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Cover:

III Claim 6

This picture painted by Mr. Jowi Burger (European Patent Attorney, NL) was part of the **epi** Artists Exhibition 2015 at the EPO, Munich



Jowi Burger

Jowi Burger (68), European Patent Attorney from the Netherlands, is painting since 1991 next to his legal activities on intellectual property rights. He studied mechanical engineering and industrial design at Delft University and after military service studied chemistry, pharmacology and IP law at Leiden University and Free University Amsterdam. Painting and designing not only give him much joy but also have proven to be a source of inspiration for his legal work. He focusses on abstract painting but also paints portraits and "en plein air" works. Inspired by the art of drafting claims of patent applications, Jowi decided to seek preferred embodiments in his paintings. The pictures shown on his website (<http://jowiartpreferredembodiments.blogspot.de/>) reveal the surprising wealth of pictures extracted from his paintings that may be regarded "main claims".

Jowi Burger (68), zugelassener Vertreter vor dem Europäischen Patentamt aus den Niederlanden, malt bereits seit 1991 neben seiner beruflichen Tätigkeit in Rechtsfragen zu geistigem Eigentum. Er studierte Maschinenbau und Industriedesign an der Universität Delft und nach seinem Militärdienst studierte er Chemie, Pharmakologie und IP Recht an der Universität Leiden und der Freien Universität Amsterdam. Das Malen und das Designen bereiten ihm nicht nur sehr viel Freude, sondern haben sich auch als eine Quelle der Inspiration für seine Arbeit herausgestellt. Er konzentriert sich auf abstrakte Malerei, malt aber ebenso Portraits und sogenannte „en plein air“ Bilder. Inspiriert durch seine Arbeit, dem Formulieren von Patentansprüchen, hat Jowi beschlossen, vorzugsweise Verkörperungen derselben in seiner Malerei auszudrücken. Die auf seiner Webseite (<http://jowiartpreferredembodiments.blogspot.de/>) präsentierten Bilder offenbaren den erstaunlichen Reichtum an Bildern, die seinen Gemälden entnommen wurden und als „Hauptanspruch“ angesehen werden können.

Jowi Burger (68), mandataire agréé près l'office européen des brevets, originaire des Pays-Bas, s'adonne à la peinture depuis 1991, parallèlement à ses activités juridiques sur les droits de la propriété intellectuelle. Il a étudié le génie mécanique et le dessin industriel à l'université de Delft et, après son service militaire, il a étudié la chimie, la pharmacologie et les droits de propriété intellectuelle à l'université de Leyde et à l'université libre d'Amsterdam. La peinture et le dessin ne lui procurent pas seulement beaucoup de joie mais se sont révélés être des sources d'inspiration pour son travail juridique. Il se concentre sur la peinture abstraite mais peint également des portraits et des œuvres "en plein air". Inspiré par l'art d'établir des revendications de demandes de brevets, Jowi a décidé de chercher des incarnations dans ses peintures. Les peintures exposées sur son site internet (<http://jowiartpreferredembodiments.blogspot.de/>) révèlent la surprenante richesse des peintures extraites de ses œuvres qui peuvent être considérées comme des "revendications principales".

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Editorial

T. Johnson (GB), Editorial Committee

The result of the UK Referendum on EU membership is in, the great British public having voted 'out', in what has become known as Brexit. There will be many issues to resolve before the UK finally leaves the EU post-Brexit, and IP will certainly not be immune from them.

One thing is certain. The UK will remain a Member State of the EPC, no matter what is decided on the Brexit front. However, we have heard of rumours being put about that the UK, and hence our British members, will have no future in the EPC, which as our readers know is not an EU creation and so has nothing to do with Brexit. We feel it regrettable that terminological inexactitudes such as these rumours are put about and can, again regrettably, gain credence by repetition. We feel confident that our Institute will quash such inaccurate rumours, to the benefit of the membership as a whole.

Reverting to Brexit, negotiations regarding the future of the UP and UPC will however continue post-Brexit. It should be borne in mind that despite the Brexit vote, the UK is still a part of the EU, and will remain so until a final EU exit strategy is agreed with the other Member States. Such agreement may well not be reached until 2019-2020. With a fair wind and national resolve, the UPC for example could be ratified before the UK formally leaves the EU. Measures would need to be agreed between the EU member states and the UK government as to how the UK would deal with the (ratified) UPC after exiting the EU. Governments will decide, but if our proposition comes to pass, we would hope that such measures would be simple, transparent and proportional, to provide certainty for all users of the system going forward from say 2020.

In our view Brexit does not mean 'put the brakes on' the UP or UPC, rather 'let's move forward'. We wish the negotiators well!

Election to Council 2017

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 2016 – 1st November 2016 according to the Rules for Election to Council that you are ready to stand for election or for re-election to the Council. This time your nomination can be done online through the **epi** website. The instructions how to log-in on the **epi** website can be found here: <http://patentepi.com>

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 2016.

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.

The election shall be by remote e-voting. You shall receive on 15 January 2017 at the latest, a web address for a secure website, and a personal password from our independent voting service provider. The **epi** Secretariat will send you a ballot paper by post if remote e-voting is impossible for you.

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 2016.

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

95th Board Meeting in Haarlem on 10th September, 2016

A. Faivre (**epi** Secretariat)

The 95th meeting of **epi**'s Board took place on 10th September, 2016 in Haarlem (NL). The President opened the meeting by welcoming the Board members. The minutes of the 94th Board Meeting were adopted with minor amendments. The Secretary General, Mr Pereira da Cruz, on behalf of Mr Markus Müller (Chair of the Electoral Committee), briefed Board about the next Council elections and on the ongoing Belgium vote on the split constituency, which resulted on a change from non-unitary to unitary. Mr Boff informed the Board about an ongoing user consultation launched by the EPO on fee payments. The EPO Finances Committee will draft a response to the consultation which will be further communicated to all **epi** members. After a discussion on the Brexit led by Mr Chris Mercer and Mr Jim Boff, Board agreed to send a

letter to the EU Council on the occasion of the forthcoming Competitiveness Council scheduled for next 29th September, expressing the **epi** views on the UPC/UP ratification and implementation. Mr Durán-Moya and Mr Leyder, on behalf of the Reporting Group, presented to Board some working recommendations for Presidium, Board and Council as well as proposals to implement electronic voting for Council decisions. The President updated the Board about the ongoing reform of the EQE. Mr Leyder, as Chair of the EPPC, gave a presentation on EPO prosecution focused on the 3-speed system.

The Board meeting was followed by an official reception and dinner on Saturday with guests and IP experts from the Netherlands.



Report of the Oral Proceedings before the Enlarged Board of Appeal in case G 1/15

R. Jorritsma (NL)

Date: Munich, 7 June, 2016

Composition of the Board:

W. van der Eijk (chair)

C. Vallet (Ms.) (legal; rapporteur)

P. Carlsson (legal, external)

I. Beckedorf (legal)

F. Blumer (legal)

W. Sieber (technical)

H. Meinders (technical)

Appellant/Proprietor: Infineum USA L.P.,
represented by Richard Hart

Respondent/Opponent: Clariant Produkte,
represented by Klaus Mikulecky

Other party: President EPO,
represented by two EPO officials

The case was referred by Board of
Appeal 3.3.6 (B. Czech) in T 557/13.

The chairman opened the proceedings by introducing the case and parties involved. He recited the referred questions (see below) and indicated that the Board was familiar with the issues at stake, and had taken due note of the numerous (over 40) amicus curiae briefs.

The case was considered admissible. The chairman further indicated that the appellant, opponent and EPO were given the floor in that order, in two rounds, and that members of the Board might ask questions afterwards. He wanted the 5 questions to be dealt with without being split, because of the close interdependence of the questions. He repeated the 5 questions (*the full questions can be found in the decision T557/13*).

The questions (in summary):

1. Can partial priority for alternative subject matters be refused at all?
2. If yes, is proviso of 6.7 of G2/98 (limited, clearly defined) to be used as a test?
3. If yes to Q2, how to interpret "limited" and "clearly defined"?
4. If no to Q2, what is the test?
5. If yes to Q1, can divisional be held against parent (or vice versa) under A54.3?

The patentee/appellant comprehensively (1.5 h) set out his position. This position fully corresponds to what many interested parties (at least *epi* and some other organisations) have argued.

Some of his arguments:

- General interest: most inventions are developed further after the first filing. If a second, improved, filing has intrinsic risks of the poisoning type, such inventions will not be protected well and active innovators are thus punished. This is increasingly relevant because of increased collaboration in innovation and hence increased demand for careful management. Self-destruction when there is no interference by others is wrong.
- Legislation, direct and indirect (interpretation): Vienna, Paris, with the explanations by Bodenhausen, EPC, Travaux Préparatoires including FICPI 1973 Memorandum C, which links Paris to EPC A88. Conclusion: Partial (multiple) priorities are allowed, and intended to have effect only for the applicant; they cannot give rise to any right of third parties.
- Disclosure test: this should be applied along the same principles of conceptuality as the novelty test. It is wrong to apply an additional test (literal, spelled-out) only to priorities. The conceptual approach is the right one.
- G2/98, in particular section 6.7 (the famous proviso): The question is whether it was intended as a new test for acknowledging multiple priorities or not. We have no clue, since the decision does not explain why the proviso was made, it was not necessary for answering the question at stake, and there was no problem to be solved. So, we must assume it was not intended by the EBoA as an extra test. If it was, it was against the legislation and the legislators' intentions. T1222/11 is helpful.
- A54.3 (Q5): a divisional is not changed compared to the parent, as to its maximum content; and it is the same from its background as the parent; only in its further examination it is treated differently, on its own merits. Therefore it cannot be a(nother) "European application" in the sense of A54.3.
- The respondent also notes that the EPO President largely agrees with his views as does the vast majority of the amicus curiae briefs.

Some of the arguments of the respondent/opponent (much was an argued disagreement with the appellant's arguments).

- Paris only rules that priority of an application (when filing; not of a patent later on) cannot be simply refused because the contents are not identical. Paris does not provide an absolute right to multiple priorities. This is not against Travaux Préparatoires and Memorandum, since it does not abolish the allowability of generic or-claims, but only reduces it.
- Full applicability of partial (multiple) priorities is undesired, following the interpretation of the law and case law, because it leads to double patenting.
- A conceptual approach for assessing partial priority is wrong, because the law, and in particular G2/98, prescribes a strict approach.
- Proviso of G2/98 6.7 (limited number, clearly defined) is to be followed.
- Partial priority cannot apply when ranges are involved, because ranges are, by nature, a collection of an infinite number of embodiments, against the proviso of G2/98 6.7.
- The FICPI Memorandum C would show, at III, where it deals with later amendments in some countries, that full applicability of partial priority was not intended by the legislators.
- A divisional is, according to the convention (A76), a different application from the parent, and therefore it can be a conflicting application under A54.3. It was also meant to be so in order to limit a practice of double patenting.
- Even if the intentions in the 1970's were to accept partial priority, times have changed, and there would now be a need to put a limit to it.

The representatives of the EPO President argued in essence:

- Multiple priorities are frequent, especially in pharma and chemistry and the present case will have a significant impact. The interested circles need legal certainty and predictability of the system.
- A literal approach would depart from the EPO principles.
- A literal approach would not lead to legal certainty, because it would compel applicants to draft complex claims. Claims need not only be complete, but also clear and concise.

- It should be possible to discern multiple alternatives (and priorities) from a claim.
- A conceptual approach raises concern with alternatives.
- A conceptual approach does not imply an automatism in acknowledging priority for generic or-claims (in response to respondent)
- A divisional is, for the purpose of A54.3, not a different application from the parent since it has the same history and does not go beyond the content of the parent (in response to the respondent).

Then members of the Board asked some questions to the parties:

Meinders: assuming that alternative subject matter having different properties would have to be spelled out, should applicant have a duty to explain it? (no clear answers from the parties, although respondent showed some support of yes).

Sieber: (to respondent): is a later broader claim after an earlier narrow claim objectionable for double patenting? If it is, this is not specific for priority situations, is it? (answer: sort of yes; no, indeed);
(to the office): is it the conceptual approach or the literal approach that should prevail? (answer: conceptual)

Beckedorf: (to respondent): what about requirement to specify alternatives later on? (answer: not only formal requirement but more, priority requires same invention, which is identical invention. If differences, then new invention, no priority)

Van der Eijk: (to respondent): what is difference in reality? hasn't assessment of disclosed subject matter changed? (answer: could be)

Blumen: (to respondent): Is FICPI Memorandum C III really to be understood as not supporting alternatives being claimed together? (no clear answer)

Van der Eijk: (to respondent): what precisely has changed in the last 40 years that would necessitate different approach? (no clear answer).

The chairman closed the oral proceedings by announcing that the Board would render its decision in November 2016 at the latest.

Considerations about the Code of Conduct for UPC representatives

G. Checcacci (IT), PCC

In the long path towards UPC, an interesting step is the definition of the code of conduct for representatives.

Since the beginning of July, it is possible to download a draft code of conduct from the website of the UPC, see <https://www.unified-patent-court.org/file/112/download?token=RUCko2XM>.

This draft is the result of a joint effort of **epi** together with EPLAW (a private association of European patent lawyers: <http://eplaw.org>) and EPLIT (a private association of European patent litigators: <http://www.eplit.eu>). It is not yet a code, as only the future Administrative Committee of the UPC will have the power to adopt a code of conduct, when UPC eventually comes to life. This might mean years from now, and besides there is no guarantee that the Administrative Committee will actually adopt this draft as the code of conduct; nevertheless reading this draft is an interesting and after all short- exercise.

The first interesting aspect of this draft code is merely political: its provisions will apply equally to UPC representatives under art. 48(1), i.e. the lawyers, and UPC representatives under art. 48(2), i.e. the European Patent Attorneys allowed to represent. So, after the milestone constituted by art. 48(2) itself, this draft code is a further step towards a better recognition of the equal dignity of our profession in the field of patent litigations.

When considering the actual provisions of the draft code, it is necessary to start from the framework already defined by the UPC Rules of Procedure, in particular rules 290.2 and 291.1:

Rule 290.2: Representatives who appear before the Court shall strictly comply with any code of conduct adopted for such representatives by the Administrative Committee.

Rule 291.1: If the Court considers that the conduct of a party's representative towards the Court, towards any judge of the Court or towards any member of the staff of the Registry is incompatible with the dignity of the Court or with the requirements of the proper administration of justice, or that such representative uses his rights for purposes other than those for which they were granted, or that such representative is otherwise in breach of any code of conduct adopted pursuant to Rule 290.2 it shall so inform the person concerned. On the same grounds, the Court may at any time, after having given the person concerned an opportunity to be heard, exclude that person from the proceedings by way of order. That order shall have immediate effect.

In simple words, rule 291.1 already defines a disciplinary body (the Court itself) and a sanction for behaviours in breach of the code of conduct (exclusion from the proceeding), as well as a disciplinary procedure (information – opportunity to be heard – order).

This is something dramatically different from what we are used to within **epi**. The sanction consisting in the exclusion from the proceeding is potentially very hard for the specific case, however not so much on the personal record of the representative; indeed, there is no such record, and -in principle- a representative might repeatedly breach the code of conduct without any direct consequences on his ability to address clients. One might argue about the lack of any “social effect” of a disciplinary system like this, that does not give the public any sort of guarantee about the quality of the service provided by a representative, but this goes beyond the purpose of this article.

It is to be noted that Rules 290 and 291 do not exclude that (further) disciplinary bodies and sanctions are defined by the code of conduct; however, the present draft code does not include anything like that.

The draft code is accompanied by a memo that gives some explanations about the process by which the draft code was defined. Inter alia, it is explained that some important aspects (e.g. conflicts) had to be left out of the draft code because of the difficulties in coordinating with existing national provisions: lawyers do not have a unified European profession; rather, they are subject to national laws. The memo also seems to keep a door open in respect of the possible future introduction of a disciplinary body; for the time being, however, there is just a reference to national and **epi** provisions.

The draft code itself is divided in four sections:

- 1 – Field of application
- 2 – General conduct
- 3 – Dealings with Witnesses and Party Experts
- 4 – Change of representation

In the first section (Field of application), it is stated that this code applies to all activities of all representatives in relation to the UPC. There is also an explicit reference to possible other existing codes and laws and to their possible disciplinary measures. This reference means that the obligations of this code must be seen as additional obligations with respect to existing other obligations, that

remain valid (as far as applicable) and will be treated according to the respective laws and codes: for European Patent Attorneys, this means that **epi** disciplinary provisions apply, and indeed they are under revision in these months in order to clearly define their application to UPC-related activities.

In the second section (General conduct), six subsections address different aspects of the conduct.

A first aspect is relationship with the Court (judges as well as registry staff): respect, courtesy, competence (based on education), reputation of the respective professional association (e.g. **epi**) are the keywords here. I trust that this is not surprising for anybody. A note explains that the reference to competence shall not be intended as a basis for imposing any formal requirement for Continuing Professional Education.

A second aspect is the conduct of the proceedings, that must be fair. Here, good faith and non-abuse of the procedure are the keywords; again, no surprise. A possibly unexpected provision is the obligation to be reasonably accommodating and flexible regarding scheduling and routine matters: this seems an obligation for which European Patent Attorneys might have to be a bit more careful than they are used, e.g. in opposition proceedings before the EPO.

A third aspect relates to contacts with judges, that must be limited to situations where the other parties also participate (or give their consent).

A fourth aspect is demeanour in Court and this includes several obligations. The representative must serve the interests of the clients, without regard to personal feelings or interests. Courtesy must be applied also in respect of other representatives, accompanying persons, parties, witnesses and experts, and a representative is responsible for taking appropriate steps to ensure that any accompanying person behaves appropriately. This latter obligation, however, does not seem to imply that a representative is responsible for misbehaviours of accompanying persons.

A fifth aspect is misleading information. Preliminarily, it must be kept in mind that a strong obligation not to misrepresent a case or facts is already included in art. 48(6) UPCA. Here, it is added that the representative must seek client's consent to inform the Court if he/she becomes aware of any inadvertently misleading information. This is not intended to introduce a US-style inequitable conduct doctrine (as explained in a note to the draft code); however it seems a quite strong obligation.

A sixth aspect somehow rules confidential information: in case a representative in the course of a proceeding,

e.g. inspection of premises- gets knowledge of information not related to the case, he/she must neither use nor disclose that information to anybody, including the client.

In the third section of the draft code (Dealings with Witnesses and Party Experts), three aspects of such dealings are ruled.

The first aspect relates to information on legal obligations and provides that the representative has the burden of keeping experts and witnesses informed of their obligations, in particular obligation of impartiality.

The second aspect relates to contacts with witnesses and party experts: they can be contacted only in limited circumstances and in a way that their opinions are not influenced.

The third aspect rules the possible compensation for witnesses and party experts.

Ultimately, all provisions of this third section of the draft code derive from the fact that both witnesses and experts (even party experts) have the same duty of impartiality, as provided by the RoP, rules 175-181: the conduct of the representative must be such as to ensure that this duty is respected.

Finally, the fourth section (Change of representation) define that the former representative must both inform the UPC Registry of the change and transfer or copy documents to the new representative.

This is the content of the four sections of the draft code. Then, one might look for what is not contained in the draft code, and here the list might be long.

In short, it might be said that any provisions similar to those of **epi** code of conduct (such as advertisements or relations with the public, with clients, with other representatives) are excluded from this draft code. Representatives who are **epi** members will have anyway the duty to comply with **epi** code of conduct; other representatives (i.e. lawyers) might have to comply with national code of conducts, depending on their place of business. This means that in practice representatives will not be subject to the same obligations: all of them will be subject to the minimum obligations of the UPC code of conduct (which is a good point), however each representative might be subject also to other obligations depending on the country and on the official association to which the representative belongs (which is certainly not the best).

Thus, this situation is well acceptable now, at the beginning of UPC operation. However, we can legitimately hope that later, after some time, the code of conduct is revised, to obtain a better uniformity of provisions among all representatives, in all associations and in all countries.

Conflict of interest

P. Rosenich (LI), Chair Disciplinary Committee

The Chairman of the Disciplinary Committee Paul Rosenich is of the opinion that the latest Decision of Chamber Dina Korper is of general Interest to the **epi** Members. For that reason a summary of said decision prepared by the Chairman is published.

Summary of the complaint and the defense

The complainant was of the opinion that the defendant breached Art. 4(f) of the Code of Conduct of the Institute of Professional Representatives (CoC) and Art. 3 (2) of the Regulation on discipline for professional representatives (RD) because the defendant was previously the representative of a national part of a European Patent of which European Patent the defendant later represented the opponent.

The defendant proved to the satisfaction of the Chamber that only administrative tasks were performed for the patentee on the national level of procedures. Furthermore, the defendant had - apart from the publicly available information - no knowledge of the matter due to the restricted involvement of the defendant's IP-law firm.

Decision

From the wording of the relevant provisions (see below) the Chamber found that they are directly aimed at punishing the use/disclosing of confidential information acquired while dealing with a "particular matter" entrusted by a client, as long as such information does not belong to the public domain. Accordingly, as a "particular matter" should be understood a substantial work – e.g. drafting a specification, since this activity provides insider knowledge on eventual weaknesses of a patent. Clerical work, such as acting as a "mail box" of the client at a national patent office or translating published patent specifications, which holds only information which are fully accessible by the

public however does – according to that Chamber – not fall into the meaning of "a particular matter". The definition of "particular matter" is corroborated by the relevant provision of Art. 2 of the RD, which refers to information acquired from the client "in confidence".

The Chamber of the Disciplinary Committee has therefore dismissed the complaint.

Relevant Regulations

Art. 2 (RD) "Professional secrecy": A professional representative shall be bound not to disclose information accepted by him in confidence in the exercise of his duties, unless he is released from this obligation.

Article 3 (RD) "Special provisions on conduct towards clients" § 2: A professional representative shall refuse or withdraw his services if acceptance or continuation would necessitate his dealing with a particular matter on which he has represented or advised another client with opposing interests and the conflict has not been resolved.

According to Art. 4(f) (CoC) "Relations with Clients": Supplementary to Art. 2 and 3 (RD), a member shall not take any action against a particular matter which is being handled or has been handled by the Member or another person in his office, unless the client in the matter agrees to this action or unless the Member has no cognizance of the matter and is no longer in a position to take cognizance of it. The Member is not permitted to make use in the action of information obtained during the time the matter was previously handled, unless the information is public.

The Chairman of the Disciplinary Committee reminds the **epi** Members that Chambers of the Disciplinary Committee are – like Chambers of the EPO Boards of Appeal - independent in their Decisions and that Appeals are open only for the Defendant and the President of the EPO as well as the President of the **epi**.

Toujours la politesse

C. Mercer (GB)

In an earlier article (see **epi** Information 2/2008), I reported on a meeting with members of the Boards of Appeal at which the question of non-attendance at oral proceedings was raised. As a result of that meeting, I wrote that, as a matter of professional courtesy and good practice, any party intending not to attend an oral

proceedings should inform the Appeal Board as soon as possible.

It now appears that non-attendance at oral proceedings is also becoming a problem for Examining and Opposition Divisions.

Non-Attendance at Examining Division Oral Proceedings

The EPO is getting worried that, in an increasing number of cases, the applicant fails to attend oral proceedings before an Examining Division which have been arranged at the applicant's request. This causes difficulties for the Examining Division and in particular can mean that the Examining Division has to spend time and effort in dealing with a case in which the applicant has no interest. As a matter of professional courtesy and good practice, any applicant intending not to attend an oral proceedings must inform the Examining Division, and must do so as soon as possible. In the majority of cases, this occurs. It should occur in all cases. However, even where the Examining Division is informed, there can still be problems.

Even if the applicant indicates that it will not attend the oral proceedings, the applicant may not indicate whether the request for oral proceedings has been withdrawn. Unless the applicant withdraws the request, the Examining Division will have to continue with the oral proceedings.

If the applicant indicates that it withdraws its request for oral proceedings, the Examining Division will still not know whether the applicant is interested in the application. If the applicant is no longer interested, it would be of great assistance to the Examining Division for the applicant actively to withdraw the application. If the applicant is still interested in the case, it would also be helpful for the applicant to indicate that it requires a decision according to the state of the file.

In some cases, as indicated in the headnote of T3/90, if oral proceedings are appointed as a result of a party's request for such proceedings on an auxiliary basis, and if that party subsequently states that it will not be represented at the oral proceedings, such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings.

Applicants should also consider seriously whether, having requested oral proceedings, not turning up is a good option. If the application is refused and the applicant appeals with amended claims, it is possible that the Board would reject the claims as inadmissible as they were not submitted, as they could have been, to the Examining Division (see Article 12(4) RPBA).

The normal result of non-attendance at oral proceedings leads to an overall inefficiency in the examination procedure. It certainly does not convey the impression that the applicant is interested in the outcome of the case. It is difficult for the Examining Divisions to deal with cases more quickly if they have to hold oral proceedings on cases in which the applicant has no interest.

Non-Attendance at Opposition Division Oral Proceedings

It is also the case that a party to an opposition decides not to attend oral proceedings before an Opposition Division without giving notice or only giving notice late. This can lead to significant wasted costs if the party had requested translation and wasted effort if the preliminary opinion of the Opposition Division was clearly against the non-attending party. The Opposition Division can award the costs incurred by the other parties against the non-attending party but cannot award the EPO's costs. Thus, again, any party intending not to attend oral proceedings before an Opposition Division should inform the EPO and other parties as soon as possible. The party should also inform the EPO whether the request for oral proceedings is withdrawn, whether the party wishes for a decision on the basis of the written submissions or whether the party is withdrawing from the proceedings completely. If the Proprietor no longer has any interest in the patent, it is recommended that it should withdraw its approval of the text of the patent and indicate that no replacement text will be filed so that the proceedings can be terminated quickly and finally.

Toujours la Politesse

Better communication with the ultimate client, whether this is an in-house business unit or a company instructing a representative in private practice, would ensure that decisions as to whether to request and attend oral proceedings and whether to maintain an application, a patent or an opposition are discussed and agreed. If possible, we should monitor whether the client is still interested in the case. In any event, on receipt of the summons to oral proceedings, we should ask the client whether it is still interested in the case. If it is not, we should find out whether the client is prepared to withdraw the application, patent or opposition, thus closing the proceedings.

We should also inform the client what we will do if the client does not give us any instructions. The two main possibilities would be to indicate either that we will only attend the oral proceedings if the client specifically instructs us to do so or that we will definitely attend the oral proceedings unless the client specifically instructs us not to. In the first case, we should also indicate that, in the absence of instructions, we will notify the EPO, as soon as possible after receipt of the summons, we will not be attending the oral proceeding and that we withdraw any request for oral proceedings.

If we make efforts to persuade clients to deal efficiently with all cases in which they no longer have any interest, it should be possible for the EPO to deal more efficiently with cases which are more important to our clients.

Report from the Workshop on the Technical Implementation of the Unitary Patent

Y. Biron (BE), OCC Associate Member

Date: 20 May 2016 08:45 h to 13:00 h
European Patent Office, ISAR Building Room 102
Bob-Van-Bentheim Platz 1 80298 Munich
Participants: EPC Member States National
Patent Offices & Observers

Welcome and opening remarks

Alberto Casado (Vice-President, DG 2)

National patent offices are interested in understanding the technical implementation of the Unitary Patent e.g. payments following the agreed repartition of renewal fees. The EPO decided to organize a dedicated workshop to answer all current concerns. The objective is that the National Patent Offices are also ready by the time the package is launched.

State of play of the implementation work Legal framework

Legal framework

Michael Fröhlich (Director European and International Legal Affairs, DG 5)

Michael reminds the audience about the Unitary Patent associated rules and its co-existence with classic European patent validations. See slides.

Nine states have deposited their instrument for the UPC. Launch expected by the UPC preparatory committee in the first half of 2017 with well over 13 states parties. Bulgaria should deposit their instrument very shortly. Lithuania and Italy should be next.

BusinessEurope's representative comments that a top-up search at the end of the European patent grant proceedings would help to identify any possibly existing national prior art, which are critical considering their impact on future Unitary Patents.

Technical implementation

Dominique Furst-Fontaine (Project Manager Technical Implementation Unitary Patent, DG 2)

All EPO systems are currently being upgraded to manage the different impacts of the implementation of the unitary patent. Compensation pay-out is a new approach to the EPO. More than 65 forms have been deployed. Interfaces are planned with the UPC and National Offices.

Online Filing System and Online Fee Payments System

Dirk van Haken (Head of IT Architecture and Solution Design, DG 2)

Presented a demo of each new system.

1. EPO Online Filing System

New feature: the system will retrieve from OPS the title of the invention to check that the patent number is correct. The application number is then required and the date of the mention of grant recommended.

Request – Three tabs: Unitary effect, Place of business at filing, Compensation (entity profile or language-related).

Names – this section allows to add proprietors.

Documents – Translations may be submitted in this section. Other documents such as a certificate of translation or translation cover letter may be associated to translations.

Fee Payment – Different mode of payment are offered. From deposit account for instance: indicate PEO account number and account holder name. The deposit account may be used for compensation or reimbursement. The list of fees to be paid

Annotations – Any comment made by made for the EPO formality Officer to review upon receipt.

Once all parameters have been entered, pressing play generates the form request. If the content is fine, the application may be signed e.g. via Smart Card.

The package is then added to the ready-to-send list. The user may then send the request to the EPO. An acknowledgement of receipt will be immediately available.

If additional documents must be filed at a later stage, EPO Form UP7038 should be used (vs. EP1038 for subsequently filed documents with classic European patents). Same process as above. Consultation is ongoing with the user community. A plugin should be installed.

2. Online Fee Payment System (through My Epoline)

A new procedure will be added on top of EP and PCT linked to UP to pay for unitary patent protection. If no

unitary patent effect has been requested, it will display such information.

3. Web-Form Filing

After login, UP7000 to request unitary effect and UP7038 for subsequently filed documents will be available to deal with UP-related filings. The forms and any type of documents may be uploaded in the system. The system then provides an overview on the request. The documents can then be checked and sent. A detailed AR should either be requested (UP7000) or downloaded (UP7038).

BusinessEurope question on multiple proprietors – when multiple proprietors request such unitary effect, they will have to act through a common representative.

BusinessEurope question on representation – No change vs. classical European patents. An employee of the patent owner could request the unitary effect just as an employee can represent its employer in European grant proceedings.

epi question on different representatives between Grant procedure and Request for Unitary Effect – EPO Form 1003 & 1004 forms are currently being revised to allow for extended representation post-grant proceedings including for the Unitary Patent related tasks. Specific authorisations would always be accepted just as a new representative may be appointed for opposition proceedings only.

Republic of Eire comments on the interaction between the different systems presented – The online filing system allows to submit online forms mostly prepared offline.

Register for unitary patent protection

Ignacio Muñoz Ozores (Administrator
General Publications, DG 5)
Annie Decroix (Lawyer, DG 5)

Presented a demo of the extended European patent register. The register will be divided into two chapters: a first one for the European patent; a second one for the unitary patent (About this file, Event history, All documents).

The list of participating member states at the date of registration will be listed (in the "About this file" section). The UP chapter will be greyed-out if no request has been filed or if the request has been filed but the mention of the grant has not yet been published.

All UP sections will only reflect UP related events and documents.

New search functionalities will be implemented. The date mentioned for the unitary effect request will be the date of registration of Unitary Patent Protection.

The federated register will include a line for unitary effect. Swedish comments on how will users be able to see registrations such as pledges or compulsory licenses or SPCs – These are planned.

UK comments on whether the national offices will have to communicate to the EPO about national decisions.

epi comment on translation: no data will be available on the translation at all. The translation will only be available in the file inspection section (All documents). No information on translation language for example.

France comment on Unitary Patent kind code – Such kind code could be very useful for patent database users. This topic is currently being discussed as it strongly impacts EPO systems. The EPO is looking into different ways to solve this issue. The UK is also interested in such feature.

SAP - Public Sector Collection Distribution module (PSCD)

Richard Grabmeir (Application Manager, DG 2)
Thomas Morandell (IT Expert Finance, DG 2)

Richard presents the distribution rules and how they will be implemented into the EPO systems (the EPO uses SAP for accounting).

Transfer of electronic bibliographic data (EBD) – Feedback and exchange

Eloy Rodriguez Barrio (IT Expert, Service Creation DG 2)

Eloy goes through the new XML parameters, as they will be shared with the national offices. All XML technical details will be described in a dedicated EBD document (available from EPO EBD website, including examples). Specific XML tags allow to identify the status of cases.

UK question on the timing between updates on the EPO and XML files – All data is updated weekly on Thursday nights. Available the next day from the EBD restricted area.

Closing remarks

Michael Fröhlich (Director European
and International Legal Affairs, DG 5)

The EPO thanks the audience for their valuable feedback and invites the community to test the demo interface.

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE), Chair



Francis Leyder

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

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

This report completed on 12 August 2016 covers the period since my previous report dated 16 May 2016 published in **epi** Information 2/2016.

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

On 18 May 2016, the EPO published on its website an invitation to the patent community to test and give feedback until 31 July 2016 on a new "Unitary Patent DEMO" plug-in for the online registration of unitary effect. This plug-in enables users of the Online Filing software to simulate the drafting, signing and sending of a request for unitary effect and to file subsequent documents in a demonstration mode.

On 20 May 2016, the EPO organised a Workshop on the technical implementation of the unitary patent system. OCC represented **epi**.

The entry into force of the unitary patent system requires ratification or accession of 13 States to the UPC Agreement, including Germany, France and the UK. The outcome of the "Brexit" referendum has created some uncertainty about the ratification by the UK.

The 20th Select Committee meeting was scheduled on 21 September, and has been postponed to 25 October 2016.

In the meantime, the series of UP/UPC seminars initiated by **epi** has successfully continued, in Paris (29 June) and in London (11 July). The schedule of the next seminars is being reviewed.

2. PCT WG9

The PCT Working Group met in Geneva from 17 to 20 May 2016, with a PCT User Meeting in the morning of 18 May. The working documents (including the summary by the Chair) are available on the WIPO website:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=39464

A report is attached.

The proposals endorsed by the PCT WG will be submitted for approval to the PCT Assembly that will take place in the 56th Series of Meetings of the Assemblies of the Member States of WIPO that will take place from 3 to 11 October 2016. The PCT Assembly documents are or will be available on the WIPO website :

http://www.wipo.int/meetings/en/details.jsp?meeting_id=39951

The proposals relate essentially to the approval of the Turkish Patent Office as ISA and IPEA, and to the amendment of Rule 45*bis*.1(a) to extend the time limit for requesting supplementary international search from 19 to 22 months from the priority date.

3. TOSC 82

The 82nd meeting of the Technical and Operational Support Committee on 19 May 2016 included an item on information exchange on ISO 9001 certification and Quality Management. Users (**epi** and BusinessEurope) had been invited to make presentations on "Quality Management Systems, their certification and user's expectations".

4. SACEPO 48

The agenda of the 48th meeting of SACEPO on 21 June 2016 contained the following items with relevance to the EPPC:

2. President's report on the development of the European patent system

Each delegate found on his table an A3-size copy of the poster prepared for and shown at the Search Matters and Examination Matters events. The pdf version is available for download in the Documents/Member section of the **epi** website.

3. Timeliness in the EPO: Early Certainty from Examination and Opposition

These "Early Certainties" had already been presented at the SACEPO/WPR meeting of 7 April 2016 (cfr my previ-

ous report). A Notice from the EPO concerning the opposition procedure as from 1 July 2016 has been published in the OJ EPO 5/2016, A42.

4. Refunds of fee for examination

This topic had also been discussed at the SACEPO/WPR meeting of 7 April 2016 (cfr my previous report). Decision CA/D 4/16 of the Administrative Council amending Article 11 RRF has been published in the OJ EPO 5/2016, A48.

5. Fee payment methods

The EPO presented again their intention, already expressed at the SACEPO/WPR meeting of 7 April 2016 (cfr my previous report), to limit the filing of a debit order to "online means".

In general, the users repeated their wishes for making payments user-friendlier. The EPO made some promises to implement alternatives.

In particular, having been alerted by one of the EPPC members, I pointed out that the EPO removed the possibility of paying by cheque in 2008, arguing in particular that the use of cheques "stands in contrast to common business practice" (CA/101/07 Rev. 1, item 7), but continues to reimburse using cheques.

6. Reform of the EPO's Boards of Appeal

See item 8 below.

7. IP5 Projects: Global Dossier, CPC, PPH

Relevant to the EPPC was the report on the various PPH programs. The EPO announced an expansion of the EPO PPH activities, with continuation of the IP5 PPH trial, promotion of the PCT-PPH, and preparation of new bilateral PPH pilot programmes (Australia, Colombia).

9. Update on PCT matters

The EPO reported on their work as ISA and IPEA, reminded us of some changes already implemented, and announced that all IP5 Offices would participate in Pilot Phase 3 of the Collaborative Search & Examination, expected to be launched mid-2017.

10. Unitary patent protection – progress report

5. PAOC thematic group

Ten **epi** delegates of the PAOC thematic group of the EPPC (pure and applied chemistry, including pharmaceuticals) met again with thirteen EPO representatives (mainly Directors in that field) on 22 June 2016. The report had not yet been finalised at the time of preparing the present report.

Examples of the specific topics discussed were use claims containing the feature "non-therapeutic" and whether

experimental evidence of a second medical use needs to be included in the priority application. Many topics of more general interest were discussed.

The **epi** delegates concluded that the meeting was very useful again, they appreciated the open and cooperative atmosphere, and they hoped such a meeting could be repeated on an annual basis.

6. Independence of the Boards of Appeal

The Administrative Council approved a comprehensive package of reform of the Boards of Appeal on 30 June 2016. The decisions (CA/D 5/16, 6/16, 7/16 and 7/16) and the preparatory documents (CA/29/16 Rev.1 and CA/43/16 Rev.1) are available on the EPO website:

<http://www.epo.org/about-us/organisation/documentation/ac-documents.html>

7. IP5

IP5 announced on 1 August 2016 a common PPH request form

<http://www.fiveipoffices.org/activities/ws/ip5pph.html>

8. Guidelines sub-committee

The **epi** delegates to the SACEPO/Working Party on Guidelines received the draft 2016 Guidelines for review in preparation of the annual meeting in the autumn. The sub-committee will meet on 15 and 16 September to discuss the draft and set up a list of further proposed amendments.

9. ITC thematic group

The ITC thematic group of the EPPC (Information and communications technology) will meet again with the EPO Directors in that field on 21 September 2016.

Guidelines

The EPPC urges the readers of this journal to address to its Guidelines Sub-Committee at

eppc@patentepi.com

any comments regarding the Guidelines for Examination in the European Patent Office <https://www.epo.org/law-practice/legal-texts/guidelines.html> or suggestions to improve them.

The same applies to the Guidelines for Search and Examination at the EPO as PCT authority

<https://www.epo.org/law-practice/legal-texts/guidelines-pct.html>.

Report of the Litigation Committee

A. Casalonga (FR), Chair



Axel Casalonga

Update on Training Activities

An inter committee working group under the lead of PEC had been established with members of LitCom, EPPC and PEC. The task of this group is to plan training events in connection with the Unitary Patent and the UPC. A series of seminars have already been scheduled.

Each seminar has three speakers, two for the Unitary Patent part and one for the UPC part. The EPO agreed to provide a speaker for the Unitary Patent part for eight of the seminars. The other speakers are **epi** members.

Due to the UK's referendum, some of the seminars have been cancelled or replaced by different topics.

Code of Conduct for UPC Representatives

A first draft Code of Conduct for the UPC has been prepared by the **epi**, EPLAW and EPLIT.

It was suggested to include rules on the conduct of a representative in ex parte proceedings, e.g. preservation of evidence or inspection. It should be regulated that the

representative needs to be careful with confidential information and is not allowed to communicate to his client anything he saw during the saisie, or inspection which is not related to the case, e.g. infringements of other patents.

Litcom's comments prepared by the Litcom were presented by Mr Casalonga and discussed with Klaus Haft who was responsible of the first draft on behalf of EPLAW. A part of the Litcom's suggestions were incorporated in the final draft. The Preparatory Committee agreed on the UPC CoC at its 17th meeting in Stockholm on 30 June 2016.

Consequences of a Brexit

The result of the referendum in UK will certainly have consequences on the UPC and the Unitary patent. At the present time it is impossible to ascertain those consequences.

The UK may decide to ratify the UPC Agreement before effectively leaving the EU, which could lead to an entry into force of the UPC and the UP in 2017 as previously announced. Specific arrangements could then be found to allow the UPC and possibly also the UP to extend their effects to the UK territory, even after UK would have left the EU.

The Litigation Committee will monitor the changing situation and draft **epi** opinions on proposed changes, if necessary.

Next Board and Council Meetings

Board Meetings

96th Board meeting on 11 March 2017 in Manchester (UK)

Council Meetings

81st Council meeting on 12 November 2016 in Berlin (DE)

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

Forthcoming epi Educational Events

epi CPE Seminars - Updated Event Calendar

25	October	2016	Milan (IT)	»Unitary patent and Unified Patent Court« epi roadshow supported by the EPO
8	November	2016	Prague (CZ)	»Unitary patent and Unified Patent Court« epi roadshow
17	November	2016	Eindhoven (NL)	Subject to be advised
7	December	2016	Hamburg (DE)	»Unitary patent and Unified Patent Court« epi roadshow

Preparation Courses for the EQE

Flexible epi Tutorial

(see announcement below)

epi Mock EQEs 2016

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

Participants may sit any combination of papers.

Scheduled epi Mock EQEs:

The registration is available on the **epi** website.

Time schedule:

Mock EQE session

24.10.2016:	Paper D	09:30 - 14:30
	Pre - Examination	09:30 - 13:30
25.10.2016:	Paper A	09:30 - 13:00
	Paper B	14:30 - 17:30
26.10.2016:	Paper C	09:30 - 14:30

Feedback session December 2016

1 Day:	Paper D Pre-Examination
2 Day:	Paper A Paper B
3 Day:	Paper C

The final selection of the location(s) are Brussels, Helsinki and Munich.

The feedback sessions can be expected to take place in December 2016

Flexible epi Tutorial

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

whenever you need it during your preparation for the EQE

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

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

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

Further information on our *website*:

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

Milestone: more than 1000 patent attorneys attended the Opposition and Appeal Seminars

C. Mulder (NL) and M. Müller (DE)

On 27 September 2016, Marcus Müller (member of the Boards of Appeal of the European Patent Office) and Cees Mulder (European patent attorney and associate professor of intellectual property law at Maastricht University) gave an *Opposition and Appeal* seminar in the Danish Patent and Trademark Office in Taastrup (close to Copenhagen) for an audience of around 70 patent attorneys. The seminar was skilfully moderated by Pia Stahr (PEC Member, DK).

The cycle of the **epi** *Opposition and Appeal seminars supported by the EPO* started in December 2013 in Milan on request of Paolo Rambelli (PEC Chairman). Since then the seminars have been given twelve times at various locations all over Europe, including Barcelona, Copenhagen, Eindhoven, Helsinki, London (twice), Munich, Oslo, Paris, Stockholm, Warsaw and Zurich. In the three years, a total of 1,034 patent attorneys have attended the Opposition and Appeal seminars. This shows the success of the programme of continued education organised by the **epi** for its members.

The format of the seminar is that Marcus Müller takes the lead in presenting the seminar and that Cees Mulder acts as a side kick with questions and remarks. This interaction

encourages the participants to ask questions and makes the seminars very vivid and stimulating. A lot of practical advice is given by the two speakers. For instance, Cees Mulder talks about how to behave in oral proceedings and how to draft a patent application with the aim of preventing problems later on in opposition and appeal.

The morning programme of the seminar focuses on opposition proceedings and the afternoon session is devoted to appeal. For instance, the *Rules of Procedure of the Boards of Appeal* are discussed in relation to their effect on the admissibility of late-filed documents and evidence and claim requests. The presentations are continuously updated to reflect the latest developments in the case law of the boards of appeal. In addition, the relevant decisions/opinions of the Enlarged Board of Appeal are discussed including the pending referrals.

Usually, the seminars are moderated by the local **epi** PEC member. The **epi** organises the events in a friendly and professional manner.

The successful cycle of *Opposition and Appeal* seminars will be continued in 2017 with events foreseen in Budapest, Dublin, Hamburg and Rome.

The eDrex tool - Leaving Dinosaurs Behind

H. Pihlajamaa, EPO Director Patent Law

During the last few years the EPO has been investing in the overhaul of its IT systems with the major purpose to streamline the procedure by processing European patent applications electronically. A further aim of this exercise is to increase the accuracy of the publications of both patent applications and patent specifications. In order to achieve this, the Office, in a first step, discontinued its past practice governing the form of amendments and thus no longer accepts handwritten amendments in documents replacing parts of the European patent application (Rule 50(1) EPC in conjunction with Rule 49(8) EPC; see also the Notice from the EPO dated 8 November 2013, OJ 2013, 603). In a next step the Office has developed a tool for examiners to produce the Druckexemplar electronically ("eDrex"). This tool allows in particular for the electronic insertion of amendments by the Examining Division to the text of the patent intended for grant.

Yet concerns have been raised about the accuracy of the OCR source that eDrex uses and the ensuing risks for applicants.

The purpose of this article is to provide relevant technical information on the eDrex tool and its functionalities and to clarify certain legal aspects arising from the introduction of this new tool.

The eDrex tool

Documents may be filed with the EPO on paper, by fax, or electronically (pdf or xml); after filing they are included in the electronic file as an image. The new eDrex tool provides examiners with the possibility to edit the Druckexemplar electronically.

The examiner can make amendments to the Druckexemplar in two different ways. The first, image mode, works on the scanned image submitted by the applicant. Text can be deleted or added and all unamended text on the page remains as filed by the applicant. The second, text mode, is where the examiner can make changes to an OCR'd version of the original page. Here, amendment is similar to editing with a traditional word processor where text can be added or deleted just like in MS Word. In addition to these two main ways of preparing the electronic Druckexemplar, there is also a bitmap mode which is used infrequently for amendments to drawings. Pages edited using image or bitmap mode are indicated as "AMENDED" in the header of the Druckexemplar. Pages edited using text mode/OCR data are specifically indicated by "AMENDED/OCR".

Any amendments or corrections using the electronic tool are indicated by means of standard marks and any insertion is made in-line. Detailed explanations on the standard marks used are contained in the Guidelines for examination before the EPO, Annex to C-V. A further advantage of this tool is that all amended pages are tracked and this information is automatically transferred to the communication under Rule 71(3) EPC (forms 2004C or 2004W). This functionality immensely improves the quality and accuracy of this communication.

Relevant legal aspects

The text (Druckexemplar) issued with the communication under Rule 71(3) EPC can only be the subject of a decision to grant if approved by the applicant (Art. 113(2) EPC). Given the opportunities an applicant has at any stage up to and including the final approval to check the accuracy of the text of the patent, corrections in the patent documents after grant are no longer accepted and the responsibility for any remaining errors lies with the applicant (see decision G 1/10, OJ EPO 2013, 194).

During the electronic preparation of the Druckexemplar, alterations in the text of the patent may occur. These so-called formatting/editing errors may be characterized by e.g. the shifting of text lines outside the margins of a document with the consequence that they are deleted or any OCR errors on the pages that were edited in text mode. These alterations are typically neither indicated by standard marks in the Druckexemplar nor in Form 2004.

Although already contained in the text approved by the applicant, these errors may be corrected under Rule 140 EPC upon a careful assessment of all relevant circumstances of each case by the competent division (see Guidelines for examination before the EPO, H-VI, 4). This kind of correction can be carried out by the EPO of its own motion or at the request of the patent proprietor.

However, for the text in or around the amended part(s) of the text of the patent requests for correction of errors will in principle not benefit from this exceptional handling, even if they were introduced by the Examining Division or otherwise arose during the automated process of the Druckexemplar. It is expected that the applicant ensures that the amended part of the text is correct when receiving the communication under Rule 71(3) EPC. Substantive amendments deliberately introduced by the Examining Division are also not covered by the new Guideline since they do not qualify as formatting or editing errors.

Conclusions

The EPO strives to ensure the high quality of its work, including any OCR processing of application documents. The text version available to the Examiner when preparing the Druckexemplar in text mode comes from a high quality OCR conversion with a quality of 99.995% accuracy (the same standard as used for all A and B publications for the last 20 years). This is achieved at considerable expense by a combination of automated conversions and human intervention to verify areas where doubts occur. This is especially the case with certain letter combinations (e.g. "rn" vs "m"), with symbols (such as "μ", "β" or "Å") or with more complex text such as tables and math-

ematical or chemical formulae. In addition, examiners receive intensive training with the new tool.

When documents submitted to the EPO comply with the requirements of the EPC as regards text size and spacing, line spacing, quality of the print, margins etc., as well as by avoiding fax and paper submissions where possible (see in particular Rule 49 EPC), OCR errors will be reduced significantly, if not avoided.

The EPO trusts that this new key development will prove to be of long term benefit for all stakeholders in supporting the quality and efficiency of the patent grant procedure.

Contact Data of Legal and Unitary Patent Division

Update of the European Patent Attorneys Database

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

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

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

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

Thank you for your cooperation.

Nächster Redaktionsschluss für epi Information	Next deadline for epi Information	Prochaine date limite pour epi Information
Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der epi Information ist der 11. November 2016 . Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.	Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of epi Information is 11th November 2016 . Documents for publication should have reached the Secretariat by this date.	Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de epi Information est le 11 novembre 2016 . Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

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

Part 3 – Modifying the Comvik Formulation of the Problem

A. Kennington (GB)

Part 3

This is the third part of a long article, which is being published in three parts in successive issues of **epi** Information.

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

made available to the public before the priority date. This rule was derived from the requirement in Article 56 EPC that there is inventive step if the claim is not obvious in view of the state of the art, and the definition of the state of the art in Article 54(2) EPC that the state of the art comprises everything made available to the public. Consequently, if the problem is not obvious in view of everything made available to the public, the problem and solution analysis cannot establish a lack of inventive step under Article 56 EPC. However, this rule appears to conflict with the treatment of non-technical features in the formulation of the problem under the so-called Comvik approach.

The second part of the article reviewed the origins of the Comvik approach and the circumstances under which it was developed. It concluded that treatment of non-technical features in the analysis of inventive step has developed since the approach was first proposed. It also concluded that in early decisions T 1053/98 Canon and T 0931/95 Pension Benefits Systems the same conclusions could have been reached without incorporating novel non-technical features into the problem. However, in decision T 0641/00 Comvik it would not have been possible to reach the same conclusion without the presence of the novel features in the problem. Therefore there is unavoidable conflict between the Comvik approach to formulation of the problem and the rule that the problem must itself be obvious.

This part of this article considers whether it is appropriate to modify the Comvik approach to the formulation of the problem, and proposes a modification to the approach to make it consistent with Articles 56 and 54(2) EPC with the proposed rule that the problem should be obvious.

Possibility of Modifying the Comvik Approach

The Comvik approach, following decision T 0641/00, can be summarised as providing two rules for the treatment of non-technical features in a claim, where those non-technical features do not combine with technical features to contribute to a technical effect (although the Comvik decision itself does not explicitly identify these as separate rules). The first rule is that such features cannot contribute to the inventive step of the claim, and in particular they cannot form part of the solution in the problem and solution approach. The second rule is that such features can be included in the formulation of the problem, for example as a constraint that has to be met, regardless of whether the features are novel or not.

The first rule (non-technical features cannot contribute to an inventive step) is well established and is at the core of the current EPO practice in the treatment of non-technical features in claims. I do not wish to challenge this rule. On the contrary, I regard it as correct. This rule has been justified on the basis that inventions are inherently technical, so that anything that is wholly non-technical cannot be an invention, and this view is reflected in the

wording of Article 52(1) of EPC 2000 which states that patents shall be granted for inventions “in all fields of technology”. On this basis, if a claim includes a feature that is non-technical and does not combine with technical features to contribute towards a technical effect, that feature can be regarded as not being part of the invention. Article 52(1) requires that patents shall be granted for inventions that have an inventive step (as defined in Article 56). It may be that the non-technical feature of the claim meets the requirements of Article 56 (not obvious over everything that was made available to the public). However, such a feature is not part of the invention and so it cannot provide the invention with an inventive step. This line of reasoning leads directly to the rule that non-technical features cannot contribute to the inventive step of the solution.

On the other hand, I propose that the second rule (novel non-technical features can be part of the problem) should be modified to state that non-technical features may be included in the formulation of the problem, regardless of whether those features are recited in the claim or not,

provided that the inclusion of those features in the problem is known or would be obvious in view of everything made available to the public before the date of the claim.

I think that it is reasonable to consider modifying this rule because the Boards of Appeal have developed their understanding of the problem and solution approach further since the time of decision T 0641/00 Comvik. In T 0641/00 Comvik, it was considered that the problem has to be a technical problem, whereas more recent decision T 1784/06 Comptel (21 September 2012) makes it clear that the problem and solution approach does not need to involve a technical problem (see part 11 of the Reasons for the Decision). Also, decision T 1689/07 Proctor & Gamble, Colour-changing absorbent article (6 November 2009) states clearly that a claim may have an inventive step even if the novel technical features are provided purely for a non-technical purpose. It seems difficult to reconcile this decision with the practice of including a novel non-technical purpose in the formulation of the problem. Thus there has clearly been a development of ideas about the nature of the problem in the problem and solution approach.

Also, the two rules set out above appear to be sufficiently independent that the proposed modification of the second rule does not have any impact on the first rule. Article 52 EPC requires that an invention must be technical and must have an inventive step. Therefore the solution in the problem and solution approach cannot rely on non-technical features that do not contribute to a technical effect, because they are not part of the invention. On the other hand, Article 56 EPC requires that an invention has an inventive step if it is not obvious over the state of the art, and Article 54 EPC defines the state of the art as everything made available to the public in any way before the priority date of the claim. Therefore the problem can be based on anything known before the priority date of the claim regardless of whether it is technical or not. Thus the need to preserve Comvik's first rule, concerning non-technical features in the solution, does not prevent a reconsideration of Comvik's second rule, concerning non-technical features in the problem.

Having established that it is reasonable to reconsider Comvik's approach to the formulation of the problem, there are several reasons to favour modification of that approach.

First, the Comvik approach to the formulation of the problem, in which novel non-technical features of the claim are included in the problem, appears to have become accepted practice without any consideration of its compatibility with Article 56 EPC.

Decision T 0641/00 Comvik, and the two preceding decisions T 1053/98 Canon and T 0931/95 Pension Benefit Systems, did not consider whether this approach to for-

mulating the problem was compatible with Article 56. After decision T 0641/00 Comvik, it was regarded as an established part of the case law of the Boards of Appeal that non-technical features of the invention, even if new, could be included in the statement of the problem. Subsequent decisions, such as T 0531/03 Catalina Marketing (17 March 2005) and T 0764/02 Online Resources & Communications Corp (20 September 2005) explicitly regard the jurisprudence as having been settled by T 0641/00 Comvik and do not examine whether it is compatible with the EPC.

In decision T 0154/04 Duns Licensing, the appellant attacked the legality of the Comvik approach as a whole, and this decision contains a lengthy defence of it. However, the Board's argument is based entirely on Article 52 EPC, and there is no consideration of whether the approach to formulating the problem is consistent with Article 56. I am not aware of any decision of the Boards of Appeal that has considered whether the practice of including novel non-technical features in the problem can be permitted under Article 56.

In retrospect, it may seem surprising that there was no consideration of whether this practice was compatible with Article 56. However, this may be the result of the way in which the whole approach to non-technical features was regarded at the time. I have characterised the Comvik approach as consisting of the two rules that I summarised above, and I have argued that these two rules are substantially independent of each other. However, that is not how the approach is discussed in decision T 0641/00 Comvik itself. The Board in Comvik does not seem to have considered that it was establishing two separate rules, but instead it seems to have regarded the manner of formulating the problem simply as a convenient way of establishing that non-technical features could not improperly contribute to the inventive step. Since the exclusion of non-technical features from the consideration of inventive step was justified by reference to Article 52, it may not have been apparent at the time that there was any issue of compatibility of the formulation of the problem with Article 56.

If the Comvik rule for formulating the problem is compared with Article 56, it appears that there is inevitably a conflict. Article 56 defines inventive step in terms of obviousness "having regard to the state of the art", and Article 54 defines the state of the art as comprising "everything made available to the public by means of a written or oral description, by use, or in any other way". There can be no justification under these Articles of the EPC for basing an obviousness argument on anything that is novel. This immediately conflicts with the statement in decision T 0641/00 Comvik that it is correct to formulate the technical problem to include non-technical aspects "whether novel or not" (Reasons for the Decision, part 7).

In decision T 0641/00 Comvik, part 7 of the Reasons for the Decision begins

“The technical problem should not be formulated to refer to matters of which the skilled person would only have become aware by knowledge of the solution now claimed. ... Thus a problem should not contain pointers to the solution or partially anticipate it

However, in the Board's view this principle applies to those aspects of the subject matter claimed which contribute to the technical character of the invention and hence are part of the technical solution.”

The principle, that the problem should not contain matters that derive only from the solution, and should not contain pointers to the solution, is fundamental to ensuring that inventive step is judged only against the state of the art and does not include any hindsight reasoning. Board does not explain why it considers that this principle applies only to aspects of the claimed subject matter that contribute to the technical character of the invention. It is understandable that aspects of the claimed subject matter that are not part of the technical solution should not be regarded as contributing to the inventive step (since such aspects are not part of the invention under Article 52 EPC). However, this does not mean that such aspects should be regarded as part of the problem. The removal of a feature from one side of the scales does not imply that it should be added to the other side. Instead, the novel non-technical features should simply be ignored. Once a novel but non-technical aspect of the claim is included in the problem, the question of inventive step is no longer being judged against the state of the art alone.

In conclusion, it seems that there has never been a proper evaluation of the compatibility of the Comvik formulation of the problem with Article 56 EPC, and there is at least a question over whether the formulation can in fact be permitted under Article 56.

The conflict with Article 56 EPC can be seen also in the comment included for several years in part G-VII, 5.4.1 of the Guidelines for Examination in the EPO (it has been removed in the 2015 edition)

The requirements specification is not deemed to belong to the prior art; it is merely used in the formulation of the technical problem.

This appears to be an explicit admission that this formulation of the problem involves the inclusion in the problem of features that are not in the prior art. Since Article 56 EPC requires that obviousness is judged “having regard to the state of the art”, there is an immediate conflict between this formulation of the problem and Article 56.

It might be argued that there is no problem in including novel features in the formulation of the problem so long as they are non-technical, since non-technical features cannot be part of the invention and therefore do not matter. However, this cannot be correct. Article 56 EPC states that an invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. This clearly excludes the possibility that a finding of obviousness (lack of inventive step) can rely on a feature that is not part of the state of the art. There is no leeway in Article 56 to base an argument of obviousness on anything that is not in the state of the art. Thus, if there is a finding of obviousness in view of the requirements specification, and the requirements specification does not belong to the state of the art, the finding of obviousness is not based on the state of the art and so it does not establish a lack of inventive step as defined in Article 56 EPC.

A second reason for favouring modification of the Comvik formulation of the problem is that the reasons given for formulating the problem in this way do not in fact support it, and in some cases actually contradict this formulation of the problem.

Thus in decision T 0154/04 Duns Licensing, part 16 of the Reasons, defending the Comvik approach, begins *“For the purpose of the problem-and-solution approach developed as a test for whether an invention meets the requirement of inventive step, the problem must be a technical problem (see the COMVIK decision T 641/00 (supra), Reasons Nos. 5 ff.)”*. The decision then states that there are difficulties in defining an intelligible technical problem without referring to non-technical features. Next, the decision states *“The Board, therefore, allowed in COMVIK an aim to be achieved in a non-technical field to appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that is to be met (Reasons No. 7)”*. However, the basic premise of this reasoning, that the problem has to be a technical problem, is no longer good law as has already been discussed above. Consequently the Comvik formulation of the problem is justified in T 0154/04 Duns Licensing on the basis of a legal requirement that no longer exists.

Decision T 0154/04 Duns Licensing continues in part 16 of the Reasons by stating *“Such a formulation has the additional, desirable effect that the non-technical aspects of the claimed invention, which generally relate to non-patentable desiderata, ideas, and concepts and belong to the phase preceding any invention, are automatically cut out of the assessment of inventive step and cannot be mistaken for technical features positively contributing to inventive step*. However, this contradicts the actual situation, since the non-technical features are not “cut out” of the assessment of inventive step according to the Comvik formulation of the problem, but are in fact

transferred to the opposing side of the assessment as part of the problem to be solved. If they were truly “cut out”, these features would not appear either in the formulation of the problem or in the features contributing to the solution.

Similarly, the decision in T 0641/00 Comvik states that *“where a feature cannot be considered as contributing to the solution of any technical problem by providing a technical effect it has no significance for the purpose of assessing inventive step”* (Reasons, part 6). However, if a feature is to have “no significance for the purpose of assessing inventive step” it should not be taken into account in that assessment. This implies that in the assessment of inventive step, such non-technical features should not be included in either the problem or the solution. Therefore the Comvik formulation of the problem is directly contrary to the fundamental objective of the treatment of non-technical features in decision T 0641/00 Comvik itself.

A further problem with the logic of the Comvik formulation of the problem can be seen in decision T 0154/04 Duns Licensing at part 16 of the Reasons, where it states *“Since only technical features and aspects of the claimed invention should be taken into account in assessing inventive step, ... it is irrelevant whether such a non-technical aim was known before the priority date of the application, or not.”* The conclusion clearly does not follow from the premise. The requirement that only technical features are to be taken into account does not imply that a non-technical aim can be included in the problem. Specifically, the inclusion of a non-technical aim in the problem makes it inevitable that this non-technical aim will be taken into account, which is directly contrary to the stated requirement that only technical features and aspects should be taken into account. Also, it is not explained how the desire to avoid taking non-technical features into account can justify the incorporation of novel features into the problem.

Thus it can be seen that the reasons given in decision T 0641/00 Comvik and in its defence in decision T 0154/04 Duns Licensing do not in fact provide any reason to maintain the Comvik approach to the formulation of the problem (new and non-obvious non-technical features of the claim may be included in the problem). It is sufficient, in order to satisfy these reasons, simply to use the Comvik approach to non-technical features in the solution (non-technical features that do not contribute to a technical effect cannot be used to provide a solution with an inventive step).

A third reason for moving away from the Comvik formulation of the problem is that it appears to make the patentability of a claim depend on what non-technical features it contains, in direct contradiction of its objectives. This has arbitrary and contradictory consequences

for the patentability of different claims to essentially the same invention.

Decision T 0641/00 Comvik considers that the problem has to be technical, and therefore non-technical features will not normally be included on the statement of the problem. However, part 7 of the Reasons in decision T 0641/00 Comvik states that *“where the claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met”*. Thus, the non-technical features that “may legitimately appear in the formulation of the problem” are those that define a non-technical aim that appears in the claim. Claim 1 of the 1st auxiliary request in decision T 0641/00 Comvik included the feature of “the selective activation being used by the home database for distributing the costs for service and private calls or among different users” as the final clause of the claim. Since the justification for including this feature in the problem was that it appeared in the claim, it must be concluded that if this feature had not appeared in the claim at all it could not have been included in the problem, according to the rule for formulating the problem as set out in the decision.

However, the finding of lack of inventive step in decision T 0641/00 Comvik relies entirely on the inclusion of this feature in the problem. If the final clause of the claim had simply been deleted, this non-technical aim would not have been present in the claim. As a result, it would not have been permitted to include it in the problem. In the absence of this feature in the problem, the Board could not have used the reasoning that led them to find that the novel technical features of the claim were obvious. It appears, from the reasoning in the decision, that this situation would have obliged the Board to find the claim non-obvious and hence inventive. In this way it seems that the reasoning of the decision, if followed strictly, implies that the simple deletion of a non-technical aim from the claim would have rendered the claim inventive, without any change to the technical features. Such a result, implied by the reasoning of decision T 0641/00 Comvik, would be the exact opposite of the intention of the Board, who wished to ensure that inventive step would not be dependent on non-technical features.

It also follows from the reasoning of decision T 0641/00 Comvik that if the same technical features are combined with different non-technical aims in different claims, the non-technical aim included in the formulation of the problem would be different for the different claims. These different formulations of the problem could lead to different conclusions concerning the obviousness or non-obviousness of the technical solution, and therefore different conclusions about the patentability of the claim. Thus the same combination of technical features could

be patentable or non-patentable depending on which non-technical aim was stated in the claim. Given that an invention must be technical, and non-technical features cannot contribute to inventive step, it seems contradictory that the patentability of a claim could depend on which non-technical features are recited in the claim.

It must be concluded from this result that the precise method of formulating the problem set out in decision T 0641/00 Comvik cannot be sustained.

Finally, it is generally accepted that the patentability of an invention is not affected by the reason why the invention was made. An invention is patentable or not on the basis of the features of the invention, irrespective of why the inventor invented it. Therefore it cannot be right to treat the inventive step of the technical features of an invention differently depending on whether the underlying purpose for making that combination of technical features is a technical objective or a non-technical objective.

Consider a situation where the technical features could be provided either for a technical purpose or for an aesthetic (non-technical) purpose. According to the Comvik formulation of the problem, it is permissible to include the non-technical aim in the formulation of the problem even if this non-technical aim is entirely new. On the other hand, it would not be permissible to include the technical aim in the problem if this aim is entirely new, since the problem may not contain pointers to the solution. If the claimed technical features would not be obvious in the absence of the aim, but become obvious if either aim (technical or non-technical) is considered, then the inventive step of the claim depends on whether the technical aim or the non-technical aim is considered at the time of formulating the problem. This has the effect that the patentability of the same set of technical features depends on why the invention was made.

Since the patentability of an invention should depend only on the technical character of the invention, and not on the reason why it was made, it does not appear possible to support the Comvik manner of formulating the problem.

Proposal – Refined Comvik Approach

For these reasons, I suggest that it is now correct to consider that the law has developed since decision T 0641/00 Comvik, as the Comvik approach has been refined and established, and it is now justified to abandon the Comvik manner of formulating the problem.

In particular, it is now recognised that the Comvik approach involves explicitly ignoring, in the assessment of inventive step, those features that do not contribute to a technical effect, and this principle can be applied

independently of the proposal to formulate the problem by reference to non-technical aims stated in the claim. This separation of the approach into two distinct parts is not present in decision T 0641/00 itself, but has only been recognised during the application of the approach in later decisions. In decision T 0641/00, the incorporation of non-technical features of the claim into the statement of the problem was not seen as a separate principle from the removal of non-technical features from the assessment of inventive step, but instead it was seen as the manner in which the removal of non-technical features was to be achieved.

With experience of applying the Comvik approach gained over more than ten years since decision T 0641/00 was issued, we can now see that the incorporation of novel non-technical features into the formulation of the problem is unnecessary. It is also problematic. It conflicts with the requirement of Articles 54(2) and 56 EPC that obviousness is considered having regard to everything made available to the public before the date of filing of the European patent application. Additionally it appears to make patentability depend on the reasons why the invention was made and on the choice of what non-technical features (if any) are recited in the claim, rather than depending on the technical features of the claim.

Accordingly, I propose that when a claim includes non-technical features, inventive step should be assessed using a refined Comvik approach in which those features that do not contribute to a technical effect are not regarded as providing an inventive step to the claimed solution, but such features are not included in the statement of the problem unless they are known or obvious.

This approach can be supported in the EPC in the following way. (i) It follows from the wording of Article 52(1) that an invention is inherently technical. Therefore only those features in a claim that are technical, or which contribute (on their own or in combination with any other feature(s)) to a technical effect, can be regarded as part of an invention. Article 52(1) also requires that an invention must have an inventive step. Therefore a claimed feature that does not contribute to a technical effect cannot contribute to an inventive step because it is not part of the invention. (ii) An inventive step is present if the combination of features having a technical character or effect are not obvious over what is made available to the public anywhere in the world (Article 56 in combination with Article 54(2) EPC). Therefore claimed non-technical features cannot be considered as part of the problem if they have not been made available to the public, but conversely such non-technical features can be included in the problem if they have been made available to the public.

To some extent, this already appears to be the practice of the Boards of Appeal. For example, decision

T 1784/06 Comptel (21 September 2012) explicitly upholds the Comvik approach that only features contributing to the technical character of the claimed subject-matter enter into the examination of inventive step (T 1784/06 at part 2 of the reasons for the Decision), but does not mention the inclusion of non-technical features of the claim in the formulation of the problem. In fact, this decision stresses that the problem does not need to be technical, in contradiction to the decision in T 0641/00 Comvik where it is stated that the problem must be technical.

However, the Comvik formulation of the problem is still being used in some cases. For example, in decision T 2063/09 BlackBerry (29 October 2013) the Board considered that the claimed feature, that a user had a fixed monthly data limit in an image repository, was a non-technical feature that could be added to the problem as a constraint to be met. It does not seem to have been necessary for the Board to taken this approach, since such data limits are very well known and it could easily have been established that they were part of the prior art (which appears to have been the view adopted in the examining division decision under appeal). If the present proposal for formulating the problem is adopted, the Board would not be able to add such a feature to the problem simply because it was in the claim and instead it would have to show that the problem (including the claimed non-technical feature) was obvious in view of the state of the art. In T 2063/09, it would probably have been easy for the Board to have done this.

Conclusion

The purpose of the problem and solution approach is to determine whether the claim is obvious over everything made available to the public before the priority date of the claim (Article 56 EPC, together with Article 54(2) and Article 89). Since the problem and solution analysis relies on an assessment of whether the claim provides an obvious solution to the problem, this approach can only be valid if the problem is itself known or obvious

over everything made available to the public before the priority date of the claim. If the problem is not obvious over what is already known, no valid conclusion can be drawn from the problem and solution analysis because obviousness of the solution over the problem fails to establish obviousness of the invention over the state of the art.

Since the assessment of inventive step has regard to everything made available to the public, it is acceptable for the problem to start from any known disclosure, and it is acceptable for the problem to include non-technical features provided that they are known or obvious. However, since an invention is inherently technical (Article 52(1) EPC), the solution provided by the claim cannot derive inventive step from non-technical features that do not contribute to a technical effect. On the other hand, the claim can derive an inventive step from a technical feature that is new and not obvious over what is already known even if the technical feature is an obvious solution to or consequence of a non-technical problem or consideration that is itself unknown and not obvious over what is already known. The mere fact that a technical feature has a (new and non-obvious) non-technical aim or motivation cannot be used to deprive that feature of inventive step over what is already known. In order to be relevant, that aim or motivation must itself be already known or obvious, and this applies equally to non-technical aims and to technical aims.

This will require a change in the manner of formulating the problem in cases where a non-technical aim is stated in a claim, but I believe that this change is both necessary and justified for the reasons set out above.

The rule, that the problem must be obvious over the state of the art, should make it easier to determine whether the problem has been stated in a permissible manner or whether it inadvertently includes an impermissible pointer to the solution. This may provide an objective way to resolve disputes over the proper formulation of the problem in some cases.

Limits of a Limited Opposition

L. Walder-Hartmann (DE)

Part 2

This is part B of a long article. Part A was published in issue 02/2016 of the epi Information

The EPC requires a statement about the extent to which a patent is opposed (R. 76 (2) (c) EPC). If it is not the entire patent that is indicated in this statement, the opposition is understood to be a limited opposition. The way in which a limited opposition influences the exam-

ination of the opposition has been determined in more detail in the decision G 9/91 of the Enlarged Board of Appeal. However, not all case constellations have been

considered. The question remains where exactly the limits of a limited opposition lie and if, and under which conditions, such a limited opposition may later be extended. To answer this question, an investigation into the nature of an opposition as well as a critical review of the reasons of the decision G 9/91 was the subject of a previous part A of this article. Based on the analysis of part A, the present part B of the article identifies the limits of a limited opposition and the conditions under which they can be pushed. The present part B seamlessly continues part A, thus starting with section III.

III. Examination Beyond the Extent to Which the Patent is Opposed

The principle of procedural fairness and the principle of procedural economy found in part A to determine the limits of limited opposition are applied here to answer the question where exactly the duty and power of the EPO to examine a limited opposition ends and under which conditions the extent to which the European patent is opposed can be changed later in the proceedings.

1. Amendment with a feature from the description

There is one trivial case in which examination (beyond the extent to which the patent is opposed) shall be carried out. Consider the example case again. If the patentee amends claim 1 with a feature from the description and requests maintenance of the European patent in this amended form then the opponent is free to oppose this amended form. The indication in the statement under Rule 76 (2) (c) EPC as to the extent of the opposition only refers to the claims as granted. If the patent is defended in some other form the opponent's statement does not cover this situation, and, as is established practice in consideration of the new situation created by the patentee, procedural fairness dictates that the opponent can react to this new situation, and even perform a further search and introduce new facts and evidence relating to the amendment.

2. Examination of independent claims

Further, in direct continuation of the balance of interest established in the second part of the order of the decision G 9/91, there are cases in which examination may even be carried out on independent claims that were not included in the statement under Rule 76 (2) (c) EPC. Such a case is given if the independent claim is a claim for which novelty

and inventive step need not be examined in grant proceedings if another independent claim is found allowable. Examples of such independent claims are given in the Guidelines for Examination in the EPO, G- VII, 13, and include method claims for manufacturing a product or claims directed to the use of a product, where an allowable independent claim is directed to the product, provided the manufacturing method inevitably leads to that product. For instance, if claim 1 of the example case were directed to a product found allowable during prosecution, then claim 1 directed to "A manufacturing method, comprising providing the product of claim 1" would be such an independent claim, no matter if it contained further features or not.

Since such an independent claim is granted without further examination, just like regular dependent claims, it is justified that the Opposition Division shall also have the opportunity to examine such a claim if its validity is *prima facie* doubtful based on information already available in the proceedings.¹ For the example claim "A manufacturing method, comprising providing the product of claim 1" the validity is evidently not only doubtful if claim 1 is found invalid, but this claim is certainly invalid. Further, claims depending from such an independent claim may also be examined under the same conditions if a corresponding request to maintain the patent in amended form is put forth.

3. Consent of the patentee

In addition, the opposition can be extended, possibly up to the point where it becomes an unlimited opposition, if the patentee consents. The situation is analogous to what

¹ Related: T 1350/09, reason 1 of the decision. Contrary to the case discussed here, the patent was formally opposed in its entirety in the case at hand in the decision T 1350/09.

is said in Reason 19 of the decision G 9/91: *volenti non fit iniuria*, i.e., a person who consents does not suffer injustice. The distinction made in Reason 12 of the decision G 9/91 according to which the extent is a matter of formal competence while the introduction of new grounds of opposition are a question of procedural principles is unfounded as explained above. Both situations are governed specifically by the principles of procedural fairness and procedural economy. In practice, the opponent would have to invite the patentee to declare his consent which, if given, removes prior legal effects of the limitation of the opposition by the statement made in accordance with Rule 76 (2) (c) EPC. This means, *inter alia*, that substantive examination must be carried out by the EPO, and is not limited to be carried out on available information. The general rules of a regular, unlimited opposition apply. The EPO is not in a position to forestall this extension of the opposition, in particular because the opposition fee for a limited opposition is not less than the opposition fee for an unlimited opposition.

4. Intervention of an assumed infringer

The decision G 9/91 does evidently not consider the situation in which an assumed infringer intervenes into a limited opposition. The intervener becomes a party to the proceedings and shall be treated as an opponent (Art. 105 EPC). The question is if the intervener is subject to the limitations of the opposition imposed by the statement of the opponent according to Rule 76 (2) (c) EPC or if his opposition is an unlimited opposition unless indicated otherwise by the intervener.

If it were true that no opposition proceedings are in existence concerning non-opposed subject matters and if it were true that the EPO lacked the formal competence to decide on such matters once and for all after expiry of the opposition period one might be led to believe that the intervener would have to accept the opposition proceedings in the state that they are in, excluding the possibility to oppose these other subject matters. However, these assumptions are incorrect as explained above. The time limit set by the opposition period does not apply to the intervener in any case, and so any reasoning based thereon cannot hold for the intervener. The question has to be decided once again by the guidance of the principle of procedural fairness.

In this case, it is the patentee who creates a new situation by attacking the assumed infringer. If a claim asserted against the assumed infringer in the infringement proceedings belongs to those claims to which the extent of the limited opposition does not reach, a fair balance of the interests of the patentee and of the assumed infringer (intervener) shifts entirely towards protecting the interest of the assumed infringer to bring down the claims asserted against him as a means of defence. Even if the claims asserted against the assumed infringer are among

those claims covered by the limited opposition, the assumed infringer (intervener) shall still be free to oppose the European patent in an unlimited way. There is no reason to restrict the possibility of defence for the assumed infringer to the choice made by the opponent. The situation and the interests are not different to the filing of a limited opposition by a first opponent and the filing of an unlimited opposition by a second opponent, resulting in opposition proceedings like any normal opposition proceedings resulting from a single unlimited opposition.

In summary, just as the intervener is not bound to the grounds of opposition set forth by the opponent², he is also not bound by the extent to which the opponent opposed the patent in the statement made in the notice of opposition in accordance with Rule 76 (2) (c) EPC. His (unlimited) intervention shall be treated as an unlimited opposition.

That this is an appropriate result is further justified by the following consideration. In Germany, the contracting state with the highest number of European patents and European patent applications, invalidity of a patent cannot be claimed as a defence in infringement proceedings. Instead, nullity proceedings are separate proceedings dealt with by a special court, the Federal Patent Court. German law provides that an action for declaration of nullity of a patent may not be brought as long as opposition may still be filed or opposition proceedings are pending (Section 81 paragraph 2 of the German Patent Act)³. There is a silent – and correct – assumption here that opposition proceedings always seize the whole patent as the matter in dispute. If one did not allow the assumed infringer to fully oppose a European patent if he intervenes into European opposition proceedings based on a limited opposition he would be left without the possibility to defend himself against “unopposed patent claims” asserted against him in Germany until such time when the European opposition proceedings are terminated⁴. With the possibility of the patentee to appeal, and possibly with a patentee trying to prolong the proceedings in any other way, the assumed infringer may be factually bereft of an effective defence in German infringement proceedings.

5. “Intervention” by an opponent to his own limited opposition

When an opponent filed a limited opposition, expressing his limited interest to attack the European patent, but the patentee changes the situation by suing this opponent, the opponent’s interest to attack the European

² G 1/94, Order.

³ BGH, BGHZ 163, 369, mn. 4 – Strahlungssteuerung; GRUR 2011, 848, mn. 9f. – Mautberechnung; Schulte/Voit, Patentgesetz mit EPÜ, 9. Auflage, § 81 PatG, mn. 34ff.

⁴ BGH, BGHZ 163, 369, mn. 6 – Strahlungssteuerung; GRUR 2011, 848, mn. 9 – Mautberechnung.

patent to a larger extent will surge, and legitimately so. Then, the opponent shall not be bound to the limitation of the opposition. The situation and the balance of interests are analogous to the case discussed above when a third party is sued and becomes an intervener. There is no reason why the third party intervening in limited opposition proceedings should be in a better position than the opponent himself.

In practice, the opponent could not intervene into his own opposition proceedings under Art. 105 EPC because he cannot become a party to the proceedings twice. Instead, he should be allowed to prove that the conditions set forth under Art. 105 (1) (a) or (b) EPC are fulfilled, and then to extend his opposition freely.

This mechanism does not only work once. Assume that either the opponent extended his opposition, but not up to the point where it becomes unlimited, or else a third party intervener filed a limited intervention to be treated as a limited opposition, and then the patentee extends his infringement action. Again, it is the patentee who changes the balance of interest, and so the opponent or the intervener shall not be bound by the limitations of their opposition and intervention, respectively.

IV. Conclusion

An opposition, be it unlimited or limited, always seizes the entire European Patent. A limited opposition means, in the first place, a limitation of the duty and the power of the Opposition Division to examine an opposed European patent. Whether examination of granted claims lying outside the extent to which the patent was opposed according to the statement made by the opponent in fulfillment of Rule 76 (2) (c) EPC needs to be carried out, and if it can be carried out, is a question of exercise of discretion by the Opposition Division. The discretion of the Opposition Division in this matter is analogous to the discretion it has to exercise when deciding if opposition proceedings are to be continued of its own motion under Rule 84 (2) EPC. The discretion has to be exercised dutifully having regard to fairly balancing the interests of the parties in interest, i.e., the parties to the proceedings and the public, and having regard to procedural fairness and procedural economy. The limitation of the duty to examine is the lower bound of the scope of discretion ("abuse of discretion by doing too little"), and the limitation of the power to examine is the upper bound of the scope of discretion ("abuse of discretion by doing too much"). The statement of extent under Rule 76 (2) (c) EPC has further implications on the right to appeal (conditional waiver).

Following these principles the consequence is that granted claims not mentioned in the statement of extent shall in principle not be examined, be it as independent claims in the patent as granted or as independent claims

in the patent as amended during opposition. Two exceptions apply. Firstly, such claims may be examined provided their validity is *prima facie* in doubt on the basis of already available information. The justification is given in this case by a predominant interest of the public. Examples are the examination of (pseudo-)independent claims in the patent as granted, and the examination of claims which formerly depended on an attacked independent claim and which are made the subject matter of an independent claim during opposition proceedings. Secondly, such claims may be examined if the balance of interests changes after expiry of the opposition period due to an action of the patentee. This action can be the patentee's consent to extending examination. This action can also be an infringement action brought against the opponent or other assumed infringer who then intervenes in opposition proceedings. In the latter case, the opponent or intervener are free to oppose the patent to any extent.

This result fits in with the order of the decision G 9/91 if that order is carefully interpreted.

Zusammenfassung

Das EPÜ erfordert eine Erklärung darüber, in welchem Umfang gegen das europäische Patent Einspruch eingelegt wird (R. 76 (2) (c) EPÜ). Falls nicht das gesamte Patent in dieser Erklärung angegeben wird, wird der Einspruch als beschränkter Einspruch verstanden. Die Art und Weise, in der ein beschränkter Einspruch die Prüfung des Einspruchs beeinflusst, wurde im Detail in der Entscheidung G 9/91 der Großen Beschwerdekammer festgelegt. Es bleibt jedoch die Frage, wo genau die Grenzen eines beschränkten Einspruchs liegen und ob, und falls ja unter welchen Bedingungen, ein solcher beschränkter Einspruch später erweitert werden kann. Um diese Frage zu beantworten, war eine Untersuchung der Rechtsnatur des Einspruchs und eine kritische Beleuchtung der Entscheidungsgründe der Entscheidung G 9/91 Gegenstand des Teils A dieses Aufsatzes. Aufbauend auf der Analyse des Teils A identifiziert der vorliegende Teil B des Aufsatzes die Grenzen des beschränkten Einspruchs und die Bedingungen, unter welchen sie verschoben werden können. Der vorliegende Teil B führt den Teil A nahtlos fort und beginnt daher mit Abschnitt III.

Effectiveness of EQE Training

B. Cronin (CH)

A previous article (epi Information 02/2016) showed that the EQE was effective for promoting training and outlined the importance of exam-driven training for our profession and for the European patent system. The efficiency of training can be assessed in terms of its learning outcomes, and this article uses the notion of learning outcomes to assess the effectiveness of the training. The EQE acts as an incentive for training but was set up with no pre-determined learning outcomes. However, by postulating notional learning outcomes that trainees ought to accomplish at the end of their training programme, and then verifying the accomplishment of these learning outcomes by comparing with what is achieved by successful EQE candidates, this article corroborates the effectiveness of EQE-driven training.

Introduction

The previous article “Thoughts on EQE Training” (epi Information 02/2016) demonstrated that the EQE has proven itself to be an effective means for promoting professional training throughout Europe. Can we now ascertain the efficiency of this training?

Learning Outcomes

The efficiency of training can be assessed in terms of its learning outcomes and I would like to use this notion to assess the effectiveness of our exam-driven training.

In academic circles, learning outcomes are used for the purpose of course design or for designing entire learning programmes, for motivating students and for providing a means of facilitating the assessment of student performance. There are various definitions of “learning outcome” for instance:

“Statements of what a learner can be expected to know, understand and/or do as a result of a learning experience”¹

Learning theories require that it should be possible to measure or assess if a learning outcome has been achieved. In a larger sense the term “learning outcomes” also applies to complete learning programmes and to actually achieved outcomes rather than those to be achieved.

In our profession, trainees follow an exam-driven learning programme that extends over several years depending on the number of sittings. It consists basically of four compo-

nents that are modulated according to the trainees’ personal situation:

- exam-directed basic training
- personal work on past exam papers
- external exam preparation by courses, mock exams etc. and
- work experience coordinated with exam preparations.

By the end of a period of 6-8 years in the profession, a considerable number of trainees has followed the just-defined learning programme, sat the EQE and succeeded in all or most papers.

At the outset, we do not confront the trainees with a specified set of learning outcomes. Instead, passing the exam is set as a challenge to provide evidence of fitness to practice. Nevertheless, I believe the learning programme can be expressed in terms of learning outcomes that are actually achieved even though these outcomes were not identified at the outset but instead identified using hindsight.

From my observations, I have identified a number of learning outcomes that I think have been achieved by trainees following the overall exam-driven learning programme. Here is a list of those I identified. After going through the list, I will discuss how the learning outcomes can be verified or measured.

By the end of the 6-8 year programme, according to my observations our trainees have accomplished the following learning outcomes, namely:

- 1) Assumed responsibility in representing clients.
- 2) Defended successfully client’s interests.
- 3) Provided reliable patent/legal advice in response to client’s questions.
- 4) Performed client-set tasks according to requirements.
- 5) Mastered the main aspects of European patent law.
- 6) Acquired a Patent Attorney’s legal thinking.
- 7) Developed arguments to achieve legal consequences.
- 8) Demystified the novel/not-novel boundary.
- 9) Mastered the problem and solution approach.
- 10) Understood the concept of claim scope.
- 11) Drafted claims for maximum protection and compliance.
- 12) Amended claims for compliance with the EPC.
- 13) Managed vast quantities of information/facts.
- 14) Shown ability to work under pressure.
- 15) Selectively input information by purposeful reading.
- 16) Planned set tasks to obtain a desired outcome.

¹ The Credit Common Accord for Wales, QCA/LSC, 2004, p. 12

- 17) Optimised performance of a task in a set time by good time management.
- 18) Acquired the perception of time peculiar to the Patent Attorney profession.

Verification of the Training Programme's Outcomes

How can we ascertain whether these learning outcomes have been achieved? For the main part, success in the EQE or a specific paper can be used as proof. Let's consider the outcomes in turn to see what support we have for their achievement.

The first four outcomes are all related to the essence of a Patent Attorney's job, performing tasks for clients.

Assuming responsibility in representing clients presupposes that the trainees have evolved from being students who are willing to learn to being representatives who take on clients and accept responsibility for handling the client's patent matters. Candidates for the EQE enter into an attorney-client relationship with the Examination Board who act as a notional client that supplies tasks to be completed and judges if the tasks are performed up to standard. Success in the exam implies that the client's tasks have been performed up to a standard of fitness to practice. By acting for the exam client the candidates have shown that they have assumed responsibility in representing clients.

Outcome 2 "defending successfully client's interests" is a key aspect of the European Patent Attorney's task as set out in the **epi** Code of Conduct. Successfully defending a client's interests is attested by passing exam papers A, B and C where the client imposed a policy of maximum defense of its interests including full compliance with the EPC. Candidates who defend the EQE client's interests successfully are deemed fit to represent any other client.

Outcome 3 "providing reliable patent/legal advice" is also defined in the Code of Conduct as a key aspect of our task. Providing reliable legal advice in response to clients' questions is tested mainly in paper D Part I. Reliable legal advice means correct advice where the legal basis is identified. For most candidates, study for the legal paper represents a monumental effort that generates enough momentum for them to continue providing reliable legal advice throughout their careers. Success in paper D Part I definitely attests that this learning outcome has been achieved.

Performing client-set tasks according to given requirements is attested mainly by success in paper A – drafting so as to obtain maximum protection that meets up to official requirements – paper B salvaging the client's proposed amendment and arguing in support of patentabil-

ity – and paper C presenting all good arguments against patentability and only arguments that will succeed. Passing these papers attests that the candidate has completed the set tasks to satisfaction.

The next learning outcomes are related to legal matters, first mastery of the main aspects of European patent law, substantive and formalities. Novelty and inventive step are the main legal notions that are exhaustively tested in papers A, B and C. Priority issues are extensively tested in papers C and D. A wide spectrum of legal matters pertaining to the EPC and the PCT is tested in paper D. There is no way of succeeding in the EQE without mastering the main aspects of European patent law.

A Patent Attorney's legal thinking takes years to develop and this form of legal thinking sets our profession apart from ordinary lawyers. Our careers are spent largely trying to achieve legal consequences wanted by clients (like obtaining a valid patent) and avoiding unwanted legal consequences (like losses of rights). It takes years for a would-be Patent Attorney to accumulate a personal database of all sorts of facts that lead to various legal consequences. There is no doubt that training for and passing the EQE greatly accelerates the development of our specific type of legal thinking.

Making arguments to achieve legal consequences is tested in paper B (arguments in support of patentability) and paper C (arguments against patentability). These papers have predetermined legal consequences so candidates have to locate and select facts that they then have to present as arguments in support of the given legal consequence. Developing convincing arguments is a key to obtaining good marks on papers B and C and is the hallmark of a proficient European Patent Attorney.

The boundary between what is novel and what is not-novel is a mystery for the uninitiated. Demystifying this boundary is one of the challenges met by our trainees. Presenting non-novel claims in papers A and B is a short cut to instant death, as is attacking a novel claim for lack of novelty or a non-novel claim for lack of inventive step in paper C. Bearing in mind that the novel/not-novel boundary can be razor edged, the difficulty of mastering it cannot be underestimated. Achieving success in these papers implies that trainees are ready to tackle this tricky issue during their careers.

Using the problem and solution approach to assess inventive step is a requirement of the EQE because the client instructs candidates to follow the Guidelines which of course include the problem-solution approach (GL-G VII.5). Candidates use the problem-solution approach informally in paper A (explaining the problem solved), in paper B to support patentability and in paper C against patentability. Trainees are also confronted with the problem-solution approach in their dealings with the EPO.

This outcome is surely achieved.

For the man in the street the concept of claim scope is difficult to understand, which is one good reason for consulting a Patent Attorney. Understanding claim scope begins nowadays with claim analysis in the pre-exam, followed by paper A (drafting claims to obtain a desired scope), paper B (limiting claims to a scope in compliance with the EPC) and paper C (attacking claims of undue scope). By considering claim scope from all angles over several years, our candidates come to a firm understanding of this concept.

By preparing for and passing paper A, trainees have drafted claims for maximum protection and compliance with EPC requirements as stipulated by the client.

Amending claims for compliance with the EPC was the task of paper B up to 2012. From 2013 this continues to be tested in a more limited way, mainly for compliance with Article 123(2). Amending claims to salvage patentability inevitably means restricting the claim scope and doing this without inadmissibly extending the subject matter presents a particular challenge. This aspect has been tested by paper B.

Patent Attorneys must manage vast quantities of information/facts. This is tested by preparing for and sitting the EQE. In their exam preparations, candidates are overloaded with numerous legal sources and commentaries that they have to manage, starting with the EPC itself, the Guidelines, the PCT, and so on. The list is long. Additionally, the individual papers all contain abundant facts that have to be managed during practice and during the exam. Dealing with enormous quantities of information/facts is part of exam preparation and is attested by success in the exam.

The ability to work under pressure is of course an important attribute for a European Patent Attorney and candidates have demonstrated this ability by succeeding in the different papers of the exam.

The pressure of the EQE is of two sorts, first the pressure generated by the accumulation of exam preparation work, especially where candidates begin late and overwork in the months before the exam. Other candidates reduce this pressure by spreading out their exam preparations and deferring the sitting of different papers. In both cases, the successful candidates showed they could manage this type of pressure.

The second type of pressure is that for completing the task of the various papers in the allotted time. The doability of the exam is tested by guinea pigs who establish that each paper can be done in the set time by a well-trained, brilliant, qualified individual. For the majority of candidates, completing the papers in time represents a major challenge that depends largely on their degree of

preparation. Working under time pressure tends to push candidates into an error mode and errors tend to compound leading to poor quality answers and low scores. Successfully finishing these exams attests an ability to work under pressure without making too many errors.

The next outcome concerns inputting information by reading. Reading is something we learn at school and take for granted. In the EQE, candidates are faced with an abundance of information, a fraction of which is useful for the task at hand. This helps to develop a Patent Attorney's way of reading which is to read given documents so as to select information according to the purpose of the given task. For example, in the opposition paper the candidate will read the patent to be opposed solely looking for ammunition for future attacks. In this way, training for the EQE develops a Patent Attorney's ability to select information by purposeful reading.

Planning tasks to obtain a desired outcome is inherent in the EQE. To complete every part of the exam in the allotted time, candidates must follow the working method : **read – plan – write**. The planning phase is specific to each part of the EQE and has to be specially prepared. In their preparations, candidates do a lot of pre-planning which reduces the amount of residual planning to complete the specific task on the day of the exam. One way or another, candidates are forced to adopt a planning strategy for each EQE paper. The planning compacts an unstructured factual input into a structured legal output in a short time and departs from everyday practices where work can be spread over several days or weeks. Success in the exam attests success of the plan.

The next outcome is optimising the performance of a task in a set time by good time management. This implies not just finishing in time, but making full use of the available time to perform the task. This can be accomplished by practice on earlier papers to get to the expected level of answering, followed by accelerating the pace to finish in time, always correcting so the answer becomes more and more reliable. Good time management for the EQE flows from good preparations.

The last listed outcome is acquiring the perception of time that is peculiar to our profession. Practicing our job induces us to adopt a forward-looking attitude that is developed by exam preparations. By doing many time-related Part I questions our trainees are conditioned to become aware of time limits and the associated consequences. The situations usually start in the past but inevitably project into the future. The Part II legal opinion gives trainees a golden opportunity to foretell future events as a basis for advising the client to plan ahead. Just like fortune tellers who use a crystal ball, we make use of time diagrams for peering into the future, to the amazement of our respective clients. Extended practice

on the time-related aspects of the exam greatly accelerates acquiring a Patent Attorney's perception of time.

It follows that all of the postulated learning outcomes are achieved. These outcomes can be regarded as components of fitness to practice in core activities. Thus, we can consider that the training programme's learning outcomes express different aspects that make up the multifaceted concept of fitness to practice. In any event, candidates who have followed the training programme and passed the EQE are well equipped to perform as European Patent Attorneys.

Note that it is the training that produces the results, not the exam itself which can be a bad experience for those who tackle it unprepared.

Summary/Conclusions

In summary, my belief that exam-driven training is effective is corroborated by the examination we have made of the accomplishment of the given learning outcomes.

As we have seen, all of the postulated learning outcomes are accomplished, which means that the trainees have reached a high level of competence. Over 10,000 candidates have passed the exam to date which corresponds to an overall 80% pass rate. These candidates were all brought to "fit to practice" level by exam-driven training. This represents a tremendous collective achievement of our profession. In my opinion we could not have accomplished this result by any other type of training.

Die Wirksamkeit der EEP Ausbildung

Effizienz der Vorbereitung auf die EEP

Ein vorangegangener Artikel hat aufgezeigt, dass die EEP (europäische Eignungsprüfung) bei der Förderung der Ausbildung wirksam war und hat die Bedeutung der prüfungsorientierten Ausbildung für unser Berufsbild und für das Europäische Patentsystem hervorgehoben. Die Effizienz der Ausbildung kann hinsichtlich der Lernergebnisse gewertet werden und dieser Artikel nutzt die Ideen der Lernergebnisse, um die Wirksamkeit der Ausbildung zu bemessen. Die EEP schafft somit einen Anreiz für die Ausbildung, wurde aber ohne vorher festgelegte Lernziele erstellt.

Wie auch immer, beim Festlegen fiktiver Lernergebnisse, die Auszubildende am Ende ihrer Ausbildung erreichen sollten und der Überprüfung der Erfüllung der Lernziele durch einen Vergleich der Resultate bei einem erfolgreichen Abschluss eines EEP Kandidaten, belegt dieser Artikel die Effizienz einer prüfungsorientierten Ausbildung zur EEP.

L'efficacité de la formation EEQ

Abrège

Un article précédent a montré que l'EEQ était efficace pour la promotion de la formation et a souligné l'importance que ces formations dérivées de l'examen ont eu pour notre profession et pour le système de brevet européen. L'efficacité de la formation peut être évaluée en termes de « résultats d'apprentissage », et cet article utilise cette notion de résultats d'apprentissage pour évaluer le rendement de la formation. Le EEQ agit comme une incitation à la formation, mais a été mis en place sans définir des résultats d'apprentissage prédéterminés. Par contre, en supposant les résultats d'apprentissage théoriques que les stagiaires devraient accomplir à la fin de leur formation, puis en vérifiant la réalisation de ces résultats d'apprentissage en comparant avec ce que les candidats ayant réussi EEQ ont accompli, cet article corrobore le rendement de la formation dérivée de l'EEQ.

The Problem and Solution Approach – Basic Case Law and Recent Development (I)

M. M. Fischer (DE), European Patent Attorney

What the Lord's Prayer is to Christians all over the world, is the problem and solution approach to European Patent Attorneys. You pray it whenever it comes to the assessment of inventive step – before the Examining Division, the Opposition Division or the Board of Appeal – in hope that your prayer will be answered and a patent will be granted. While it cannot be proven that the Lord's Prayer is God's favourite prayer, there cannot be any doubt that the problem and solution approach is the EPO's favourite prayer. And what is more, it is the one and only that will be answered. This should be reasons enough to know as much as possible about this approach. Although the problem and solution approach is very well established case law of the Boards of Appeal, there has been a development in the understanding of the term "closest prior art" which has now found its way into the latest version of the Guidelines for Examination in the European Patent Office (GL). While the Guidelines give some advice on how to apply the problem

and solution approach, some more examples from the case law may be helpful to add some flesh to the bones in order to fully elucidate the approach. The purpose of this article is to give an introduction into the concept of the problem and solution approach in its basic version by supplementing the corresponding passages in the Guidelines with recent decisions of the Boards of Appeal and the author's personal thoughts. This article does not cover the treatment of a mix of technical and non-technical features, partial problems, problem inventions and secondary indicia.

Part 1

This is the first part of an article that is based on a talk held by the author on September 8, 2015 at the European Patent Experts' Forum (EuPEX) in Munich. The author thanks the audience for the animated discussion accompanying the talk. Some of the contributions have been woven into the article. The second part of this article will be published in epi Information 4/2016.

The EPO assesses the presence of an inventive step (Art. 56 EPC) using the problem and solution approach. Although the problem and solution approach does not have a direct basis in the EPC, it can be derived from R. 42(1) (c) EPC which stipulates that the invention must be disclosed in terms of a technical problem and its solution.¹ The Guidelines state under G-VII, 5 that in order to assess inventive step in an objective and predictable manner, the so-called "problem and solution approach" should be applied. Thus deviation from this approach should be exceptional. In the problem and solution approach, there are three main stages:

- (i) determining the "closest prior art",
- (ii) establishing the "objective technical problem" to be solved, and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

A. Closest Prior Art

Turning to the identification of the closest prior art first, the main criteria for selecting the closest prior art document² are that the closest prior art:

- a) should have a same or similar purpose or effect as the invention or
- b) should deal with a similar technical problem as the invention or at least belong to the same or a closely related technical field as the claimed invention or
- c) should have a similar use and require minimal structural modifications.

It has always been emphasized that the number of features that the claim has in common with the prior art is by itself not a suitable criterion for selecting the closest prior art. Although the criteria above are based on well-established case law, it still seems to be a constant source of dispute as more recent decisions show.

A lot of effort was invested in the past to show that one document is the (one and only) closest prior art document, while other documents may have been prematurely disregarded as closest prior art documents³. This practice is probably also due to the superlative expression "closest prior art". Fortunately, in response to some recent decisions of the EPO, also section G-VII, 5.1 of the Guidelines has been updated such that it now explains that in some cases there are several equally valid starting points for the assessment of inventive step, e.g. if the skilled person has a choice of several workable solutions, i.e. solutions starting from different documents, which might lead to the invention.

¹ Visser, D., "The Annotated European Patent Convention", 21st edition, 2013, p.115, section 6

² To be precise, it can also be a single embodiment (item) within a document. Art 56 EPC itself states that documents within the meaning of Art. 54(3) EPC must not be considered in deciding whether there has been an inventive step.

³ This practice was, for example, criticized in the decision "Fischbissanzeiger" (BGH Xa ZR 138/05) by the Federal Court of Justice of Germany.

The requirement of inventive step is negatively defined in the EPC. Pursuant to Art. 56 EPC, an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. That means that it cannot be shown directly that the subject-matter of a claim invention involves an inventive step. Rather, if the subject-matter of a claim can be derived from the state of the art in an obvious manner, it can be concluded that it does not involve an inventive step; in all other cases, it involves an inventive step. The problem and solution approach allows to construct a logical chain of arguments (or “convincing chain of considerations”) to demonstrate that the subject-matter of a claim can be derived from the state of the art in an obvious way. If such a logical chain of arguments cannot be built, the subject-matter of the claim involves an inventive step.

As a consequence, in order to show that the subject-matter of a claim involves an inventive step, it may be necessary to apply the problem and solution approach to each of these starting points in turn, i.e. in respect of all these workable solutions. In order to show that the subject-matter of a claim does not involve an inventive step, it is sufficient to show starting from one appropriate starting point using the problem-and-solution approach that it was obvious for the skilled person to arrive at the claimed subject-matter.⁴ The Guidelines come to the conclusion that the only relevant question is whether the document used is an **appropriate/feasible starting point** for assessing inventive step.

Hence, any document that fulfills one or more of the criteria mentioned above may qualify as an appropriate starting point. Instead of thinking of the selection of the closest prior art as the one and only document, one should think of this step in terms of a (pre-)selection of a set of documents from which the skilled person could have realistically started to arrive at the subject-matter of the claim in an obvious way. In other words, only those

starting points (documents) are considered from which the skilled person had a reasonable chance to arrive at the subject-matter of the claim in an obvious manner⁵. If it cannot be shown from these appropriate starting point documents that the subject-matter of the claim is obvious, then it can be shown even less that the subject-matter of the claim can be arrived at in an obvious way starting from any other (inappropriate) starting point which leads to the conclusion that the subject-matter of the claim is inventive.

In **T 967/97** the Board stated that the problem and solution approach was essentially based on actual knowledge of technical problems and ways to solve them technically that the skilled person would, at the priority date, be expected to possess objectively, i.e. without being aware of the patent application and the invention that it concerned. If the skilled person had a choice of several workable solutions that might suggest the invention, the rationale of the problem and solution approach required that the invention be assessed relative to all these possible solutions before any decision confirming inventive step was taken. To **deny** inventive step, no special grounds had to be given for a pre-selection of prior-art citations, even if several workable solutions were available to the skilled person; the reasoning on inventive step merely served to show that the invention was obvious to the skilled person from the prior art in relation to (at least) one of these solutions (**see also T 558/00, T 970/00, T 172/03, T 323/03, T 21/08, T 308/09, T 1289/09**).

The following table⁶ provides an exemplary overview over how the Boards of Appeal have applied the main criteria above (and other criteria) in various cases to qualify documents as appropriate starting points:

4 section 3.5 of http://www.bardehle.com/en/publications/interactive_brochures/inventive_step.html

5 If this selection was not made, theoretically, one would have to test each available prior art document whether one could (and would) arrive at the subject-matter of the claim in an obvious manner from it until one finds such a document. In this case, the subject-matter of the claim is not inventive. If such a document is not found, one will have to go through all prior art documents available to show that the subject-matter of the claim is inventive.
6 A comprehensive selection of decisions illustrating the selection of the closest prior art can also be found at “Case Law of the Boards of Appeal”, section I.D.3.4, 7th edition, 2013

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
T 570/91	"1. A piston for an internal combustion engine..."	Piston for internal combustion engines	Piston for a compressor	Same purpose (generically the same)
T 817/94	"1. An electrically operated hand mixer for processing food..."	Electrically operated hand mixer	Stand mixer	Similar use and requires minimal structural modifications. In contrast to the stand mixer, in the hand mixer, the drive unit and the mixing tool are in a right angle.

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
T 487/95	"1. Military protective helmet comprising a calotte resistive against gunfire..."	Military protective helmet	A worker's safety helmet. This document also forms part of the knowledge of the person skilled in the art and can be used as a document in which the skilled practitioner could find a solution to an objective technical problem, see also T 149/00 .	Same purpose (generically the same)
T 870/96	"1. An image projection apparatus comprising an information display system having at least one display panel [typically a LCD panel] with a rectangular surface for generating images to be projected,..."	Image projection apparatus having an LCD panel with a rectangular surface for generating images to be projected. It also relates to problem of increasing the brightness and uniformity of the illumination system associated with said display panel.	Lenticulated collimating condensing system. It does not relate to LCD projection.	Examining Division chose inappropriate CPA, possibly based on number of common features.
T 66/97	"1. A method of connecting a pair of hermetic optical fibers having an electrically conductive hermetic layer coated on optical fiber glass,..."	A method of connecting hermetic optical fibres by an aerial discharge. It also relates to the problem of reduced break strength arising in this context due to the interference of the hermetic layer with the fusion process.	It has no reference to hermetic optical fibres and, not surprisingly, to any fusion problems caused by the presence of hermetic layers.	Examining Division chose an inappropriate CPA, which cannot be considered as a technically realistic starting point.
T 513/00	<Automatic coffee maker that has one brew chamber for coffee alone or together with milk for cappuccino.>	No appropriate starting point available. The available prior art documents do not show any piece of prior art from which the subject-matter of claim 1 could be obtained in an obvious manner.	D1 refers to known coffee machines which require a human being for the preparation of cappuccino. D1 shows a coffee maker which has a first station for the delivery of coffee and a second station for the delivery of milk foam. A human being has to move a cup from the first station to the second station.	The problem indicated in the patent and the original patent application refers to a difficulty that arises with an automatic coffee maker that has one station for the delivery of either coffee or cappuccino. It makes sense that the skilled person starts from a coffee maker for which this difficulty exists. <u>Since this difficulty does not exist with a coffee maker as disclosed in D1, such a coffee maker represents an artificial rather than a realistic starting point.</u> See also T 835/00 which says that if a relevant problem is not derivable, the measures for its solution are a fortiori not derivable. In other words, the invention is not obvious in the light of such art.

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
T 211/01	"1. A process for preparing a halogen-free hydroxy- polyalkene amine composition...."	The most suitable starting point is the prior art process mentioned in the patent in suit on page 2, lines 25 to 29, from which the same products were obtainable as in the patent in suit via imination of an ozonolysis product of a polyolefin and final hydrogenation of the imine.	Evidence was provided that D5 did not furnish any amination reaction at all but merely an inhomogeneous mixture of starting materials. Since this evidence was not contested by the Appellants, the Board concludes that D5 is obviously defective as would be readily recognised by those skilled in the art when trying to reproduce its disclosure.	A document which is <u>obviously defective</u> as would be readily recognised by those skilled in the art when trying to reproduce its disclosure cannot be taken as the most promising and appropriate starting point for the assessment of inventive step. Quite apart from the fact that a skilled person would normally not consider an obviously defective disclosure at all, the Board deems it in particular artificial to select such defective disclosure as a starting point for evaluating inventive step, when there exists other prior art which is not doubted with regard to its disclosure but is also directed to the same purpose or effect as the patent in suit.
T 1228/08	"1. Apparatus for processing a signal comprising: <features relating to hierarchical coding but not to multicasting>"	In this music-on-demand system, a server stores various compressed versions of a musical piece, each version corresponding to a different connection speed between the server and the client and consequently to a different quality. In delivering the music to a client, the appropriate version is packetized and communicated through a packet-switched network.	It discloses the use of hierarchical coding, which is indeed a major aspect of the present, <u>but in the context of multicasting.</u>	A conscious choice of starting point not only determines the subject-matter serving as a starting point but also defines the framework for further development. Thus, using D1 as a starting point would mean that any further development would be carried out in the context of multicasting: it is unrealistic to suggest that, starting from this disclosure, the skilled person would go outside this framework - indeed take a technical step back - to develop a non-multicasting system (see also T 439/92).
T 56/09	"1. A syringe by which medicine may be apportioned in preset doses from an ampoule..."	A syringe by which medicine may be apportioned in preset doses from an ampoule.	The syringe disclosed in D6 is not of the same type as that claimed, since it is not a syringe by which medicine may be apportioned in set doses from an ampoule, and as already mentioned above it has fewer features in common with the subject-matter of claim 1 than D1.	Different type of syringe cannot be appropriate starting point. [To make the case even more vivid and memorable: A fire brigade syringe can never be an appropriate starting point prior art for a medical syringe regardless how many features they have in common.]

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
T 1764/09	<p>"A variable focus lens (2, 26) being adapted for a contact lens or an intraocular lens comprising a transparent rear wall (8, 28), a transparent front wall (6, 106) having a convex curved surface (10) and a concave inner surface (19), a cavity (14, 114) formed between the transparent front wall and the transparent rear wall, <u>first and second immiscible fluids (16, 17) of differing refractive index contained within said cavity, and electrodes (18, 21) to which a voltage is able to be applied to change the curvature of a fluid meniscus (4, 104) between the two fluids</u>, wherein at least the rear wall of the lens includes a biocompatible material, which material provides for biocompatibility of the lens with the eye and a periphery of the front wall joins a periphery of the rear wall to form an acute internal angle (alpha) at their joining region (J)."</p>	<p>The invention generally relates to a lens adapted for a contact lens or an intraocular lens. Its focal length can be varied by controlling the voltage applied to electrodes so as to change the curvature of a fluid meniscus between two immiscible fluids, <u>based on the physical phenomenon of electro-wetting</u>. No prior art is available disclosing the use of electro-wetting in such a lens. (Possibly a pioneering invention.)</p>	<p>D1 is no more than a speculative review of what might be potentially feasible in the future. No concrete realisation of a fully adapted lens for a contact or intraocular lens was described in D1.</p>	<p>Speculative document not suitable as appropriate starting point (similar to T 211/01)</p>
T 535/10⁷	<p>"A mirror (1) comprising a first transparent glass plate (4) at least partly provided on the rear side with a reflecting coating (2) as well as at least one integrated electrical means (6), wherein the first glass plate (4) comprises transparent and/or half-reflecting portions (8), the first glass plate (4) is bonded to a second glass plate (10) with the aid of a transparent adhesive layer (12) in the form of a laminated glass pane, and electrical means (6) are mounted on an electrically conducting coating (14) of the second glass plate (10) in portions opposite the transparent</p>	<p>D1 shows a mirror for use in a damp room.</p>	<p>The mirror shown in D13 is an interior rear-view mirror for a vehicle and not appropriate for use in damp rooms.</p>	<p>Appellant has explained that the skilled person would proceed in this way in order to make the mirror [of D13] suitable for use in a damp room. However, this argument cannot be endorsed. There is no reason to make an interior rear-view mirror suitable for use in a damp room. This would lead to rebuilding said mirror for a completely different use. Such a way of proceeding cannot be obvious.</p> <p>Although the skilled person is completely free in the choice of a starting point, he is later bound by this choice. If a skilled person chooses a specific interior rear-view mirror</p>

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
	and/or half-reflecting portions (8) of the first glass plate (4)." Although not explicitly mentioned in the claim (but implicit by the features), the claim is directed to a mirror for use in a damp room.			for a car as starting point, he can pursue its development, but the normal outcome of this development will in the end still be a rear-view mirror for a car and not a mirror suitable for use in a damp room (see T 570/91 [4.4]). A conscious choice, i.e. a choice made in full awareness of the advantages and drawbacks of the different types, not only determines the subject-matter serving as starting point but also the framework of the development, i.e. a development within this type. In the course of the development a change from the consciously chosen type to another, which was known before but which had not been chosen, is unlikely and, as a rule, not obvious (T 817/94).
T 698/10	"A method for video processing, the method comprising: decoding an AVS bitstream based on decoding version information within said AVS bitstream, wherein said decoding version information was inserted in said AVS bitstream into a sequence user data (206) after a sequence header (204) of the AVS bitstream during coding of said AVS bitstream, wherein decoding comprises mapping of the sequence user data (206) to a decoding version ID via a AVS decoding list."	D1 is an article describing the main technical features of the AVS standard for coding and decoding video signals. The AVS standard is described in the present application as the starting point for the invention (see paragraphs [0002] to [0006] of the application as filed). D1 thus belongs to the same technical field as the claimed invention, i.e. the coding and decoding of video signals according to the AVS standard. It also serves a similar purpose and implicitly or explicitly addresses similar or the same technical problems as the claimed invention, i.e. those solved by the use of the AVS standard, such as a highly efficient video coding/decoding and an optimisation between absolute coding performance and complexity of implementation (see the INTRODUCTION section on the first page	According to the appellant, no available prior document is an appropriate starting point.	The appellant disputed that D1 could be regarded as the closest prior art, because it did not disclose the problem arising from the existence of different versions of the AVS standard. The Board concurs with the appellant that D1 does not disclose this further problem, but disagrees that it should disqualify D1 as starting point for the assessment of inventive step. <u>Indeed, the closest prior art need not disclose all the problems solved by the claimed invention, in particular it need not disclose the objective technical problem, which is only determined in the second step of the problem and solution approach based on the technical effect(s) provided by those features distinguishing the invention as claimed from the closest prior art.</u>

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
		of D1). Moreover, the video processing method disclosed in D1 has several technical features in common with the method of claim 1, these features being essentially implied by the reference to the AVS standard in claim 1.		In the present case, there is no other prior art on file which discloses the objective technical problem or which would qualify better than D1 as the closest prior art. During the oral proceedings, when asked by the Board which prior art was the closest prior art if not D1, the appellant replied that there was none. The Board cannot agree with this view. According to Article 56 EPC an invention is to be considered to involve an inventive step if, "having regard to the state of the art", it is not obvious to the skilled person. Hence, <u>the assessment of inventive step has to be based on an evaluation of the invention in view of the prior art. The expression "closest prior art" also does not mean that it must be sufficiently close to the claimed invention on an absolute basis, but only that it must be relatively closer to the claimed invention than the other prior-art disclosures, i.e. it is selected as the most promising starting point - or the most promising springboard towards the invention.</u>
T 2255/10	"1. A production method for silicon wafers, comprising:..."	D1 discloses a method by which vacancies are injected into a silicon wafer. Moreover, the method of document D1 has many technical features in common with the claimed invention. The Board therefore considers that document D1 is a perfectly suitable choice as closest prior art for the main request.	The appellant stresses the aspect of providing a high density of oxygen precipitates (BMDs). The Board accepts that this aim is mentioned in the application, the invention being described, for example, as providing a "high quality silicon wafer having a DZ layer, which is suitable for forming a device, as the surface layer, and also having a high BMD density area having a proximity gettering effect". The appellant concludes that document D1 is not a suitable choice of closest prior art, as the pur-	In establishing the closest prior art, the determination of the purpose of the invention <u>is not to be made on the basis of a subjective selection from among statements of purpose which may be set out in the description of the application</u> , without any reference to the invention as defined in the claims. On the contrary, the question to be asked is, what, in the light of the application as a whole, would be achieved by the invention as claimed. The applicant cannot influence the selection of

Decision	Claim	Appropriate starting point	Inappropriate starting point	Remark
			pose of the method disclosed in this document is different, namely to control the distribution of dopant elements in the silicon wafer, thereby controlling resistivity. <u>The Board holds that it cannot be legitimately asserted that the purpose of the invention as claimed is to provide a silicon wafer having BMD layer with high density, or for that matter having a denuded zone.</u>	the closest prior art by adding purposes into the application that are not achieved by the invention.
T 386/11	"1. "An apparatus for conveying slaughtered animals, in particular birds or parts of birds, which apparatus comprises ..., and wherein along the conveyor's path there is at least one guide member provided which is capable, after the carrier is rotated to a predetermined position, of moving the animal suspended from the carrier <u>such that it is diverted around the processing station</u> , characterized in that..."	It discloses an apparatus comprising carriers that can rotate the transported birds over 90° <u>but that do not divert them around a processing station</u> , which is a central aspect of the present patent.	It discloses an apparatus for conveying slaughtered birds, comprising a plurality of carriers for the birds which travel a path passing at least one processing station and which is also capable of moving the bird suspended from the carrier such that it is <u>diverted around the processing station</u> .	Not only features at the beginning of the claim which often define the "main object" of the claim are important. If, for instance, for whatever reason it may be, a person skilled in the art prefers and decides to start from a specific apparatus for rotating the transported birds over a quarter turn, he can further develop that apparatus, but at the end of that development the normal result will still be an apparatus for rotating the transported birds over a quarter turn and not an apparatus for diverting the transported birds around a processing station.
T 749/11	"1. Steam cooker for warming up food at ambient pressure... <steam is led from the steam generator into a heating chamber>"	Standard oven (does not work with steam). A standard oven is basically not arranged to heat food using steam. It belongs to another type and is not a steam cooker. Even if a bowl filled with water were in the heating chamber, the standard oven cannot be considered as a steam cooker. Furthermore, the steam would not be led into the heating chamber, as claimed, since it would develop in the heating chamber itself.	Steam cooker	Same type (generically the same)

In the determination of an appropriate starting point, not all features of the claim have the same weight. While some features define the type/genus of the subject-matter, other features are less important. In apparatus claims, the claims start with the term defining the “main subject-matter”, e.g. “A lawn mower, comprising...”. These first words of a claim typically define what the subject-matter of the claim is all about and also contain inherent features (e.g. four wheels, engine, blades, etc.). The first words of a claim are often an important indicator for documents which qualify as appropriate starting point. However, also other features which define the type of the main subject-matter should be disclosed in the appropriate starting point. Indications of purpose (“Apparatus for cooking...”) are important. An appropriate starting point should/must be designed for the same purpose. The purpose of an apparatus does not have to be mentioned explicitly but can also be implicitly derived by the features it contains. Moreover, the term “type” or “genus” is intimately related to the term “purpose” in the sense that things that belong to the same type/genus also have the same purpose. In particular if a prior art item accidentally anticipates all the features of a claim, it often occurs that a small clarification of the claim renders the subject-matter of the claim novel and at the same time diverts the subject-matter of the claim so far from the prior art item that it disqualifies as closest prior art.

Also the constituent material (main material) of the subject-matter of the claim can be an indicator for a closest prior art document.⁸ It can be derived, for instance, from **T 1228/08** that the skilled person would not make any step back (undo any steps that are substantial for the appropriate starting point). For example, if the invention concerns a “tool made from metal”, it would not make any sense for the skilled person to start with a “tool made from wood” because it would be of no use to him in the sense of a realistic further development. As will be discussed below, it is often impossible in such cases to formulate a problem without giving a hint to the solution. Moreover, a claim dependent on an independent claim may have a different closest prior art item since e.g. a feature in the dependent claim may change the constituent material such that a closest prior art item for the independent claim may disqualify as the closest prior art item for the dependent claim.

A document that the applicant mentions himself in the background section of the application but which is only an “internal prior art” that has not become public before the priority date of the application cannot be used for the assessment of inventive step (T 211/06).

One may be inclined to think that a first document is better starting point than a second document since the first doc-

ument already contains the features relating to what is subjectively considered to be the “gist”, “core” or “knack” of the invention. This, however, may be a misconception since the skilled person may well be able to transfer the teaching relating to this “knack” of the invention from a teaching relating to the same, broader or neighboring technical field. As explained above, it is more important to select a generically similar or identical document as appropriate starting point.

Regarding the criterion “similarity of the problem”, it should be mentioned that this criterion appears to be more problematic than the criterion of the same or similar purpose. The reason is that it is not quite clear which problems are to be compared. Since the selection of one or more appropriate starting points is made to determine the objective technical problem, it cannot be the objective technical problem. Hence, one can only compare the subjective technical problem of the potential appropriate starting point with the subjective technical problem of the claimed invention. However, while a purpose can be attributed to any subject-matter disclosed in a prior art document, a problem cannot always be attributed. The reason is that a purpose is an absolute criterion while a problem is a relative criterion. In particular non-patent prior art documents do not always mention a (subjective) problem. The situation is even worse for a prior use. Nevertheless, the problem mentioned in the background section of a prior art document from patent literature often is a good indicator whether the document is suitable as an appropriate starting point or not.

The most recent decision regarding the selection of the closest prior art, **T 1841/11** of 3 December 2015, states that a document relating to a similar purpose as the claimed invention is not disqualified as closest prior document if there is another document which even relates to the same purpose. “The closest prior art should relate to the same or at least a similar purpose (or objective) as the claimed invention. Even if prior art relating to the same purpose is available, it is not excluded that a document relating to a similar purpose might be considered to represent a better - or at least an equally plausible - choice of closest prior art, provided that it would be immediately apparent to the skilled person that what is disclosed in the document could be adapted to the purpose of the claimed invention in a straightforward manner, using no more than common general knowledge. If, despite the availability of prior art relating to the same purpose as the claimed invention (here: manufacturing a semiconductor substrate comprising a silicon-germanium film), it is nevertheless considered appropriate to select as closest prior art a disclosure relating to a similar purpose (here: manufacturing a semiconductor substrate comprising a germanium film), at least one claimed feature corresponding to the purpose of the invention will generally appear as a difference over the closest prior art (here: silicon-germanium). However, this difference is not one which can legitimately be invoked in support of

⁸ Hoekstra, J., “Methodology for Paper C – Training for the European Qualifying Examination”, Deltapatents, October 2009, p.151-152

inventive step. The problem-solution approach presupposes that the skilled person has a purpose in mind from the very beginning of the inventive process, which in this case is the manufacture of a known type of semiconductor substrate comprising a silicon-germanium film. Within this conceptual framework, it cannot be logically argued that the skilled person would find no motivation to incorporate silicon-germanium. Moreover, an argument that it would not be straightforward to incorporate this difference into the teaching of the document considered to be closest prior art, or that this would require more than common general knowledge, would not, in such a case, constitute an argument in favour of inventive step, but rather an argument that this document is not in fact a promising starting point".

It is often criticized that the selection of the appropriate starting point is based on hindsight. The author of this article cannot share this criticism. The selection of an appropriate starting point merely serves to make a reasonable pre-selection of documents departing from which there was a realistic chance of arriving at the invention in the sense that if one cannot arrive from these documents, then it is not possible to arrive from any other documents. (Otherwise one would have to test all documents.) As long as this pre-selection is not made too restrictive (e.g. by focusing on one closest prior art document), the hindsight in selecting an appropriate starting point does not appear to be problematic.

In **T 1613/09** the appellant argued that D1 cannot be considered the closest prior art since starting from a "tower" computer is plainly contrary to the situation encountered

by the inventor. This statement implies that, according to the appellant, the closest prior art should necessarily reflect the situation allegedly tackled by the person mentioned as inventor in the present application.

It goes without saying that the actual situation in which the person mentioned as inventor was does not play any role in the assessment of inventive step.

The content of a prior art document has to be carefully assessed since it is read/interpreted in the knowledge of the subject-matter of the claims. It is important to note that according to the GL G-VII, 5.2, "the closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention". (By contrast, for the assessment of novelty, a prior document should be read as it would have been read by a person skilled in the art on the relevant date of the document. By "relevant" date is meant the publication date in the case of a previously published document and the date of filing (or priority date, where appropriate) in the case of a document according to Art. 54(3), see GL G-VI, 3). For example, when inventive step is assessed for a claim commencing with "A device for generating blue light...", selecting an LED as closest prior art was not an appropriate starting point until the middle of the nineties of the last century since no technology was known until then how to produce blue light with LEDs⁹. Hence, LEDs were considered to be not "suitable for"¹⁰ the generation of blue light. After the invention of blue LEDs, an LED could indeed be selected as a closest prior art. The situation is different for a claim starting with "A device for generating wind, comprising a, b, c...". A grinding machine having features a, b and c may qualify as a closest prior art since it was known before the priority date that a grinding machine is (at least to a certain degree) suitable for generating wind.

To be continued

This article will be continued in the **epi** Information 4/2016

9 The Nobel Prize for physics in 2014 was awarded for "the invention of efficient blue light-emitting diodes, which has enabled bright and energy-saving white light sources". The "blue diode case" is also interesting for another reason. After one of the inventors sued his employer because the compensation he received for the invention was far too low, a court decided that his employer had to pay him 8.1 Mio US\$.

10 GL G-IV, 4.13 "An apparatus for carrying out the process of ...etc." is construed in the sense of merely meaning an apparatus that is suitable for carrying out the process.

Evaluation of Claim Amendments

S. Adams (DE)

Many practitioners who attempt to steer patent applications through the gauntlet of prosecution are painfully aware of the different ways the applications are assessed on opposite sides of the Atlantic. The difference in assessment is perhaps most visible with regard to claim amendments. While starting from virtually the same roots and having more similarities than might be initially apparent, the EPO and the USPTO approach changes to claims in patent documents very differently. Although the EPO might be accused of being biased against applicants when assessing amendments, particularly in comparison to their American counterpart, the approach of the USPTO seems to defy clear explanation.

Applicable Law and Brief Interpretation

The applicable law for assessing the formal allowability¹ of amendments to the claims before the USPTO is the "written description" requirement of 35 U.S.C. 112(a). It reads, in relevant part, as follows:

"The specification² shall contain a written description of the invention".

In more detail, to meet the written description requirement, the applicant must convey "with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention... now claimed" (*Vas-Cath v. Mahurkar*, *Fed. Cir.* 1991). Further, an applicant shows "possession" by describing the claimed invention with all of its essential novel elements (*Lockwood v. American Airlines*, *Fed. Cir.* 1997).

Under 35 U.S.C. Sec. 112, the "specification" contains a written description and concludes with the claims. Drawings are covered by Sec. 113, a separate provision. However, in the context of the written description requirement, "possession may be shown ... by showing that the invention was 'ready for patenting' such as by the disclosure of drawings" (MPEP, 2163.02).

Also, a US Examiner should be "mindful of the prohibition against the addition of new matter in the claims or description" (MPEP, 2163.04, I).

The applicable law for a corresponding assessment before the EPO is Article 123(2) of the European Patent Convention. It reads, in relevant part, as follows:

"The European patent application ... may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed".

Thus, claim amendments "are permitted within the limits of what the skilled person would derive directly and unambiguously, using common general knowledge[,] from the application as filed" (CLBA, II.E.1).

Similarities in the Approaches of the EPO and the USPTO when Assessing Claim Amendments

1. The requirements of 35 U.S.C. 112(a) and Art. 123(2) EPC serve a similar goal

In particular, the written description requirement prevents claim amendments that introduce "new matter" into the disclosure of the invention. "The proscription against the introduction of new matter in a patent application ... serves to prevent an applicant from adding information that goes beyond the subject matter originally filed" (MPEP, 2163, I, B).

Similarly, as articulated by the Enlarged Board of Appeal of the EPO, "the underlying idea [of Article 123(2) EPC] is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed" (G 1/93, reasons 9).

2. A requirement to submit a basis for claim amendments is also provided for

According to USPTO regulations, "[a]ll claims being currently amended ... shall be ... submitted with markings to indicate the changes that have been made" (37 CFR 1.121 (c)(2); see also MPEP, 714, II.C).

Further, "Applicant should... specifically point out the support for any amendments made to the disclosure" (MPEP, 2163, II, A) and when "the support for the [claim] limitation is not apparent, and applicant has not pointed out where the limitation is supported", a statement from the

1 In examination proceedings before the EPO, "allowability" refers to the application of Art. 123(2) EPC, whereas "admissibility" refers to procedural requirements that must be met before compliance with Art 123(2) EPC is assessed. The term "formal allowability" occasionally appears in opinions of the Boards of Appeal of the EPO and is used in this article with respect to the assessment of claims before both the EPO and the USPTO.

2 The EPC and EPO Examination Guidelines use the term "specification" differently than the US Patent Act. In the EPC (e.g. Art. 98, 103), the term "specification" refers to an entire published patent, including drawings, and is not used in the context of an application. In contrast, the US Patent Act (e.g. 35 U.S.C. Sec. 10-12) uses "specification" in the context of both applications and patents to refer to the description and claims while excluding the drawings.

Examiner to this effect may be enough to support a rejection³ for lack of adequate written description (MPEP, 2163.04, I).

The EPO has implemented this requirement more concisely in Rule 137(4) EPC:

“When filing any amendments ... the applicant shall identify them and indicate the basis for them in the application as filed”.

3. Subject matter must be disclosed to be available as a claim amendment.

“To comply with the written description requirement of 35 U.S.C. Sec. 112(a) ... each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure” (MPEP, 2163, II, 3, (b)). What is claimed by the patent application must be the same as what is disclosed in the specification; claims directed to a “distinct invention from that disclosed in the specification” do not satisfy the written description requirement (*Lockwood v. American Airlines, Inc.* (Fed. Cir. 1997)).

Similarly, the EPO requires the claims to be directly derivable from the originally filed application, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document (GL, H-III, 2.1-2.2).

4. Rendering a claim amendment obvious is not sufficient

Although amendments based on what is implied by the original application are allowed by both the EPO and the USPTO, amendments rendered obvious by the original disclosure are not.

Referring to the case law of the Federal Circuit, “a description that merely renders the invention obvious does not satisfy the [written description] requirement” (*Ariad v. Eli Lilly, Fed Cir., en banc, 2010*). “Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed” (*Lockwood v. American Airlines, Fed. Cir. 1997*).

Similarly, in T 118/88, a Technical Board of Appeal of the EPO concluded that “[o]bviousness is not... an allowable replacement for disclosure. ... in the examination of what has been disclosed, novelty criteria may be applied, but not ... obviousness”. (T 118/88, reasons 4.4). Accordingly, “the question of what may be *rendered obvious* by [the] disclosure [of a document] in the light of common general knowledge is not relevant to the assessment of what is *implied* by the disclosure of that document” (T 823/96, emphasis added).

5. Literal disclosure of claim amendments is not required

Just as a disclosure rendering a claim obvious is not sufficient, there also seems to be common ground that literal disclosure of new claim language is not required.

Referring to the MPEP, the “subject matter of the claim need not be described literally ... in order for the disclosure to satisfy the [written] description requirement” (MPEP, 2163.02). In *Kennecott Corp. v. Kyocera International, Inc.* the Federal Circuit held that “the earlier and later applications need not use the identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it ... an invention may be described in different ways and still be the same invention” (1987).

Similarly, the Guidelines for Examination in the EPO specify that literal support is “not required by the wording of Art. 123(2)” (GL, H-IV, 2.2).

6. A claim amendment may be supported by a drawing

In the following, the USPTO seems to put drawings on the same level as other means of description, “An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas” (MPEP, 2163.02).

Similarly, according to the Technical Boards of Appeal, “[t]he drawings are not treated differently from either the claims or the description as regards amendments made to the application or to the patent itself as governed by Article 123” (T 169/83, reasons 3.2.5). Put another way, regarding the allowability of claim amendments, “[d]rawings were to be **treated on an equal footing with the other parts of the application**” (CLBA, II.E.1.5, emphasis in original).

Differences in the Approaches of the EPO and the USPTO When Assessing Claim Amendments

1. Burden of proof

The allocation of the burden of proof might be the most important difference between the approaches of the EPO and the USPTO. In particular, it seems likely that the allocation of the burden of proof is one of the main reasons that objections to claim amendments are far more common before the EPO than the USPTO.

Before the USPTO, “the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the

³ According to MPEP, 706.01, a “rejection” relates to the substance of a claim, whereas an “objection” is raised with respect to formal aspects of a claim.

claims" (MPEP, 2163, II, A). Accordingly, once an indication of support in the application for claim amendments has been provided, a US Examiner bears the initial burden of making a case that the amendments cannot be derived from the original disclosure.

Before the EPO, the applicant has the initial burden of establishing that the requirements of Art. 123(2) EPC have been met after amending the claims, even assuming that the applicant has already cited portions of the application supporting the amendments. The indication of the basis for the amendments required by Rule 137(4) EPC "should be understood as an opportunity for the applicant to provide convincing arguments to the [examining] division as to why the amendment(s) is/are directly and unambiguously derivable from the application as filed" (GL, H-III, 2.1). Simply citing passages of the description having wording similar to the claim amendment in question is often insufficient. If a connection between the amended claims and the original application is not immediately clear to an EP Examiner, the Examiner can (and often does) simply object to the claims, without making a case to support the objection.

For example, in T 1239/03, a Technical Board of Appeal answered the question as to "which requirements have to be satisfied by the author of the amendment(s) in order to [establish] that the requirements of Article 123(2) EPC have been met". Upon examination of claims amended by the patent proprietor, the Board found that the patent proprietor "has not discharged the burden of proof which was on him" in meeting the requirements of Art. 123(2) EPC. Accordingly, the amendments were not allowed.

2. Standard for evaluating claim amendments

An applicant before the USPTO generally has much more freedom to depart from the literal wording of the description than his counterpart before the EPO.

When an applicant amends a claim before the USPTO, the support for the claim amendment in the original disclosure need not exclude all possibilities other than the claim amendment. In other words, the claim amendment does not need to be *unambiguously* derivable from the original disclosure.

For example, in *Vas-Cath v. Mahurkar*, a US District Court interpreted the written description requirement in a way that is not so different from a typical interpretation of Art. 123(2) EPC. The Court found that the drawings provided in a priority application did not provide an adequate written description of claim 1 of a patent relying on the drawings for a filing date.

Claim 1 of one of US 4,568,329 (Mahurkar) specifies a double lumen catheter in which the diameter of the return lumen is greater than one-half but less than the full diameter of the catheter tubing. The Court posed the following

question: "how does [the priority application] necessarily exclude" other ratios? The Court also noted that "Mahurkar's patents... contain limitations that did not follow ineluctably from the [priority application]". The phrases "necessarily exclude" and "ineluctably" suggest that the Court was of the opinion that the claimed ratio and other claimed limitations must be unambiguously derivable from the original disclosure.

The Federal Circuit held that the district court "erred in applying a legal standard that essentially required the drawings of the [priority] application to necessarily exclude all diameters other than those within the claimed range... the proper test is whether the drawings conveyed with reasonable clarity to those of ordinary skill that Mahurkar had in fact invented the catheter recited in those claims" (*Vas-Cath Inc. v. Mahurkar*, Fed. Cir., 1991).

Accordingly, the Federal Circuit held invalid a legal standard in which the original disclosure must "necessarily exclude" all other possibilities and "ineluctably" lead to the amended claims in favor of a lower standard of "reasonable clarity".

In *Lizardtech Inc. v. Earth Resource Mapping Inc.* (2005), the Federal Circuit found that "a recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that the inventor possesses the full scope of the invention, and vice versa". In other words, if the claims are enabled (i.e. sufficiently disclosed), then the claims ordinarily meet the written description requirement (i.e. the claim amendments are formally allowable).

As discussed above, both the EPO and the USPTO require claim amendments to be *directly* derivable from the original application. Unlike the USPTO, the EPO also requires the claim amendments to be *unambiguously* derivable (GL, H-IV, 2.1). In other words, starting from the original application, formal allowability under Art. 123(2) EPC requires that the skilled person would inevitably (or ineluctably) arrive at the amended claim.

For example, in T 824/06 the claim at issue was directed to the preservation of a slaughtered chicken. The claim was amended during opposition proceedings to associate a maximum temperature of 15°C for the surface of the chicken with both a first cooling step and a second cooling step. The application discloses that the temperature of the surface of the chicken "is brought to a maximum of 15°C". However, the Board found that this indication "can be understood as being the result of the overall process and not as a requirement for each individual cooling step".

The Board accepted the appellant's argument that providing for a maximum temperature of 15°C for the cooling steps would be a reasonable way to carry out the invention.

The Board also indicated that the amendment would be "within the scope of the disclosure of the application as originally filed" and would meet a standard of "reasonable plausibility". Presumably, reasonable plausibility is similar to the standard of reasonable clarity articulated by the Federal Circuit. However, the Board rejected the amendment in view of the stricter requirement of "unambiguous disclosure", particularly because the application did not unambiguously disclose that the maximum temperature of 15°C was applicable to the claimed cooling steps.

3. Claim amendments derived via (intermediate) generalization

In contrast to EP practice, the US practice with regard to generalizations seems to be rather liberal. In particular, it appears that a preferred embodiment or a list of ranges can often be used to derive generic claim language, at least in the absence of inconsistencies or specific disclosure to the contrary.

For example, "where no explicit description of a generic invention is to be found in the specification ... mention of representative compounds may provide an implicit description upon which to base generic claim language" The disclosure of forty working examples was found to sufficiently describe the subject matter of claims directed to a generic process (*In re Robins*, 57 CCPA 1321, 1970).

In the case of *In re Smith*, the specification disclosed two methods of making polymers. The second method included starting materials "free of alkylatable groupings", while the first method did not specify this particular limitation. The USPTO Board of Appeals held that the disclosure of the specification was not sufficient to support a broad claim for *all* polycationically active polymers free of alkylatable groups. A Technical Board of Appeal at the EPO might have agreed with the USPTO Board of Appeals.

The CCPA heard the appeal of the decision of the USPTO Board of Appeals in *In re Smith*, and did not agree. According to the CCPA, the specification did not contain "language which corresponds identically to the language of the claims on appeal," but the "tenor of the specification" was that the applicant had made a generic invention, not one limited only to certain particular polycationically active polymers (*In re Smith*, 481 F.2d 910, 1973).

From the opinion in *Union Oil Co. of California v. Atlantic Richfield Co.* (Fed. Cir., 2000), the "Appellant refiners assert that the specification does not describe the exact chemical component of each combination that falls within the range claims of the '393 patent. However, neither the Patent Act nor the case law of this court requires such detailed disclosure", and citing an earlier decision, "ranges found in applicant's claims need not correspond exactly to those disclosed in [the specification]; [the] issue is whether one skilled in the art could derive the claimed

ranges from the [] disclosure." (*Vas-Cath Inc. v. Mahurkar, Fed.Cir.*, 1991)

However, US judges occasionally offer stricter opinions. In his dissent in *Union Oil Co. of California v. Atlantic Richfield Co.* (2000), Judge Lourie argued that the specification is required to give "full, clear, concise, and exact direction" to a claimed combination of limitations in order to meet the written description requirement. Judge Lourie did not favor the "picking and choosing" from the specification that was required to arrive at the limitations of the claims at issue.

Also, the Federal Circuit invalidated claims broader than the disclosed embodiments because "[t]here is no evidence that the specification contemplates a more generic way" of performing the claimed invention (*LizardTech Inc v. Earth Resource Mapping Inc.*, Fed. Cir. 2005).

Similarly, the Federal Circuit recently affirmed an examiner, who, in arguing that the written description requirement was not met, held that "while each element [of the claim] may be individually described in the specification, the deficiency was lack of adequate description of their combination" (*Hyatt v. Dudas*, Fed. Cir. 2007).

Claim amendments derived by generalizing features from the description are generally not allowed under EP practice. In particular, an amendment is not allowable under Art. 123(2) EPC when it replaces "a disclosed specific feature either by its function or by a more general term and thus incorporate[s] undisclosed equivalents into the content of the application as filed" (CLBA, II.E.1.2).

Judge Lourie's description of "picking and choosing" features to arrive at the limitations of a claim appears to correspond to what the EPO refers to as an "intermediate generalization". According to EPO practice, an intermediate generalization occurs when a claim is limited "by a feature extracted from a combination of features" (GL, H-V, 3.2.1).

In general, the EPO allows an intermediate generalization "only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination" (CLBA, II.E.1.2). This means that if a claim is to be restricted to a preferred embodiment, it is normally not permissible "to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment" (Id.).

4. Different Goals of the Written Description Requirement and Art. 123(2) EPC

Article I, Section 8, Clause 8, of the US Constitution grants Congress the power "[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". This clause is the reason the US Congress

is able to enact patent legislation. In order to comply with the cited clause of the US Constitution, the written description requirement should serve the goal of promoting the progress of science and useful arts.

Accordingly, "the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term" (MPEP, 2163, I). The term "adequate" is used in the context of the written description requirement at various other points in the MPEP (e.g. MPEP, 2103, IV, B), as well as in a number of decisions of the Federal Circuit (e.g. *Vas-Cath Inc. v. Mahurkar*, Fed. Cir., 1991).

In contrast, the Enlarged Board of Appeal held that adding undisclosed subject matter to an application "could be damaging to the legal security of third parties relying on the content of the original application" (G 1/93). Although legal security is not mentioned in the EPC, the Protocol on the Interpretation of Art. 69 EPC, for determining the extent of protection of a European patent or application, specifies that Art. 69 EPC "is to be interpreted as defining a position... with a reasonable degree of legal certainty for third parties".

Conclusion

The US approach to claim amendments can be characterized as more lenient than the "strict" approach of the EPO. Policy justifications have been brought forward for both approaches.

In an early decision discussing the assessment of claim amendments, a Technical Board of Appeal opined that under a lenient approach "there is a definite risk that the protection conferred by the patent would actually be extended if, as a result of amendments to clarify the granted claims, the claims may be more widely construed than a court would have construed them by the application of Article 69 EPC" (T 113/86, reasons 2.2).

In an even earlier decision of the CCPA, the Court held that a strict approach "places upon patent applicants, the Patent Office, and the public the undue burden of listing, in the case of applicants, reading and examining, in the case of the Patent Office, and printing and storing, in the case of the public, descriptions of the very many structural or functional equivalents of disclosed elements or steps which are already stored in the minds of those skilled in the arts, ready for instant recall upon reading the descriptions of specific elements or steps" (*In re Smythe*, 1973).

While the strict approach is sometimes less than ideal for patentees, it is questionable whether the lenient approach can be consistently applied. After listing various efforts of US courts to articulate the standard for adequate written description in his treatise on US patent law, Professor Donald Chisum wryly notes that "[i]t can seriously be questioned whether any of these articulations provide a standard clearer or more certain than the statutory language itself, which is, in simple terms, whether the specification describes to a person of ordinary skill in the art the invention later claimed" (Chisum on Patents, § 7.04[1][e], 2007).

Abbreviations used in this article

- CCPA – United States Court of Customs and Patent Appeals (predecessor of the Federal Circuit)
- CLBA – Case Law of the Boards of Appeal of the European Patent Office, Seventh Edition, 2013
- CFR – Code of Federal Regulations (US)
- EP – European
- EPC – European Patent Convention
- EPO – European Patent Office
- Fed. Cir./Federal Circuit – United States Court of Appeals for the Federal Circuit
- GL – Guidelines for Examination in the European Patent Office, 2015
- MPEP – Manual of Patent Examining Procedure for the United States Patent and Trademark Office, Ninth Edition, November 2015 revision
- USC – United States Code

Computing time limits under the EPC

F. Leyder (BE), Chair of the EPPC

The paper “Correcting the Text of a Published Patent”, published in **epi** Information 02/2016 at pages 43-44, contains the following paragraph:

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

The readers of this journal are no doubt aware of Rule 126(2) EPC, which states

(2) Where notification is effected by registered letter, whether or not with advice of delivery, such letter shall

be deemed to be delivered to the addressee on the tenth day following its posting, unless it has failed to reach the addressee or has reached him at a later date; [...]

Rule 127(2) EPC is applicable to electronic transmission and refers to the tenth day following transmission.

Thus, I trust it was immediately evident to our readers that nothing else had been intended than two months from the date of delivery, the deemed date of delivery being specified by either Rule 126(2) EPC or Rule 127(2) EPC as being normally the tenth day after posting or transmission.

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Terry Johnson

Marc Nevant

Maarten Nollen

Albert Wiedemann

Postanschrift / Mailing address / Adresse postale

epi

Bayerstrasse 83

80335 Munich

Germany

Tel: +49 89 24 20 52-0

Fax: +49 89 24 20 52-20

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