

All sessions will be held from 16:00 to 18:00 CEST (and then CET after the end of October) on Monday and Thursday.

Paper A:
20 June to 7 July 2022

Paper B:
13 June to 30 June 2022
Further EQE online workshops will be offered in autumn 2022. The schedule can be found on **epi** website.

epi Tutorials

The most individually tailored training offering is **epi** Tutorials. Candidates can privately write answer scripts for one or more of the past EQE papers including mock papers January 2021 and December 2021 (pre- or main examination). Experienced **epi** Tutors will then review the answer scripts and provide personal feedback via videoconference or e-mail.

Due dates and feedback sessions are individually organised between the tutee and tutor. The tutorial fee (400€ per paper) covers a maximum of two different years. **epi** Students enjoy a 50% discount.

epi Tutor consultation hour exclusive for epi Students

Each week, an experienced epi Tutor will be available for an hour to answer questions you may have relating to each one of the exam papers starting with the Paper D (first week) with the other papers following in each of the next four weeks. The cycle of sessions will then repeat in 5 week blocks.

Session Calendar

All sessions will be held from 16:00 to 17:00, CEST (and then CET after the end of October).

Paper D:
12 October 2022 | 16 November 2022
04 January 2023 | 08 February 2023

Paper A:
19 October 2022 | 23 November 2022
11 January 2023 | 15 February 2023

Paper B:
26 October 2022 | 30 November 2022
18 January 2023 | 22 February 2023

Paper C:
02 November 2022 | 07 December 2022
25 January 2023 | 01 March 2023

Pre-Examination:
09 November 2022 | 14 December 2022
01 February 2023 | 08 March 2023

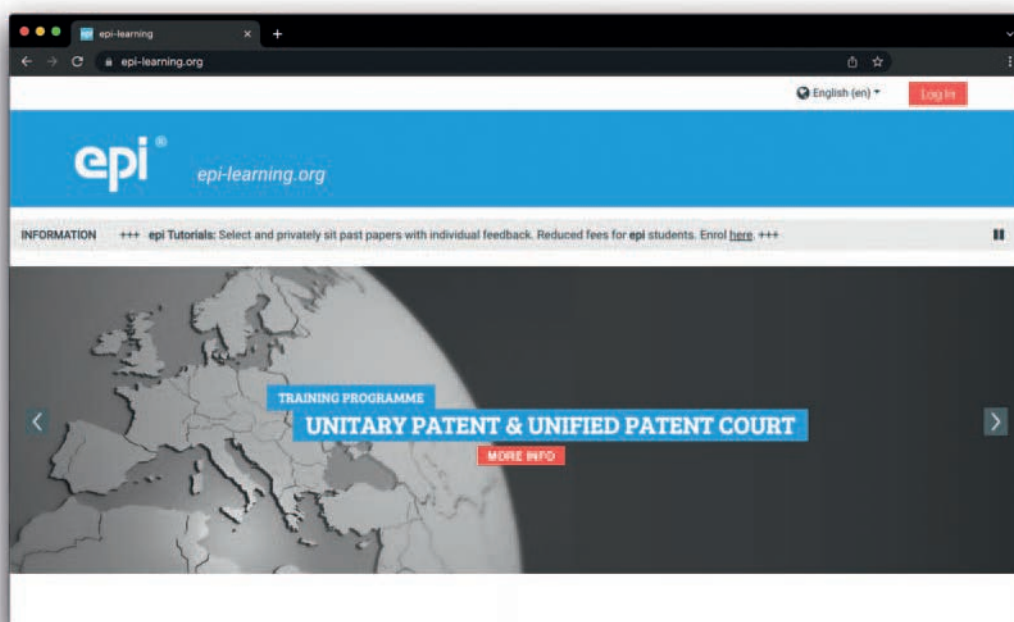
epi Student membership

epi student members have access to additional information on the **epi** learning website, including the student forum described below. Other benefits of student membership include receiving alerts about **epi** training courses, priority access to our educational events, and reductions on course fees for **epi** educational events, such as tutorials, Mock EQEs, seminars and webinars. Candidates for **epi** student membership may apply, at

any stage of their training, to the **epi** Secretariat (epi.student@patentepi.org), simply by filling in the online application form¹, providing the necessary documents² and paying the fee.

- 1 <https://patentepi.org/en/epi/form/47/registration>
- 2 <https://patentepi.org/en/epi-students/epi-studentship/rules-governing-the-epi-student-membership.html>

epi-learning



epi-learning¹ is the platform for all online training activities organised by the **epi**.

epi students are automatically registered in this platform and can take advantage of support and training offers specifically designed for **epi** students.

To register you on the platform we need your consent. This will be presumed when you fill in the survey link² the required data.

Via **epi-learning**, **epi** members and **epi** students can access relevant online courses, online lessons, and other resources, such as recordings of the following webinars:

- Essential training on UP/UPC
- Added Matter
- New Rules of the Procedure of the BoA and further developments
- Supplementary Protection Certificates (SPC)
- Conflicts of Interest
- Privilege in patent matters
- Collaboration with overseas patent colleagues

You can find more training offers on **epi-learning**³.

1 <https://www.epi-learning.org>
 2 https://www.surveymonkey.de/r/epi-learning_platform

3 <https://www.epi-learning.org/course/>



Committee Reports



John Gray

Report of the Online Communications Committee

J. Gray (GB), Chair

Further to our report in issue 1/2022, OCC members remain busy in various ways. Our annual meeting (online again this year) took place on 15 June 2022. Personally, I attended the Main SACEPO meeting on 23 June and will join the **epi** presidium in their bilateral meeting with the EPO president, in July.

Central Fee Payment

SACEPO was told that the existing online fee payment system will be turned off on or around 10 September 2022. Users have limited time to switch to using the new Central Payment platform. Unfortunately, until 10 September automatic debit orders can only be managed in the old system: i.e. zero sunset/sunrise period for some users!

Unitary Patent designation procedures and IT infrastructure

OCC has been pressing for early access and testing of the online filing procedures relating to the request for Unitary Effect. We consider it important that users can test it and adapt their procedures and software robustly, before the new regime is legally force. I am pleased to note that EPO launched demo versions of the UP forms in eOLF and OLF 2.0 on 16 June 2022. OCC's Tassilo Meindl is leading a

group of OCC members looking into the functionality of these systems as soon as possible. Members responsible for pending applications close to grant should do the same, and raise any concerns with the EPO and copy OCC at the address below.

New User Area ("MyEPO Portfolio")

This new user portal *MyEPO Portfolio* was launched for general use in May 22. On 2 June, one of our members highlighted a bug in the mailbox function of *MyEPO Portfolio*. This was communicated from **epi** to the EPO and the system was placed out of service as a precaution. Together with OCC deputy chair David Brophy and OCC member Tassilo Meindl, I met with the EPO experts to understand the origin of this bug, the nature of the fix and measures to minimise the risk of such bugs in future. Based on these discussions, **epi** is satisfied that this incident happily had very limited consequence and *MyEPO Portfolio* can be reopened with confidence. Users directly affected by the bug are being contacted directly by the EPO. We commend the swift action of the EPO and their openness to discussing the matter with **epi**.

Interacting with the OCC

Thanks always to the members who report to us the random issues they face with EPO IT systems. You can submit issues and information directly to the OCC Chair at OCC@patentepi.org.

Report of the epi Harmonisation Committee

up to and including 17th May 2022

J. D. Brown (GB), Chair

Until December, 2021, Substantive Patent Law Harmonisation ("SPLH") had not been receiving the attention it should. This changed when the **epi** President received a letter from the EPO Chief Economist, informing of a new study on the grace period. After numerous virtual meetings of HC and a virtual meeting with the EPO Chief Economist and some of his team, a response to the EPO Chief Economist was prepared by the **epi** Harmonisation Committee and then approved by the **epi** Board and filed on 3rd March 2022.

On the main topic, namely SPLH, the EPO, at the 53rd meeting of CPL, agreed to conduct concerted national consultations on the basis of a common document and questionnaire. At the 54th meeting of CPL held on 15th February, 2022, it was reported that a draft Common Consultation Document had been prepared and sent to Member States for comment by Monday, 28th February 2022. Once finalised, a period of only 6 – 8 weeks would be provided for national offices to carry out consultations, draw up reports and provide them to the EPO. The EPO intends to consolidate the reports.

The objective is optimally to provide a final consolidated report, approved prior to the Group B+ Plenary meeting in September 2022, via written consultation if necessary. If not, a presentation of preliminary findings will be made.

The EPO will themselves only consult **epi**, not Business Europe (BE were after all party to the preparation of the IT3 Elements Paper). We received the consultation papers on 4th April.

The **epi** Harmonisation Committee are going to have the task of preparing the **epi** response. Two resolutions were passed by **epi** Council at the Council Meeting on 7th May 2022 in Munich, namely:

- **Council agrees that the epi is opposed to any kind of grace period.**
- **However, epi could consider a grace period as a safety net as part of a harmonised system.**

The Harmonisation Committee will now prepare a formal response to the EPO.

Report of the Litigation Committee

T. Walshe (IE), Secretary

1. Meetings of the Litigation Committee:

The Litigation Committee held two virtual meetings on 27th January and 16th March 2022 respectively. The first meeting was devoted to topics relating to the UP/UPC, the second meeting in March addressed all other topics that the Litigation Committee is working on. An outline of the topics discussed at both meetings is presented below.

2. Update on UPC

On 18th January 2022, Austria deposited its instrument of ratification of the Protocol to the Agreement on a Unified Patent Court on Provisional Application (PAP-Protocol). This was the final of the thirteen Signatory States required to express their consent to be bound by the PAP-Protocol in order for the PAP-Protocol to enter into force. Consequently, the period of Provisional Application of the UPC

Agreement commenced on 19th January 2022. All administrative, technical and other necessary preparations required to establish the UPC are currently underway. It is expected that the UPC system will be ready to become operational towards the end of 2022 or early in 2023.

The Litigation Committee continues to maintain the overview on ratification of the UPCA, which is publicly available on the **epi** website¹.

3. European Patent Litigation Certificate (EPLC)

The Executive Committee of the Litigation Committee were made aware of proposed amendments to the Rules on the EPLC. The proposed amendments included removal of the courses mentioned in R12 lit. a)iv to viii, namely courses based in the UK. The removal of these courses had conse-

quences for those members of **epi**, in particular members of **epi** from Member States that are participating/are going to participate in the UPCA that successfully attended such courses with the expectation that such courses would count before the UK withdrew from the UPC Agreement. Therefore, after discussion in the **epi** Presidium, the Litigation Committee submitted a letter to the



Triona Walshe

Preparatory Committee (now Administrative Committee) on behalf of **epi** in relation to this matter. We are pleased to report that as a result the Administrative Committee have ensured that any **epi** members that successfully completed the UK courses before 31 December 2020 will be deemed to have an appropriate qualification and may apply for registration on the list of entitled representatives before the UPC.

4. Code of Conduct

The Litigation Committee has actively been following events surrounding the draft of the amended Regulation on Discipline and Code of Conduct (CoC) of the **epi** as prepared by the Professional Conduct Committee (PCC) and approved by the **epi** Council in order to fully take into account new professional activities for European Patent Attorneys when the UP/UPC system will start. Possible solutions have been discussed with EPO and the UPC Preparatory Committee. New amendments to the Code of Conduct have been proposed in light of discussions with the EPO and are being presented to **epi** Council at this meeting. It is further planned to address the EPOrg Administrative Council regarding this issue to ensure that

the existing disciplinary bodies may also deal with possible violations of the Code of Conduct in relation to activities of European Patent Attorneys before the UPC.

5. UPC Rules of Procedure and Case Management System (CMS) Sub-Committee

The Sub-Committee (in collaboration with the Virtual Proceedings Sub-Committee) reviewed the Rules of Procedure (RoP) relating to the rules on video conferencing together with the "Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL on the digitalisation of judicial cooperation and access to justice in cross-border civil, commercial and criminal matters, and amending certain acts in the field of judicial cooperation [Brussels, 1.12.2021, COM(2021) 759 final, 2021/0394 (COD)]". On foot of this work, the Sub-Committees worked together to prepare a letter in relation to 'virtual proceedings in the form of video conferences before the UPC'. It was ensured that the letter was fully consistent with **epi**'s position regarding use of videoconferences before the EPO. This letter was reviewed by the Presidium, signed by the President and sent to the Administrative Committee of the UPC on the 14th March 2022. A favourable response (was received from the Administrative Committee on 21st March 2022, confirming that the relevant rules of the RoP are currently being revised 'to update measures for video conferencing, implementing appropriate flexibility while maintaining onsite proceedings as a rule'.

The Sub-Committee is currently actively working with the **epi** Online Communications Committee (OCC) in relation to proposed amendments to the RoP and also possible difficulties with bulk opt-outs in the CMS.

6. Enforcement and Jurisdiction Sub-Committee.

The Sub-Committee has prepared a paper in relation to the practical implications of the changes that have been recently implemented by the new German Patent Act, specifically in relation to the proportionality defense to injunctions in patent infringement proceedings (Section 139(1) Patent Act).

7. Representation and Privilege Sub-Committee.

In addition to the work on the Code of Conduct, this Sub-Committee is working with the Harmonisation Committee on behalf of the Litigation Committee in relation to the Group B+ discussion on the draft of an international "Agreement on Cross-Border aspects of Client-Patent Attorney Privilege". The **epi** were successful in inserting reference to regional qualifications in the proposed text of the potential international instrument on privilege, thereby ensuring that European Patent Attorneys fall within the

¹ <https://patentepi.org/r/info-2202-01>

definition of a 'patent advisor'. A further draft of the Instrument for Agreement on Cross-Border aspects of Client-Patent Attorney Privilege is expected imminently.

8. Virtual Proceedings Sub-Committee.

As mentioned above, this Sub-Committee (in collaboration with the UPC Rules of Procedure and Case Management System (CMS) Sub-Committee) examined the RoP with regard to virtual proceedings at the UPC. The committee continues to work on other aspects of the topic specifically with regard to identifying best practices (e.g., regarding technical equipment, visibility of the persons, separate channels of communication, access for the public, dealing with technical problems and so forth).

9. Brexit Implications on Patent Litigation Sub-Committee.

This Sub-Committee continues to monitor the activity of the UK Government with regard to any activity that is relevant to litigation and is as a consequence of Brexit. Some of the major topics under discussion include the difficulties that

hinder the UK's accession to the Lugano Convention and the implications of same. The Sub-Committee are also following the UK Governments public consultation on 'Exhaustion of IP rights in the UK'.

10. Educational Topics/Training Activities

The Litigation Committee is supporting and assisting the PEC in preparing and delivering the various educational topics.

The Inter-committee Working Group, for planning of **epi**'s educational activities in connection with the new UP/UPC system has been re-activated wherein members of the LitCom are working together with members of the European Patent Practice Committee (EPPC) and members and chair of the Professional Education Committee (PEC) to prepare and deliver a programme of training for **epi** members.

11. Next Meeting

The next meeting of the Litigation Committee is planned for September 2022.

Report of the Committee on Biotechnological Inventions

A. De Clercq (BE), Chair

Below is a summary of discussion points since our last report in **epi** information issue 4-2021. A meeting was held also between a delegation of our committee and DG1 relating to biotech topics on 31 March 2022. This biotech session was very interactive and interesting.

1. ST26 standard for Sequence listings

An ad-hoc group of the Biotech Committee is following the developments regarding the new ST.26 WIPO Standard for Sequence Listings which will come into force on the big bang date of 1 July 2022¹. We had several meetings and prepared our position in advance of further discussions with the EPO. A discussion took place on this topic during our meeting with DG1 on 31 March 2022. We have flagged several times and are further trying to clarify possible added matter and priority issues relating to conversions of ST.25 format sequence listings to ST.26 format sequence listings and ways to avoid these type of problems. Conversion of an ST.25 format sequence listings to an ST.26 format sequence listing is necessary for (1) divisional EP applications filed as from 1 July 2022 when the parent application was filed before 1 July 2022 with an ST.25 format sequence listing

and (2) end of priority applications filed as from 1 July 2022 (both EP or PCT) when the earlier application was filed before 1 July 2022 with an ST.25 format sequence listing. Annex VII of the WIPO Standard ST.26² explains situations in which subject-matter could be added when making a conversion of a sequence listing from the ST.25 to the new ST.26 format. This involves many



Ann De Clercq

risks and creates a huge extra effort and costs for applicants. We are of the strong opinion that the EPO should consider the requests of the users to introduce transitional measures to allow that at least divisional applications can be filed with an ST.25 format sequence listing if the parental case was filed with an ST.25 format sequence listing. We refer to the position paper prepared by our committee and published

¹ On the legal side a decision of the President (<https://patentepi.org/r/info-2202-02>) and Notice of the EPO (<https://patentepi.org/r/info-2202-03>) were published on 9 December 2021. Future publications will follow on this topic.

² <https://patentepi.org/r/info-2202-04>

separately in this edition. In their recent May 2022 newsletter WIPO³ also acknowledged the risk of adding matter when going from an ST 25 to an ST26 sequence listing.

The UK Patent Office has already indicated on 28 February 2022 in an update of their Guidelines for examination⁴ that they will allow such transitional measures. The UK mentions that for new divisional patent applications filed on or after 1 July 2022, the sequence listing should be supplied in the format required for the parent application. For a parent application filed on or after 1 July 2022, this must be ST.26. For a parent application filed before 1 July 2022 this should be ST.25. This is a change compared to the original plan of the UK and this change was made in response to feedback from their stakeholders. We strongly continue to request that the EPO would adopt the same practice as the UK Patent Office for EP applications.

A new software version of the program WIPO sequence 2.0.0 became available on 16 May 2022 and can be found on WIPO Sequence Suite⁵.

epi stressed at the meeting with DG1 that further training webinars by the EPO may be very useful and needed to further inform patent attorneys and paralegal assistants dealing with the matter and allow questions to be addressed. Also further communications/statements from the EPO on this matter were requested to inform the public on how to avoid adding matter for conversions of sequence listings.

2. Plant patenting

We commented on the current version of the GLs on plants (see parts F-IV, 4.12 and G-II, 5.4) both at the meeting with DG1 on 31 March 2022 and via our comments as prepared for the SACEPO meeting on Guidelines of 19 May 2022.

We mainly informed about the need for **plant disclaimers** for which we held there is no legal basis. The EPO confirmed they are not needed for genetically modified transformed plants and gene edited plants (created by CRISPR technology), provided the latter can be distinguished from natural variation and also are not needed for offspring and propagatable parts of said plants. **epi** explained that the boundaries are not clear in terms of single or multiple nucleotide exchanges. The EPO explained that it is up to the applicant to show that it does not relate to a plant produced by an essentially biological process and mentioned they had not yet encountered any case gene-edited plants which could not have been obtained by natural variation.

EPO will quite automatically raise an objection as it is an exception to patentability. EPO explained they consider what kind of exchanges are known for the plant in question and

depending on the plant make an objection or not. We are of the opinion that the EPO should only raise an objection when the objection is reasoned. EPO requested **epi** to raise further questions relating to specific cases if needed.

A further question concerning adaptation of the description to conform with the allowable claims was discussed in relation to plant patents. In particular, it was questioned whether a description containing passages relating to crossing and selecting with plants obtained by technical means needed to be deleted or explicitly marked. The EPO confirmed such passages do not need to be deleted as the guidelines explain that progeny plants of such technically obtained plants are also covered by the claims. On the other hand, passages relating to natural variation equivalents of technically obtained plants would need to be deleted or marked.

3. Antibodies

With respect to antibodies we informed the EPO at the meeting on 31 March 2022 and via our comments as prepared for the SACEPO meeting on Guidelines of 19 May 2022 that the 2022 GLs (G-II, 5.6) address some of our comments on the inventive step requirements for antibodies but they are still perceived to be too strict. Inventive step of antibodies does not have to rely anymore only on an unexpected effect. Some changes have been included. Also a further clarification has been incorporated regarding the definition of antibodies as to the amount of necessary CDRs. At the level of alternative antibodies, we see no change yet from the EPO. A further discussion will be needed on this topic and also on the topic of general platform technologies applicable to a multitude of antibodies. The discussion on inventive step of antibodies is also much related to the plausibility discussion as in pending G2/21. On the basis of our detailed comments provided at the SACEPO meeting, we assume the EPO will keep on updating the section on antibodies in the next versions of the Guidelines. We deem it important that the EPO may wish to be continuously updated by practitioners in the field also regarding the commercial importance of antibody inventions. Antibody patenting should receive prime importance.

4. Deposits of Biological Material

Case **T 32/17**⁶ (relating to EP2311654) was discussed during the meeting with DG1 on 31 March 2022 relating to an antibody produced by a deposited hybridoma. The EPO would look more closely into this case in the future. They confirmed that hybridomas can be used to define an antibody as mentioned in the GLs. In most cases antibodies were identified by their sequence nowadays. The overlap with the principles of G1/92 were also briefly discussed. We assume we will learn more about this matter in the future.

³ <https://patentepi.org/r/info-2202-05>

⁴ <https://patentepi.org/r/info-2202-06>

⁵ <https://patentepi.org/r/info-2202-07>

⁶ <https://patentepi.org/r/info-2202-08>

Report of the Professional Conduct Committee

G. Checcacci (IT), Chair

1) Amendments to the epi Code of Conduct

Two different sets of proposals to amend the **epi** Code of Conduct have been prepared and discussed at various levels in the last seven years: a first set of proposals dealing with the application of **epi** disciplinary provisions to activities in respect of UPC and a second set of proposals addressing some articles and including a general revision of the wording of the CoC. The first proposal was presented and voted at the Council meeting in autumn 2018, however it was then stopped because of the opposition of the EPO; the second proposal was presented at the two Council meetings in 2021, and a vote was foreseen at a Council meeting in 2022.

Towards the end of 2021, however, an alternative approach was found with the EPO and a new proposal to address the UPC issue was then prepared by a working group with members from PCC and from the By-Laws Committee. This proposal, including amendments to the **epi** Code of Conduct only (i.e. excluding any amendments to the Regulation on Discipline) was presented at the Council

meeting C92 on May 7, 2022, and eventually approved. The amended CoC will be soon published in the OJ of the EPO; the amendments are the subject of another article in this issue of **epi** Information.

Now that the UPC issue has been eventually solved, PCC will go back to the second proposal: taking into account also the comments received after Council meetings in 2021, a new proposal will be prepared and submitted to the Council.

2) Webinars relating to professional conduct

The specific Working Group within PCC is cooperating with the Professional Education Committee to offer **epi** members some webinars addressing interesting aspects of the conduct provisions of the Regulation on Discipline and the Code of Conduct.

Two webinars have been issued in 2021 (on Conflict of Interest and on Privilege in Patent Matters) and are available in the **epi** website dedicated to learning, <https://www.epi-learning.org>. Other webinars are under preparation, to be issued in 2022.

Report of the epi-Finances Committee

C. Quintelier (BE) Chair, T. J. Powel (UK) Secretary

The 88th Meeting of the Finances Committee took place by video conference on 8 April 2022. The Treasurer, Deputy Treasurer and Substitute Internal Auditors attended as invited guests. The Executive Director and Head of Finance also attended.

- The Committee reviewed and approved the income, expenditure and budget figures for 2021 reported by the Treasurer;
- The Committee also approved the major expenditure projects currently in progress;
- The Committee is happy with the performance of investments and the safeguards put in place with respect to currency investments;
- The Committee considered a request that arose to donate a surplus on the organising of educational events to charity, but notes that this is not contemplated in the constitution of **epi** and therefore cannot be actioned as things stand;

- The Committee received a report from the Executive Director and noted with approval her work and restructuring plans that have been properly costed and are being implemented in accordance with the proposed timetable;
- The Committee received and debated a report from the Internal Auditors; and recorded that the question of “four eyes” approval of contracts raised in that report had been fully dealt with some years earlier. The scheme set up at that time seems to be working satisfactorily and the Committee sees no need for changes.
- The Committee noted and supports proposals by the Treasurer to establish post-pandemic hybrid working protocols for the committees of **epi**.

The next meeting of the Committee is scheduled for 7 October 2022.



General Information

epi Board

Präsident / President / Président

BE – LEYDER Francis

Vize-Präsident(in) / Vice-Presidents / Vice-Président(es)

DE – VOGELSANG-WENKE Heike

MK – ILIEVSKI Bogoljub

Generalsekretär / Secretary General / Secrétaire Général

BG – SIRA KOVA Olga

Stellvertretender Generalsekretär

Députy Secretary General / Secrétaire Général Adjoint

PL – AUGUSTYNI AK Magdalena

Schatzmeister / Treasurer / Trésorier

CH – THOMSEN Peter

Stellvertretender Schatzmeister / Deputy Treasurer

Trésorier Adjoint

HU – SZENTPÉTERI Zsolt

Next Board and Council Meetings

Board Meetings

121st hybrid Board Meeting in Munich on 5 July 2022

122nd hybrid Board Meeting in Spain on 23 September 2022

Council Meetings

93rd Council Meeting in Spain on 22 October 2022

Disciplinary Bodies, Committees and Audit

Disziplinarorgane, Ausschüsse und Rechnungsprüfung · Organes de discipline, Commissions et Vérification des comptes

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de Discipline (epi)
AL – NIKA Melina	FR – NEVANT Marc	MK – DAMJANSKI Vanco
AT – POTH Wolfgang ^{oo}	GB – GRAY John	MT – SANSONE Luigi A.
BE – DEBLED Thierry	GR – TSIMIKALIS Athanasios	NL – VAN LOOIJENGOED Ferry A.T.
BG – PAKIDANSKA Ivanka Slavcheva	HR – MARSIC Natasa	NO – THRANE Dag
CH – REUTELER Raymond	HU – KOVÁRI Zoltán	PL – ROGOZIŃSKA Alicja
CY – ROUSOUNIDOU Vasiliki	IE – SMYTH Shane	PT – DIAS MACHADO António J.
CZ – FISCHER Michael	IS – HARDARSON Gunnar Örn	RO – FIERASCU Cosmina
DE – FRÖHLING Werner ^o	IT – MAZZINI Giuseppe	RS – BOGDANOVIC Dejan
DK – KUHN Oliver Wolfgang	LI – ROSENICH Paul*	SE – KARLSTRÖM Lennart
EE – KAHU Sirje	LT – GERASIMOVIC Jelena	SI – JAPELJ Bostjan
ES – STIEBE Lars Magnus	LU – KIHN Pierre	SK – LITVÁKOVÁ Lenka
FI – WESTERHOLM Christian	LV – SERGEJEVA Valentina	SM – MARTINI Riccardo
	MC – HAUTIER Nicolas	TR – YURTSEVEN Tuna**

Disziplinarausschuss (EPA/epi)	Disciplinary Board (EPO/epi)	Conseil de Discipline (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
BE – CAMPABADAL Gemma	DE – MÜLLER Wolfram	IS – VILHJALMSSON Arni
	FR – QUANTIN Bruno	

Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi)	Disciplinary Board of Appeal (EPO/epi)	Chambre de Recours en Matière Disciplinaire (OEB/epi)
epi Mitglieder	epi Members	Membres de l'epi
DE – REBBEREH Cornelia	HR – KORPER ŽEMVA Dina	NL – HOOVELD Arjen
FR – GENDRAUD Pierre H.	IT – COLOMBO Stefano	TR – ARKAN Selda

Ausschuss für Berufliche Bildung	Professional Education Committee	Commission de Formation Professionnelle
Ordentliche Mitglieder	Full Members	Membres titulaires
AT – SCHARDMÜLLER Robert	GB – GWILT Julia Louise*	MT – PECHAROVÁ Petra
	GR – LIOUMBIS Alexandros	NL – VAN WEZENBEEK
BE – VAN DEN HAZEL Hendrik Bart	HR – PEJGINOVIC Tomislav	Lambertus A.C.M.
BG – KOSSEVA Radislava Andreeva	HU – TEPFENHÁRT Dóra Andrea	NO – BERG Per Geir
CH – KAPIC Tarik	IE – SKRBA Sinéad	PL – DARGIEWICZ Joanna
CY – THEODOULOU Christos A.	IS – GUDMUNDSDÓTTIR Anna Valborg	PT – CARVALHO FRANCO Isabel
CZ – HARTVICOVA Katerina	IT – RAMBELLI Paolo	RO – TEODORESCU Mihaela
DE – POTT Thomas	LI – ALLWARDT Anke	RS – PLAVSA Uros
DK – STAHR Pia	LT – GERASIMOVIC Liudmila	SE – HERBJØRSEN Rut
EE – SARAP Margus	LU – MELLET Valérie Martine	SI – FLAK Antonija
ES – PATO COUR Isabel	LV – KROMANIS Artis	SK – MAJLINGOVÁ Zuzana
FI – KONKONEN Tomi-Matti Juhani	MC – THACH Tum	SM – AGAZZANI Giampaolo
FR – COLLIN Jérôme	MK – PEPEJUGOSKI Valentin	TR – ATALAY Baris
Stellvertreter	Substitutes	Suppléants
AT – GEHRING Andreas	FI – NIELSEN Michael Jon	NL – OP DEN BROUW-SPRAKEL
BE – DUYVER Jurgen Martha Herman	FR – FERNANDEZ Francis Lionel	Vera Stefanie Irene
BG – BENATOV Samuil Gabriel	GB – MACKETT Margaret	PT – DO NASCIMENTO GOMES Rui
CH – RUDER Susanna Louise	GR – KOSTI Vasiliki	RO – BONCEA Oana-Laura
CZ – HALAXOVÁ Eva	HR – HADZIJA Tomislav	SE – MATSSON Malin
DE – STORK Martina	HU – RAVADITS Imre Miklós	SI – BORIC VEZJAK Maja
EE – KOPPEL Mart Enn	IE – GILLESPIE Richard	SK – MISKOVIČOVÁ Ivica
ES – SÁNCHEZ Ruth	IT – MORABITO Sara	SM – PRIMICERI Maria Vittoria
	LI – HOFMANN Markus Günter	TR – AGCA KIZIL Tugce

*Chair/ **Secretary ^oVice-Chair / ^{oo}Vice-Secretary

Ausschuss für Europäische Patent Praxis		European Patent Practice Committee		Commission pour la Pratique du Brevet Européen	
AT	– VÖGELE Andreas	FR	– THON Julien	MC	– SCHMALZ Günther
BE	– RACINE Sophie Christiane Carol	GB	– MERCER Christopher Paul*	MK	– FILIPOV Gjorgji
BG	– TSVETKOV Atanas Lyubomirov	GR	– SAMUELIDES Emmanuel	NL	– KETELAARS Maarten F.J.M.
CH	– WILMING Martin	HR	– HADZIJA Tomislav	NO	– REKDAL Kristine
CY	– THEODOULOU Christos A.	HU	– LENGYEL Zsolt	PL	– KAWCZYNSKA Marta Joanna
CZ	– BUCEK Roman	IE	– MCCARTHY Denis Alexis	PT	– PEREIRA DA CRUZ Joao
DE	– FLEUCHAUS Michael A.	IS	– FRIDRIKSSON Einar Karl**	RO	– NICOLAESCU Daniella Olga
DK	– HEGNER Anette	IT	– MODIANO Micaela Nadia	RS	– HERAK Nada
EE	– TOOME Jürgen	LI	– GYAJA Christoph Benjamin	SE	– MATSSON Malin Pernilla
ES	– SÁEZ GRANERO Francisco Javier	LT	– PAKENIENE Ausra	SK	– MICHALÍK Andrej
FI	– HONKASALO Terhi Marjut Anneli	LU	– OCVRK Philippe	SM	– TIBURZI Andrea
		LV	– FORTUNA Jevgenijs	TR	– MUTLU Aydin
Technical Field: Information and Communication Technologies					
CH	– KAPIC Tarik	GB	– ASQUITH Julian Peter	MC	– SCHMALZ Günther
DE	– BITTNER Peter	GR	– SAMUELIDES Emmanuel	NL	– VAN WOUDEBERG Roel
DE	– FLEUCHAUS Michael A.*	IT	– PES Matteo	PL	– BURY Marek
FI	– HONKASALO Terhi Marjut Anneli	LT	– PAKENIENE Ausra	SM	– PERRONACE Andrea
Technical Field: Pharmaceuticals					
CH	– WILMING Martin*	FR	– TARAVELLA Brigitte	HU	– SZENTPÉTERI Zsolt
DE	– NESTLE-NGUYEN Denise Kim-Lien Tu-Anh	GB	– SARDHARWALA Fatema Elyasali	IT	– MACCHETTA Francesco
FI	– KARLSSON Krister	GR	– VARVOGLI Anastasia Aikaterini**	PL	– KAWCZYNSKA Marta Joanna
				RS	– HERAK Nada
Technical Field: Chemistry					
BE	– LUYTEN Ingrid Lena Rene	FI	– KOKKO Antti Ohto Kalervo	LU	– MELLET Valérie Martine**
CH	– COGNAT Eric Jean Marie	GB	– BOFF James Charles*	SE	– CARLSSON Carl Fredrik Munk
DE	– KREMER Véronique Marie Joséphine	HU	– LEZSÁK Gábor		
Technical Field: Mechanics					
CZ	– BUCEK Roman	FI	– HEINO Pekka Antero	NL	– COOLEN Marcus Cornelis Johannes
DE	– DÜRR Arndt Christian	GB	– DUNN Paul Edward	PL	– LEWICKA Katarzyna Dorota**
DE	– STORK Martina	IT	– PAPA Elisabetta	RO	– VASILESCU Raluca
DK	– CARLSSON Eva*				
Geschäftsordnungsausschuss		By-Laws Committee		Commission du Règlement Intérieur	
Ordentliche Mitglieder		Full Members		Membres titulaires	
AT	– FORSTHUBER Martin	FR	– MOUTARD Pascal Jean*	IT	– GERLI Paolo
CH	– LIEBETANZ Michael	GB	– WRIGHT Simon Mark		
Stellvertreter		Substitutes		Suppléants	
GB	– MERCER Christopher Paul	MC	– SCHMALZ Günther	MK	– VESKOVSKA Blagica
FR	– NEVANT Marc				
Ausschuss für epi-Finzen		epi-Finances Committee		Commission des Finances de l'epi	
BE	– QUINTELIER Claude*	GB	– POWELL Timothy John**	PT	– PEREIRA DA CRUZ Joao
CH	– BRAUN André jr.	IT	– RAMBELLI Paolo	RO	– TULUCA F. Doina
DE	– WINTER Andreas	LU	– BEISSEL Jean		
EE	– SARAP Margus	PL	– MALEWSKA Ewa		
Ausschuss für EPA-Finzen		Committee on EPO Finances		Commission des Finances de l'OEB	
DE	– WINTER Andreas**	MC	– THACH Tum	DE	– SCHÖBER CHRISTOPH D.
GB	– BOFF James Charles*		Substitutes	GB	– FÈ LAURA
IE	– CASEY Lindsay Joseph	BE	– KELLENBERGER JAKOB	IT	– FATTORI MICHELE

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

Ausschuss für Standesregeln	Professional Conduct Committee	Commission de Conduite Professionnelle
Ordentliche Mitglieder	Full Members	Membres titulaires
AL – SHOMO Vjollca	HR – DLACIC Albina	NL – BOTTEMA Johan Jan
AT – PEHAM Alois	HU – SOVARI Miklos	NO – THORVALDSEN Knut
BE – VAN DEN BOECK Wim	IE – MCCARTHY Denis Alexis	PL – KREKORA Magdalena
BG – BENATOV Samuil Gabriel	IS – DAVIDSSON Snaebjorn H.	PT – CORTE-REAL CRUZ António
CH – MAUÉ Paul Georg	IT – CHECCACCI Giorgio*	RO – NICOLAESCU Daniella Olga
DE – STORK Martina	LI – KÜNSCH Joachim	RS – PETOSEVIC Slobodan
ES – JORDÁ PETERSEN Santiago	LT – PETNIUNAITÉ Jurga	SE – HOLMBERG-SCHWINDT Tor Martin
FI – SAHLIN Jonna Elisabeth	LV – SMIRNOV Alexander	SM – MAROSCIA Antonio
FR – DELORME Nicolas	MC – THACH Tum	TR – CAYLI Hülya
GB – POWELL Timothy John	MK – KJOSESKA Marija	
Stellvertreter	Substitutes	Suppléants
AT – FOX Tobias	FI – VÄISÄNEN Olli Jaakko	PL – CHIMIAK Monika
BE – WÉRY François	FR – TARAVELLA Brigitte	RO – POPA Cristina
BG – BENATOV Samuil Gabriel	GB – DUNN Paul Edward	SE – BJERNDELL Per Ingvar
CH – KÖRNER Thomas Ottmar	LI – BAZZON Andreas	SM – AGAZZANI Giampaolo
DE – WINTER Andreas	MK – VESKOVSKA Blagica	TR – AKSOY Okan Alper
ES – SATURIO CARRASCO Pedro Javier	NO – HJELSVOLD Bodil Merete Sollie	

Ausschuss für Streitregelung	Litigation Committee	Commission Procédure Judiciaire
Ordentliche Mitglieder	Full Members	Membres titulaires
AL – PANIDHA Ela	FR – NUSS Laurent	MK – PEPEJUGOSKI Valentin
AT – STADLER Michael	GB – RADKOV Stoyan Atanassov	MT – GERBINO Angelo
BE – JAEKEN Annemie	GR – VAVEKIS Konstantinos	NL – LAND Addick Adrianus Gosling
BG – GEORGIEVA-TABAKOVA Milena Lubenova	HR – VUKINA Sanja	NO – SIMONSEN Kari Helen
CH – THOMSEN Peter René*	HU – TÖRÖK Ferenc	PL – LEWICKA Katarzyna Dorota
CY – THEODOULOU Christos A.	IE – WALSHE Triona Mary**	PT – CRUZ Nuno
CZ – HALAXOVÁ Eva	IS – INGVARSSON Sigurdur	RO – PUSCASU Dan
DE – PFRANG Tilman	IT – COLUCCI Giuseppe	RS – ZATEZALO Mihajlo
DK – THORSEN Jesper	LI – HARMANN Bernd-Günther	SE – PRESLAND Torbjörn
EE – KOPPEL Mart Enn	LT – VIESUNAITE Vilija	SI – OSOLNIK Renata
ES – ARIAS SANZ Juan	LU – BRUCK Mathis	SK – NEUSCHL Vladimir
FI – FINNILÄ Kim Larseman°	LV – OSMANS Voldemars	SM – BALDI Stefano
	MC – SCHMALZ Günther	TR – TAS Emrah
Stellvertreter	Substitutes	Suppléants
AT – HEDENETZ Alexander Gernot	GB – CRITTEN Matthew	NL – CLARKSON Paul
BE – RACINE Sophie Christiane Carol	HR – DLACIC Albina	PL – DARGIEWICZ Joanna
BG – NESHEVA Valentina Velikova	IE – WHITE Jonathan Patrick	PT – SILVESTRE DE ALMEIDA FERREIRA Luís Humberto
CH – KÖRNER Thomas Ottmar	IT – DE GREGORI Antonella	RO – PAVEL Sorin Eduard
CZ – GUTTMANN Michal	LI – HOLZHEU Christian	SE – RÅDBO Lars Olof
DE – TÖPERT Verena Clarita	LU – PEETERS Jérôme Pierre	SM – PETRAZ Davide Luigi
ES – CARBONELL Enric	LV – FORTUNA Jevgenijs	TR – DERIS M.N. Aydin
FI – KARLSSON Krister	MK – VESKOVSKA Blagica	
FR – MELLET Valérie Martine		

Ausschuss für IP-Kommerzialisierung	IP Commercialization Committee	Commission de commercialisation de la propriété intellectuelle
CH – BLÖCHLE Hans	ES – DURÁN MOYA Luis-Alfonso	HR – MARSIC Natasa
CH – RUDER Susanna Louise**	ES – IGARTUA Ismael	IT – BARACCO Stefano
DE – MÜLLER Hans Jörg	GB – LESSARD Jason Donat	
DE – STÖCKLE Florian*	GR – VAVEKIS Konstantinos°	

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

Ausschuss für Biotechnologische Erfindungen		Committee on Biotechnological Inventions		Commission pour les Inventions en Biotechnologie	
AL – SINOJMERI Diana	GB – WRIGHT Simon Mark**	PL – KAWCZYNSKA Marta Joanna			
AT – PFÖSTL Andreas	GR – KOSTI Vasiliki	PT – TEIXEIRA DE CARVALHO Anabela			
BE – DE CLERCQ Ann G. Y.*	HR – MARSIC Natasa				
BG – TSVETKOV Atanas Lyubomirov	HU – PETHO Arpad	RO – POPA Cristina			
CH – SPERRLE Martin	IE – HALLY Anna-Louise	RS – BRKIC Zeljka			
CZ – HARTVICOVA Katerina	IS – JONSSON Thorlakur	SE – MATTSSON Niklas			
DE – EXNER Torsten	IT – TRILLAT Anne-Cecile	SI – BENČINA Mojca			
DK – SCHOUBOE Anne	LI – BOGENSBERGER Burkhard	SK – MAKELOVÁ Katarína			
ES – ALCONADA RODRIGUEZ Agustin	LT – ARMALYTE Elena	SM – PRIMICERI Maria Vittoria			
FI – VIRTAHARJU Outi Elina	MK – VESKOVSKA Blagica	TR – YALVAÇ Oya			
FR – TARAVELLA Brigitte	NL – SWINKELS Bart Willem				

Harmonisierungsausschuss		Harmonisation Committee		Commission d’Harmonisation	
CZ – ZEMANOVÁ Veronika	FI – KÄRKKÄINEN Veli-Matti	IE – ROCHE Dermot			
DE – LEISSLER-GERSTL Gabriele	GB – BROWN John D.*	IT – SANTI Filippo**			
DE – WEINGARTEN Ulrich	IE – HANRATTY Catherine	PL – KREKORA Magdalena			
ES – DURÁN MOYA Luis-Alfonso					

Ausschuss für Online-Kommunikation		Online Communications Committee		Commission pour les Communications en Ligne	
AT – GASSNER Birgitta	DE – GRAU Benjamin	IE – BROPHY David Timothy°			
BE – BIRON Yannick**	DE – SCHEELE Friedrich	IT – MEINDL Tassilo			
CH – VAVRIN Ronny	FR – MÉNÈS Catherine	RO – BONCEA Oana-Laura			
DE – BANZHOF Felicitä	GB – GRAY John James*				

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

Redaktionsausschuss		Editorial Committee		Commission de Rédaction	
BE – BLANCHE Emilie	DE – THESEN Michael	IE – CASEY Lindsay Joseph**			
DE – HERRMANN Daniel	FR – NEVANT Marc*	MC – AMIRA Sami			
DE – SCHMID Johannes	GB – MURNANE Graham John				

Zulassungsausschuss für epi Studenten		epi Studentship Admissions Committee		Commission d’admission des étudiants de l’epi	
AT – SCHWEINZER Friedrich	GB – MERCER Christopher Paul*	NL – VAN WEZENBEEK Lambertus A.C.M.			
CH – FAVRE Nicolas	IT – MACCHETTA Francesco				
DE – LEISSLER-GERSTL Gabriele	IT – PROVVISORATO Paolo				

Rechnungsprüfer		Auditors		Commissaires aux Comptes	
Ordentliche Mitglieder		Full Members		Membres titulaires	
CH – KLEY Hansjörg	FR – CONAN Philippe				
Stellvertreter		Substitutes		Suppléants	
AT – HEDENETZ Alexander Gernot	LV – FORTUNA Larisa				

Nominierungsausschuss		Nominations Committee		Commission de Proposition	
CH – MAUÉ Paul Georg*	FR – NUSS Laurent				
GB – MERCER Chris	RO – TEODORESCU Mihaela				

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

Ständiger Berater Ausschuss beim EPA (SACEPO)	Standing Advisory Committee before the EPO (SACEPO)	Comité consultatif permanent auprès de l'OEB (SACEPO)
epi-Delegierte BE – LEYDER Francis DE – VOGELSANG-WENKE Heike DK – HEGNER Anette	epi Delegates GB – BOFF James Charles GB – GRAY John James	Délégues de l'epi GB – MERCER Christopher Paul MK – ILIEVSKI Bogoljub
SACEPO – Arbeitsgruppe Regeln	SACEPO – Working Party on Rules	SACEPO – Groupe de Travail Règles
DE – WILMING Martin	GB – MERCER Christopher Paul	FI – HONKASALO Terhi Marjut Anneli
SACEPO – Arbeitsgruppe Richtlinien	SACEPO – Working Party on Guidelines	SACEPO – Groupe de Travail Directives
DE – WILMING Martin	DK – HEGNER Anette	GR – SAMUELIDES Emmanuel
SACEPO – Arbeitsgruppe Qualität	SACEPO – Working Party on Quality	SACEPO – Groupe de Travail Qualité
MK – ILIEVSKI Bogoljub	DE – VOGELSANG-WENKE Heike	
SACEPO – PDI	SACEPO – PDI	SACEPO – PDI
AT – GASSNER Birgitta BE – LEYDER Francis	GB – MERCER Christopher Paul	IT – PROVVISORATO Paolo
SACEPO – EPP	SACEPO – EPP	SACEPO – EPP
BE – BIRON Yannick	FI – HONKASALO Marjut Anneli	

Contact Data of EPO Legal Division

Update of the European Patent Attorneys Database

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the Legal Division of the EPO (Dir. 5.2.3) of any change in your contact details.

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

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

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

The relevant form(s) to be submitted in the case of changes can be downloaded from the EPO website:
<https://www.epo.org/applying/online-services/representatives/changes.html>

Further information and forms relating to the list of professional representatives can be found on the EPO website (<https://www.epo.org/applying/online-services/representatives.html>) and in the FAQ section of the **epi** website (<https://patentepi.org/en/faq>).

Thank you for your cooperation.

IPRISK Professional Liability Insurance for epi Members

Why?

European patent attorneys handle National, European and Foreign patent applications and patents. Those patent applications and patents may have a high commercial value and the loss of those patents might cause their proprietor serious damages for which the patent attorney might be liable. In particular for those working in private practice it is thus highly recommended to have a professional liability insurance.

At **epi** we realized that it was not always easy, and in particular not cheap, for our members to subscribe an appropriate professional liability insurance, so we decided to help our members in offering them a product tailor-made for them.

What?

In line with the **epi** Council decisions, **epi** negotiated and agreed a framework contract for a professional liability insurance setting out general principles and conditions applicable in all 38 EPC Contracting States. The framework contract was signed with RMS, a Coverholder at Lloyd's, and placed by certain Underwriters at Lloyd's of London.

Any **epi** member offering services to external clients can benefit from this insurance. The insurance premium to be paid is calculated on the basis of the turnover of the insured **epi** member and depending on the insurance coverage selected.

Which are the advantages for epi members?

- An insurance coverage selectable between 500 000€ and 5 000 000€ per incident, per year and per insured member
- Covers the work done by the support staff of the patent attorney
- Covers the work of the patent attorney before the EPO and the national offices in Europe before which the **epi** member is entitled to act
- Additional coverage for trademarks and design work can be obtained with the payment of an additional premium
- Competitive conditions and premiums
- Possibility to have a retroactive coverage
- Knowledge of the profession on the side of the insurance company

More information needed?

Please have a look at the **epi** website <https://patentepi.org/r/iprisk> where you can also find a questionnaire which you can fill in to obtain a price offer.

For further information you can also send an email to insurance@patentepi.org



Under Framework Agreement with



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

Redaktionsausschuss / Editorial Committee / Commission de Rédaction

Sami Amira
Emilie Blanche
Lindsay Joseph Casey (Vice-Chair)
Daniel Herrmann
Graham John Murnane
Marc Nevant (Chair)
Johannes Schmid
Michael Thesen

Postanschrift / Mailing address / Adresse postale

epi

Bayerstrasse 83
80335 Munich
Germany
Tel: +49 89 24 20 52-0
Fax: +49 89 24 20 52-220
Email: info@patentepi.org
www.patentepi.org



Layout und Satz / Layout and composition / Mise en page et ensemble

SIMIUS New Media GmbH
Am Söldnermoos 17
85399 Hallbergmoos
Tel: +49 (811) 1283 4089
Email: info@simius.de
www.simius.de

© Copyright epi 2022

Das Institut ist weder für Erklärungen noch für Meinungen verantwortlich, die in Beiträgen dieser Zeitschrift enthalten sind. Artikel werden in der oder den Amtssprachen (deutsch, englisch, französisch) wiedergegeben, in der bzw. denen diese Artikel eingereicht wurden.

The Institute as a body is not responsible either for the statements made, or for the opinions expressed in the publications. Articles are reproduced in the official language or languages (German, English or French) in which they are submitted.

L'Institut n'est pas responsable des déclarations ou des opinions exprimées dans cette publication. Les articles sont publiés dans celle ou celles des trois langues officielles (allemand, anglais ou français) dans laquelle ou lesquelles ils ont été proposés.

Die Marke „**epi**“ ist Eigentum des Instituts der beim Europäischen Patentamt zugelassenen Vertreter. epi ist international, als Unionsmarke und national in Deutschland eingetragen.

The trade mark “**epi**” is the property of the Institute of Professional Representatives before the European Patent Office. epi is registered internationally, as a EU trade mark and nationally in Germany.

La marque « **epi** » est la propriété de l'Institut des mandataires agréés près l'Office européen des brevets, et est enregistrée en tant que marque internationale, marque de l'UE et marque nationale en Allemagne).

© Photos: **epi**, European Patent Office, istock.com (designer491, vm, Mlenny, noipornpan, Vesnaandjic, Goodboy Picture Company)



European Patent Institute
Bayerstrasse 83
80335 Munich | Germany