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Cover:

Balance (Inle Lake, Myanmar)

This picture, photographed by Valérie Plasman (European Patent Attorney, BE), was part of the **epi** Artists Exhibition 2018 at the EPO, Munich



Valérie Plasman

Valérie Plasman arbeitet seit 2011 als zugelassener Vertreter vor dem Europäischen Patentamt für die Firma Exxon Mobil. Aufgrund ihres Wohnortes Brüssel promovierte sie an der Université Libre de Bruxelles in Organischer Chemie und arbeitete für die Firma Solvay in der Forschung bevor sie sich 2009 als Europäischer Patentanwalt in IP Recht spezialisierte.

In ihrer Freizeit liebt Valérie es, zu reisen und andere Länder und Kulturen zu entdecken. Dies ist die perfekte Möglichkeit, Portraits und Landschaften durch ihre Kamera einzufangen – dies alles mit einer besonderen Betonung der Farben. Das gezeigte Foto wurde im Februar letzten Jahres in Myanmar von ihr aufgenommen.

Valérie has been working as European Patent Attorney at Exxon Mobil since 2011. Living in Brussels, she obtained a PhD in Organic Chemistry at the Université Libre de Bruxelles and worked for Solvay as a researcher before specializing in IP and qualifying as European Patent Attorney in 2009.

In her free time, Valérie loves traveling to discover other countries and cultures. This is the perfect opportunity to capture portraits and landscapes through her camera, with a special emphasis on colors. The photo on the cover was taken in Myanmar in last February.

Valérie travaille comme mandataire européenne chez Exxon Mobil depuis 2011. Vivant à Bruxelles elle a obtenu un Doctorat en Chimie Organique à l'Université Libre de Bruxelles et a travaillé chez Solvay comme chercheuse avant de se spécialiser en PI et de réussir l'EEQ en 2009.

Pour ses loisirs, Valérie adore voyager pour découvrir d'autres pays et d'autres cultures. C'est une opportunité idéale pour capturer des visages et des paysages à travers son objectif, avec une importance particulière pour les couleurs. Les photos présentées à l'exposition ont été prises au Myanmar en février dernier.

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Editorial

M. Névant (FR)**, Editorial Committee

Ecosystem?



Marc Névant

So, as promised, we are back!

We genuinely thought that an ecosystem – despite the fact that there does not seem to be a single definition of that term – is linked to ecology. We know for example of terrestrial, marine or else rainforest ecosystems where living organisms and non-living components (such as air or water) interact.

We were thus somehow taken aback when we read some time ago in the news section of the EPO website that the Office was about to host the 2018 IP Executive Week the aim of which was “to make the IP ecosystem more efficient and effective”.

Digging a bit further we realized that the word “ecosystem” is actually used in a broader sense and, shall we dare to say, a fashionable one, to describe a place where *something HUGE* is happening, notably a place where innovation hubs are located. It is for example common place to hear about the Silicon Valley ecosystem or the Boston ecosystem.

In this context having a reliable, efficient and global IP ecosystem makes sense so that patent protection can be smoothly secured for the steadily growing number of inventions made around the world. No matter what kind of challenges may lie ahead of us, our Institute is certainly willing to contribute to the development of a successful IP ecosystem, in collaboration with our long-standing partner, the EPO.

One interesting point about ecosystems is that they are dynamic entities which are subject to periodic disturbances. When a perturbation occurs, an ecosystem responds by moving away from its initial state. The tendency of an ecosystem to remain close to its equilibrium state, despite that disturbance, is termed its resistance. On the other hand, the speed with which it returns to its initial state after disturbance is called its resilience. No doubt that resistance and resilience are the bread and butter of European patent attorneys so we should be well prepared to embark on a journey where ecosystems will govern innovation.

** Just a reminder that France is now a two-star football team :-)

Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionsausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der **epi** Information ist der **16. November 2018**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of **epi** Information is **16 November 2018**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de **epi** Information est le **16 novembre 2018**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

New comment function available

[Leave a comment](#)

The Editorial Committee

The Editorial Committee is pleased to announce that it is now possible to comment on **epi** information articles:

- Comments are visible to all visitors.
- All **epi** member can leave their comments after login.
- The author can edit his own comment.

This new function aims at fostering exchange and discussion among our members about current issues and developments. It is now possible to give direct feedback to the authors, raise questions and express ones thoughts and views.

We are looking forward to fruitful discussions and getting insights into what topics are of interest for our members and what they think about possibly controversial subjects.

New comment section



Amendment of Rule 154 (1)

Upcoming Substantial changes in the procedure to pay annual subscription for European Patent Attorneys

Peter R. Thomsen (CH), epi Treasurer

For us as European Patent Attorneys, it is not the most exciting thing to look after the payment of our annual subscription and for many of us our employer or accounting persons are taking care of those payments. However, the **epi** as the central institution to look after our interests being probably the only current real pan-European profession relies on our annual subscription. The subscription constitutes by far the major income source to finance the bodies of **epi**'s self-regulation, the Secretariat in Munich and all other activities. It was already one of the principles enshrined in the Founding Regulations from the very beginning of our profession that each European Patent Attorney has to pay annually a fee in order to remain on the list of professional representatives acting before the EPO.

With its decision CA/D 6/18 of June 28, 2018 the Administrative Council of the European Patent Organization has decided an amendment of the wording of Rule 154(1) EPC which will trigger substantial changes in the procedure to pay the annual subscription for European Patent Attorneys from 2019 onwards. This amendment was proposed jointly by the Legal Division of the EPO and the **epi** and has as its main objective to streamline and simplify the procedure. Under the new wording of R. 154(1) EPC a European Patent Attorney can be deleted from the list of professional representatives if he/she has not paid, despite a reminder, the applicable annual subscription to the **epi** within 5 months from either January 1 of each year or, for those members who are only

entered on the list during a year, within 5 months from the date of their entry on the list. As a consequence, the **epi** Council has adapted the Rules governing payment of the annual subscription (**epi** Collection of Decisions no. 5.1.1). According to the new version, which will also come into force on January 1, 2019 together with the new R. 154(1) EPC, an **epi** member is supposed to pay the annual subscription until May 31 of each year at the latest, i.e. within 5 months from January 1, which is 1 month earlier than so far. However, if he/she pays the subscription during the last 2 months of this period (i.e. within April and May), the amount due will be higher than if paid during the first 3 months. For 2018 the regular annual subscription amount was 190 EUR and the increased amount, if paid late 240 EUR. The amounts for 2019 will be announced in this journal and on the **epi** webpage after the **epi** Council will have decided on them at its meeting on November 10, 2018 in Helsinki upon a proposal from the Treasurer.

Those timelines are new and 1 month shorter for the majority of the members, who are already on the list at the beginning of the year. Every year there are hundreds of members of the Institute who have not paid their subscription and where the deletion procedure has to be initiated by the EPO Legal Division in autumn. Whenever the **epi** proposes a member to be deleted due to non-payment of the annual subscription, the EPO Legal Division sends out a communication according to Art. 113 EPC (right to be heard), and if no satisfactory response is received, a decision of deletion is issued offering the possibility to file an appeal within the usual 2 months period under Art. 108 EPC. Together with the voluntary invoice that the **epi** sends out every year and one informal reminder via email plus the additional formal reminder required by R. 154(1) EPC sent by post, a member normally receives at least 5 communications from either **epi** or the EPO before a deletion becomes effective. A payment of the increased annual subscription, if affected before any deletion decision becomes effective, will stop the deletion procedure. Once a deletion decision has become effective due to non-payment, re-entry can be requested at any later time and will be implemented if the non-paid annual subscription for that year is paid. It is clear that the applicable annual subscription has to be paid to the Institute also for the current year.

The new R. 154(1) EPC together with the adapted Rules governing payment of the annual subscription (CoD no. 5.1.1) will ensure that in the future, the whole process from sending the voluntary invoice until a possible deletion becomes effective, can be finished within the running year and is not drawn into the next year. The

amended procedure also increases legal certainty because the possibility to start disciplinary proceedings against a non-payer by **epi** has been deleted from the disciplinary legislation because a much more effective sanction in the form of deletion from the list is available.

What members should consider and change

Since the formal reminder must be sent by post, members are responsible to be reachable by the EPO and **epi**. Hence you should generally make sure that their contact address and ideally email address are up-to-date in the professional representative list administered by the EPO Legal Division (e.g. in case of moves or changes of employers). Although the email address is a voluntary information, it is highly recommended for a proper and efficient communication between the Institute and its members (e.g. also if there are problems with your EPO smart card).

Additionally, members should decide on the way of payment for their annual subscription: the **epi** is offering beside usual bank transfer, payment by credit card, Paypal or automatic debiting from the running accounts at the EPO (for the latter, a direct debiting mandate signed by the account holder is necessary to be filed with the **epi**, available under <https://patentepi.com/en/the-institute/annual-subscription.html>).

If you have paid your annual subscription by automatic debiting from the running accounts at the EPO last year and there are no changes (e.g. account number, holder, address), there is no need to change anything because your annual subscription will be automatically paid around the end of February (you just have to ensure that the running account has sufficient funds around that time). If you have a standing order with a bank or you make a manual transfer or pay online by using Paypal and credit card, please make sure the payment is effected at latest by March 31, 2019 in order to avoid the amount of the increased subscription fee.

If, for whatever reason, you are not longer interested in remaining on the list, please actively inform the EPO Legal Division of that intention. During the first 3 months of a year, no annual subscription will then be due and money already paid will be refunded.

As **epi** Treasurer, I expect that the new streamlined process following the amendment of R. 154(1) EPC will simplify the internal procedures within the **epi** and the EPO Legal Division, and will also help you to focus on the more exciting matters around patent filings, prosecution, opposition and litigations.

Report of the Harmonisation Committee (HC)

F. Santi (IT), Secretary

This report completed on 24th August 2018 covers the period since the previous report dated 18th May 2018.

The Harmonisation Committee deals with all questions concerning the worldwide harmonisation of Patent Law, and in particular within the framework of WIPO.

Meeting of epi Harmonisation Committee

A meeting of **epi** Harmonisation Committee was held at the **epi** Secretariat in Munich, on 16th May 2018.

It was agreed that **epi** would be represented at the SCP meeting at WIPO from 9th to 12th July 2018, see the report below.

The Chair updated the members of the Committee on his attendance at the UK IPO Stakeholder Roundtable on Harmonisation.

The participants discussed the Industry Trilateral proposals and **epi** position on conflicting applications (namely on treatment of PCT applications) and anti-self-collision.

IP5 Heads of Office and IP5 Industry

On 13th June 2018, the IP5 Heads of Office met with IP5 Industry in New Orleans, USA, to update the industry representatives on important developments and engage in a dialogue on IP topics of strategic nature, including quality and the further development of IP5 co-operation.

The meeting papers, including presentations on ongoing projects, are available on the joint web site of the 5 offices: <https://www.fiveipoffices.org/industry-consultation/headsandindustry/june2018.html>

28th Session of the SCP

The 28th session of the Standing Committee on the Law of Patents (SCP/28) was held at WIPO in Geneva, from the 9th to the 12th of July 2018. **epi** was represented by Filippo Santi, Secretary of **epi** Harmonisation Committee, and Francis Leyder, **epi** President.

The agenda of the session covered exceptions and limitations to patent rights; quality of patents, including opposition systems; patents and health; confidentiality of communications between clients and their patent advisors and transfer of technology.

SCP/26 decided that discussions on these main topics, to be intended as a non-exhaustive list, will remain open for further elaboration and discussion. Without prejudice to the mandate of the SCP, the Committee agreed that its work for the next session be confined to fact-finding and not lead to harmonisation at this stage.

The meeting papers, including an updated draft Reference Document on Exceptions regarding Acts for obtaining Regulatory Approval from Authorities, a further Study on Inventive Step, a Report on WIPO's Technical Assistance Activities in Respect of Enhancing Patent Examiners Capacity, Proposals made by National Delegations, Presentations shown during the Meeting by National Delegations and the Summary by the Chair, are available on the WIPO website: http://www.wipo.int/meetings/en/details.jsp?meeting_id=46439

The next session of SCP has tentatively been scheduled from 3rd to 6th December, 2018.

IP5 Patent Harmonisation Experts Panel

In August 2018, the IP5 Offices published the report of the first case studies (chemistry field, support requirement) on written description/sufficiency of disclosure.

The report can be downloaded from the IP5 Offices website: <http://www.fiveipoffices.org/activities/harmonisation/writtendescriptioncasestudy.pdf>

Next committee meeting

The next meeting of the Harmonisation Committee has been scheduled on 13th December 2018.

Report of the Disciplinary Committee (DC)

P. Rosenich (LI), W. Fröhling (DE) and M. Névant (FR)



Paul Rosenich

Chair



Werner Fröhling

Vice Chair



Marc Névant

Member DC

The Disciplinary Committee (DC) had its annual meeting on 14th and 15th June 2018.

As a reminder, the DC is established based on Article 134a(1)(c) EPC concerning the Institute of Professional Representatives before the European Patent Office and on Article 11 of the Regulation on the establishment of the Institute adopted by the Administrative Council of the European Patent Organisation back in 1977.

The most important role of the DC is to maintain the public reputation of **epi** and to ensure that professional representatives before the EPO “exercise their profession conscientiously and in a manner appropriate to their dignity”. In practice, the DC considers any alleged breach of the Rules of professional conduct which may be brought to its notice.

The DC is comprised of 38 members (one per country of the EPOrg) among which 4 Officers are elected: a Chair, a Deputy Chair, a Secretary and a Deputy Secretary. The DC is assisted by a Registrar who is a member of the **epi** Secretariat appointed by the Chair of the DC with the approval of the Secretary General of the **epi**. The DC comprises (i) Chambers (each made up of 3 full members and a substitute) which handle complaints, and (ii) ad hoc Working Groups the aim of which is to reflect e.g. on the functioning of the DC, to provide comments and suggestions e.g. on proposed amendments to the Regu-

lation on Discipline, or to assist the Professional Conduct Committee (PCC) on matters related to the UPC Code of Conduct.

As in previous years, cases of interest handled by the Chambers during the past 12 months were discussed to the benefit of all members. A report was made on the progress of the implementation of an IT tool making it possible to streamline the work of the DC, this tool giving for example access to a database of Decisions from Chambers, and to Workflow support charts and Templates for Chambers. The news was well received as it will be easier to publish Decisions from Chambers for the benefit of all the members of the Institute.

The Working Group dealing with the amendments of the Regulations presented the result of their work and the changes that could be made to the Regulation on Discipline and to the Additional Rules of Procedure of the DC. The presentation triggered a thorough and very efficient discussion on the changes proposed, mandate being given to the Working Group to liaise *inter alia* with the PCC to make progress on this matter.

Before the meeting concluded, Mr. Rosenich thanked Mr. Fischer, on behalf of the DC, for assisting with the organization of the meeting. The next meeting is scheduled to take place in April or May 2019.

*In issue 1/2018 we published an obituary for **Mr Sertaç Köksaldı**, then a Turkish Council Member of the **epi**. We actually should have also published the following text written by Ms. Selda Arkan, another Turkish Council member of the **epi**:*

Obituary

»As the liaison member for the Turkish Group, I have the heavy burden to report, with deep sorrow, the passing away of our close friend and Council Member Sertac Köksaldı due to a sudden heart attack on January 18 last. He was a source of strength and inspiration to everyone in our profession and he will always be remem-

bered for his leadership and efforts because he devoted not only his time but also his heart to everything he was doing.

His loss will leave a great gap in the Turkish IP Community.«

Next Board and Council Meetings

Board Meetings

102nd Board Meeting on 12 October 2018 in Munich (DE)

Council Meetings

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

86th Council Meeting on 11 May 2019 in Sofia (BG)

Continuing Professional Education (CPE)

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

Opposition and Appeal

27 November 2018

Madrid (ES)

epi roadshow supported by the EPO

Unitary Patent and Unified Patent Court

postponed

Bologna (IT)

epi roadshow supported by the EPO

Case Law

21 September 2018

London (GB)

epi roadshow supported by the EPO

29 October 2018

Paris (FR)

epi roadshow supported by the EPO

7 December 2018

Eindhoven (NL)

epi roadshow supported by the EPO

Course on Patent Litigation in Europe

The 16th edition of the Diploma on Patent Litigation in Europe will be launched next October 2018. This course started in 2003 as a joint initiative of the Institute of Representatives before the European Patent Office (**epi**) and the Center for International Intellectual Property Studies (CEIPI) of the University of Strasbourg, under the direction of Mr Walter Holzer, former President of **epi**.

The course was born with the vision that one day a unified patent system would exist in Europe, and that European patent attorneys would become litigators of that system. The objective of the course, in 2003 and nowadays, is to offer to European patent attorneys the possibility to specialize in comparative European patent litigation and prepare them for the advent of the unitary patent and the Unified Patent Court.

Speakers of the program include leading authorities and renowned judges and practitioners, and the program consists of a combination of lectures, practical cases and a mock trial, which take place in Strasbourg.

More details of the Course, leading to a Diploma of the University of Strasbourg and which will be deemed as appropriate qualification for a European patent attorneys to represent parties before the UPC, can be found at <http://www.ceipi.edu/en/patent-litigation-in-europe-unified-patent-court/course-on-patent-litigation-in-europe>



CENTER FOR INTERNATIONAL
INTELLECTUAL PROPERTY STUDIES

CEIPI – Centre d'Études Internationales de la Propriété Intellectuelle

Results of the 2018 European Qualifying Examination

Statistics on the results of the 2018 EQE

Number of candidates per country and passes pursuant to Article 14 (1) of the Regulation on the European qualifying examination (REE)

Place of residence	Total number of candidates	Pass
AL	0	0
AT	20	9
BE	35	13
BG	3	2
CH	56	21
CY	0	0
CZ	6	2
DE	672	191
DK	29	8
EE	3	2
ES	49	10
FI	35	10
FR	174	55
GB	229	116
GR	6	1
HR	2	1
HU	4	2
IE	4	0
IS	0	0
IT	88	11
LI	3	0
LT	3	2

Place of residence	Total number of candidates	Pass
LU	1	1
LV	0	0
MC	0	0
MK	0	0
MT	0	0
NL	127	39
NO	11	3
PL	17	3
PT	5	1
RO	4	1
RS	0	0
SE	77	21
SI	4	1
SK	2	0
SM	0	0
TR	24	2
CN	1	
IL	1	
SG	1	
Grand Total :	1696	528

Information source: <http://www.epo.org/learning-events/eqe/statistics.html>

Candidates are free to choose which paper(s) they wish to sit. Candidates who have only sat a sub-set of papers cannot fulfill the conditions of Article 14(1) REE (ie have obtained the minimum grades for all four papers) and thus cannot be included in this table.

Example: A candidate has only sat papers A and B and passed both papers. Nonetheless the conditions of Article 14(1) REE are not yet fulfilled and this candidate is not included in this table.

This table includes all candidates who fulfill the conditions of Article 14(1) REE.

List of Professional Representatives

by their place of business or employment in the Contracting states as at 31.08.2018

Contr. State	Number Total	% of Total Repr.
AL	14	0,11%
AT	159	1,28%
BE	248	1,99%
BG	55	0,44%
CH	574	4,62%
CY	11	0,09%
CZ	86	0,69%
DE	4557	36,65%
DK	268	2,16%
EE	25	0,20%
ES	225	1,81%
FI	183	1,47%
FR	1170	9,41%
GB	2352	18,92%
GR	24	0,19%
HR	24	0,19%
HU	69	0,55%
IE	79	0,64%
IS	20	0,16%
IT	522	4,20%

Contr. State	Number Total	% of Total Repr.
LI	2	0,16%
LT	24	0,19%
LU	22	0,18%
LV	17	0,14%
MC	7	0,06%
MK	26	0,21%
MT	6	0,05%
NL	531	4,27%
NO	101	0,81%
PL	286	2,30%
PT	40	0,32%
RO	48	0,39%
RS	45	0,36%
SE	437	3,51%
SI	30	0,24%
SK	29	0,23%
SM	17	0,14%
TR	83	0,67%
Total :	12434	100,00%

Contact Data of Legal and Unitary Patent Division

Update of the European Patent Attorneys Database

Please send any change of contact details using EPO Form 52301 (Request for changes in the list of professional representatives: <http://www.epo.org/applying/online-services/representatives.html>) to the European Patent Office so that the list of professional representatives can be kept up to date. The list of professional representatives, kept by the EPO, is also the list used by **epi**. Therefore, to make sure that **epi** mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 5.2.3 of any change in your contact details.

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

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

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

Thank you for your cooperation.

New Entrance for EPO building in The Hague

As of 8 October 2018, the EPO building in The Hague will only be accessible via a new entrance at Patentlaan 2. The entrance at Van Benthemlaan will no longer be open to visitors. Practical information for visitors can be found at <https://www.epo.org/service-support/contact-us/new-building-in-the-hague.html>

The Right of Priorities: Recent developments in EPO Case Law

R. Teschemacher (DE)

Recent decisions passed by three different instances of the EPO have significant effects on the patentability of inventions under European patent law. All of them concerned priority problems and their effect on the validity of patents to be assessed in opposition proceedings. Applicants should be aware of the consequences of these decisions. Avoidable mistakes when filing a European patent application and even previously may later result in the loss of the patent.

1. EPO, Enlarged Board of Appeal, decision of November 29, 2016, Case G 1/15, OJ EPO 2017, A82 – *Infineum USA L.P. v Clariant Produkte (Deutschland) GmbH*

Prior to decision G 1/15 of the Enlarged Board of Appeal (EBA), divergent case law created considerable legal uncertainty in respect to the application of Article 88 (2), 2nd sentence, EPC on partial priorities. One line of case law interpreted the previous decision G 2/98 of the EBA to mean that partial priority can only be claimed if the relevant claim comprises alternative embodiments, one or some of which are covered by the priority. By contrast, these decisions did not acknowledge that partial priority was validly claimed if the subject-matter disclosed in the priority application was claimed in more general terms (e.g. by a broader range) in the European application claiming priority.¹

This had the consequence that a European application as a priority application could become novelty destroying under Article 54(3) EPC for a more generically defined claim in the later European application claiming priority. In *Nestec v Dualit* [2013] EWHC 923 (Pat), the Patents Court for England and Wales followed this line of Board of Appeal decisions. The same approach created the problem of “poisonous divisionals”. In decision T 1496/11 of September 9, 2012, Board of Appeal 3.2.05 concluded that an embodiment disclosed in a divisional application could anticipate a generic claim of the parent application. While this decision was not followed by others and remained isolated, it added to the already existing uncertainty and made it difficult to advise applicants on how to use divisional applications.

In G 1/15, the EBA found that this restrictive practice did not have a basis in the EPC or the Paris Convention. The EBA restored legal certainty² and answered to the referred question as follows:

Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic “OR”-claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.

2. EPO, Technical Board of Appeal 3.3.07, decision of November 9, 2017, Case T 282/12 – *Coated tablets/ JOHNSON & JOHNSON*

It was foreseeable that the definition in G 1/15 which subject-matter may give rise to partial priority could not be without consequences for the assessment of what is the first application from which priority can be claimed within the meaning of Article 87 (1) EPC, corresponding to Article 4A (1) of the Paris Convention.

The contested claim of the European application in case T 282/12 related to a coated tablet in which a feature for the structure of the tablet was defined by a range of 3% to 33% of a given length. This range was disclosed for the same tablet in the US continuation-in-part application from which priority was claimed. However, a previous application in the US of which the priority application is the continuation-in-part already defined a narrower range of 5% to 33% and disclosed all other features. This means, that the previous application already gave rise to a right of priority for a tablet with the narrower range. On the basis of the principle laid down in G 1/15, the Board found that the claimed subject-matter had to be conceptually divided into two parts, i.e. 3% to 5% enjoying priority from the continuation-in-part disclosing a tablet with this part of the range as claimed for the first time and 5% to 33% not enjoying priority. Since a prior use had been alleged exhibiting a value of 17%, i.e. within the part of the range from 5% to 33% for which the priority was held to be not valid, the case was remitted to the Opposition Division for examination of prior use.

3. EPO, Opposition Division, decision concerning European patent 2 771 468 issued in writing on March 26, 2018, *The Broad Institute, Inc. et al. v Schlich, George et al.*

The contested patent relates to an essential aspect of the CRISPR technology for modifying genetic information. Although the decision, denying priority from a US provisional application, is only a first instance decision, the revocation of the patent pronounced in the oral proceedings on January 17, 2018 has resulted in many comments on blogs and else-

¹ Case Law of the Boards of Appeal of the EPO, 16th ed. 2016, II.D.5.3.
² Schultz and Geißler discuss further consequences of the decision, GRUR Int. 2018, 536.

where. In reaction, the proprietors of the patent stated in a press release that the decision is based on a technical formality and in conflict with international treaties. They immediately filed an appeal and expect that the Board of Appeal will resolve the problem not just for CRISPR patents, but for a wider range of European patents and applications claiming priority from US provisional applications.

The European patent was granted on the basis of a Euro-PCT application claiming priority from 12 US provisional applications. Not all the applicants of the provisional applications were indicated as applicants in the PCT application and the decisive question was whether this was detrimental to some of the priorities.

In their final submissions, the proprietors relied on 3 lines of arguments.

(i) No competence of the EPO to assess legal entitlement to the right of priority

According to the proprietors³, ownership of the right to priority should only be a matter for the national courts to decide and challenging the right of priority should only be allowed for the truly entitled person.

The Opposition Division finds that, under Articles 87 to 89 EPC, the EPO has to assess the validity of the priority claim in order to determine patentability requirements. Thus, it cannot simply rely on the applicant's declaration on the entitlement to the priority right for determining the relevant state of the art. Rather, it has to examine whether the applicant of the European patent application was the applicant of the first application or is his successor in title. This is in line with EPO's established practice, relevant case law and the legal history of the EPC.

(ii) Any person within the meaning of Article 87(1) EPC should mean anyone of a plurality of co-applicants of the first application

The proprietors submitted that it is the purpose of the priority right to assist the applicant in obtaining international protection. According to them, this can only mean to assist each of the co-applicants of the first application indiscriminately. They stated that third parties' interests are sufficiently guaranteed by the "same invention" requirement.

In the end, the Opposition Division does not agree. The text of the Convention ("Any person", "Jedermann", "Celui qui") does not give any clear answer as to whether, in the case of co-applicants, "all applicants" or "any of them" is meant, although the French version is the more restrictive one. Neither did the travaux préparatoires of the EPC or the Paris Convention provide a clear reading. However, a basis for the "all applicants" approach can be found in the first commentaries on the Paris Convention as well as in EPO and national practice and case law. The Opposition Division discusses whether claiming priority by one co-applicant may be considered an act of exploitation which would not exclude

the other co-applicants but notes that this approach would lead to the far-reaching consequence of a multiplication of proceedings with identical content. In any case, there are no exceptional circumstances for the Opposition Division to deviate from the practice established by the Guidelines and consistent case law requiring that the right of priority has to be exercised by all co-applicants of the first application or their successors in title.

(iii) Any person "who has duly filed" – to be assessed under US law

Under US law, the person who has duly filed a provisional application as the first application is a person who has contributed to the invention as claimed in the application claiming priority. Considering that the US provisional(s) disclosed multiple inventions and that some of the inventors/applicants of the provisionals did not contribute to the inventions claimed in the PCT application in the case at hand, the proprietors suggest that US law should be decisive for assessing "who has duly filed".

The Opposition Division disagrees. It holds that, under the Paris Convention, national law only applies to assessing whether the first application is to be accorded a filing date. It does not refer to a condition of substance, in the sense that the person filing the first application should be entitled to the invention. It states that this approach is consistent with Article 5 of the Patent Law Treaty which does not foresee any entitlement to the invention by the person filing the application. The Division argues that Article 8(2)(b) PCT invoked by the proprietors is not relevant in the present context since it is concerned with internal priorities whereas the priority at issue is a Convention priority for which Article 8(2)(a) PCT refers to the Paris Convention. Thus, under the Paris Convention and the EPC, the right to claim priority is derived from the formal filing of the first application, irrespective of the status of inventor.

Discussing the merits of the case is not the purpose of this paper, but it may be expected that the proprietors will spare no pains to get the decision of the Opposition Division set aside. It has been counted that the EPO file has some 42 000 pages, many will be added in appeal proceedings. Maybe a point of law of fundamental importance will be argued and a referral to the EBA be requested.

The present difficulties arise from the fact that the system of provisional applications establishing US internal priority and introduced in 1995 was not conceived analogously to priority under the Paris Convention. Rather, the specific aspects of the US first-to-invent system were the determining factors. At the outset, it was not even possible to get a patent granted on a provisional application. This raised doubts whether a provisional application was "an application for a patent" within the meaning of Article 4A (1) of the Paris Convention.⁴ Only later was the problem solved with the possibility to convert a provisional application into a regular application (35 U.S.C. § 111b (5), 2nd sentence). Nevertheless, the system of provisional applications remains amalgamated with questions of inventorship which are outside of the

³ A position shared by Breimi GRUR Int. 2018, 128.

scope of the Paris Convention. While the Paris Convention does not restrict the freedom of the Member States how to establish a system of internal priorities, national provisions on internal priorities cannot modify the requirements of the Paris Convention on priorities in its Article 4.

Those users of the European patent system not sharing the proprietors' optimism about the result of the appeal proceedings will be well advised to take appropriate precautionary measures in case their right of priority becomes relevant and contested. There are two alternatives:

a) The applicants of the first application remain the applicants for the application claiming priority. Any necessary transfer is made after that point in time. In the international phase of an international application, the indications on the applicant(s) are amended on a request under Rule 92bis PCT.

b) If the applicants for the application claiming priority are not the same as the applicants of the first application, all co-applicants of the first application who are not co-applicants of the application claiming priority must transfer their right of priority to at least one of the co-applicant(s) of the application claiming priority before filing the latter. Appropriate documentation of the transfer fulfilling the civil law requirements of the applicable law has to be kept available.

4. EPO, Technical Board of Appeal 3.5.05, decision of February 9, 2017, Case T 1201/14 – Transfer of right of priority

Neither the EPC nor other relevant treaties contain guidance as to the requirements for a valid transfer of the ownership of the right of priority. Therefore, the EPO commonly applies national law to this question.⁵

In T 1201/14, the Board was faced with the situation that the proprietor relied on a transfer of the priority right in which the effective date of the transfer was defined by way of a so-called nunc pro tunc assignment, i.e. the contract was concluded later in time than the contractually stipulated effective date of the transfer. The Board held that Article 87 (1) EPC requires that the applicant owned the right of priority before filing the European application. It follows therefrom that, even if a transfer with retrospective effect such as the nunc pro tunc assignment is valid under the US civil law invoked by the proprietor, it is not acceptable under Article 87(1) EPC. Any natural or legal person can only then be considered a "successor in title" for the right of priority within the meaning of Article 87(1) EPC 1973 if it obtained that right from its previous owner by a transfer agreement concluded before the filing of the later European patent application.

The Board's reasoning is in line with the decision of the Enlarged Board of Appeal G 1/13 dealing with the relation

between the EPC and national law in which the EBA stated the principle that a provision of national law which would confer on a party rights which conflict with requirements of the EPC cannot be acknowledged by the EPO.⁶

In T 1201/14, the Board addressed several approaches which national law is applicable to assessing the validity of a priority transfer. As in some previous decisions, the question was left undecided since it was not relevant to the result of the decision taken. In two decisions in corresponding cases T 205/14 and T 517/14, both of November 11, 2015, Technical Board of Appeal 3.3.01 applied the law on employees' invention of Israel, inter alia arguing that both parties will be familiar with the law that governs their legal relationship and thus be aware of any formal requirements regarding the transfer of the right of priority.

By contrast, taking the law of the country of the first application⁷ is not an appropriate approach, at least not in cases of a European application or an international application under the PCT from which the priority right arises. For example, for a European application as a first application, a difference might be made between filing in Munich and The Hague,⁸ with the consequence that the law of Germany or the law of the Netherlands would apply, and both legal systems might be of no relevance at all for the relations between the parties of a priority transfer. A similar situation would arise if an international application is filed in Geneva at the International Bureau as receiving Office. It may not be expected that an applicant realizes that this route of filing could determine the law of Switzerland as the legal system for the priority transfer. Looking at the introductory part of Article 87 (1) EPC ("Any person who has duly filed ... in or for a country ..."), one could also argue that each country for which the European or international application is filed also is a country of the first application. However, the validity of a civil law transaction has to be assessed on the basis of a single legal regime. Considering the law of the country in which priority is claimed as the relevant legal regime would create similar problems. Within the priority year, applicants would have to comply with the legal requirements for a transfer in all states which acknowledge priorities under the Paris Convention.

Hence, it appears reasonable to generalize the approach taken in T 205/14 and T 517/14 by applying the law governing the civil law relations between the parties, be it contract law,⁹ labor law or specific law on employees' inventions.

Updated and enlarged version of a paper previously published on Bardehle Pagenberg's website and the Eplaw Patentblog.

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4 See Miller, "The same effect" United States Provisional Patent Applications and Paris Convention Priority Rights, 76 JPTOS 716 (1996) and the Notice from the President of the EPO, OJ EPO, 1996, 81, recognizing priorities from provisional applications, expressly referring to the "independent decision-making competence of the EPO boards of appeal".

5 Case Law of the Boards of Appeal, supra, II.D.2.2.

6 G 1/13, OJ EPO 2015, A42 – Fischer-Tropsch Catalysts/SASOL TECHNOLOGY II, Reasons pt. 8.

7 BGH, GRUR 2013, 712 – Fahrzeugscheibe.

8 Which place applies to electronic filing?

9 Pahlow, GRUR Int. 2017, 393; Breimi, epi Information 1/2010, 17; Breimi, sic! 3/2017, 109.

PCT Practical Advice and Updates, a Report from the Seminar “PCT at the EPO” in Bucharest

O. Boncea (RO), M. Nollen (BE)

A new seminar from the series “PCT at the EPO” took place in Bucharest on 12 July 2018. It was organized by the European Patent Office with the support of the Romanian State Office for Inventions and Trademarks (OSIM). Around thirty participants attended the seminar. Although this number may not look impressive compared with other countries with a high number of PCT applications, it is gratifying to see that the interest in the patent field is increasing in Romania. In fact, the majority of the participants were newcomers in the field, representing the main IP companies in the country.

The whole-day seminar contained a mixture of theoretical aspects combined with a lot of practical advices. The highly interactive presentations, fully engaged the public. The lectures were directed to a good understanding of how the PCT system works, the overall procedure and benefits thereof. Additionally, real case studies offered the opportunity to learn from actual situations and not only from hypothetical ones. Furthermore, new rules and developments were presented.

The programme of the seminar

The seminar included two speakers and three topics. The first one was Isabel Auría Lansac, lawyer at the PCT Affairs Department within the EPO. She gave insight into the way the EPO as Receiving Office treats restoration of the right of priority and missing elements or parts. The participants were encouraged to “judge” each practical case on their own before presenting the solution.

The system as seen from a professional representative perspective, including also a comprehensive analysis of PCT Direct, was presented by Filippo Santi, European patent attorney, who advised the participants on how to take strategic decisions in accordance with the clients’ needs.

The seminar ended with a very useful presentation on PCT updates, again by Mrs Auría Lansac. These updates included the proposed amendment to Rule 69.1(a) PCT which would allow a systematic earlier start of Chapter II procedure. Further, the so called Collaborative Search and Examination Pilot Project was presented, wherein the five major Patent Offices around the world (EPO, USPTO and the patent offices from Korea, Japan and China) cooperate. The aim of the collaboration is the establishment of high quality international search reports and written opinions. The Pilot Project is already available for the applicants since the beginning of July 2018¹ and, for the time being, it involves no additional costs than the regular international search fees.

Restoration of right of priority²

As well known, the end of the priority year is a critical deadline; the general rule used to be: once missed, it cannot be restored. However, the Rule 26bis.3 PCT, in force since 1 April 2007 and slightly modified as of 1 April 2017, changes that principle to a certain extent. If the EPO is chosen as the receiving office (RO), restoration of the right of priority is feasible under certain conditions. The EPO applies the Rule 26bis.3 PCT in line with the principles of re-establishment of rights under Article 122 EPC.

The principle is specified in Rule 26bis.3 (a) PCT:

a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to paragraphs (b) to (g) of this Rule, restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period: (i) occurred in spite of due care required by the circumstances having been taken; or (ii) was unintentional.

As specified in the following subparagraphs. Most importantly, a request is to be filed within two months from the date on which the priority period expired. A fee for restoration is to be paid (640 euro at the EPO) and a statement of reasons is to be furnished.

Restoration of right of priority at the EPO as receiving office

The EPO applies the due care criterion. The starting point is that the primary responsibility lies with the applicant. If an agent is hired, it must be shown that proper instructions were sent to the agent and that the agent applied due care by virtue of his responsibility. The standard of ‘all due care’ is therein well developed in accordance with the jurisprudence of the Boards of Appeal; as expertise entails a higher standard, failure to file within the priority period is only dispensed if it is caused by an isolated mistake within a normally satisfactory system for monitoring time limits or by an exceptional circumstance. Where an isolated mistake was made by an assistant, it must be shown that the assistant is a

¹ See Information from the EPO in EPO OJ 2018, A47

² This summary is based on the presentation given by Isabel Auría Lansac.

suitable person well selected for the task, properly instructed and reasonably supervised by the responsible agent. Notwithstanding, the due care must not be interpreted in an excessive manner and the reference is an average, reasonably competent applicant and agent³.

Consequences for the national phase

In the national phase, designated offices normally accept restorations granted when the 'all due care' principle is applied. There are two exceptions, namely that (i) 15 designated offices notified incompatibility with national law and thus do not apply the provisions on restoration of the right of priority, and that (ii) a designated office may review the decision of restoration if it reasonably doubts that one of the substantive requirements for restoration is complied with.

On the other hand, if a Receiving Office grants restoration according to the 'unintentionality' criterion, this decision will only be effective in the designated offices applying this criterion. Thus, if a designated office does apply the 'all due care' criterion, priority will not be considered to be restored.

Restoration at the request at the EPO as designated office

A new request for priority restoration must be filed upon entry into the European phase, when either (i) no request was filed during the international phase, or (ii) the request was granted under the 'unintentional criterion' or (iii) the receiving office refused the request. The requirements for filing this request are set out in Rule 49ter.2 PCT. In addition, the EPO as designated office may review a decision to restore when it has reasonable doubts as to whether one of the substantive requirements for restoration was complied with.

³ For further details, see paragraphs 166A to 166T of the PCT receiving office guidelines PCT/GL/RO/17 available at <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ro.pdf>

Earlier start of International Preliminary Examination

The final part of the presentation by Mrs Auria Lansac was dedicated to prospective changes to the PCT legal framework and, in particular, to the proposed amendments to Rule 69.1(a) PCT as approved at the last meeting of the PCT Working Group.

International Preliminary Examination must be requested by filing a demand within the deadline foreseen in Rule 54bis.1 PCT. However, under current Rule 69.1(a) PCT, International Preliminary Examination shall not start until the expiry of the time limit for filing the demand, even if the demand was filed well before the expiry of the deadline contained in Rule 54bis.1 PCT, unless the applicant expressly requests an earlier start.

The latter prohibition does have some drawbacks, as it reduces the effective period for the preliminary examination and thus the time for drafting a second written opinion. In fact, considering that the International Preliminary Examination Report must be ready at 28 months from priority, this leaves only six months for the preliminary examination.

The proposal is therefore to remove the said prohibition and to introduce a systematic earlier start of the International Preliminary Examination, unless the applicant expressly requests to postpone the start until the expiry of the deadline for filing the demand. This will allow more time for dialogue between the applicant and the examiner and therewith higher chances to obtain a positive IPER. It is the hope that the Chapter II procedure will therewith become more even more attractive and useful.

The proposed amendments to Rule 69.1(a) PCT will be submitted to the PCT Assembly at its next session in Autumn 2018.

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Price-Winning Inventors of Michelin's Auto-Regenerating Tyre Tread Band Regenion, Patented as EP2379352B1

M. Nollen (BE)

Not every patent application becomes an important business instrument. Some do, and can be the basis for a profitable business or a fortune of royalties. When reading back, we can recognize therein the technical creativity or genius that proposed a model of new products to follow. One of the marvellous aspects of the patent profession is to work on such patents and to recognize and defend the important innovation therein.

Such inventions and their patent attorneys deserve an award – at least this is the concept behind the European Inventor Award. Each year since 2006, the EPO provides five such awards in different categories. There is no prize money as such, as the patent protected invention should already be profitable, but a lot of valuable positive

publicity. **epi**-information asked the patent attorney behind one of this year's Awards to tell his story.

This year, 2018, the European Inventor Award in the category of Industry went to Jacques Barraud (deceased) and Agnes Poulbot of Michelin for their invention of an auto-regenerating tyre tread (patented as EP2379352B1). Behind these inventors stand two patent attorneys from the Michelin patent department: Christian Diernaz who wrote the patent application and Stéphane Le Cam who put together the file for this award.

Can you shortly introduce the field of technology, and some of the key technical problems and issues therein?

The adhesion of tyres to the road or soil is determined by the humidity of the soil. On a dry road, there is good adhesion as nothing opposes the contact between the rubber and the road. However, this is different when it is wet; too much humidity results in a water film between the tyre and the road, which limits adhesion/grip. Tyres therefore contain channels and zones suitable for storage and removal of the water. Traditionally, tyres merely had channels exposed to the surface and the storage capacity significantly reduced during use of the tyre.

Can you explain the inventive gist of the invention?

The inventors came up with the idea to provide cavities in deeper regions of the tyre. These regions will appear at the surface after a certain usage of the tyre, and thus increase the water capacity. The effect is further increased by supplementary channels extending between such cavities, which allow absorption of a water film. In this manner, the lifetime of a tyre is extended with 15-20%. It was moreover found that such cavities make a new tyre less deformable and therefore reduce the petrol consumption with up to 10%.

When receiving the invention, was it clear to you that this was an important and breakthrough invention, and if so why?

It was in 2007 or in the beginning of 2008 that I first heard of the invention. For us, in the patent department, the importance of the invention was clear from the angle of functionality. However, its realisation was less straightforward. Tyres are produced by insert moulding technology using moulds. In fact, the realisation required fabrication of specific metallic moulds. This was achieved by means of additive manufacturing using laser sintering, also known as metal 3D printing.

Have you applied specific procedural options to ensure full patentability (for instance national search report, PCT-II, filing several applications to obtain claims of different scope, filing divisional etc)?

We have not done anything particular for the case. Contrarily, since the filing of the first patent we have filed many more applications on the same subject, so as to protect implementation details and modifications. Today, more than hundred patent families exist on the technology.

Was the patent easily granted? Did the patent examiners immediately see and recognize the inventive merit, or was it needed to explain this?

Yes, the granting was easy.

Can you say something more about the Award process?

I prepared the nomination. All subsequent communication was made between the EPO and one of the inventors. The inventor received a letter from the EPO that they have been selected as finalists (3 per category) and invited them to get into contact with the EPO. Normally, all inventors would have been involved, but unfortunately the other inventor died.

As the patent attorney and submitter of the nomination, I supported the process in the background. This started with two telephonic conversations, one of which is an interview with the agency that will prepare two video films (of about 5 and 3 minutes respectively)¹. The person in charge of the video scripts was a German science journalist who was very competent. He well understood the invention and rendered it comprehensible by means of images. The videos were then recorded at Michelin in two days by a film team using the film script.

Did you get additional questions from the Jury to respond? And did you need to defend the patent?

The jury is responsible for making the final selection from the finalists. There was no contact with the jury that clearly made its decision on the basis of the file prepared by us and without doubt also looking at the patent. There were no questions on the patentability, but rather on the invention and its importance. There were furthermore questions on the personality of the inventors.

What it a surprise to the inventors and/or you to be selected as a winner?

Yes, evidently we were surprised. We had presented the case in the best possible manner with little hope. When we heard that we were among the three finalists in our category, our hope went on rise but remaining doubtful, but it remained a surprise as the other finalists seemed also very good.

*Nominations for the 2019 European Inventor Award are open until 28 September 2018. As expressed by the **epi** President, Francis Leyder, there were hardly any submissions made by patent attorneys. We would like to stimulate patent attorneys to submit nominations for their inventors.*

The Editorial Committee is interested to get into contact with further patent attorneys who would like to be interviewed on their award winning inventor.

¹ See the short film (2 minutes) at <https://www.youtube.com/watch?v=UcoF9XU7uV0>, and the journalistic film (6 minutes) at <https://www.youtube.com/watch?v=yIFolKVN6sw>

Implications of the General Data Protection Regulation (GDPR) for Detecting Infringement of Artificial Intelligence (AI) Patents

Why is the ability to detect patent infringement important?

R. Free, L. Pugh (GB)

New AI technology typically comprises new algorithms which express new ways of learning, new ways of representing data, new ways of searching through large search spaces to find solutions and other processes which enable AI technology to act in intelligent ways. Helping clients to protect this type of technology using patents is challenging in a number of ways, one of which is that it is often very difficult to detect infringement of patent claims which contain details of AI algorithms.

A patent claim sets out the scope of monopoly held by the patent owner and generally speaking, can be thought of as a list of features, such as a list of things to do in the case of an invention which is a method. Generally speaking, a competitor infringes the method claim when the competitor does all the things in the list. The things in the list are referred to as features. Features of the algorithms relating to inputs to the algorithms and outputs of those algorithms are features which can sometimes be observed in competitor products, from application programming interfaces, or found from product literature. However, features about types of computation and types of representation used by the algorithms are much harder to detect in competitor products. Sometimes an educated guess can be made that a competitor product is likely to be using a particular type of algorithm, but to be certain of this is often not possible. As a result the value of the AI algorithm patent may be significantly reduced because the patent cannot be effectively exploited through licensing. Turning to trade secrets as an alternative form of protection is often not possible where for commercial reasons the details of the algorithms are made public.

One option for applicants is to try to reduce the features of the algorithm in the patent claim which are not easy to detect and instead try to include features related to the application domain (i.e. the task the AI is being used for), any observable user inputs, and any observable data or sensor inputs and outputs to the algorithm from other sources. However, often the application domain itself is not a technical one and so the applicant is forced into finding a technical problem and solution within the algorithmic detail. Examples of non-technical application domains include online advertising, linguistic processing and presentation of information.

Why is the GDPR potentially relevant for detecting infringement of AI patents?

The GDPR is new European Union law in relation to the processing of personal data and from 25 May 2018 applies across the EU.

The principles of the GDPR include that personal data shall be processed lawfully, fairly and in a transparent manner (see GDPR Article 5). The transparency requirement means that a data controller has to disclose various information and there could be a possibility that the disclosed information is helpful for detecting patent infringement. The disclosed information is made without a duty of confidence.

Generally speaking, the definition of personal data in the GDPR is very broad. Personal data is information that relates to an identified or identifiable individual (a so called 'data subject') and may include data identifying a person, such as a name, internet protocol address or telephone number. Where personal data is collected from a data subject, the data controller (being the person that determines the purposes and means of processing of the personal data) is obliged by GDPR Article 13 to provide the data subject with various information at the time the personal data is collected. In certain circumstances, the information to be provided includes "*the existence of automated decision-making, including profiling, referred to in Article 22(1) and (4) and, at least in those cases, meaningful information about the logic involved, as well as the significance and the envisaged consequences of such processing for the data subject*".

Article 22 of the GDPR is about automated decision-making. Article 22 states in paragraph 1 that, "*The data subject shall have the right not to be subject to a decision based solely on automated processing, including profiling, which produces legal effects concerning him or her or similarly significantly affects him or her.*" A data subject is able to give his or her explicit consent so that the prohibition in paragraph 1 is lifted. Important things to note include that Article 22 has the word "solely" so that it reads "a decision based solely on automated processing". Also, it says that the decision is one "which produces legal effects concerning him or her or similarly significantly affect him or her".

Given that the GDPR sets out that data controllers must disclose “*meaningful information about the logic involved*” in certain circumstances it could be that such disclosures are useful for detecting infringement of algorithm patents.

How should we interpret “meaningful information about the logic involved” in the GDPR?

There are various documents available to help us interpret the wording in the GDPR and these include the *Guidelines on Automated Individual Decision-making and Profiling for the Purposes of Regulation 2016/679*, last revised and adopted on 6 February 2018, by the Article 29 Data Protection Working Party; and the UK Information Commissioner’s Office detailed guidance on automated individual decision-making and profiling which was published on 23 May 2018 (these two documents are referred to herein as the “**Guidance Documents**”). The Guidance Documents suggest that it is not necessary to disclose the full details of an AI algorithm as a result of the GDPR. However, it is necessary to disclose some details of the AI algorithm as explained in the next section of this document.

Not necessary to disclose the full details of an AI algorithm

The Guidance Documents make it clear that a data controller does not have to disclose the source code of the AI algorithm, does not have to give a complex explanation of the algorithms used, and does not have to disclose the full algorithm. Practically, a lay person is not going to be able to understand a complex explanation or source code anyway. Also, the authors of the Guidance Documents were presumably aware that scientists currently have no good way to explain the predictions computed by deep neural networks.

What does have to be disclosed?

The following list of what has to be disclosed has been compiled by the author from the Guidance Documents. The list uses verbatim wording from the Guidance Documents where possible and contains duplication and overlap, since as many relevant extracts from the Guidance Documents as possible have been included. The circumstances in which disclosure has to be made are discussed later.

- The criteria relied on in reaching the decision
- The rationale behind the decision
- Information which is sufficiently comprehensive for the data subject to understand the reasons for the decision
- Meaningful information about the logic involved
- The likely consequences for individuals
- Why the data controller is using the automated decision-making process and the likely results

- Categories of data that have been or will be used in the profiling or decision-making process
- Why these categories are considered pertinent
- How any profile used in the automated decision-making process is built including any statistics used in the analysis
- Why the profile is relevant to the decision-making process
- How the profile is used for a decision concerning the data subject
- Controllers may wish to consider visualization and interactive techniques to aid algorithmic transparency
- The type of information collected or used in creating a profile or making an automated decision
- Why this information is relevant
- What the likely impact is going to be/how it’s likely to affect them

In the Guidance Documents there is an example given about a data controller who uses credit scoring to assess and reject an individual’s loan application. The score is computed automatically based on information held by the data controller. The example goes on to state that the if the credit score is used to reject an individual’s loan application, then the data controller is obliged to explain that the scoring process helps them to make fair and responsible lending decisions (i.e. the rationale behind the decision) and that the data controller should provide details of the main characteristics considered in reaching the decision, the source of the information and the relevance.

In the example it could be that automated statistical rules are used without any AI technology. However, it could also be that a neural network is used to predict the credit score. Thus the example is relevant both in the case that machine learning is involved and in the case where there is no machine learning involved. The example is useful to help understand what information will be disclosed. A discussion of how the disclosed information may help with detecting patent infringement is given later in this document.

What are the conditions which have to apply in order for a data controller to disclose “meaningful information about the logic involved” to the data subject?

At least the following conditions have to apply:

- an automated decision using personal data;
- the decision is solely automated;
- the decision has a legal or similarly significant effect on the data subject; and
- the decision is necessary for entering into, or performance of, a contract between the controller and data subject; the decision is authorized by EU or Member State law; or the decision is based on the individual’s explicit consent.

With regards to “solely automated” note that it is not enough to have a cursory human review of the output of the AI algorithm. As explained in the Guidance Documents, to avoid “solely automated” a human needs to “*weigh up and interpret the results of an automated decision before applying it to the individual*”. Also, a process is still “*considered solely automated if a human inputs the data to be processed, and then the decision-making is carried out by an automated system*”.

Going forwards it is likely that automated decision-making will be increasingly used in situations where the above conditions do apply, however, in cases of contract and explicit consent, human intervention does still have to be available on request of the data subject. This increase is because of the business case involved, in particular around cost savings. In addition in the case of the use of AI, AI is already more accurate than humans at many tasks and this will increase in terms of the variety of tasks where AI outperforms humans and the level of outperformance.

Fictitious example

Suppose a new algorithm is created which learns from many recordings of calls to an alcoholic beverage delivery service. The calls are labelled as being from adults or children, and consent has been obtained to use the data. The algorithm is able to learn from the examples and to generalize its learning so that it can predict with accuracy, whether a new incoming call is from a person who is old enough to legally buy alcoholic drinks.

Once the algorithm has been trained it is then used as part of a delivery service selling alcoholic drinks. When a customer calls the service the customer is asked to give consent to an automated decision being made as to whether the customer is old enough to purchase alcoholic drinks. If consent is given, the incoming call is then used by the trained algorithm to predict the age of the customer and make the automated decision. In this case the GDPR provisions regarding disclosing “meaningful information about the logic involved” arguably apply, since the decision is solely automated, uses data which identifies a person (his or her voice), has a significant effect on the person (ability to buy a product), and is made with the consent of the user.

Suppose there is a patent protecting the technology. The details of the patent claim include that the algorithm learns using features of the calls, including the voice of the caller, the geographical location of the originating phone and the time of day of the call. If a competitor launches a similar service then it is very difficult to tell whether the competing service infringes the patent claim because it is not known whether the same features are used. However, the GDPR requires that the criteria for the decision are disclosed, and the categories of data used are disclosed. Therefore there is a strong argument that infringement of the patent will be found through disclosure of the “meaningful information about the logic involved” to the data subject.

If we modify this example slightly we can see a situation where the GDPR is less helpful for detecting patent infringement. Suppose the artificial intelligence has learnt using features of the voice recordings computed from fast Fourier transforms of the voice signals and without using any other categories of data except the age of the callers. In this case the GDPR requires that the data controller discloses that the algorithm has reached its decision using features of the voice recordings computed from the voice signals themselves. This is not enough to detect infringement since there are many ways to compute features from an audio signal and the data controller does not have to disclose the particular details of the algorithm according to the Guidance Documents.

How to find a practical way for data controllers to give “meaningful information about the logic involved”?

The authors of the Guidance documents had the difficult problem of how to find a practical way for data controllers to give “meaningful information about the logic involved” to members of the public. Providing source code is not useful because often, even to expert programmers, messy source code is difficult to interpret. Providing algorithm design documents would explain the logic involved but is likely to bamboozle the lay member of the public. Even more difficult is the situation where deep neural networks are used where scientists currently have no easy ways of explaining the computed decisions. However, one approach which is more pragmatic and practical is the counterfactual approach which has seemingly been followed, at least in part, in the Guidance Documents mentioned above.

The counterfactual approach

Under the counterfactual approach the term “meaningful information about the logic involved” is interpreted as giving information to the data subject to enable him or her to understand what things the data subject needs to change in order to obtain a different outcome of the automated decision-making process. The Guidance Documents go some way towards the counterfactual approach because they speak about giving information to the data subject about the rationale, and about the categories of data used. If the categories of data are known, the data subject can think about how to modify his or her data within those categories in order to obtain a different outcome of the automated decision.

For the purposes of detecting patent infringement, the counterfactual approach is not as useful an approach as disclosing the full algorithm. However, the counterfactual approach is still useful, especially if more than one observation is taken into account. That is, suppose I collect automated decision outcomes made by a competitor service. I collect data about automated decision

outcomes over different data subjects, over different times, and over different values of the personal data in the disclosed categories. I potentially collect a very large number of sets of values in this manner and then use them to infer how the automated decision was computed. However, collecting data about multiple automated decision outcomes will be time-consuming and costly. Making the inferences will also be time-consuming and costly.

Tips for patent drafting

To make patent claims more valuable we can think about including features which are likely to be disclosed as a result of the GDPR requirements and minimizing the use of features which relate to mathematical or computational detail. Features likely to be disclosed pursuant to the GDPR will be features concerning the categories of data used by the artificial intelligence algorithm, the criteria used, and features about the overall application domain (i.e. the reason for the automated decision-making process).

Conclusion

In conclusion, the GDPR will be useful for detecting patent infringement in cases where patents are directed to AI algorithms for making automated decisions, and where the requirements of the GDPR to disclose “meaningful information about the logic involved” apply. Information about categories of data used by algorithms and about rationale for automated decisions is publicly disclosed in some situations and can be used to help detect patent infringement. Collecting multiple sets of data about observed automated decisions and using them to infer how the automated decision algorithm works in detail is potentially possible, but will be costly and time intensive.

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Dealing with Non-Technical Features before the EPO

M. M. Fischer (DE)

Inventions having a mix of technical and non-technical features are allowable before the EPO and can often be found in the realm of computer implemented inventions, a field with an ever increasing number of applications and of great importance for our technological future. This alone but also the recent decision T 2101/12 of 24 January 2018, which expressly puts itself in contradiction with Catchword 2 of T 172/03 of 27 November 2003, gives occasion to recap the EPO's practice regarding non-technical features.

1. Introduction

The COMVIK approach (T 641/00) is well established case law of the Boards of Appeal and gives guidance on how to deal with inventions defined by a mix of technical and non-technical features. This approach is further elaborated in T 931/95 (Pension Benefit Systems Partnership), T 258/03 (Hitachi), T 154/04 (DUNS) and G3/08. To be precise, the case law and the Guidelines distinguish between three groups of features, a) technical features “as such”, b) non-technical features “as such” and c) features which, when taken in isolation, are non-technical, but do, in the context of the invention, contribute to producing a technical effect serving a technical purpose, thereby contributing to technical character of the invention (Guidelines G-VII, 5.4). For instance, features relating to mathematics/algorithms may belong to group c). Only features of group b) cannot support the presence of an inventive step.

2. Non-technical features in the claims

T 154/04 of 15 November 2006 says that it is legitimate to have a mix of technical and “non-technical” features appearing in a claim, in which the non-technical features may even form a dominating part of the claimed subject matter. Novelty and inventive step, however, can be based only on technical features, which thus have to be clearly defined in the claim. Non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem, i.e. non-technical features “as such”, do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and inventive step.

The steps below outline the application of the problem-solution approach to mixed-type inventions, also referred to as “COMVIK approach” or “modified problem-solution approach” (G-VII, 5.4).

- (i) The features which contribute to the technical character of the invention are determined on the basis of the technical effects achieved in the context of the invention (see GII, 3.1 to 3.7).
- (ii) A suitable starting point in the prior art is selected as the closest prior art based with a focus on the features contributing to the technical character of the invention identified in step (i) (see GVII, 5.1).

(iii) The differences from the closest prior art are identified. The technical effect(s) of these differences, in the context of the claim as a whole, is(are) determined in order to identify from these differences the features which make a technical contribution and those which do not.

(a) If there are no differences (not even a non-technical difference), an objection under Art. 54 is raised.

(b) If the differences do not make any technical contribution, an objection under Art. 56 is raised. The reasoning for the objection should be that the subject-matter of a claim cannot be inventive if there is no technical contribution to the prior art.

(c) If the differences include features making a technical contribution, the following applies:

- The objective technical problem is formulated on the basis of the technical effect(s) achieved by these features. In addition, if the differences include features making no technical contribution, these features, or any non-technical effect achieved by the invention, may be used in the formulation of the objective technical problem as part of what is “given” to the skilled person, in particular as a constraint that has to be met (see GVII, 5.4.1).
- If the claimed technical solution to the objective technical problem is obvious to the person skilled in the art, an objection under Art. 56 is raised.

The question whether non-technical features are also to be disregarded in the assessment of novelty is more of an academic one. Even though G 2/88, T 154/04 and T 688/05¹ answer this question in the affirmative and suggest the concept of “technical novelty”, this question does not seem to be undisputed and becomes important if the prior art document is prior art under Art. 54(3) EPC which was the case in T 2050/07 of 19 February 2013. However, the Board refrained from deciding the question because it came to the conclusion that the features in question did contribute to the technical character of the claimed invention.

3. Non-technical disclosures as prior art

a) T 172/03 (Board 3.5.01) of 27 November 2003

In T 172/03 the board went even one step further and held that non-technical disclosures were not even part of the prior art. The Catchwords read:

“1. The term ‘state of the art’ in Article 54 EPC should, in compliance with the French and German text, be

understood as ‘state of technology’, which in the context of the EPC does not include the state of the art in commerce and business methods. The term ‘everything’ in Article 54(2) EPC is to be understood as concerning such kind of information which is relevant to some field of technology.

2. From these considerations it follows that anything which is not related to any technological field or field from which, because of its informational character, a skilled person would expect to derive any technically relevant information, does not belong to the state of the art to be considered in the context of Articles 54 and 56, even if it had been made available to the general public before the relevant priority date (see points 8 to 10 of the reasons).”

This decision is also cited in Guidelines for Examination under G-VII, 2.

Although this decision was rendered by the same board (3.5.01) that devised the COMVIK approach, the question arises how T 172/03 fits together with the COMVIK approach. If non-technical features may be entirely disregarded in the problem-solution approach, it seems to be tautological that a non-technical disclosure is excluded from the prior art. To put it differently, if I am allowed to disregard non-technical features in the claims (and put them into the formulation of the problem), there is no need to show them in the prior art. Whilst T 172/03 is not in contradiction with the COMVIK approach, it appears that the question of whether a non-technical disclosure is part of the prior art is simply obsolete in view of the COMVIK approach. The COMVIK approach does not require disregarding non-technical features of the prior art. T 172/03 assumes that the skilled person is skilled in the field of technology and cannot be competent in non-technical fields. The skilled person can neither search nor assess prior art in non-technical fields and will contact a non-technical expert², if he is prompted to do so or he will get triggers to technical problems / solutions from the non-technical expert. Maybe, the rationale behind T 172/03 in view of the COMVIK approach is that if all non-technical prior art is excluded, then it cannot qualify as closest prior art and consequently a general-purpose computer must be selected as closest prior art. The reason for this is the following: In the field of computer implemented inventions, in particular business methods, a claim often has as technical feature only a “computing device”. All the remaining features are considered to be non-technical features. In an archetypal argumentation following the problem-solution approach, a (notoriously known) general-purpose computer is used as the closest prior art. Even though the non-technical

¹ “The concept of ‘novelty’ in Article 54(1) EPC is only defined for ‘inventions’. It does not apply to the exceptions enumerated in Article 52(2) EPC. By analogy it could be held that claim features which do not contribute to the definition of an ‘invention’ cannot be classified as new or not new in the sense of Article 54 EPC.”

² e.g. “notional businessman” as defined in T 1685/15 “Cardinalcommerce”

features are considered as a requirements specification and are put into the formulation of the objective technical problem, the objective problem remains a technical one since it typically relates to the implementation of the given non-technical concept/requirements specification by technical means. The next step in the argumentation is to say that starting from a general-purpose computer and given the requirements specification as part of the objective technical problem, the skilled person would face no problems in implementing the requirements specification using technical means. The implementation would be straight-forward since the implementation would not require surmounting any technical problems. In such an argumentation, the examiner would not have to search the non-technical features in the prior art.

Although the disregarded prior art in T 172/03 was a business method which is undisputedly non-technical, it appears that Catchword 2 of T 172/03 could be understood in the sense that even a per se technical teaching can be disregarded if it is disclosed in a non-technical publication/context since "because of its informational character, a skilled person would [not] expect to derive any technically relevant information" therefrom. The article "State of the art: Which art has to be considered?"³ by Martin Wilming gives six such examples, among those some comic strips, a scene from a James Bond movie and the Holy Bible⁴. I concur with the author that the 1949 Walt Disney comic in which a sunken ship had been raised by Donald Duck and his nephews by pushing ping pong balls into it to lift it up would have had to be considered as "state of the art" in the assessment of patentability of a later patent application. Moreover, the EPO explains in its Inventors' handbook: "A prehistoric cave painting can be prior art. A piece of technology that is centuries old can be prior art. A previously described idea that cannot possibly work can be prior art. Anything can be prior art."⁵ However, the Guidelines of Examination at G-IV 2 require that the prior art must be an enabling disclosure: "Subject-matter can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), if the information given to the skilled person is sufficient to enable him, at the relevant date (see GVI, 3), to practise the technical teaching teaching which is the subject of the disclosure, taking into account also the general knowledge at that time in the field to be expected of him (see T 26/85, T 206/83 and T 491/99)."⁶

b) T 2101/12 (Board 3.5.06) of 24 January 2018

The invention in T 2101/12 is in the field of electronic signatures for documents. The Board refused to accept D2 as closest prior art document and considered without giving any evidence that the most suitable starting point was common general knowledge, namely an authentication process at a notary's office. The appellant explained that something could only be state of the art if it were related to a technological field or a field from which, because of its informational character, a skilled person would expect to derive technically relevant information, referring to T 172/03. The Board countered as follows:

"6.5 According to the Board, the wording of Article 54(2) EPC is clear and requires no interpretation:

'The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application'

Article 54(2) EPC itself contains no limitation according to which a non-technical process, such as the signing of a contract at the notary's office, may not be considered state of the art.

6.6 The Board agrees with the appellant that this opinion is not in line with Catchword 2 of T 172/03 (as also relied upon in the Guidelines for Examination G-VII, 2), unless one interprets the expression 'technically relevant' in that Catchword in a trivial manner. The board however considers that the interpretation of Article 54(2) EPC given in T 172/03 is incorrect.

In T 172/03, Reasons 9, it is said that a consistent construction of the patentability provisions 'requires the term 'everything' in Article 54(2) EPC to be understood as concerning such kind of information which is relevant to some field of technology'. According to the Board, however, the legislator would have used a different term if such meaning had indeed been intended. A more appropriate expression would then for instance have been 'all technical information'. Instead, the wording of Article 54(2) EPC is unambiguous in that it contains an unqualified 'everything', in all three languages ("alles" in German and "tout" in French).

No provision in the EPC requires said term to be interpreted differently. In particular, the appearance of the terms 'Stand der Technik' and 'état de la technique' in respectively the German and the French version of Article 54(2) does not require it. It is precisely Article 54(2) which defines what should be understood as 'state of the art', and

³ <https://www.patentlitigation.ch/state-of-the-art-which-art-has-to-be-considered>

⁴ Whether or not this interpretation of Catchword 2 of T 172/02 was really intended, I have encountered this interpretation many times, not only in Martin Wilming's article. I am not aware of any decisions of the Boards of Appeal in which this interpretation of Catchword 2 of T 172/03 has been adopted.

⁵ <https://www.epo.org/learning-events/materials/inventors-handbook/novelty/prior-art.html>

⁶ http://www.epo.org/law-practice/legal-texts/html/guidelines/e/g_iv_2.htm

because it is a definition one cannot first ignore the definition, by saying that the term 'state of the art' should be interpreted in some sense, and only then start to read the definition in the light of that interpretation. This is however exactly what is done in T 172/03 Reasons 9.

As to the statement in T 172/03 Reasons 9 that it 'can hardly be assumed that the EPC envisaged the notional person skilled in the (technological) art to take notice of everything, in all fields of human culture and regardless of its informational character', the board observes that there is in this respect no difference with 'technical' prior art, i.e. a skilled person will not take notice of any prior art, regardless of whether it is technical, if it does not contain information that is useful to him or her as a skilled person. On the other hand, if some generally known information is useful, even if it should be designated 'non-technical', there is no reason why the skilled person would ignore it.

6.7 The Board further notes that the statement made in Catchword 2 of T 172/03 is not part of established jurisprudence. Most notably, this limited view on prior art has not been mentioned in the summary of the pertinent case law given in T 154/04 DUNS (see point 5 of the reasons), which G 3/08 has referred to for its summary of the case law (see point 10.7.1 and 10.13.1 of the reasons)."

The Board came to the conclusion that an authentication process at a notary's office constitutes a valid prior art under Article 54(2) EPC and may be used as the starting point in an inventive step analysis. Setting out from this process, the Board continued its argumentation by saying that the desire to automate human activities is a constant one. The Board therefore deemed it obvious that at some point the skilled person will want to automate said activity. The Board furthermore considered it obvious that a skilled person wishing to implement such automation would use commonly available tools for this purpose. The Board concluded that the claimed subject-matter did not involve an inventive step.

Thus, in T 2101/12 a publicly known entirely non-technical practice has been selected as the closest prior art. This is in contradiction with T 172/03, which considers only a technical teaching to be a prior art, and also seems to be in contradiction with step (ii) of the COMVIK approach outlined above which requires, in the selection of the closest prior art, a focus on the features that contribute to the technical character of the invention.

Finally, the Board refused that the following questions be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC:

"1. In the assessment of the inventive step of subject matter presenting both technical and non-technical aspects, is it compatible with the holding in T 172/03 and the 'COMVIK' approach to conduct a problem-solution analysis using a publicly known entirely non-technical practice as 'closest prior art', notwithstanding the existence of technical teachings in the same field?

2. If the first question is answered in the affirmative, does it make any difference whether there is a substantial body of prior technical teachings in the field, or only a small number of isolated publications?"

The reason for not referring the questions to the Enlarged Board of Appeal is that the Board has not identified any questions that would need to be answered by the Enlarged Board of Appeal, in order for the present Board to be able to reach its decision. In particular, the Board answered the first question in the negative. However, having given reasons for its deviation from Catchword 2 of T 172/03 (Article 20(1) RPBA, see point 6.6 above), the Board did not have to refer the question to the Enlarged Board of Appeal. The second question depends on an affirmative answer to the first question and thus does not arise.

4. Conclusion

Catchword 2 of T 172/03 is in contradiction with T 2101/12. While T 172/03 is in line – albeit possibly obsolete – with the COMVIK approach, T 2101/12 challenges the COMVIK approach since it took a publicly known entirely non-technical practice as closest prior art. Although there may be good reasons not to follow the harsh decision of T 172/03 to exclude all non-technical disclosures (and possibly even technical disclosures in a non-technical context) from the prior art and in view of the fact that the approach taken by the Board in T 2101/12 may not lead to a different outcome than the COMVIK approach, a deviation from the COMVIK approach seems to be a development in the case law that may cause (unnecessary) uncertainty and confusion among the users of the European patent system. Unfortunately, a referral to the Enlarged Board of Appeal, which could have clarified the situation, has been refused. In view of the importance of the questions of the referral regarding the field of computer implemented inventions, this is regrettable.

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Please also write to this e-mail address, if you wish to subscribe to the author's quarterly newsletter on computer implemented inventions.

Disclaimer, Union IP Position Paper

Note from the Editorial Committee:

It is our intention to inform our members of developments and/or opinions of members and others in the field of IP. We therefore scrutinise rigorously requests for publication in **epi** Information with we trust transparency and fairness. There is, however, an understood caveat that the views and opinions expressed in documents that are published are

solely those of the author(s), and not those of the **epi** or of the Editorial Committee. Neither the **epi** nor our Committee endorses the views and opinions expressed in documents selected for publication. With the above statement in mind, we publish below for the information of our members a position paper recently submitted to us by UNION IP.

Position paper on Client-Attorney Privilege in IP advice

R. Wijnstra, President of Patents Commission of UNION-IP

M. Baccarelli, President of IP Litigation Commission of UNION-IP

UNION-IP is an association of practitioners from different European countries in the field of IP, that is of individuals whose principal professional occupation is concerned with patents, trademarks or designs and related questions and who carry on their profession independently or as employees.

UNION-IP was asked to produce a position paper on client-attorney privilege for patent advisers. Client-attorney privilege in the IP context should be considered as the right to resist requests from authorities or other parties to disclose communications between a person and that person's IP advisor. We find that it is unacceptable that IP professionals, who are obliged to keep information confidential under one national law, may face criminal prosecution in other countries for complying with this obligation.

With regard to the WIPO study on Patent Attorney privilege, the agreed position between the Patents and the Litigation Commissions of the **UNION-IP** is that we endorse the position taken by the **AIPPI** and we wish to continue as an interested observer. We refer to the Joint Proposal of the AIPLA, AIPPI and FICPI, reproduced below (completed with our comments):

IN ORDER to give effect to the statements recited above, the nations cited in the Schedule to this Agreement have executed this Agreement on the dates stated respectively in that Schedule.

The nations so cited AGREE as follows.

1. In this Agreement, 'intellectual property advisor' means a lawyer, patent attorney or patent agent, or trade mark attorney or trade mark agent, or other person, where such advisor is officially recognized as eligible to give professional advice concerning intellectual property rights.

Comment: we note that the qualification of "IP advisor" is unclear and the following must be taken into account:

- Contrary to common law countries, in many civil law countries, there is generally no protection for in-house counsels since they are considered to be a separate profession and do not enjoy the same status as attorneys.
- In some countries it could be unclear whether "patent attorney" is a qualified professional or not. For instance, in Sweden, the title "patent attorney" is not protected, thus any one may say that they are a patent attorney even though they do not possess any relevant education at all.
- In other countries, even communications with third parties can be covered by privilege. For instance, in the UK, the protection by privilege covers communications between lawyer or client and a third party which come into existence for the dominant purpose of being used in connection with actual or pending litigation ("litigation privilege").

Our position is that the IP advisor should be a qualified professional, duly authorized in accordance with domestic law and to whom exist adequate regulation. In this respect, we find beneficial if each country should provide WIPO with the specific categories of advisers whose clients benefit from privilege under this standard.

'intellectual property rights' includes all categories of intellectual property that are the subject of the TRIPS agreement, and any matters relating to such rights.

Comment: we find that the use of the expression "any matters relating to such rights" is unclear and could be enhanced by including some examples that would allow the reader to understand the full scope of this definition.

'communication' includes any oral, written, or electronic record whether it is transmitted to another person, or not.

Comment: we find that such wording could be enhanced if redrafted the definition as following:

"communication includes any communication made by any means (for example, oral, written, or electronic record) irrespective of the country of origin of that communication, whether it is transmitted to another person authorized to receive such communication or not", as doubt to the application of the agreement may arise in relation to cross-border communications.

'professional advice' means information relating to and including the subjective or analytical views or opinions of an intellectual property advisor but not facts including mere statements of fact which are objectively relevant to determining issues relating to intellectual property rights (for example, the existence of relevant prior art).

Comment: we suggest that the reference to "facts including mere statements of fact" could be further explained in order to avoid misinterpretations of the scope of the exception.

2. *Subject to the following clause, a communication made for the purpose of, or in relation to, an intellectual property advisor providing advice on or relating to intellectual property rights to a client, shall be confidential to the client and shall be protected from disclosure to third parties, unless it is or has been made public with the authority of that client.*
3. *Nations may have and apply specific limitations, exceptions and variations on the scope or effect of the provision in clause 2 provided that such limitations and exceptions individually and in overall effect do not negate or substantially reduce the objective effect of clause 2 having due regard to the need to support the public and private interests described in the recitals to this Agreement which the effect of*

the provision in clause 2 is intended to support, and the need which clients have for the protection to apply with certainty.

Comment: we highlight that there are already specific limitations which cover communications from patent attorneys. For instance, in the context of the future Unified Patent Court (UPC), the Proposed Rule 287 provides that advice from lawyers and non-lawyer patent attorneys are privileged from proceedings before UPC. Also, Rule 153 of the European Patent Convention (EPC) provides that advice from "professional representatives" to client are privileged from disclosure in proceedings before European Patent Office. However, there are two specific issues regarding the application of this specific rule:

- Article 64 (3) EPC makes reference to national law in case of infringement of a European patent, so it expands significantly the scope of such protection by national laws ; and
- Rule 153 was amended under French law on 21 October 2008 and the amended version entered into force on 01 April 2009, so it is unclear if the privilege applied to communications/advice before this date.

Considering the above, **UNION-IP** thinks that it will be very difficult to implement a system which prevents states from limiting, excepting or varying the scope of the effect of the provisions in clause 2. We tend to believe that the "weakest protection", which cannot be abolished by the state in any circumstance, would be the best solution, provided that it does not reduce the protection provided for by clause 2.



Done on 10 December 2017 at Amsterdam.

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